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Gender-neutral language
Any references to persons made in the “Case Law of the Boards of Appeal” publication are to be understood as being gender-neutral.

Foreword to the eleventh edition

The first edition of the "Case Law of the Boards of Appeal of the EPO" (CLB) publication was printed in 1993, compiling six special editions of the Official Journal on important decisions of the Boards of Appeal up to that time. By then, the Boards of Appeal had decided on some 5 000 cases.

More than three decades after the first edition of the CLB and almost 50 years since the first decision of the Boards of Appeal was issued, the Boards of Appeal have dealt with over 67 000 cases and issued over 45 000 decisions.

The present new edition reflects almost 9000 important decisions from the Boards of Appeal and provides updates on the evolution of the case law through to the end of 2024.

The CLB has since become an integral and highly valued resource for the work of patent attorneys in particular, the judiciary in the EPC contracting states and beyond, as well as in-house and outside counsel. This was confirmed by the results of a survey conducted by the Boards of Appeal in 2024, in which 85% of patent attorneys replying to the survey stated the main reason for using the CLB was for the preparation of cases and/or applications.

Since the 10th edition in 2022, which was the first digital-only edition of the CLB, there have been many changes.

Interim revisions of selected chapters were introduced for the first time in 2024, keeping users updated on the most recent and important changes between triennial editions. These included in particular the case law and approaches following Enlarged Board decisions as well as the developing jurisprudence on the application of the revised Rules of Procedure, which came into force in 2020.

These interim revisions will continue on an annual basis and will be available in the HTML version of the publication, allowing for a more dynamic and up-to-date insight into the development of our jurisprudence.

Furthermore, our regularly published abstracts of decisions, which summarise key aspects of selected BoA decisions as they are published, are available every month on a dedicated webpage. On a quarterly basis, the abstracts are updated on the "New Decisions" sidebar in the relevant section of the HTML version. This enables users to read the abstracts in the context of the relevant chapter more regularly and stay updated on recent case law on a certain topic.

I wish to sincerely thank the Legal Research Service of the Boards of Appeal for their dedication and commitment to provide this important trilingual resource, not only every three years but to ensure more frequent updates for the user community and our key stakeholders. My thanks also go to the EPO's Language Service for the translation of the

text spanning over 2 000 pages, as well as the Publications and IT teams for their co-ordination and support to publish the 11th edition.

I hope you find it useful.

Carl Josefsson

President of the Boards of Appeal

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User guide

1. Structure and additional features of the HTML version

The Case Law of the Boards of Appeal publication (CLB) is published in electronic formats only (HTML and PDF). The HTML version has additional features allowing users to stay up-to-date between full editions.

The left navigation bar/menu can be expanded chapter-by-chapter, sub-chapter-by-sub-chapter, for an overview of the structure and table of contents. If you would like to search for specific terms in the chapter structure of the CLB, this can be achieved by clicking on "Detailed table of contents" near the top of the navigation bar/menu. Learn more about searching the CLB in the "Search the Case Law of the Boards of Appeal" section.

The HTML version also features the "New decisions" sidebar on the right of the main text for each section or chapter. This list is updated quarterly with abstracts of decisions, which summarise key aspects of selected decisions that were issued after the CLB's publication, allowing users to review them briefly in their thematic context.

Between the triennial editions of the CLB, the HTML version is updated annually with interim revisions and updates of selected sections. The revisions can be viewed in the HTML version only; the PDF version remains unchanged for any given edition. Any changes to the relevant webpages are flagged accordingly with a notice in the heading.

2. Abbreviations

AAD	Arrangements for the automatic debiting procedure
ADA	Arrangements for deposit accounts
AI	Artificial intelligence
BDS	Business Distribution Scheme
Biotech Directive	Directive 98/44/EC of the European Parliament and of the Council of 6 July 1998 on the legal protection of biotechnological inventions
BlfPMZ	Blatt für Patent-, Muster- und Zeichenwesen (German periodical)
Budapest Treaty	Budapest Treaty on the International Recognition of the Deposit of Microorganisms
CJEU	Court of Justice of the European Union
CLB	"Case Law of the Boards of Appeal" publication
Corr.	corrigendum
DBA	Disciplinary Board of Appeal
DG	Directorate General of the European Patent Office
EC	European Community
ECHR	Convention for the Protection of Human Rights and Fundamental Freedoms
ECtHR	European Court of Human Rights
Enlarged Board	Enlarged Board of Appeal
EPC	European Patent Convention

epi	European Patent Institute (Institute of Professional Representatives before the European Patent Office)
EPO	European Patent Office
EQE	European qualifying examination
EU	European Union
FICPI	International Federation of Intellectual Property Attorneys
Guidelines	Guidelines for Examination in the European Patent Office
IPEA	International Preliminary Examining Authority
IPER	International Preliminary Examination Report
IPREE	Implementing provisions to the Regulation on the European qualifying examination for professional representatives
ISA	International Searching Authority
ISPE Guidelines	International Search and Preliminary Examination Guidelines
Legal Board	Legal Board of Appeal
OJ	Official Journal of the European Patent Office
OJ SE	Special Edition of the Official Journal of the European Patent Office
Paris Convention	Paris Convention for the Protection of Industrial Property
PCT	Patent Cooperation Treaty
RDR	Regulation on Discipline for Professional Representatives
REE	Regulation on the European qualifying examination for professional representatives
Register	European Patent Register
RFees	Rules relating to Fees
RPBA	Rules of Procedure of the Boards of Appeal
RPDBA	Additional Rules of Procedure of the Disciplinary Board of Appeal
RPEBA	Rules of Procedure of the Enlarged Board of Appeal
TRIPS	Agreement on Trade-Related Aspects of Intellectual Property Rights
UPOV	International Union for the Protection of New Varieties of Plants
USPTO	United States Patent and Trademark Office
Vienna Convention	Vienna Convention on the Law of Treaties
WIPO	World Intellectual Property Organization
WTO	World Trade Organization

3. Citations

(a) Generally, for all legislative provisions only superseded legislation will indicate the year. The text of the EPC as revised in 2000 and which entered into force in 2007 is cited without the attribute "2000". The text valid before that is cited as "EPC 1973". The Rules of Procedure of the Boards of Appeal in the revised version of 2020 (see OJ 2019, A63), including its subsequently amended articles, are cited as "RPBA". The Rules of Procedure of the Boards of Appeal in the version of 2007 (see OJ 2007, 536) are cited as "RPBA 2007". Prior versions are cited by the year of their entry into force. Please see the EPO website for the most up-to-date version of the EPC.

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

(c) If a decision of a board of appeal has been **published** in the OJ the reference is provided at its first mention in a chapter. Thereafter the OJ reference is generally omitted and is repeated for clarity reasons within the same chapter or sub-chapter as required. If a decision has **not** been **published** in the OJ, only the case number is cited.

(e) If more than one decision shares the same appeal number, the date of the decision is provided in addition.

(f) Previous editions of the "Case Law of the Boards of Appeal" publication are cited as "CLB, xth edn."

4. Case numbers

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

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

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

5. Search the Case Law of the Boards of Appeal

(a) Navigating the HTML version

The left navigation sidebar can be expanded chapter-by-chapter, sub-chapter-by-sub-chapter, for an overview of the structure and table of contents.

(i) Click on the chapter you are interested in and the text will appear in the centre of the screen.

(ii) While you are viewing your chosen chapter, you can continue to explore the contents of the CLB using the left navigation/menu without leaving your chosen chapter.

(iii) Your location in the structure of the CLB is highlighted in the navigation menu for your convenience.

(b) Quick keyword search

Both the HTML and PDF versions offer users the possibility to search key words or topics using the "Detailed table of contents". This replaces the "General Index", last included in CLB 9th edn., which was based on an alphabetical listing of the table of contents.

HTML version:

(i) Click on the "Detailed table of contents" on the lefthand navigation bar, which will open a new, expandable contents view in the centre of your screen displaying the section titles.
(ii) Click on "Expand all" in the upper right corner of the centre-view, or alternatively expand each section you are interested in.
(iii) Type Ctrl+F to search for your desired term. Your search term will be highlighted as it appears in each section.

PDF version:

A full detailed table of contents can be consulted at the starting of the publication, and can be read much like a print publication. This can also be searched using Ctrl+F, however this will also search the whole CLB, not just the table of contents.

(c) Advanced search

HTML version:

To optimise your search within the full-text HTML version of the Case Law of the Boards of Appeal:

(i) access the **Advanced Website Search Tool**

(ii) select the heading "Legal text"

(iii) in the "Filter options" sidebar, select the desired language for your search and select "Case Law of the Boards of Appeal" in the "Legal text" box.

(iv) type in your desired search term in the search field.

It is also possible to search in more than one legal text simultaneously. Simply select all desired sources in the "Legal Text" box.

The 11th edition of the Case Law of the Boards of Appeal also offers users the possibility to search on a topic basis using the "**Detailed table of contents**". This replaces the "General Index" from previous printed editions.

PDF version

By downloading the Case Law of the Boards of Appeal as a PDF, it is also possible to access the fully-expandable table of contents in the left-side margin and to use this to quickly navigate to the desired chapters. You will be able to access the table of contents while simultaneously viewing the text of the chapters. This expandable table of contents can be accessed by clicking on the "bookmarks", "contents" or similarly named tab in the PDF (browser/application dependent).

Alternatively, if you are searching for a specific term, simply use the "Ctrl+F" function to type in your search term for a full text search in the publication.

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1. Patent protection for technical inventions

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

Article 52(1) EPC expresses the fundamental principle of a general entitlement to patent protection for any invention in all technical fields (see **G 5/83**, OJ 1985, 64, point 21 et seq. of the Reasons; **G 1/98**, OJ 2000, 111, point 3.9 of the Reasons; **G 1/03**, OJ 2004, 413, point 2.2.2 of the Reasons; **G 1/04**, OJ 2006, 334, point 6 of the Reasons; **T 154/04**; OJ 2008, 46, 62, point 6 of the Reasons). Any limitation to the general entitlement to patent protection is thus not a matter of administrative or judicial discretion, but must have a clear legal basis in the EPC (see **G 2/12**, of 25 March 2015, OJ 2016, A28; **T 154/04**).

2. Whether there is an invention under Art. 52(1) EPC

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

The application of Art. 52(1) EPC presents a problem of construction as there was no legal or commonly accepted definition of the term "invention" at the time of conclusion of the Convention in 1973. Moreover, the EPO has not developed any such explicit definition since. Art. 52(2) EPC is merely a negative, non-exhaustive list of what should not be regarded as an invention within the meaning of Art. 52(1) EPC. It was the clear intention of the contracting states that this list of "excluded" subject-matter should not be given too broad a scope of application, as follows from the legislative history of Art. 52(2) EPC. Art. 52(3) EPC is a bar to a broad interpretation of Art. 52(2) EPC (**T 154/04**, OJ 2008, 46, point 6 of the Reasons; see also **G 2/12**, OJ 2016, A28).

The question of whether there is any invention at all within the meaning of Art. 52(1) EPC is to be treated as distinct from the question of whether it is susceptible of industrial application, is new and involves an inventive step. In **T 154/04**, the board distinguished the concept of "invention" as a general and absolute requirement of patentability from the relative criteria, novelty and inventive step, (which, in an ordinary popular sense, were to be understood as the attributes of any invention), as well as from the requirement of industrial applicability.

3. Technical character as a requirement for an invention

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

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

It has been part of the European legal tradition that patent protection should be reserved for technical creations. It was indeed always common ground that creations in engineering and technology were entitled to patent protection under the EPC (see e. g. **T 22/85**, OJ 1990, 12; **T 154/04**, OJ 2008, 46). The use of the term "invention" in Art. 52(1) EPC 1973 in conjunction with the so-called "exclusion provisions" of Art. 52(2) and (3) EPC 1973 was interpreted by the boards of appeal as **implying** a requirement of technical character or technicality to be fulfilled by an invention as claimed in order to be patentable (**T 931/95**, **T 1173/97** and **T 935/97**).

Thus, an invention may be an invention within the meaning of Art. 52(1) EPC if, for example, a technical effect is achieved by the invention or if **technical considerations** are required to carry out the invention. In **T 1173/97** (OJ 1999, 609) and **T 935/97** the board stated that within the context of the application of the EPC the technical character of an invention was generally accepted as an essential requirement for its patentability. In **T 931/95** (OJ 2001, 441) the board held that technical character was an implicit requirement of the EPC to be met by an invention in order to be an invention within the meaning of Art. 52(1) EPC 1973 (see also **T 1543/06**).

In **T 154/04** (OJ 2008, 46) the board summarised the main principles underlying the relevant jurisprudence of the boards of appeal. The board held that "technical character" was an **implicit requisite** of an "invention" within the meaning of Art. 52(1) EPC 1973 (requirement of "technicality"). Art. 52(2) EPC 1973 did not exclude from patentability any subject-matter or activity having a technical character, even if linked to items listed in this provision since these items were **only excluded "as such"** (Art. 52(3) EPC 1973).

In examining the patentability of an invention in respect of a claim, the claim had to be construed to determine the **technical features** of the invention, i.e. the features which contributed to the technical character of the invention (see also **T 931/95**, OJ 2001, 441, **T 914/02** and **T 1543/06**). The board observed that the intention of Art. 52(3) EPC 1973 was clearly to ensure that anything which had previously been a patentable invention under conventional patentability criteria should remain patentable under the EPC.

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

Additionally, the board noted that a technical invention is generally useful and practical within the generic meaning of these terms, but the reverse is not necessarily true, i.e. not every "practical art" and not every entity or activity that is practical or useful is necessarily technical in the patent law sense (see **T 388/04**, OJ 2007, 16). It was noted that in some national patent law systems, "useful" is the counterpart to the requirement of industrial applicability set out in Art. 57 EPC 1973 (see Note 5 to Art. 27(1) TRIPS); however, this special meaning of the term does not necessarily convey technical character either. Accordingly, considerations of usefulness and practicality are no substitute for, or criteria equivalent to the prerequisite of technical character inherent in the EPC. The board observed that although industrial applicability and technical character of an invention are intimately related to each other (**T 854/90**), they are not synonymous and constitute two distinct, non-equivalent requirements under the EPC 1973 (**T 953/94**).

4. Two-hurdle approach G 1/19

In **G 1/19** (OJ 2021, A77), the Enlarged Board set out what is referred to as the two-hurdle approach: the twofold test for patent eligibility and for inventive step (using the COMVIK criteria). The Enlarged Board stated that a shift may have taken place in the relative level of each of these two hurdles in the sense that it has become easier to clear the eligibility hurdle of Art. 52 EPC and more difficult to pass the inventive step hurdle of Art. 56 EPC. This chapter relates to the first hurdle; for the question of technicality in relation to Art. 56 EPC, see chapter I.D.9.2. The two-hurdle approach de facto entails three questions: (i) the invention's eligibility under Art. 52 EPC, (ii) whether a feature contributes to the technical character of the invention and (iii) whether the invention is based on an inventive step vis-à-vis the closest prior art (**G 1/19**).

5. Assessment of technical character

5.1. Assessment without regard to the prior art

In order to assess whether the claimed subject-matter was an invention within the meaning of Art. 52(1) EPC 1973, the boards of appeal applied, in their earlier case law, what was called the "contribution approach", according to which an invention had a technical character if it provided a technical contribution to the state of the art in a field not excluded from patentability under Art. 52(2) EPC 1973 (see **T 121/85**; **T 38/86**, OJ 1990, 384; **T 95/86**; **T 603/89**, OJ 1992, 230; **T 71/91**; **T 236/91**; **T 833/91**; **T 77/92**). Thus, prior art was taken into account to some extent (**T 258/03**, OJ 2004, 575; **T 769/92**, OJ 1995, 525).

Subsequent decisions found any comparison with the prior art to be inappropriate for determining whether or not there was an invention.

In **T 1173/97** (OJ 1999, 609) the board consciously abandoned the "contribution approach" and found that compliance with Art. 52(2) and (3) EPC can be established by features already known in the art. Determining the technical contribution an invention achieves with respect to the prior art is more appropriate for the purpose of examining novelty and inventive step than for deciding on possible exclusion under Art. 52(2) and (3) EPC 1973. In **T 931/95** (OJ 2001, 441) it was stated that there is no basis in the EPC for distinguishing between "new features" of an invention and features of that invention which are known from the prior art, when examining whether the invention concerned may be considered to be an invention within the meaning of Art. 52(1) EPC 1973. Thus there is no basis in the EPC for applying the contribution approach for this purpose (see also **T 1001/99**; **T 388/04**, OJ 2007, 16; **T 619/02**, OJ 2007, 63; **T 553/02**; **T 258/03**, OJ 2004, 575).

In **T 1543/06** the board found that the requirement of technical character was recognised as separate and independent of the remaining requirements of Art. 52(1) EPC, in particular novelty and inventive step, and that compliance with it could therefore be assessed without having recourse to the prior art.

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

In **G 1/19** too, the Enlarged Board summarised that the assessment of whether a method involving technical means is an invention within the meaning of Art. 52(1) EPC is made without reference to the prior art (**T 258/03**; **T 388/04**). Only in the context of the second hurdle of the two-hurdle test is the invention considered in relation to the prior art.

5.2. Concept of technical character in the case law

Even in their leading decisions (**G 3/08**, **G 2/07**, **G 1/19**), the boards of appeal do not explicitly define in the case law how they understand the concept of technical character. Nor does the EPC prohibit the patenting of inventions that consist of a mix of technical and non-technical features. It is not necessary to give a relative weighting to technical and non-technical features. If the invention defined in the claim uses technical means, it can be patented provided it meets the requirements of Art. 52 to 57 EPC (**T 26/86**). In **G 1/19** the Enlarged Board held that a method involving technical means is an invention within the meaning of Art. 52(1) EPC. This approach has sometimes been described as the "any technical means" or "any hardware" approach (**G 3/08**).

5.2.1 Apparatus

In **T 931/95** the board decided that an apparatus for carrying out an activity excluded as such from patentability by Art. 52(2) and (3) EPC 1973 was not itself excluded from patentability. In particular, a claim directed to a computer loaded with a program was not excluded from patentability by Art. 52(2) EPC 1973 even if the program itself would be, i.e. if the program caused no "further technical effect" when run (**T 931/95**, OJ 2001, 441; see also **G 3/08**, OJ 2011, 10).

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

In **T 258/03** (OJ 2004, 575) the board was not convinced that the wording of Art. 52(2)(c) EPC 1973, according to which "schemes, rules and methods for performing mental acts, playing games or doing business" shall not be regarded as inventions within the meaning of Art. 52(1) EPC 1973, imposed a different treatment of claims directed to activities and claims directed to entities for carrying out these activities. What matters having regard to the concept of "invention" within the meaning of Art. 52(1) EPC 1973 is the presence of technical character which may be implied by the **physical features** of an entity or the **nature of an activity**, or may be conferred on a non-technical activity by the use of technical means. The board held that the apparatus was an invention within the meaning of Art. 52(1) EPC 1973, since it comprised features which were clearly technical such as a "server computer", "client computers" and a "network". The board stated that this line of reasoning was independent of the category of the claim.

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

In **T 323/21** the technical nature of the claimed subject-matter was held to be limited to the existence of the software code running on the claimed device. The algorithm underlying the claimed device was exclusively of a mathematical nature. It was without any interaction

with the device on which it operated. The technicality of the claimed device lay only in its materiality. Concretely, its technicality was limited to the combination of software code with the associated processing unit. The claimed device with its program code implemented a purely mathematical method deprived, in its generality, of any technical purpose.

5.2.2 Methods

a) Methods involving technical means

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

According to **T 258/03** (OJ 2004, 575) technical character results either from the **physical features** of an entity or (for a method) from the **use of technical means**. **T 258/03** came to the conclusion that any claim involving technical means is not excluded from patentability by Art. 52(2) EPC, and since a claim directed to a method of operating a computer involved a computer it could not be excluded from patentability by Art. 52(2) EPC (see also **G 3/08**). The board noted that previous decisions of the boards of appeal had held that the use of technical means for carrying out a method for performing mental acts, partly or entirely without human intervention, might, having regard to Art. 52(3) EPC 1973, render such a method a technical process or method and therefore an invention within the meaning of Art. 52(1) EPC 1973 (T 38/86, OJ 1990, 384; **T 769/92**). However, method steps consisting of modifications to a business scheme and aimed at circumventing a technical problem rather than solving it by technical means could not contribute to the technical character of the subject-matter claimed.

The board in **T 258/03** found that the technical character is determined by the presence or use of **technical means alone**, irrespective of purpose, even if that purpose is purely non-technical. This finding was irrespective of whether or not it can be associated with a technical effect or serves a technical purpose or function.

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

was explicitly overturned by **T 258/03** (point 1 of the Headnote). In decision **T 931/95** the board had stated that **using technical means** for a purely non-technical purpose and/or for processing purely non-technical information **did not necessarily** confer technical character on any such individual steps of use or on the method as a whole. The mere occurrence of technical features in a claim did not turn the subject-matter of the claim into an invention within the meaning of Art. 52(1) EPC 1973.

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

b) Methods used in a technical process carried out on a physical entity

In accordance with the established case law, if a method which is not per se "technical" e.g. a mathematical method, is used in a technical process, and this process is carried out on a physical entity by some technical means implementing the method and provides as its result a change in that entity, it contributes to the technical character of the invention as a whole (**T 1814/07**).

Any claimed subject-matter defining or using technical means is an invention within the meaning of Art. 52(1) EPC (see **T 424/03** and **T 258/03**, and confirmed in **G 3/08**, OJ 2011, 10). Therefore, the mere inclusion of a computer, a computer network, a readable medium carrying a program, etc. in a claim lends technical character to the claimed subject-matter.

5.2.3 Technical considerations and technical implementations

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

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

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

Thus, although it may be said that all computer programming involves technical considerations since it is concerned with defining a method which can be carried out by a machine, that in itself is not enough to demonstrate that the program which results from

the programming has technical character; the programmer must have had technical considerations beyond "merely" finding a computer algorithm to carry out some procedure (**G 3/08**, point 13.5 of the Reasons; see also **T 1358/09**).

In **T 914/02** the involvement of technical considerations, however, was **not sufficient** for a method, which might exclusively be carried out mentally, to have technical character. Technical character could be provided through the technical implementation of the method, resulting in the method providing a **tangible, technical effect**, such as the provision of a physical entity as the resulting product, or a non-abstract activity, such as through the use of technical means. The board rejected a claim directed to an invention involving technical considerations and encompassing technical embodiments on the grounds that the invention as claimed could also be exclusively performed by purely mental acts excluded from patentability under Art. 52(2)(c) EPC 1973.

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

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

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

In **T 1234/17** the board essentially held that it was not enough that an algorithm makes use of a technical quantity in the form of a measured physical parameter (weather data). What matters was whether the algorithm reflects any additional technical considerations about the parameter, such as its measurement. In the case in hand there were none, in contrast to **T 2079/10**.

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

6.1. Legal basis

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

Seeing as Art. 52(2), (3) EPC is a **limitation** to the general entitlement to patent protection laid down in Art. 52(1) EPC, it is not a matter of judicial discretion, but must have a clear legal basis in the EPC (see **T 154/04**, OJ 2008, 46; see also **G 2/12**, OJ 2016, A28).

According to **T 930/05**, the mere fact that the list of items not to be regarded as inventions in accordance with Art. 52(2) EPC 1973 was non-exhaustive, ("in particular"), indicated that there was a common criterion for exclusion which these items shared and which could serve as the basis for possible additions to the list. The enumeration of typical non-inventions in Art. 52(2) EPC 1973 covered subjects whose common feature was a lack of technical character. The catalogue of exclusions under Art. 52(2) EPC 1973, with its reference to Art. 52(1) EPC 1973, was to be regarded as a negative definition of the concept of invention.

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

6.2. Scope of application

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

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

the EPC 1973 (see "Botschaft des Bundesrates an die Bundesversammlung über drei Patentübereinkommen und die Änderung des Patentgesetzes", 76.021, 24 March 1976, page 67).

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

For further information on the technical character of the invention, see in this chapter I.A.3. "Technical character as a requirement for an invention".

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

6.3. Discoveries, scientific theories and mathematical methods

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

6.3.1 Discoveries and scientific theories

If a new property of a known material or article is found out, that is mere discovery and unpatentable because discovery as such has no technical effect and is therefore not an invention within the meaning of Art. 52(1) EPC. If, however, that property is put to practical use, then this constitutes an invention which may be patentable. To find a previously unrecognised substance occurring in nature is also mere discovery and therefore unpatentable. However, if a substance found in nature can be shown to produce a technical effect, it may be patentable. In addition, if a microorganism is discovered to exist in nature and to produce an antibiotic, the microorganism itself may also be patentable as one aspect of the invention. Similarly, a gene which is discovered to exist in nature may be patentable if a technical effect is revealed, e.g. its use in making a certain polypeptide or in gene therapy (Guidelines G-II, 3.1 – April 2025 version).

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

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

In **T 2079/10** the invention was seen to lie in the improvement of the measurement technique itself, which involved technical considerations about the sensors and their positions. In the case in hand, the measurements themselves did not play a role; the improvement was in the processing of data to provide a better weather forecast. The applicant's argument was essentially that an improvement in the weather data by calculating and further processing it was also technical. In the board's view this led to the key issue in this case, namely whether improving the accuracy of given data of a weather forecast was technical. If it was not, then the details of the algorithm, the "mathematics" as the division put it, do not help. The board held that it was not. The "weather" is not a technical system that the skilled person can improve, or even simulate with the purpose of trying to improve it. It is a physical system that can be modelled in the sense of showing how it works. This kind of modelling is rather a discovery or a scientific theory, both of which are excluded from patentability under Art. 52(2)(a) EPC and thus cannot contribute to the technical character of the invention (see also **T 2331/10**).

6.3.2 Mathematical methods

Purely abstract or intellectual methods are not patentable. The exclusion applies if a claim is directed to a purely abstract mathematical method and the claim does not require any technical means. If a claim is directed either to a method involving the use of technical means (e.g. a computer) or to a device, its subject-matter has a technical character as a whole and is thus not excluded from patentability under Art. 52(2) and (3) EPC.

Merely specifying the technical nature of the data or parameters of the mathematical method may not be sufficient to define an invention in the sense of Art. 52(1) EPC, as the resulting method may still fall under the excluded category of methods for performing mental acts as such (Art. 52(2)(c) and (3) EPC, see Guidelines G-II, 3.3 and 3.5.1 – April 2025 version).

Even if the idea underlying an invention may be considered to reside in a mathematical method a claim directed to a technical process in which the method is used does not seek protection for the mathematical method "as such" (**T 208/84**, OJ 1987, 14; **G 2/88**, OJ 1990, 93).

The case law of the boards of appeal has established that, if a method which is not per se "technical" e.g. a mathematical method, is used in a technical process, and this process is carried out on a physical entity by some technical means implementing the method and

provides as its result a change in that entity, it contributes to the technical character of the invention as a whole (**T 208/84**, OJ 1987, 14; **T 641/00**; **T 258/03**; **T 1814/07**, OJ 2003, 352).

In **T 1784/06** (point 3.1.1 of the Reasons) the board stated that the algorithm is a mathematical (inter alia Boolean) method and, as such, has technical character only if it served a technical purpose (see e.g. **T 1227/05**, point 3.1 of the Reasons, OJ 2007, 574; see also **T 306/10**). In **T 1326/06** it was held that a method of encrypting/decrypting or signing electronic communications may be regarded as a technical method, even if it is essentially based on a mathematical method.

In **T 208/84** (OJ 1987, 14) the board stated that a basic difference between a mathematical method and a technical process can be seen in the fact that a mathematical method or a mathematical algorithm is carried out on numbers (whatever these numbers may represent) and also provides a result also in numerical form, the mathematical method or algorithm being only an abstract concept prescribing how to operate on the numbers. No direct technical result is produced by the method as such. In contrast, if a mathematical method is used in a technical process, that process is carried out on a physical entity (which may be a material object but equally an image stored as an electric signal) by some technical means implementing the method and provides as its result a certain change in that entity. The technical means might include a computer comprising suitable hardware or an appropriately programmed general-purpose computer. The board was, therefore, of the opinion that, even if the idea underlying an invention may be considered to reside in a mathematical method, a claim directed to a technical process in which the method is used does not seek protection for the mathematical method as such. In contrast, a "method for digitally filtering data" remains an abstract notion not distinguished from a mathematical method as long as it is not specified what physical entity was represented by the data and it forms the subject of a technical process, i.e. a process which is susceptible of industrial application (see also **T 1161/04** and **T 212/94**).

In **T 953/94** the board stated that an analysis of the cyclical behaviour of a curve was clearly a mathematical method excluded as such from patentability. The reference to a digital computer only had the effect of indicating that the claimed method was carried out with the aid of a computer, i.e. a programmable general-purpose computer, functioning under the control of a program excluded as such from patentability. The fact that the description disclosed examples in both non-technical and technical fields was confirmation that the problem solved by the claimed mathematical method was independent of any field of application and could thus lie, in the case at issue, only in the mathematical and not in a technical field.

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

In **T 556/14** the invention related to a method for masking a private key used in cryptographic operations on a security token such as a smartcard against power analysis

attacks. The board held that due to the express reference to a smart card on which the key parts and also the new parts are stored, the claimed method of masking was not a mathematical method as such.

6.4. Aesthetic creations

Subject-matter relating to aesthetic creations will usually have both technical aspects, e.g. a "substrate" such as a canvas or a cloth, and aesthetic aspects, the appreciation of which is essentially subjective, e.g. the form of the image on the canvas or the pattern on the cloth. If technical aspects are present in such an aesthetic creation, it is not an aesthetic creation "as such" and it is not excluded from patentability. The aesthetic effect itself is not patentable, neither in a product nor in a process claim. Nevertheless, if an aesthetic effect is obtained by a technical structure or other technical means, although the aesthetic effect itself is not of a technical character, the means of obtaining it may be (Guidelines G-II, 3.4 – April 2025 version).

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

In **T 119/88** (OJ 1990, 395) the subject-matter of the application in question related to a flexible disk jacket made of a plastic sheet presenting to the outside world a surface colour of a certain minimum light intensity. The board first of all stated that the feature of having a specific colour as such did not constitute a technical feature indicating that an object or device was entirely or partly covered by that colour; however, the board did not rule out the possibility that this did not hold in all circumstances. The feature taken by itself might not seem to reveal any technical aspect, but its technical or non-technical character could be decided by **the effect it brought about after being added to an object** which did not comprise the feature before (see e.g. **T 336/14**). In considering whether the subject-matter of a claim is excluded from patentability under Art. 52(2) and (3) EPC 1973, i.e. whether it is non-technical or technical, that claim has to be considered in its entirety. This is in line with decisions **T 38/86** and **T 65/86**, in which Art. 52(3) EPC 1973 was interpreted to mean that the subject-matter of a claim is not excluded from patentability under Art. 52(2)(c) EPC 1973 if the said subject-matter contributes anything to the prior art in a field that is not excluded from patentability. In these decisions this interpretation was only applied with regard to Art. 52(2)(c) EPC 1973. However, once applied to Art. 52(2)(c) EPC 1973 it must hold for all the paragraphs of Art. 52(2) EPC 1973, since Art. 52(3) EPC 1973 refers to all the items summed up in Art. 52(2) EPC 1973. The board stated that it had to be investigated whether the effects implied by the sole feature of possessing a specific colour, could make that feature into a feature not excluded from patentability the known object or device provided with that colour. The board concluded

that the alleged resistance to fingerprints was a purely aesthetic effect which contributed nothing technical to the invention concerned (Art. 52(2)(b) EPC 1973) and the advantage of easy classification by colour represented a non-technical effect in the form of a presentation of information. As such it was excluded from patentability under Art. 52(2)(d) and (3) EPC 1973 (see also **T 962/91**).

For more information on the inventive-step analysis in connection with features relating to subject-matter excluded under Art. 52(2) EPC, see chapter I.D.9.2.2 "Excluded subject-matter".

6.5. Computer-implemented inventions

6.5.1 Definition of computer-implemented invention

"Computer-implemented invention" is an expression intended to cover claims which involve computers, computer networks or other programmable apparatus wherein at least one feature is realised by means of a computer program (Guidelines G-II, 3.6 – April 2025 version).

6.5.2 Distinction from computer programs

A computer program and a corresponding computer-implemented method are distinct from each other. The former refers to a sequence of computer-executable instructions specifying a method while the latter refers to a method being actually performed on a computer (Guidelines G-II, 3.6 – April 2025 version).

6.5.3 Scope of Article 52(2)(c) EPC exception to patentability

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

Art. 52(3) EPC establishes an important limitation to the scope of this exclusion. According to this provision, the exclusion applies only to the extent to which a European patent application or a European patent relates to programs for computers "as such". In **T 935/97** the board stated that the combination of the two provisions (Art. 52(2) and (3) EPC 1973) demonstrates that the legislators did not want to exclude from patentability all programs for computers. In other words, the fact that only patent applications relating to programs for computers as such are excluded from patentability means that patentability may be allowed for patent applications relating to programs for computers where the latter are not considered to be programs for computers as such (see also **T 1924/17**, points 17 to 19.4 of the Reasons, on the background to Art. 52 EPC).

Claims directed to a computer-implemented method, a computer-readable storage medium or a device cannot be objected to under Art. 52(2) and (3) EPC as any method involving the use of technical means (e.g. a computer) and any technical means itself (e.g. a computer or a computer-readable storage medium) have technical character and thus

represent inventions in the sense of Art. 52(1) EPC (**T 258/03**; **T 424/03**; **G 3/08**, OJ 2011, 10).

6.5.4 Patentability of computer programs: G 3/08

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

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

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

The Enlarged Board pointed out that the referral did not identify, and they were not aware of, any decision whatsoever of one of the boards of appeal which followed **T 1173/97** on this point (although **T 1173/97** was evidently considered decisive in its definition of "further technical effect" and abandonment of the contribution approach to exclusion). Secondly, the conclusion arrived at in **T 424/03** had not been challenged in any later decisions; nor was it isolated but rather came as the last of a series of decisions, the logic of which was consistent and, at least to the knowledge of the members of the Enlarged Board, had also not been challenged in any later decision of a board of appeal (national court decisions were another matter).

The Enlarged Board came to the conclusion that the position taken in **T 424/03** that a claim to a program on a computer-readable storage medium was necessarily not excluded from patentability by the provisions of Art. 52(2) and (3) EPC 1973 was in fact a consequence of the principles laid out in **T 1173/97**. It stated that **T 424/03**, did deviate from a view

expressed in **T 1173/97**, concerning whether a claim to a program on a computer-readable medium necessarily avoided exclusion from patentability under Art. 52(2) EPC 1973. However, this was a legitimate development of the case law. Therefore, the Enlarged Board decided that there was no divergence which would make the referral of this point to the Enlarged Board by the President admissible (for further legal considerations which were taken into account in that regard, see points 5 to 7 of Opinion **G 3/08**).

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

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

6.5.5 Patentability of computer programs: technical character

Whereas the view had been taken on a number of occasions in the boards' earlier case law (**T 26/86**, OJ 1988, 19, **T 110/90**, OJ 1994, 557, **T 164/92**, OJ 1995, 305, and **T 204/93**) that the exclusion from patentability under Art. 52(2)(c) and (3) EPC 1973 applied to all computer programs, independently of their contents, that is, independently of what the program could do or perform when loaded into an appropriate computer, the board in **T 1173/97** (OJ 1999, 609) held that, in the context of applying the EPC, the **technical character** of an invention was **generally accepted as an essential requirement** for its patentability, as was illustrated, for instance, by R. 27 and 29 EPC 1973. The exclusion from patentability of computer programs as such (Art. 52(2) and (3) EPC 1973) could be construed to mean that such programs were considered to be mere abstract creations, lacking in technical character. The use of the expression "shall not be regarded as inventions" seemed to confirm this interpretation. This meant that computer programs had to be considered patentable inventions **when they had a technical character**.

Further, Art. 27(1) TRIPS provides that "patents shall be available for any inventions, whether **products or processes**, in all fields of technology". The board went on to state

that it was the clear intention of TRIPS not to exclude from patentability any inventions, whatever field of technology they belong to, and therefore, in particular, not to exclude programs for computers as mentioned in and excluded under Art. 52(2)(c) EPC 1973. The board held that a computer program product is not excluded from patentability under Art. 52(2) and (3) EPC 1973 if the program, when running on a computer or loaded into a computer, brings about, or is capable of bringing about, a **technical effect** which goes beyond the "normal" physical interactions between the program (software) and the computer (hardware) on which it is run.

The combination of the two provisions (Art. 52(2) and (3) EPC 1973) demonstrated that the legislators did not want to exclude from patentability all programs for computers. In other words, the fact that only patent applications relating to programs for computers as such were excluded from patentability (see **T 208/84**, OJ 1987, 14 and **T 115/85**, OJ 1990, 30) meant that patentability could be allowed for patent applications relating to programs for computers where the latter were not considered to be programs for computers as such. This interpretation is also reflected in the "travaux préparatoires" for the EPC 2000, which saw the redrafting of Art. 52 EPC.

6.5.6 Establishing technical character

a) Further effects of programs for computers and G 1/19

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

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

G 1/19 concerned the computer-implemented simulation of the movement of a pedestrian crowd through an environment such as a building. The questions of law referred to the Enlarged Board were answered as follows:

1. A computer-implemented simulation of a technical system or process that is claimed as such can, for the purpose of assessing inventive step, solve a technical problem by producing a technical effect going beyond the simulation's implementation on a computer.

2. For that assessment it is not a sufficient condition that the simulation is based, in whole or in part, on technical principles underlying the simulated system or process.

3. The answers to the first and second questions are no different if the computer-implemented simulation is claimed as part of a design process, in particular for verifying a design.

The Enlarged Board agreed with the findings of **T 1227/05** and **T 625/11** if they were understood as being that the claimed simulation processes in those particular cases possessed an intrinsically technical function. It also did not see a need to require a direct link with (external) physical reality in every case. However, it held that there were rather strict limits for the consideration of potential or merely calculated technical effects according to the COMVIK approach (**T 641/00**). Like any other computer-implemented inventions, numerical simulations may be patentable if an inventive step can be based on features contributing to the technical character of the claimed simulation method. In **T 761/20** the board held that though **G 1/19** was related to computer-implemented simulations, its reasons apply to computer-implemented methods other than simulations as well.

In the opinion of the Enlarged Board in **G 1/19**, when the COMVIK approach is applied to simulations, the underlying models form boundaries, which may be technical or non-technical. In terms of the simulation itself, these boundaries were not technical. However, they may contribute to technicality if, for example, they were a reason for adapting the computer or its functioning, or if they formed the basis for a further technical use of the outcomes of the simulation (e.g. a use having an impact on physical reality). In order to avoid patent protection being granted to non-patentable subject-matter, such further use had to be at least implicitly specified in the claim. The same applied to any adaptations of the computer or its functioning.

b) Direct link to physical reality

The President of the EPO referred the following point of law to the Enlarged Board (**G 3/08**, OJ 2011, 10; Question 3(a) of the referral): must a claimed feature cause a **technical effect on a physical entity** in the real world in order to contribute to the technical character

of the claim? It was noted in the referral that according to decisions **T 163/85** and **T 190/94**, a technical effect **on a physical entity** in the **real world** was required. This was, however, not the case in **T 125/01** and **T 424/03**. In these decisions the technical effects were essentially confined to the respective computer programs.

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

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

The second problem with the alleged divergence was that the decisions **T 163/85** and **T 190/94** said in the referral to require a technical effect on a physical entity in the real world, simply did not do so. They merely accepted this as something sufficient for avoiding exclusion from patentability; they did not state that it was necessary.

Dealing with this issue again in **G 1/19**, the Enlarged Board found as follows: beyond those considered in **G 3/08**, the referring board identified cases apparently requiring a technical effect directly linked to physical reality, but also others which suggested that a potential technical effect, i.e. an effect achieved only in combination with non-claimed features, was taken into account (**T 1351/04**, **T 625/11**, see points 36 and 37 of the Reasons of **T 489/14** of 22 February 2019, OJ 2019, A86). Following existing case law and taking into account the relevant legal provisions, the Enlarged Board in **G 1/19** (OJ 2021, A77) did not see a need to require a direct link with (external) physical reality in every case. On the one hand, technical contributions might also be established by features within the computer system used. On the other hand, there were many examples in which potential technical effects - which could be distinguished from direct technical effects on physical reality - had been considered in the course of the technicality / inventive-step analysis. While a direct link with physical reality, based on features that per se are technical and/or non-technical, was in most cases sufficient to establish technicality, it could not be a necessary condition, if only because the notion of technicality needs to remain open.

In **T 761/20** the board recalled that according to **G 1/19**, a direct link with physical reality is not required for a technical effect to exist. However, an at least indirect link to physical

reality, internal or external to the computer, is required, according to the board in **T 761/20**. The link can be mediated by the intended use or purpose of the invention ("when executed" or when put to its "implied technical use").

c) Potential technical effect

In **G 1/19** the argument was put forward, that it was sufficient for a computer-implemented invention to have the potential to produce a technical effect, citing **T 1173/97** as well as a number of other decisions (**T 208/84**, OJ 1987, 14; **T 163/85**, OJ 1990, 379; **T 110/90**, OJ 1994, 557; **T 1351/04**).

The Enlarged Board held that the principle developed in **T 1173/97** that software (which in itself may only have "potential effects") is treated as software running on a computer is still applied, while the further analysis (i.e. whether the software causes further technical effects) is now carried out according to the COMVIK approach. When run on a computer, the combination of the claimed features must establish a technical invention. In the COMVIK analysis, the features have to be assessed as to their contribution to the technical character of the invention.

The Enlarged Board distinguished between the potential effects discussed in **T 1173/97** and the potential technical effects seen in older cases such as **T 208/84** and **T 163/85**. While the potential effects in **T 1173/97** include all (technical and non-technical) effects resulting directly from the running of a program on a computer, i.e. effects occurring within the computer and relating to the hardware which executes the program, **T 208/84** and **T 163/85** appeared to confirm that data intended for controlling a technical device may be considered to have technical character because it has the potential to cause technical effects. These potential technical effects are "downstream" effects which may or may not be caused by said data output.

In the context of the problem-solution approach and the COMVIK approach, such potential technical effects may be considered if the data resulting from a claimed process is specifically adapted for the purposes of its intended technical use. In such cases, either the technical effect that would result from the intended use of the data could be considered "implied" by the claim, or the intended use of the data (i.e. the use in connection with a technical device) could be considered to extend across substantially the whole scope of the claimed data processing method.

Numerical data output from a computer is a necessary pre-condition for any effects that are caused, and the "downstream effects" can be seen as a potential effect of the software. However, the necessarily technical nature of some effects inside the computer does not mean that the "downstream" effects caused by the data output of the computer are necessarily of a technical nature.

d) Virtual or "calculated" technical effect

In **G 1/19** it was argued that technical effects which are not achieved through an interaction with physical reality, but are calculated in such a way as to correspond closely to "real"

technical effects or physical entities, should be treated as technical effects for the purposes of the COMVIK approach. In the Enlarged Board's view, virtual or calculated technical effects should be distinguished from potential technical effects which, for example when a computer program or a control signal for an image display device is put to its intended use, necessarily become real technical effects. Calculated status information or physical properties concerning a physical object are information which may reflect properties possibly occurring in the real world. However, first and foremost, they are mere data which can be used in many different ways. There may exist exceptional cases in which such information has an implied technical use that can be the basis for an implied technical effect. Still, in general, data about a calculated technical effect is just data.

e) Tangible effect

The Enlarged Board in **G 1/19** fully supported the view expressed in **T 533/09** that a tangible effect is not a requirement under the EPC. Moreover, it was unclear to what extent the notions of "tangible effect" and "further technical effect" overlapped. A criterion based on tangibility - in addition to the requirement of technicality - thus cannot contribute to a more precise delimitation of patentable inventions.

f) Technical considerations: programming a computer

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

The President of the EPO referred to the Enlarged Board the following point of law (see **G 3/08**, OJ 2011, 10; Question 4 of the referral): Does the activity of programming a computer necessarily involve technical considerations? The President of the EPO cited decision **T 1177/97**, where the board found that "implementing a function on a computer system always involves, at least implicitly, technical considerations". The reference to 'computer routines' made it clear that this implementation consisted of programming the computer (see also **T 172/03**). Contrary to these decisions **T 833/91**, **T 204/93** and **T 769/92** (OJ 1995, 525) considered programming to be a mental act of the programmer.

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

The Enlarged Board stated that there was no contradiction between these positions, as may be seen by considering the same case in a non-controversial field, for example bicycle design. Designing a bicycle clearly involves technical considerations (it may also involve non-technical, e.g. aesthetic, considerations), but it is a process which at least initially can

take place in the designer's mind, i.e. it can be a mental act and to the extent that it is a mental act would be excluded from patentability (see also **T 833/91**, **T 769/92**, **T 204/93**, **T 914/02** and **T 471/05**). Hence the question did not satisfy the requirement for a divergence in the case law and was therefore inadmissible.

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

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

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

In **T 2825/19**, the board considered that opinion **G 3/08**, when compared to decision **T 1173/97**, reframed the interpretation of technicality with respect to computer programs. **G 3/08** (point 13.5 and 13.5.1 of the Reasons), explicitly rejected the position that any technical considerations are sufficient to confer technical character on claimed subject-matter. Such a narrower interpretation of the term "technical" with respect to computer programs is a normal development for the interpretation of a legal provision open to interpretation (see opinion **G 3/19**), and this was the case for "programs for computers"

"as such" in Art. 52(2)(c) and (3) EPC. The board understood opinion **G 3/08** as taking a negative view on the technical character of the activity of programming a computer. Computer hardware is without any doubt a field of technology within the meaning of Art. 52(1) EPC. Consequently, the board saw no reason why considerations that specifically exploit technical properties of the computer system hardware to solve a technical problem related to the internal operation of the computer system, such as storing data in main memory instead of on a hard disk to be able to read the stored data with less delay, should not be viewed as "further technical considerations" in accordance with opinion **G 3/08**. Such considerations (and associated "further" technical effects) were not present in all computer programs. By contrast, the board saw no support for the appellant's view that the concept "further technical considerations" should be interpreted with a broader meaning that would also cover considerations aiming to solve problems "merely" relating to programming.

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

In **T 1177/97** claim 1 was directed to a method for translation between natural languages; accordingly, it used various linguistic terms and involved linguistic aspects of the translation process. The board raised the question whether such linguistic concepts and methods could form part of a technical invention at all. It referred to EPO case law which provided various examples showing that even the automation of such methods did not make good a lack of technical character (e.g. **T 52/85**, **T 302/19**). On the other hand, coded information had been considered, on a case-by-case basis, as a patentable entity, i.a. **T 163/85**, OJ 1990, 379; **T 769/92**, OJ 1995, 525 and **T 1194/97**, OJ 2000, 525. The board confirmed that, in accordance with this case law, it seemed to be common ground that the use of a piece of information in a technical system, or its usability for that purpose, could confer a technical character on the information itself, in that it reflected the properties of the technical system, for instance by being specifically formatted and/or processed. When used in or processed by the technical system, such information could be part of a technical solution to a technical problem and thus form the basis for a technical contribution of the invention to the prior art.

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

peculiarities of the field of linguistics, however, had to be ignored in assessing inventive step.

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

h) Methods performed by a computer

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

In **T 313/10** the examining division had argued, using their own criteria, that a method performed by a computer was excluded. The first issue in this case was whether the claimed method, performed by a computer, of matching items in a table is excluded from patentability (Art. 52(2) and (3) EPC). The board stated that it is the established case law of the boards of appeal that claimed subject-matter specifying **at least one feature** not falling within the ambit of Art. 52(2) EPC is not excluded from patentability by the provisions of Art. 52(2) and (3) EPC (see **G 3/08**, OJ 2011, 10; **T 258/03** and **T 424/03**).

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

i) Computer-implemented simulation methods

In the Enlarged Board's opinion in **G 1/19**, the COMVIK approach was suitable for the assessment of computer-implemented simulations. Like any other computer-implemented inventions, numerical simulations may be patentable if an inventive step can be based on features contributing to the technical character of the claimed simulation method. When the COMVIK approach is applied to simulations, the underlying models form boundaries, which may be technical or non-technical. In terms of the simulation itself, these boundaries are not technical. However, they may contribute to technicality if, for example, they are a reason for adapting the computer or its functioning, or if they form the basis for a further technical use of the outcomes of the simulation (e.g. a use having an impact on physical reality). In order to avoid patent protection being granted to non-patentable subject-matter, such further use has to be at least implicitly specified in the claim. The same applies to any adaptations of the computer or its functioning. The same considerations apply to simulations claimed as part of a design process.

Whether a simulation contributes to the technical character of the claimed subject-matter does not depend on the quality of the underlying model or the degree to which the simulation represents "reality". However, the accuracy of a simulation is a factor that may have an influence on a technical effect going beyond the simulation's implementation and may therefore be taken into consideration in the assessment under Art. 56 EPC (see also **T 489/14** of 26.11.2021).

A simulation is necessarily based on the principles underlying the simulated system or process. Even if these principles can be described as technical, the simulation does not necessarily have a technical character. The Enlarged Board was of the opinion that it is neither a sufficient nor a necessary condition that a numerical simulation is based, at least in part, on technical principles that underlie the simulated system or process.

In coming to its decision, the Enlarged Board also looked at the decision in **T 1227/05** (OJ 2007, 574), which had dealt with an application relating to a computer-implemented method with mathematical steps for simulating the performance of a circuit subject to 1/f noise. The solution was based on the notion that 1/f noise can be simulated by feeding suitable random numbers into the circuit model. In the deciding board's view, the simple generation of the random numbers and the possibility of calculating them separately, before the start of the circuit simulation, provided for a resource-efficient computer simulation. In its analysis under Art. 56 EPC, the board explicitly relied on the COMVIK approach, finding that the simulation of a circuit subject to 1/f noise constituted an adequately defined technical purpose for a computer-implemented invention "provided that the method is functionally limited to that technical purpose". In view of the method's functional limitation to the simulation of a noise-affected circuit, the board came to the conclusion that such simulation could be considered to be a functional technical feature. The board also made clear that the metaspecification of an (undefined) technical purpose could not be considered adequate.

In **G 1/19** the Enlarged Board, regarding **T 1227/05**, stated that calculated numerical data reflecting the physical behaviour of a system modelled in a computer usually cannot

establish the technical character of an invention in accordance with the COMVIK approach, even if the calculated behaviour adequately reflects the behaviour of a real system underlying the simulation. Only in exceptional cases may such calculated effects be considered implied technical effects (for example, if the potential use of such data is limited to technical purposes). However, the Enlarged Board stated that its role was not to re-assess decision **T 1227/05**, which was taken in the specific circumstances of the case. It also noted that the board in **T 1227/05** did not rely for its decision solely on its findings that the simulated system was a technical system and that the system could only be understood and modelled by relying on technical considerations.

The Enlarged Board in **G 1/19** also referred to **T 625/11**, which concerned a method for establishing by a computer system at least one limit value for at least one operational parameter of a nuclear reactor, which method included a simulation step and resulted in numerical value(s) for one or more limit values for e.g. global power P of the reactor. The board in **T 625/11** considered that the relevant questions were the same as in **T 1227/05** and ultimately followed the conclusions of that decision, accepting that the calculated limit values for the operation of a nuclear reactor conferred a technical character to the invention. The Enlarged Board agreed with the findings of **T 1227/05** and **T 625/11** **if they were understood as being that the claimed simulation processes in those particular cases possessed an intrinsically technical function**. However, there were rather strict limits for the consideration of potential or merely calculated technical effects according to the COMVIK approach. The often-quoted criterion of **T 1227/05** that the simulation constituted an adequately defined technical purpose for a numerical simulation method if it was functionally limited to that purpose should not be taken as a generally applicable criterion of the COMVIK approach for computer-implemented simulations, since the findings of **T 1227/05** were based on specific circumstances which did not apply in general.

The Enlarged Board in **G 1/19** also referred to **T 1265/09**. The case concerned computer-implemented methods of determining an efficient schedule for a plurality of scheduled agents in a telephone call centre. The effect of an efficient schedule was found to be a business aim which did not necessarily imply any technical effects The Enlarged Board stated that in **T 1265/09**, as well as in **T 531/09**, the negative assessment under Art. 56 EPC was (or could have been) based on the lack of a technical effect by the simulation rather than on the non-technical nature of the simulated system.

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

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

6.6.1 Methods for doing business

In accordance with Art. 52(2)(c) EPC, in particular methods for doing business shall not be regarded inventions within the meaning of Art. 52(1) EPC. According to Art. 52(3) EPC the patentability of such methods shall only be excluded to the extent that the application, and indeed the claimed subject-matter as this defines the matter for which protection is

sought, relates to methods for doing business as such. However, where the claimed method involves technical means, it does not relate to a method for doing business as such and its patentability is therefore not excluded (see also **T 258/03**, OJ 2004, 575).

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

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

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

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

In **T 388/04** (OJ 2007, 16) the board considered that transmitting information as specified in the claim, even if performing the transmission might involve the use of technical means, does not go beyond a business activity as such. If the contrary were true, no method for doing business that implicitly could make use of a functionality offered by technical means

would be excluded from patentability, which, in the view of the board, could not be what is intended by Art. 52(2) and (3) EPC 1973. The board held that subject-matter or activities that are excluded from patentability under Art. 52(2) and (3) EPC 1973 remain so even where they imply the possibility of making use of **unspecified technical means**.

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

6.6.2 Methods for performing mental acts

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

In **T 2720/16**, the board held that an activity was purely mental if it was performed entirely by the human brain. As soon as it manifested itself physically outside the brain, it lost its purely mental character. It did not matter whether this physical dimension to the activity was performed using a body part (eye, hand, etc.) or separate mechanical devices.

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

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

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

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

The invention at issue in **T 547/14** concerned a method for predicting the formation of mould on an object, for an example a building component. The examining division had found that there was nothing to distinguish the features of claim 1, which related to an experimental determination of biological germination conditions for moulds, from a purely intellectual activity, because the experimental determination was not specified in technical terms and could be performed by purely cognitive observation. The board disagreed: if the biological germination conditions were determined experimentally, experiments had to be carried out and that meant having to use technical means; if they were determined using a computer, its use as a technical means similarly rendered the subject-matter technical. For the purpose of establishing whether the claimed method had technical character, it did not matter what details the application gave as to how the claimed experimental determination was technically implemented. That was instead a matter to be considered when assessing whether the invention could be carried out.

In **T 670/19** the claim concerned a scale system for clinical assessment of the lips and mouth area comprising a lip fullness scale comprising illustrations of the mouth area. The board held that the invention did not relate to purely abstract subject-matter and did have a technical character. The presence of a concrete physical medium, such as a board or a screen, carrying the illustrations was implied. The implicit presence of a physical medium conferred technical character to at least part of the subject-matter of the claim and this

regardless of a possibly non-technical nature of the cognitive content of the illustrations carried by or displayed on the physical medium "per se".

In **T 1465/22** The board held that while at least some of the method steps of claim 1 might be carried out manually, this did not lead to these method steps being "schemes, rules and methods for performing mental acts" as set out in Art. 52(2)(c) EPC. A method for performing mental acts requires that the method be performed entirely within the human brain. As the respondent (patent proprietor) argued, the features of claim 1 inter alia of "inserting, extracting, transferring, juxtaposing and capping" could not be considered to be purely mental acts. They required concrete handling of containers, nests, a transport tub, a substance, a stopper and a cap. It could not be seen how any of these steps could possibly be achieved purely through mental activity. The appellant's further argument that a user might not actually carry out the steps of the method, as the method steps were merely instructions, was not convincing either. The board noted that claims to methods were clearly allowed under the EPC (**G 2/88**). Any method claim requires that the steps are indeed carried out (whether manually, automatically or in a combination of both) and not just given to a user as instructions, otherwise the user would not be working within the scope of the claim.

6.6.3 Word-processing

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

In **T 38/86** (OJ 1990, 384) the board first of all had to assess the patentability of a method for automatically detecting and replacing linguistic expressions which exceeded a predetermined level of understanding in a list of linguistic expressions. The board was of the opinion that a person who wished to carry out such a task using their skills and judgment would perform purely mental acts within the meaning of Art. 52(2)(c) EPC 1973; the schemes, rules and methods used in performing such mental acts were not inventions within the meaning of Art. 52(1) EPC 1973. The board stated that the use of technical means for carrying out a method, partly or entirely without human intervention, which, if performed by a human being, would require him to perform mental acts, **might**, having regard to Art. 52(3) EPC 1973, render such a method a technical process or method and thus an invention within the meaning of Art. 52(1) EPC 1973. Since patentability was excluded only to the extent to which the patent application related to excluded subject-matter or activities as such, it appeared to be the intention of the EPC to permit patenting in those cases in which the invention involved a contribution to the art in a field not

excluded from patentability. In the case in point this condition was not satisfied: once the **steps of the method for performing the mental acts** in question had been defined, the implementation of the technical means to be used in those steps involved no more than the straightforward application of conventional techniques and had therefore to be considered obvious to a person skilled in the art. If a claim for an apparatus (here, a word-processing system) for carrying out a method did not specify any technical features beyond those already comprised in a claim pertaining to said method and furthermore did not define the apparatus in terms of its physical structure, but only in functional terms corresponding to the steps of that method, the board stated that the claimed apparatus did not contribute anything more to the art than the method, in spite of the fact that the claim was formulated in a different category. In such cases, if the method was excluded from patentability, so was the apparatus (see also **T 71/91**, **T 121/85**).

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

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

6.7. Presentation of information

Presentation of information in the sense of Art. 52(2)(d) EPC is understood as the conveying of information to a user. It concerns both the cognitive content of the information presented and the manner of its presentation (**T 1143/06**, **T 1741/08**). However, it does not extend to the technical means used for generating such presentations of information. Furthermore, conveying information to a user is to be distinguished from technical representations of information directed to a technical system which will process, store or transmit that information. Features of data encoding schemes, data structures and electronic communication protocols which represent functional data as opposed to cognitive data are not regarded as presentations of information in the sense of Art. 52(2)(d) EPC (**T 1194/97**; Guidelines G-II, 3.7 – April 2025 version).

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

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

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

In **T 599/93** a configuration for simultaneously displaying several images on one (computer) screen was claimed. The screen was divided into four sections, for example by means of one horizontal and one vertical demarcation line. The board was of the view that imparting information on events in a screen window by changing the colour of the relevant surface of the setting mark was not of a technical nature (no information was given, for example, on the operating status of the claimed configuration), but merely drew the user's attention to particular contents of the relevant images and thus served to present information within the meaning of Art. 52(2)(d) EPC 1973 (**T 1704/06**).

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

In **T 528/07** the appellant cited several decisions of the boards of appeal in order to demonstrate that the display of data can have technical character. The board found that

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

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

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

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

In decision **T 1143/06** the board noted that a non-technical claim feature is a feature which does not interact with the technical features to produce a technical effect. According to the jurisprudence of the boards of appeal such a feature cannot establish novelty and inventive step (**T 154/04**, OJ 2008, 46, point 15 of the Reasons). Since the invention was concerned

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

6.7.1 User Interfaces

User interfaces, in particular graphical user interfaces (GUIs), comprise features of presenting information and receiving input in response as part of human-computer interaction. Features defining user input are more likely to have a technical character than those solely concerning data output and display, because input requires compatibility with the predetermined protocol of a machine, whereas output may be largely dictated by the subjective preferences of a user (Guidelines G-II, 3.7.1 – April 2025 version).

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

The issues of GUIs layout and presentation of information in the assessment of inventive step is analysed in detail in chapter I.D.9.2.11 "Assessment of features relating to a presentation of information".

B. Exceptions to patentability

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1. Introduction

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

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

As part of the EPC 2000 revision, several amendments were made to Art. 53 EPC. However, these are unlikely to affect the EPO's practice (see OJ SE 4/2007): Art. 53(a) EPC was brought into line with Art. 27(2) TRIPS and Art. 6(1) of the Biotech Directive 98/44/EC. In the German version, moreover, the term "Tierarten" in

Art. 53(b) EPC 1973 was replaced by "Tierrassen" to bring it into line with the Biotech Directive and R. 23c(b) EPC 1973 (MR/2/00, 45).

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

1.2. Basic principles

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

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

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

2. Breaches of "ordre public" or morality

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

Art. 53(a) EPC is supplemented by R. 28 EPC, which sets out four categories of biotechnological inventions excluded from patentability under that article. R. 28 EPC is part of the chapter on "Biotechnological inventions" inserted into Part II of the

Implementing Regulations, and is identical to Art. 6(2) of the Biotech Directive. The Biotech Directive was thereby transposed into European patent law.

Where an invention falls under one of the categories set out in R. 28 EPC, it is by its very nature non-patentable and there is no need additionally to consider Art. 53(a) EPC. However, if it does not fall under one of those categories, it must be examined more closely under Art. 53(a) EPC (**T 315/03**, OJ 2006, 15; see also **G 2/06**, OJ 2009, 306).

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

2.1. Rule 28 EPC

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

2.1.1 Scope of exception under Rule 28(c) EPC

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

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

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

The appellant had argued that, for the R. 28(c) EPC prohibition to apply, the use of human embryos had to be claimed. The Enlarged Board disagreed, observing that R. 28(c) EPC

did not mention claims, but rather referred to "invention" in the context of its exploitation. What had to be looked at was not just the explicit wording of the claims but the technical teaching of the application as a whole as to how the invention is to be performed. The Enlarged Board thus answered the second point referred as follows: R. 28(c) EPC forbids the patenting of claims directed to products which – as described in the application – at the filing date could be prepared exclusively by a method which necessarily involved the destruction of the human embryos from which the said products are derived, even if the said method is not part of the claims.

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

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

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

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

In **T 1553/22** the application concerned the generation of pig-human chimeric animals with the aim of using them as a source of human vasculature and blood. The board held that if an invention corresponds to one of the examples set out in the non-exhaustive list of R. 28(1) EPC, there is no room for tests aimed at balancing possible risks associated with the implementation of the invention and its benefit for mankind. Without disregarding the principle of narrow interpretation of exceptions, the board took the view that the exclusion of Art. 53(a) EPC in conjunction with R. 28(1) EPC may extend to other chimeras, where the rationale underlying the examples identified in Recital 38 is also applicable to the chimeras concerned. Thus, by means of R. 26(1) EPC a further special case is added to the non-exhaustive list of R. 28(1) EPC.

When considering the possible rationale underlying the specific exclusions of Recital 38 of the Biotech Directive , the board found that the reason why the chimeras identified in Recital 38 of the Biotech Directive are regarded as offensive against human dignity is due to concerns that, in chimeras including human germ cells or totipotent cells, these human cells may integrate into the brain and/or develop into germ cells and result in a chimera with human or human-like capabilities.

This reason is straightforward for chimeras including totipotent cells, which in view of their developmental capability to form an entire organism may form a brain with human-like cognitive abilities or human germ cells. However the same reason applies to the application at hand, which concerned pluripotent cells, which despite lacking the ability to differentiate into totipotent cells or cells of the placenta, nevertheless have the ability to differentiate into neural cells or germ cells. Thus, if an invention relates to a situation where human cells might integrate into the chimera's brain, potentially giving the chimera human-like cognitive or behavioural capabilities, or into its germ line, potentially giving it the ability to pass on humanised traits, the board considers that the underlying rationale of Recital 38 of the Biotech Directive would be relevant and shall be taken into account in examining compliance with Art. 53(a) in conjunction with R. 28(1) EPC. The board thus found that the application offended against human dignity and was excluded from patentability in accordance with Art. 53(a) EPC.

2.1.2 Scope of exception under Rule 28(d) EPC

Rule 28(d) EPC (R. 23d(d) EPC 1973) provides that European patents should not be granted in respect of processes for modifying the genetic identity of animals which were likely to cause them suffering without any substantial medical benefit to man or animal, and also animals resulting from such processes.

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

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

In **T 1553/15** the board held that contrary to the transgenic mouse of **T 19/90**, which opened up new research avenues in the field of oncology at the cost of the suffering of a limited number of animals, the board considered that the benefit to mankind brought by the present invention was not such as to weigh up against the suffering of animals which was necessary to produce the claimed pharmaceutical composition. The new pharmaceutical composition did not open up new avenues in the treatment of the claimed diseases, and animal suffering was not limited to a given number of animals needed for testing but rather was always present and involved a considerable number of animals every time the composition was produced. There were also alternatives to the claimed pharmaceutical composition available.

2.1.3 Test date

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

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

2.2. Article 53(a) EPC

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

2.2.1 Test date

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

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

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

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

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

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

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

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

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

The board held that the concept of **morality** was related to the belief that some behaviour was right and acceptable whereas other behaviour was wrong, this belief being founded

on the totality of the accepted norms which were deeply rooted in a particular culture. For the purposes of the EPC, the culture in question was the culture inherent in European society and civilisation. Accordingly, inventions the exploitation of which was not in conformity with the conventionally accepted standards of conduct pertaining to this culture were to be excluded from patentability as being contrary to morality.

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

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

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

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

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

In **T 866/01** the invention related to euthanasia compositions which were used for producing humane death in "lower animals". The proprietor argued that the avowed use of the invention's teaching indicated in the patent ("bestimmungsgemäßer Gebrauch der erfindungsgemäßen Lehre") was the use of the claimed composition for mercy killing of lower animals and that this particular intended use did not infringe "ordre public" or morality. It was, in the proprietor's opinion not sufficient for an objection under Art. 100(a) and 53(a) EPC that the invention could also be exploited in a way that would infringe principles of morality or "ordre public". The board noted that no evidence had been

provided that euthanasia of lower animals under the particular conditions described in the application would obviate any ethically based constitutional or other rules. The board therefore held that in the circumstances of the present case, Art. 53(a) EPC provided no legal basis for denying absolute substance protection for the claimed composition per se on the grounds that, with the exception of the intended use or exploitation, one or more of several or even all conceivable other exploitations or uses of the claimed composition (falling within the scope of protection) would be or could be regarded as breach of the principles of "ordre public" or morality, even if such conceivable exploitation might constitute a serious breach of the principle of "ordre public", such as a criminal offence including the killing of humans. The board noted that the mere possibility of abuse of the invention was not sufficient to deny patent protection pursuant to Art. 53(a) EPC.

In **T 2510/18** the board rejected parallels with **T 356/93** and **G 2/06** and held that the development of an invention was distinct from its commercial exploitation once it had been implemented. The question of whether, an invention derived from traditional remedies using unfair means was contrary to morality was answered in the negative by the board. It was the bad faith and breach of trust associated with how the invention had been derived that was contrary to morality, not the actual exploitation of the invention itself. The board concluded that the patent in suit did not violate Art. 53(a) EPC.

c) Donor consent

The invention in **T 1213/05** related to the human BRCA1 gene isolated from the genome, mutant forms of that gene and its use in the diagnosis of predisposition to breast and ovarian cancer. Appellant II submitted that the lack of proof that the donors of the cells had given previous informed consent to the commercial exploitation of the research results by patents as well as a benefit sharing agreement meant that the initial obtaining of these research results involved a violation of ordre public or morality as referred to in Art. 53(a) EPC.

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

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

3. Patentability of biological inventions – Article 53(b) EPC

3.1. Plants and plant varieties

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

3.1.1 Definition of the term "plant varieties"

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

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

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

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

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

The words "the expression of the characteristics that results from a given genotype or combination of genotypes" used in R. 26(4)(a) EPC refer to the entire constitution of a plant or a set of genetic information. In contrast, a plant defined by single recombinant DNA sequences is not an individual plant grouping to which an entire constitution can be attributed within the above meaning. A plant defined in this way is not a concrete living being or grouping of concrete living beings but an abstract and open definition embracing an indefinite number of individual entities defined by a part of its genotype or by a property bestowed on it by that part (**G 1/98**, **T 189/09**, **T 547/10**).

In **T 1208/12** the board held that a claim for a hybrid plant seed produced by a cross of two types of Brassica plants, was directed to an excluded plant variety. The board held that the technical situation underlying the present case was different from that in **G 1/98** and that the claims were not for a seed or plant merely defined by the presence of a single recombinant DNA sequence. The definition of the claimed subject-matter thus did not fit the concept set out in **G 1/98** of "an abstract and open definition embracing an indefinite number of individual entities defined by a part of its genotype or by a property bestowed on it by that part". In the case at hand, the subject-matter defined a seed or a plant which necessarily belongs to a particular plant grouping which complies with the definition of plant variety pursuant to R. 26(4) EPC, i.e. it relates exclusively to individual plant groupings to which an entire constitution can be attributed.

3.1.2 Limits to patentability

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

The Enlarged Board further held that Art. 64(2) EPC 1973 should not be taken into consideration when a claim to a process for the production of a plant variety was examined, in conformity with the established case law according to which the protection conferred by a process patent is extended to the **products obtained directly by the process**, even if the products are not patentable per se (see chapter II.A.7.).

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

3.2. Animals and animal varieties

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

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

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

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

3.3. Essentially biological processes

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

3.3.1 Essentially biological processes for the production of animals

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

product claim defined in terms of the process by which it was produced and that a product-by-process claim remained a product claim irrespective of the process it referred to.

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

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

3.3.2 Essentially biological processes for the production of plants

a) G 2/07 and G 1/08

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

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

After rejecting a series of possible approaches to the interpretation of the exclusion, the Enlarged Board concluded that a non-microbiological process for the production of plants which contains or consists of the steps of sexually crossing the whole genomes and of subsequently selecting plants is "essentially biological" within the meaning of Art. 53(b) EPC. Such a process does not escape the exception to patentability merely because it contains, as a further step or as part of any of the steps of crossing and selection, a step of a technical nature which serves to enable or assist performance of the steps of sexually crossing the whole genomes of plants or of subsequently selecting plants.

This outcome was largely based on the Enlarged Board's findings with regard to the legislative history of the Strasbourg Patent Convention and the EPC 1973. The legislator's

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

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

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

In **T 2323/11** the invention concerned the removal of unwanted sequences from the genome of transgenic plants which comprise an introduced gene for an agronomically valuable trait. In **G 2/07** and **G 1/08** the Enlarged Board considered that, under Art. 53(b) EPC, excluded processes were characterised by the fact that the traits of the plants resulting from the crossing were determined by the underlying natural phenomenon of meiosis. The board held – contrary to the appellant's argument – that the trait of the excision of the target gene is the result of the crossing of the parent plants and is determined by the underlying natural phenomenon of meiosis, as the latter determines the genetic make-up of the plants produced. The claimed method therefore did not fall under the exception made in **G 2/07** and **G 1/08** for those processes which contain an additional step of technical nature.

In **T 2435/13** the board dealt with the interpretation of the term "essentially biological process for the production of plants" in the light of **G 2/07** and **G 1/08**. The claimed subject-matter was directed to obtaining a Brassica oleracea plant resistant to clubroot by crossing a Brassica rapa plant resistant to clubroot with a B. oleracea plant, rescuing embryos resulting from the cross and regenerating plants from them, selecting plants that were resistant to clubroot, back-crossing such plants with a B. oleracea plant, rescuing embryos resulting from the back-cross, and again selecting a plant that was resistant to clubroot.

The board held that all methods containing or consisting of steps of sexually crossing the whole genome of plants and the subsequent selection of plants, regardless of those plants being sexually incompatible or not, to be excluded from patentability and not just those methods involving meiotic recombination events throughout the whole genome during perfect pairing of homologous chromosomes in the process of meiosis. Furthermore, the board held that while the embryo rescue steps were additional steps of a technical nature, as defined in answer 3 of decisions **G 2/07** and **G 1/08**, the embryo rescue steps by themselves did not introduce the clubroot resistance trait into the genome of the plants produced. The claimed subject-matter was held to be excluded from patentability.

In **T 915/10** the invention concerned soybean plants which had been genetically modified. The claimed method was defined solely by the technical process step of introducing a gene sequence into the genome of the plant by a genetic engineering step introducing heterologous DNA in plant cells. The board noted that the introduced trait was due directly to the expression of the inserted DNA and was not the result of a plant breeding method characterised by crossing and selection. Indeed, the method as claimed did not require nor define steps of mixing genes of plants by sexual crossing and subsequent selection of plants, either explicitly or implicitly. The board was thus satisfied that the claimed method did not fall under the exclusion of "essentially biological processes for the production of plants" pursuant to Art. 53(b) EPC. The board considered that the claimed subject-matter was a method for the production of plants by means of genetic-engineering techniques, which involves laboratory techniques essentially different from breeding methods and which as such have been accepted in the case law to be patentable. The board noted that there was nothing in decisions **G 2/07** and **G 1/08** which would indicate that the Enlarged Board was of the opinion that this practice ought to be reconsidered as a result of its analysis of the process exclusion in Art. 53(b) EPC.

b) Patentable technical processes

In **T 1729/06** the invention was in the field of the production of watermelon fruit, in particular of seedless watermelons. The claimed use and methods concerned the pollination of the sterile female flowers of the triploid watermelon plant with pollen of the diploid polliniser plant. They did not concern sexually crossing two whole genomes of plants (implying meiosis and fertilisation) and the subsequent selection of plants. The board was therefore satisfied that the use and methods as subject-matter of the claims were not such methods which the Enlarged Board in its decisions **G 2/07** (OJ 2012, 130) and **G 1/08** (OJ 2012, 206) had considered to fall under the exclusion of "essentially biological processes for the production of plants".

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

The board found that they were not. The legislator drafting Art. 53(b) EPC had not intended to exclude from patentability a whole class of inventions, i.e. horticultural or agricultural

(agronomic) processes, under which the claimed use and methods undoubtedly fell. The EPC 1973 legislator (and the EPC 2000 legislator) had only wished to exclude from patentability the – then conventional – processes applied by plant breeders in connection with new plant varieties for which a special property right was available under the UPOV Convention, and processes which were fundamentally of this type.

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

3.3.3 Product claims for plants or plant material

a) G 2/12 and G 2/13

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

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

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

The Enlarged Board considered whether allowing patenting of a product claim or a product-by-process claim for a plant or plant material that is obtained by a means of an essentially biological process could be regarded as a circumvention of the process exclusion. It found that it could not, referring to the clear wording of Art. 53(b) EPC. It warned that broadening the scope of the process exclusion to the extent that it included products obtained by essentially biological processes for the production of plants would introduce an inconsistency in the system of the EPC, as plants and plant material other than plant varieties were generally eligible for patent protection.

On the question whether it was of relevance that the protection conferred by the product claim encompassed the generation of the claimed product by means of an essentially biological process for the production of plants excluded as such under Art. 53(b) EPC, the Enlarged Board highlighted the distinction between the requirements for patentability and

the extent of protection. Whether a product claim or a product-by-process claim was patentable was to be examined irrespective of the extent of protection that is conferred by it after grant.

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

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

1. The exclusion of essentially biological processes for the production of plants in Art. 53(b) EPC does not have a negative effect on the allowability of a product claim directed to plants or plant material such as a fruit (**G 2/12**) or plant parts (**G 2/13**).

2. The fact that the process features of a product-by-process claim directed to plants or plant material other than a plant variety define an essentially biological process for the production of plants does not render the claim unallowable (**G 2/13**). The fact that the only method available at the filing date for generating the claimed subject-matter is an essentially biological process for the production of plants disclosed in the patent application does not render a claim directed to plants or plant material other than a plant variety unallowable (**G 2/12**, **G 2/13**).

3. In the circumstances, it is of no relevance that the protection conferred by the product claim encompasses the generation of the claimed product by means of an essentially biological process for the production of plants excluded as such under Art. 53(b) EPC (**G 2/12**, **G 2/13**).

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

In **T 1242/06** of 8 December 2015 the board applied **G 2/12**. The newly submitted claims were restricted to claims for products and related to a (naturally) dehydrated tomato fruit of the species L. exculentum. The board held that the subject-matter in question was not excluded from patentability pursuant to Art. 53(b) EPC. The board remitted the case to the opposition division with the order to maintain the patent on the basis of these claims.

Following a notice of the European Commission, clarifying that the Biotech Directive of the European Parliament and of the Council of 6 July 1998 intended to exclude products 'exclusively obtained by means of an essentially biological process', the Administrative Council amended R. 27 EPC and R. 28 EPC in 2017 (OJ 2017, A56) to exclude from patentability plants exclusively obtained by means of an essentially biological process.

In **T 1063/18**, the board, in an enlarged composition consisting of three technically and two legally qualified members, held that R. 28(2) EPC (see OJ 2017, A56) is in conflict with Art. 53(b) EPC as interpreted by the Enlarged Board in decisions **G 2/12** and **G 2/13**. The board referred to Art. 164(2) EPC, according to which the provisions of the Convention prevail in case of conflict with the Implementing Regulations, and decided to set the decision under appeal aside and to remit the case to the examining division for further prosecution.

The board did not see any reason to deviate from **G 2/12** and **G 2/13**. The interpretation of the Biotech Directive as put forward in the notice of the European Commission on certain articles of the Directive was not seen as a relevant development because it had not been confirmed in a legally binding way. Considering whether an interpretation of Art. 53(b) EPC, different from that given in decisions **G 2/12** and **G 2/13**, was necessary in view of Art. 31(3)(a) of the Vienna Convention, the board concluded that neither the decision of the Administrative Council to adopt R. 28(2) EPC nor the notice of the European Commission could be regarded as a subsequent agreement between the parties in the sense of the Vienna Convention.

b) G 3/19 – dynamic interpretation of Article 53(b) EPC

On 4 April 2019 the President of the EPO referred to the Enlarged Board points of law on the interpretation of Art. 164(2) EPC and the assessment of R. 28(2) EPC under said provision.

In its opinion **G 3/19**, the Enlarged Board began by analysing the scope and focus of the referral and held that the two issues underlying it were interlinked and could be combined in the following single question:

"Taking into account developments that occurred after a decision by the Enlarged Board giving an interpretation of the scope of the exception to patentability of essentially biological processes for the production of plants or animals in Article 53(b) EPC, could this exception have a negative effect on the allowability of product claims or product-by-process claims directed to plants, plant material or animals, if the claimed product is exclusively obtained by means of an essentially biological process or if the claimed process feature define an essentially biological process?"

Interpretation of Art. 53(b) EPC and subsequent agreement or practice

Considering Art. 53(b) EPC on its own, i.e. without reference to R. 28(2) EPC, the Enlarged Board confirmed its earlier decisions in cases **G 1/98**, **G 2/07** and **G 1/08**, and **G 2/12** and **G 2/13**. Furthermore, the Enlarged Board did not find any subsequent agreement or practice within the meaning of Art. 31(3)(a) and (b) Vienna Convention regarding its earlier interpretation.

Dynamic interpretation in the light of Rule 28(2) EPC

The Enlarged Board held that the application of the various methods of interpretation provided for in Art. 31 and 32 Vienna Convention, also taking into account the subsequent developments in the contracting states, did not lead to the finding that the term "essentially biological processes for the production of plants" in Art. 53(b) EPC was to be read clearly and unambiguously as extending to products defined or obtained by such processes. It therefore endorsed the respective conclusions that it came to in **G 2/12**. At the same time, however, the Enlarged Board acknowledged that Art. 53(b) EPC did not prohibit this broader understanding of the process exclusion either. Furthermore, the Enlarged Board recognised that, with the introduction of R. 28(2) EPC, the legal and factual situation underlying decision **G 2/12** had substantially changed. This amendment constituted a new aspect that had arisen since the EPC was signed which could give reason to believe that a grammatical, and restrictive, interpretation of the wording of Art. 53(b) EPC conflicted with the legislator's aims, whereas a dynamic interpretation could bring a result that diverged from the wording of the law. The Enlarged Board held that the exclusion of products exclusively obtained by means of an essentially biological process was not incompatible with the wording of Art. 53(b) EPC, which did not rule out this broader construction of the term "essentially biological processes for the production of plants or animals". The Enlarged Board concluded that, in view of the clear legislative intent of the contracting states as represented in the Administrative Council and having regard to Art. 31(4) Vienna Convention, the introduction of R. 28(2) EPC allowed and indeed called for a dynamic interpretation of Art. 53(b) EPC. Accordingly, the Enlarged Board abandoned the interpretation of Art. 53(b) EPC given in decision **G 2/12** and, in the light of R. 28(2) EPC, held that the term "essentially biological processes for the production of plants or animals" in Art. 53(b) EPC was to be understood and applied as extending to products exclusively obtained by means of an essentially biological process or if the claimed process feature defined an essentially biological process.

In conclusion, the Enlarged Board answered the referral as follows:

"Taking into account developments after decisions **G 2/12** and **G 2/13** of the Enlarged Board, the exception to patentability of essentially biological processes for the production of plants or animals in Article 53(b) EPC has a negative effect on the allowability of product claims and product-by-process claims directed to plants, plant material or animals, if the claimed product is exclusively obtained by means of an essentially biological process or if the claimed process features define an essentially biological process. This negative effect does not apply to European patents granted before1 July 2017 and European patent applications which were filed before that date and are still pending" (see also **T 420/19** where the board reiterated this point).

3.4. Microbiological processes and the products thereof

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

3.4.1 The concept of "microbiological processes"

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

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

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

3.4.2 Difference between microbiological and genetic-engineering processes

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

4. Medical methods

4.1. Introduction

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

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

4.2. Differences and similarities in approaches to establishing whether a method for treatment by surgery or therapy or a diagnostic method involved

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

An important difference between the two approaches is that, whilst a method claim falls under the prohibition on patenting methods for treatment by therapy or surgery if it comprises or encompasses at least **one** feature defining a physical activity or action that constitutes a method step for treatment of a human or animal body by surgery or therapy (**G 1/07**), a much narrower interpretation of Art. 52(4) EPC 1973 was applied with regard to the exclusion from patentability of diagnostic methods in **G 1/04** (see in this chapter I.B.4.6. "Diagnostic methods" – **G 1/04**).

4.3. No need for practitioner involvement

Referring to **G 1/04**, the Enlarged Board in **G 1/07** (a decision concerning treatment by surgery) confirmed that whether or not a method is excluded from patentability under Art. 53(c) EPC cannot depend on the person carrying it out. The Enlarged Board in **G 1/07**

found that, although the findings in **G 1/04** related to diagnostic methods, they dealt quite generally with the exclusion from patentability under Art. 52(4) EPC 1973 and were thus equally valid with respect to the other exclusion conditions contained in the new Art. 53(c) EPC.

In **G 1/04** (OJ 2006, 334) the Enlarged Board held that whether or not a method is a diagnostic method may neither depend on the participation of a medical or veterinary practitioner nor on the fact that all method steps can also, or only, be practised by medical or technical support staff, the patient himself or herself, or an automated system (see also **G 1/07**). This also reflects the fact that technological advances are penetrating human and veterinary medicine and the related professions more and more. Moreover, no distinction is to be made in this context between essential method steps having diagnostic character and non-essential method steps lacking it.

In **T 467/18** the board observed that it had been explicitly pointed out in **G 1/04** and **G 1/07** that the ability to delegate a method at best indicated whether a particular method could be considered to form part of the "core of the medical profession's activities".

In **T 1680/08** the claim concerned a non-invasive method and apparatus for optimising the respiration for atelectatic lungs. The appellant submitted that a medical doctor would never be hampered by the claimed method as it was executed by a computer. The board however held that there was no term in Art. 53(c) EPC which would allow concluding that hampering of the practitioner's freedom was a prerequisite for the exclusion to apply in the individual case considered.

4.4. Surgical methods

G 1/07 (OJ 2011, 134) marked an important turning point in the boards' case law on the exclusion of surgical methods from patentability. The Enlarged Board rejected the practice followed by the EPO thus far of broadly construing interventions of a surgical nature, such as in decisions **T 182/90** and **T 35/99**, namely that all methods involving irreversible damage to or destruction of living cells or tissues of the living body were regarded as non-insignificant interventions and thus as surgical treatments, irrespective of the underlying mechanism of the intervention (e.g. mechanical, electrical, thermal, chemical). However, the Enlarged Board did not redefine the term "treatment by surgery" but indicated the direction in which it expected future practice and case law to develop. According to **G 1/07**, the required new direction is that the exclusion from patentability should not be applied to methods in respect of which the interests of public health, of protection of patients and as a counterpart to that of the freedom of the medical profession to apply the treatment of choice to their patients does not call for their exclusion from patentability.

4.4.1 One surgical step in a multi-step method

Opinion **G 1/04** (OJ 2006, 334) made it clear that a method claim falls under the prohibition of Art. 52(4) EPC 1973 if it includes at least one feature defining a physical activity or action that constitutes a method step for treatment of the human or animal body by surgery or therapy.

In **G 1/07** the Enlarged Board upheld this principle confirmed in opinion **G 1/04** (OJ 2006, 334). This principle is not only formally justified by the fact that the exclusion under Art. 53(c) EPC does not contain any limitation as to the defined methods being excluded only when claimed as such. More importantly, it is also justified as to substance, i.e. it enables the legislative purpose served by the exclusion to be achieved (see in this chapter I.B.4.1.).

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

In **G 1/07** (OJ 2011, 134) the Enlarged Board concluded that neither the legal history nor the object and purpose of the exclusions from patentability in Art. 53(c) EPC would justify a limitation of the term "treatment by surgery" to curative surgery (overruling **T 383/03**). Such a limitation would be contrary to the ordinary understanding of the word "surgery" as referring to the nature of the treatment rather than its purpose, and contrary to the fact that Art. 53(c) EPC defines three separate alternative exclusions thereby suggesting that these are not merely identical in scope. The Enlarged Board observed in **G 1/07** that the comparison between **T 383/03** and **T 1172/03** showed how inconsistent the decisions to be made could become if the term "treatment by surgery" was seen as limited to therapeutic surgery only. The term "treatment by surgery" is therefore not to be interpreted as being confined to surgical methods pursuing a therapeutic purpose (**G 1/07**). As stated in the Guidelines (G-II, 4.2.1.1 – April 2025 version), the term "surgery" thus defines the nature of the treatment rather than the purpose.

4.4.3 Towards a new concept of "treatment by surgery"

In **G 1/07** the Enlarged Board disagreed with the EPO's practice of broadly interpreting the surgical character of interventions.

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

It is for the departments of first instance and the boards to define the boundaries of a more narrowly construed concept of "treatment by surgery", based on the technical reality of the individual case under consideration.

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

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

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

a) Surgical nature of a method step

In **T 992/03** of 4 November 2010, ^{129}Xe gas was used as part of the claimed method. The board referred to **G 1/07** according to which "there is an exclusion from patentability as a surgical method only if the health risk is associated with the mode of administration and not solely with the agent as such" and any anaesthetic effect of the ^{129}Xe gas thus did not fall under the exclusion (see also **T 318/21**).

b) Assessment of "substantial health risks"

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

However, in **T 1075/06** the board held that venipuncture of blood donors and the extraction of blood from a donor's body represent substantial physical interventions on the body which require professional medical expertise to be carried out and which entail a substantial health risk even when carried out with the required professional care and expertise. A method claim comprising steps encompassing such procedures is a method for treatment of the human body by surgery.

Similarly, in **T 1695/07** the board held that a blood manipulation process involving the continuous removal of blood from a patient, its subsequent flowing through a circulating line of an extracorporeal circuit and its re-delivery to the patient was a method of treatment of the human body by surgery. It stated that even when the process was carried out with the required medical professional care and expertise, it involved "substantial health risks" for the patient. A health risk was considered to qualify as "substantial" whenever it went beyond the side-effects associated with treatments such as tattooing, piercing, hair removal by optical radiation, micro abrasion of the skin as mentioned in **G 1/07**. A factual

analysis of absolute or relative risks and their likelihood of occurrence based on objective evidence was hardly feasible and should therefore not be required.

In **T 2699/17** the application related to the guided expansion of an elastomeric material within the sulcus of a tooth. In this way, the gingiva was retracted from the tooth, such that an appropriate impression of the tooth could be obtained, which was then used in the manufacture of the crown restoration. The criteria as defined in **G 1/07** were applied and the board found that minor injury of the epithelium could occur. It then had to examine whether the method qualified as "substantial physical intervention on the body", i.e. whether the health risk was a substantial health risk within the meaning of **G 1/07**. For that evaluation, different approaches had been suggested in the case law, namely, the 'risk matrix' in decision **T 663/02** and a 'more abstract risk criterion' in decision **T 1695/07**. The board followed the latter approach, which was limited to the question "Is a certain health risk present?" and "Is it substantial?" The board held that the risks here were at a level equal to those present in the methods which **G 1/07** considered not to involve a substantial health risk (see also **T 467/18**).

In **T 434/15** the inventions concerned apheresis, a method in which blood was removed from a person, passed through an apparatus for separating and collecting a particular constituent of the blood (in the present case, stem/progenitor cells) and re-transfused without the collected constituent. The fact that a certain method was routine for a highly specialised centre could not, according to the board, automatically lead to the conclusion that such a method would generally be a safe and routine technique. Apheresis was held to be a method using invasive techniques that allowed for extra corporeal manipulation of an organ of the human body. There were considerable health risks involved. Furthermore, apheresis could not be considered to be a generally safe, simple, routine procedure. Consequently, apheresis had to be seen as a method of surgery within the meaning of Art. 53(c) EPC.

c) Surgical step part of claimed method or simply a preparatory measure?

The boards have had to consider whether particular surgical steps form part of the claimed method or are simply preparatory measures which cannot be deemed such a part.

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

In **T 2438/11** the claim was directed to a method for instrument alignment comprising steps whereby a surgical drill or mill was aligned with a target point. Said alignment was to take place in the patient's body, in direct physical contact with the bone. The board held that the very act of alignment, i.e. actively moving an instrument of this kind within the patient's

body, was a substantial physical intervention on the body and thus a method step for treatment of the human body by surgery. The claimed method for instrument alignment, which explicitly included the (active) alignment step, also differed fundamentally from a mere (passive) position-tracking method of the kind at issue in **T 836/08** (see below).

d) Surgical step not in the claim but covered by it?

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

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

In **T 2102/12** the claim related to medical robotic systems. The appellant sought to protect a method performed by a device for determining and displaying distance information, the claimed method being performed contemporaneously and in parallel with an unclaimed, surgical process. The board held that these two "types" of method steps were inextricably interrelated. The board found, that the presently claimed method of intertwined non-surgical ("claimed") and surgical ("unclaimed") steps was not comparable to that underlying **T 836/08**.

In **T 1631/17** too, the wording of the claim did not explicitly mention any method step that could be considered surgical within the meaning of Art. 53(c) EPC; however, the claimed method included such a step. The surgical method step in question fell within the claimed method in terms of both when and where it was done. The claimed method could not be performed without immediately performing this intermediate step, and this was sufficient for it to fall under the exception in Art. 53(c) EPC (**G 1/07**, OJ 2011, 134).

In **T 699/12** the board noted that according to the jurisprudence of the boards there was no uniform approach how to interpret method claims, in which no particular therapeutic/surgical step was claimed, although it derived from the context that such a therapeutic/surgical step would be present in relation to the claimed method. In **T 699/12**, the claimed method implied an irradiation of the patient, because otherwise a quantification of the dose delivery in the radiotherapy treatment of the patient would not be possible.

However, when carefully considering the wording of the claims, there was no basis for identifying a step like an "intermediate treatment of irradiating the patient for therapeutic purposes" that was de facto not claimed. Hence, claim 1 could not be interpreted to include a step of irradiating the patient.

e) The apparatus claim is not a disguised method claim

In **T 1798/08**, although all claims were directed to a visual prosthesis, i.e. an apparatus, they were objected to by the opponent under Art. 53(c) EPC as relating to a surgical method. The features "suitable to be located on the body of the user outside a wall of the sclera and attached to the sclera" and "suitable to be located implanted in the eye behind the iris", the opponent argued, related to a method for treatment of the human or animal body by surgery and thus transformed the claim into a "disguised" method claim, even though it was notionally directed to a device.

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

f) Unpatentable claims for products that can only be produced in a surgical step

Pursuant to the second clause of Art. 53(c) EPC, the exclusion from patentability "shall not apply to products, in particular substances or compositions, for use in any of these methods."

In **G 1/07** it was found that a single surgical method step was enough to regard a multi-step method as being excluded from patentability. It was not a question of whether a medical practitioner would then infringe the claimed method. In decision **T 775/97** this approach was transferred to particular products. The claim related to a new product which had been produced from two components, both known per se, by means of a surgical step in the human body. The board in **T 775/97** held that no European patent could be granted with claims directed to a new and even possibly inventive way of using materials or devices, in particular endoprostheses, involving a treatment by surgery. This was held to be equally true for product claims defined by a construction which was only arrived at in the human or animal body following a surgical method step.

The board in **T 1731/12** endorsed **T 775/95** and continued its approach, holding that a device defined by a feature that could be arrived at only by a surgical or therapeutic step was excluded from patentability under Art. 53(c) EPC. It agreed with the thinking that a product defined by a surgical step could not exist without it, and thus that the surgical step was part of the claimed product. Moreover, the exclusion of such a product from patentability was not contrary to the second clause of Art. 53(c) EPC, which provided that products for use in therapeutic or surgical methods were patentable. Otherwise, medical and veterinary practitioners' freedom would be limited, as also discussed for example in

G 1/07. The board saw a fundamental difference between the actions of "using" and "making" a product. Using patented subject-matter was generally allowed once that subject-matter had been duly purchased. To be allowed to make a patented product, by contrast, medical staff would need to purchase a licence for the process of making it; where that process involved a surgical or therapeutic method step, that would interfere precisely with the freedom of medical staff that the exclusion from patentability under Art. 53(c) EPC intended to protect. In **T 1552/22** by contrast, the board held that while in **T 1731/12** and **T 775/97** surgical steps were required to reproduce the invention such that the apparatus/the device was excluded from patentability, in the present case no surgical step was required to reproduce the annuloplasty implant of claim 1.

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

a) Claim cannot be left to encompass surgical step

A claim encompassing an embodiment which is excluded from patentability under Art. 53(c) EPC cannot be left unamended (**G 1/07**, OJ 2011, 134; as previously held in **G 1/98**, OJ 2000, 111).

In **G 1/07** the board also found the following: whether or not a step being or encompassing a surgical step excluded from patentability can be omitted either by using positive wording for such omission like "pre-delivered" or by simply leaving it out from the claim depends, under Art. 84 EPC, on whether the claimed invention is fully and completely defined by the features of the claim without that step. That requires an assessment of the individual case under consideration.

b) Disclaimer

The Enlarged Board in **G 1/07** went on to say that the exclusion from patentability under Art. 53(c) EPC can be avoided by disclaiming an embodiment, it being understood that in order to be patentable the claim including the disclaimer must fulfil all the requirements of the EPC and, where applicable, the requirements for a disclaimer to be allowable as defined in decisions **G 1/03** (OJ 2004, 413) and **G 2/03** (OJ 2004, 448) (see also **G 1/16**). Whether or not the wording of a claim can be amended so as to omit the surgical step without offending against the EPC must be assessed on the basis of the overall circumstances of the individual case under consideration (see **T 923/08**, in this chapter I.B.4.4.4 d)).

c) Methods only concerning the operation of a device

It is the established case law of the boards of appeal that a method which is only concerned with the operating of a device without any functional link between the claimed method and the effects produced by the device on the body does not qualify at all as a method for treatment within the meaning of Art. 52(4) EPC 1973 (Art. 53(c) EPC) (**T 245/87**, OJ 1989, 171, **T 789/96**, OJ 2002, 364). If, on the contrary, there is such a functional link the method is excluded from patentability (**T 82/93**, OJ 1996, 274, **T 1680/08**, **T 141/15**).

In **T 1075/06** the board explained that this principle, initially developed for devices for use in a therapeutic treatment (**T 245/87**, OJ 1989, 171), had been endorsed by the EBA for treatments by therapy as well as surgery (**G 1/07**).

According to the Enlarged Board in **G 1/07**, whether or not a claimed method only concerns the operation of a device without any functional link to the effects of the device on the body requires an evaluation of the overall technical circumstances of the case and is therefore a matter to be determined in the individual cases under consideration.

In **T 1680/08** a non-invasive method and apparatus for optimising the respiration for atelectatic lungs was held to be a method for treatment by therapy, because there was a functional and indissociable link between the claimed method and any artificial ventilation practised on a connected patient.

In **T 44/12** the board stated that, whether or not a method has to be considered a method for treatment of the human body by therapy is determined by the existence of a functional link or a direct influence of the method claimed in itself on a given therapy, such that the medical doctor's freedom of choice and of practice in this respect is hindered. In the present case the board considered that the subject-matter only concerned the operation of a device, without any functional link to the effects of the device on the body.

In **T 699/12** the invention pertained to a method of verifying a radiotherapy treatment device. The board held that the claimed method only concerned the technical operation of a device without any functional link to the effects of the device on the body. While the intention of the claimed method was to verify the actual dose that the patient should receive, what was measured was the output dose of the radiation source and it was checked whether the radiation source worked as expected. In the claimed method there was no step that would influence the actual treatment of the patient. The medical practitioner was free to choose the next steps of treatment of a patient.

In **T 944/15**, the invention, as described, related to a data processing method for controlling a process of monitoring the position of at least a part of a patient's body during a radiation treatment by means of a computer. The board rejected the claim as being a medical method, even though the claim was restricted to a method implemented on a computer. It held that it was not the claimed scope, but the corresponding teaching of the invention which was decisive for establishing what the invention is, and, for the purpose of Art. 53(c) EPC, whether or not a claimed invention only concerned the operation of a device without any functional link to the effects of the device on the body (**G 1/07**). In conclusion and paraphrasing **G 1/07**, the board held that the claimed method was not merely directed to the control of the device, because the teaching of the invention was not complete without the steps of initiating the monitoring and using the result; their necessary consideration as part of the teaching of the invention meant that the claim defined a method of treatment excluded under Art. 53(c) EPC.

In **T 2136/19** the board did not follow the line of argument of **T 944/15**. The invention concerned a method for assisting the positioning of a medical structure on the basis of two-dimensional image data. The board held that claim 1 did not recite any method step

defining or encompassing a physical activity or action that constituted a method step for treatment of a human or animal body by surgery or therapy (**G 1/07**). The claimed method was strictly limited to a purely "passive" data processing method, which was carried out entirely and exclusively within a computer without causing any effect on the patient's body as a result. It was irrelevant that the claimed method may be performed after or even iteratively during a surgical intervention on the body. In any event, there would be no functional link between the claimed method and any effects of a surgical or therapeutic nature that would occur during this intervention. Therefore, in the absence of such a functional link, the claimed method as such did not qualify as a method for treatment of the human or animal body within the meaning of Art. 53(c) EPC.

In **T 1526/17** the claim was directed to a method for operating a medical navigation system. The medical navigation system comprised a stationary marker device and an electronic device which was rigidly attached to the bone. Hence, its operation was not limited to mere data processing or calculation steps. The possibility that the bone is moved with the attached electronic device was not excluded from the claimed method by the wording of the claim. The board held that the output signal of the camera could only be analysed to calculate the first point if the camera assumed different positions during bone movement. Hence, the movement of the bone with the attached electronic device and the associated data acquisition were indispensable requirements for calculating the first point, even when the calculation involved some approximation and may be carried out after the movement is completed. Hence, said movement was to be considered an integral part of the claimed method. As a consequence, the claimed method comprised the step of pivoting the bone with the electronic device attached to it to produce the data for calculating point P1. The board considered the step of pivoting the bone to be a surgical step, because pivoting the exposed bone involved substantial health risks for the patient.

In **T 318/21** the board held that neither **G 1/07** nor the decisions cited therein, in point 4.3.2 of the Reasons, defined what was meant by "functional link" in the case of a surgical procedure. Furthermore, the presence or absence of a functional link was relevant solely in so far as the claimed method only concerned the operating of a device (**G 1/07**, point 4.3.2 of the Reasons, first paragraph). **G 1/07** found that a method – even if the method was to be viewed as a method for operating a device – was excluded from patentability as a method for treatment by surgery if it comprised or encompassed a surgical step. In the case at hand, the surgical step – the movement of the endoscope inside the body – was not simply a preparatory step that was performed upstream and not part of the method. Rather, the movement of the endoscope was part of the claimed acquisition of data.

4.4.6 Data obtained during surgery

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

4.5. Therapeutic methods

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

4.5.1 The term "therapy"

a) Definition of the term

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

In **T 81/84** (OJ 1988, 207) the board found that the concept of therapy should not be construed narrowly. It would be impossible and undesirable to distinguish between basic and symptomatic therapy, i.e. healing or cure and mere relief. The board concluded that irrespective of the origin of pain, discomfort or incapacity, its relief, by the administration of an appropriate agent, was to be construed as therapy or therapeutic use within the meaning of Art. 52(4) EPC 1973.

In **T 24/91** (OJ 1995, 512) the board observed that the term "therapy" was not restricted to curing a disease and removing its causes. Rather, this term covered any treatment which was designed to cure, alleviate, remove or lessen the symptoms of, or prevent or reduce the possibility of contracting any disorder or malfunction of the human or animal body. The board found that the claimed process removed, by treatment of the patient's eye, the symptoms of myopia, hyperopia and astigmatism and was therefore a therapeutic treatment. In **T 979/23** too, the board noted that treatment by therapy does not per se require the disease to be completely cured or even that its cause be addressed, but does encompass the alleviation of symptoms (see also **T 1779/21**).

In **T 752/17**, the board referred to the definition of "therapy" in **T 24/91** and held that contrary to the view taken by the appellant, there was no requirement for a purpose-restricted product claim pursuant to Art. 54(5) EPC to recite a disease or pathological condition.

In **T 2420/13** the board stated that a "therapeutic treatment" required some intervention on the body or body part to be treated which caused a therapeutic effect.

In **T 1075/09** the patent proprietor had argued that the feature had been part of the definition of the patient group and could not be considered to be a claimed therapeutic method. The board held that claim 1 was worded in such a way that it taught the direct administration of FSH to the patient for inducing folliculogenesis because the feature "and wherein folliculogenesis is induced by the administration of FSH" was not covered by the

Swiss-type format. Therefore this feature constituted a therapeutical method of its own involving a direct physical intervention on the human body.

In **T 944/15**, the invention, as described, related to a data processing method for controlling a process of monitoring the position of at least a part of a patient's body during a radiation treatment by means of a computer. The appellant argued that the invention was a data processing method confined to the computer, i.e. a computer-implemented method. In the board's view, the second leg of the provision in Art. 53(c) EPC refers essentially to products and held that a computer program, as defined in the claimed invention was not such a product. In providing protection for a computer program which is designed to implement a method of treatment, de facto protection is provided for the method of treatment, because running the program is using the method. As the method is excluded, so the computer program should also be excluded: even if indirectly conferred, a protection for a method of treatment goes against the ratio legis of Art. 53(c) EPC (**G 1/07**, point 3 of the Reasons).

b) Prophylactic treatments

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

In **T 2071/15** the invention concerned a dental care product for the purpose of restoring pH in the mouth, from a lower pH to neutral pH. This was held to be based on the therapeutic mechanism of action of inhibition of growth of oral bacteria, and therefore excluded.

In **T 2074/22** claim 1 related to an agent for use in the prophylaxis or improvement of frailty in an elderly person. The board held that prophylaxis of frailty is previous prevention of its symptoms from being developed, and the improvement of frailty includes bringing these symptoms to fall within a normal range, as well as preventing the progression or exacerbation of the disease.

c) Distinction from performance improvement

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

d) Distinction from cosmetic methods

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

e) Examples from case law

In **T 469/94** the board observed that the treatment for reducing the perception of fatigue due to an increase in acetylcholine level in the brain and tissue was not comparable with the relief of pain, discomfort and incapacity (see above **T 81/84**, OJ 1988, 207).

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

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

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

In **T 1819/13** the use of an antibiotic for the manufacture of a medicament for use in treating or preventing a bacterial infection in an animal by injection of the medicament subcutaneously at the junction of a pinna with the cranium of the animal was claimed. The site of injection was held to be an integral technical element of the administration of the medicament and thus of the therapeutic application. However, this feature of a specific site of injection did not mean that the claim fell within the scope of Art. 53(c) EPC (see also **T 1554/11**).

In **T 1599/09** and **T 235/15** the boards considered enteral feeding to fall under the meaning of the term "therapy". The alleviation of symptoms was considered to be therapeutic, especially in the case of tube feeding to alleviate a patient's inability to receive nutrition through a normal diet.

T 815/22 concerned a growth promoting infant formula. The board held that the use of an infant formula for promoting, in an infant, a postnatal growth trajectory or body development towards a growth trajectory or body development similar to those observed in human milk fed infants, does not qualify as a method of treatment by therapy under Art. 53(c) EPC. Similarly, the board in **T 884/23**, where the claim was directed to a milk fortifier for use in prevention of visceral adiposity and/or decreasing the ratio visceral adipose tissue to subcutaneous adipose tissue in a preterm infant human, the board held that decreasing the ratio of visceral adipose tissue to subcutaneous adipose tissue in a preterm infant is not a method of treatment by therapy pursuant to Art. 53(c) EPC.

4.5.2 Methods with both therapeutic and non-therapeutic indications

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

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

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

In **T 290/86** (OJ 1992, 414) the board held that the disclosed method of eliminating plaque was not considered allowable because it inevitably had the therapeutic effect of preventing caries and periodontal disease. The board took the view that whether or not a claimed invention was excluded from patentability under Art. 52(4) EPC 1973 depended in particular on the wording of the claim in question. If the claimed invention was not directed solely to a cosmetic effect, but was also necessarily defining a treatment of the human body by therapy as well, such a claim was excluded from patentability (distinguishing

T 144/83, OJ 1986, 301). The board held that if the claimed use of a chemical product inevitably always had a therapeutic effect as well as a cosmetic effect the invention as claimed necessarily defined a treatment of the human body (see also **T 475/12**).

In **T 780/89** (OJ 1993, 440) the claim in question related to a method of general immunostimulation for animals which led, inter alia, to an increase in meat production. The board regarded the effect of increasing meat production as a consequence of the improvement in the animals' health. Moreover, the general stimulation of the immune system was integrally linked to the specific prophylactic function of safeguarding against particular infections. The secondary effect of a therapeutic treatment did not render it patentable.

In **T 438/91** the patentee contended that the main purpose of the claimed process was to increase the weight of the animals which effect was separable from the effect of prevention or cure of scours. This latter was merely a beneficial side effect. The board found that, in the light of the patent disclosure, the two effects were linked by the single action of feeding the animals, and that the intention was to obtain both effects at the same time in animals suffering from scours (treatment by therapy) and to prevent the latter complaint in those animals which did not already have it (treatment by prophylaxis).

In **T 1077/93** the board held that a composition intended to protect the human epidermis against ultraviolet radiation and notably to reduce the intensity of erythema, recognised as the most spectacular form of damage to the skin by sunlight, and of skin-level cellular changes such as the formation of degenerated and necrotised keratinocytes, generally known by the term "sunburn cells (SBC)", was excluded from patentability. Citing the point, already explored in **T 820/92** (OJ 1995, 113), that the exclusion of therapeutic methods from patentability could not be avoided by a purely formal rewording of the claim to qualify the purpose of the process, in its indivisible entirety, as non-therapeutic, the board found that, since at least part of the protective effect did not derive from a simple filtering at the level of the skin surface, but rather from an interaction with the cellular mechanisms in the epidermis, the process had a genuine therapeutic effect.

T 1635/09 (OJ 2011, 542) related to a method for oral contraception whereby the pathological side-effects were prevented or reduced. The board held that the prevention of side-effects – which was affirmed in claim 1 by the indication of the concentrations of active substance – was inseparably associated with the per se non-therapeutic contraceptive process. In such a case too, the exclusion from patentability under Art. 53(c) EPC could not be avoided even by limiting the claim to a "non-therapeutic use".

In **T 158/13** it was not possible to distinguish between a therapeutic or non-therapeutic use of the stimulative perfume composition, since the way of administering the composition was the same for a therapeutic and a non-therapeutic use. Sleepiness or inactivity in daily life may not only be a physiological condition, but may also arise from a pathological condition. Without a clear and unambiguous distinction between a physiological and a pathological nature of a person's mental condition, a clear distinction between therapeutic and non-therapeutic use is also impossible.

b) Therapeutic and non-therapeutic effects distinguishable

In **T 144/83** (OJ 1986, 301) was concerned with whether an appetite suppressant was being used to cause loss of weight or to cure obesity. The board pointed out that the language of the claim in question clearly covered a method of cosmetic use and was unrelated to the therapy of a human or animal body in the ordinary sense. The board held that the fact that a chemical product had both a cosmetic and a therapeutic effect when used to treat the human or animal body did not render the cosmetic treatment unpatentable.

In **T 36/83** (OJ 1986, 295) the board held that, in the treatment of comedones, a distinction could be made between an antibacterial effect (therapeutic) and a cosmetic effect. The use of the term "cosmetic" was held to be sufficiently precise, although the cosmetic treatment according to the application might also incidentally involve a medical treatment.

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

In **T 1916/19** the claimed methods and uses related to providing an anti-microbial effect to skin. In the view of the examining division this inherently implied a prophylactic treatment of several diseases since skin disinfection will always remove pathogenic bacteria. However, the board held that there were at least some identifiable realisations of the method which were clearly non-therapeutic such as removing non-pathogenic bacteria responsible for unpleasant body odour.

4.5.3 Disclaimer for escaping the exception to patentability under Article 53 c) EPC

One way of escaping the exception to patentability is a disclaimer, but the claim featuring the disclaimer must then meet all the EPC requirements (see also in this chapter I.B.4.4.5). In **T 774/89** the board accepted the patentability of using a medication to increase milk production in cows, because it was evident that the success of the treatment did not depend on the animals' state of health, and the insertion in the claim of the term "non-therapeutic" served as a disclaimer, excluding the therapeutic effects of the medication.

According to **T 1635/09** (OJ 2011, 542), the following applies to claims encompassing both therapeutic and non-therapeutic uses: a disclaimer "non-therapeutic" allows for the exclusion of therapeutic uses from a claim encompassing both therapeutic and non-therapeutic uses in such a way that they are substantively separable, so that the remaining subject-matter is no longer covered by the exception to patentability under

Art. 53(c) EPC. However, such a disclaimer cannot be employed to define as non-therapeutic a use which – like that at issue in this case – necessarily includes one or more therapeutic steps, since the question whether or not a claimed use is therapeutic can be decided only in the light of the activities carried out, or the effects achieved, in the course of that use.

In **T 385/09** the addition of the disclaimer "non-therapeutic" was accepted by the board, even though the difference between a therapeutic and non-therapeutic application of the method was not explicitly explained in any other manner. However, the board was satisfied that the application did contain teaching of a method which might have been regarded as therapeutic (cooling of cows in a heat stress), but also teaching of a method which was clearly not therapeutic (cooling of healthy cows for luring them to the milking stall).

In **T 767/12** non-therapeutic and therapeutic methods for normalising infradian rhythm were considered indistinguishable. A disclaimer intended to restrict the claim to "non-therapeutic" methods was considered unallowable for lack of clarity under Art. 84 EPC (**G 1/03**, **G 1/16**) since it rendered the scope of the claim void.

4.6. Diagnostic methods

Under Art. 53(c) EPC diagnostic methods practised on the human or animal body are also excluded from patentability. However, the boards construe the exception applicable to diagnostic methods more narrowly than that applicable to surgical and therapeutic methods (**G 1/04**). In **G 1/04** (OJ 2006, 334) the President of the EPO had referred fundamental questions relating to the interpretation of the term "diagnostic methods practised on the human or animal body" to the Enlarged Board. The Enlarged Board emphasised that its interpretation of the scope of the exclusion from patentability under Art. 52(4) EPC 1973 in respect of diagnostic methods practised on the human or animal body would remain valid under the EPC 2000.

4.6.1 Opinion G 1/04 and its application in case law

a) What constitutes "diagnostic methods"

In **G 1/04** the Enlarged Board gave the term "diagnostic methods" a narrow interpretation: in order that the subject-matter of a claim relating to a diagnostic method practised on the human or animal body falls under the prohibition of Art. 52(4) EPC 1973, the claim is to include the features relating to: (i) the diagnosis for curative purposes *stricto sensu* representing the deductive medical or veterinary decision phase as a purely intellectual exercise, (ii) the preceding steps which are constitutive for making that diagnosis, and (iii) the specific interactions with the human or animal body which occur when carrying those out among these preceding steps which are of a technical nature.

The Enlarged Board pointed out that the surgical or therapeutic nature of a method claim could be established perfectly by a single method step without contravening Art. 84 EPC 1973. Diagnostic methods, however, differed in this respect from the methods of surgery and therapy. The method steps to be carried out prior to making a diagnosis as

an intellectual exercise were related to examination, data gathering and comparison. If only one of the preceding steps which were constitutive for making such a diagnosis were lacking, there was no diagnostic method, but at best a method of data acquisition or data processing that could be used in a diagnostic method (see **T 385/86**). It followed that, whilst the surgical or therapeutic nature of a method claim could be achieved by a single method step, several method steps were required to define a diagnostic method due to the inherent and inescapable multi-step nature of such a method.

These required method steps (**G 1/04**) consist of: (i) the examination phase involving the collection of data, (ii) the comparison of these data with standard values, (iii) the finding of any significant deviation, i.e. a symptom, during the comparison, and (iv) the attribution of the deviation to a particular clinical picture, i.e. the deductive medical or veterinary decision phase.

In **T 1255/06** the claim in question only defined the data acquisition steps (the temperature of the body) which could be used in a diagnostic method. Although the acquisition of the temperature data lead to the detection of a deviation from the normal values, it did not allow per se the attribution of the detected deviation to a particular clinical picture.

T 1232/15 related to the use of several adhesive and haptic strips for forming an aid for visually impaired people to enable line-by-line palpation of the breasts when performing a clinical breast examination. The board held that the claimed steps merely included the preparation of a diagnostic method to be performed by a visually impaired person, and that the steps constitutive for making the diagnosis were not included.

The board in **T 529/19** stated that the interpretation of the scope of exclusion from patentability under Art. 52(4) EPC 1973 elaborated in Opinion **G 1/04** is still valid for Art. 53(c) EPC. Claim 1 of the main request at hand defined a method "of determining skin health of an area of skin". The steps of this method included calculating a ratio between the intensities measured for two fluorescent emissions induced on the area of skin and comparing this ratio to a control ratio. In the decision under appeal, the examining division had found that the phases (i) to (iii) of **G 1/04**, were present in the steps of the method recited by claim 1. It further found that the phase (iv) of **G 1/04** was derivable from the wording "[a] method of determining skin health" at the beginning of claim 1. The appellant contested the latter finding and submitted that the method of claim 1 did not include the attribution of the deviation to a particular clinical picture.

The board observed that claim 1 left open what the determined "skin health" was. For example, it could refer to the quotient between the two ratios being compared in step (vi) of claim 1 or to some other parameter related to skin health, which may at most be an intermediate finding of diagnostic value. Although the term suggested that some assessment of the skin health was made, neither the claim wording nor the relevant passages of the description indicated that the assessment would actually include the attribution to a particular clinical picture. Even if the method were construed as including some judgment of skin ageing for the assessed skin area, this would not represent the attribution to a particular clinical picture. Establishing that skin ageing is greater than expected for an individual would be, at most, an intermediate finding of diagnostic value.

The board thus held that the method of claim 1 did not include the attribution of the deviation to a particular clinical picture, i.e. the deductive medical or veterinary decision phase and was therefore not excluded under Art. 53(c) EPC.

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

According to **G 1/04** all method steps of a technical nature should satisfy the criterion "practised on the human or animal body", i.e. the performance of each and every one of these steps should imply an interaction with the human or animal body, necessitating the presence of the latter.

In **G 1/04** the Enlarged Board held that in a diagnostic method, the method steps of a technical nature belonging to the preceding steps which were constitutive for making the diagnosis for curative purposes stricto sensu must satisfy the criterion "practised on the human or animal body".

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

Article 52(4) EPC 1973 did not require a specific type and intensity of interaction with the human or animal body; a preceding step of a technical nature thus satisfied the criterion "practised on the human or animal body" if its performance implied any interaction with the human or animal body, necessitating the presence of the latter. If the preceding technical method steps were performed by a device, this did not satisfy the criterion "practised on the human or animal body" (**G 1/04**).

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

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

In **T 1920/21** the board considered the following: The Enlarged Board held in **G 1/04** that since a narrow interpretation of the scope of the exclusion from patentability under Art. 52(4) EPC 1973 in respect of diagnostic methods was equitable, it was justified to require that the performance of each and every one of the method steps of a technical nature of a diagnostic method should satisfy the criterion "practised on the human or animal body" (Reasons 6.4.4).

Conversely, the Enlarged Board held that a claim is not excluded from patentability under Art. 52(4) EPC 1973 if at least one of the preceding steps which are constitutive for making a diagnosis for curative purposes comprises a method step of a technical nature which does not satisfy the criterion "practised on the human or animal body", e.g. a method step carried out by a device without implying any interaction with the human or animal body or a method step carried out in vitro in a laboratory (**G 1/04**, Reasons 6.4.3 and 6.4.4). In the case at hand, claim related to a method for diagnosing a Helicobacter pylori (H. pylori) infection, step 1 of which entailed the collection of a breath sample. The board concluded from the facts of the case, that not all steps of a technical nature belonging to phase (i) in claim 1 of the main request satisfied the criterion "practised on the human or animal body". In particular, the further method step of a technical nature of phase (i), i.e. "measuring the content of **(13)C in the CO2 of the first and second sample and determination of a **(13)C/**(12)C ratio by spectroscopy in the respective samples" did not meet the criterion "practised on the human or animal body". The method of claim 1 therefore did not satisfy the second requirement for a method to constitute a diagnostic method within the meaning of Art. 53(c) EPC and therefore was not excluded from patentability under Art. 53(c) EPC.

c) Clarity of a claim relating to diagnostic methods

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

d) Intermediate findings of diagnostic relevance

In **G 1/04** the Enlarged Board stated that intermediate findings of diagnostic relevance must not be confounded with diagnosis for curative purposes stricto sensu, which consisted in attributing the detected deviation to a particular clinical picture. It followed that a method for obtaining such results or findings did not constitute a sufficient basis for denying patentability by virtue of Art. 52(4) EPC 1973.

In **T 1016/10** the appellant claimed an analogy to **T 1255/06**, arguing that step (iv) was missing and that thus the claim could not fall under the exception clause. The board disagreed. The appellants had argued that an "amyloidogenic disorder", identified as step (iv) in claim 1, merely represented an "intermediate finding", which according to Reasons 6.2.3 of **G 1/04**, were not to be confounded with diagnosis for curative purposes stricto sensu. Such an intermediate finding did not make it possible to immediately determine the nature of a disease and to decide on a particular course of medical treatment (**T 385/86**). The board however considered that an "amyloidogenic disorder" was not merely an "intermediate finding" but did indeed represent a "particular clinical picture".

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1. General

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

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

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

2. State of the art

2.1. General

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

As a rule, there are no restrictions as to where, how or in what language the relevant information must have been made available to the public; nor is any limit stipulated as to how old the documents or other sources of the information may be.

2.2. Applications with same filing or priority date

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

2.3. Relevant date of documents

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

According to the boards' established case law, for ascertaining the disclosure of a document forming part of the state of the art within the meaning of Art. 54(2) EPC, the relevant date is that of publication (see **T 205/91**, **T 737/00**, **T 1162/07**). The date is conveniently taken as the publication date of the document, because in normal situations, the meaning to be attributed to the various technical terms of the document does not vary until its publication so that its content can be analysed as if it had been written on the date it was made available to the public. In the particular situation in the case in hand, however, where a technical term such as a trade name was known to have been abandoned between the filing or priority date and the publication date, this circumstance is to be taken into account (**T 2020/13**).

For the purposes of examining novelty, a document is to be assessed from the perspective of the skilled person on the publication date, **T 305/94**. Interpreting a document using knowledge which only became available to the relevant experts between the publication date of the cited prior art and the filing or priority date of the application to be examined or the patent in dispute is an issue relating to **inventive step, not novelty** (see **T 205/91**).

2.4. Prior rights – Article 54(3) EPC

2.4.1 European prior rights

Pursuant to Art. 54(3) EPC the content of European patent applications as filed, the dates of filing of which are prior to the date referred to in Art. 54(2) EPC and which were

published on or after that date, shall be considered as comprised in the state of the art. However, such earlier applications are part of the state of the art only when considering novelty and **not when considering inventive step**. The "date of filing" referred to in Art. 54(2) and (3) EPC is thus to be interpreted as meaning the date of priority in appropriate cases.

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

In **T 1926/08**, in order to establish novelty with respect to document D1, the patent proprietors had filed two sets of claims for different contracting states. The patent at issue was granted before the date of entry into force of the EPC 2000. The point of dispute was whether or not R. 87 EPC 1973 was a rule implementing Art. 54(4) EPC 1973, or whether the situation was covered by Art. 123 and R. 138 EPC. R. 87 EPC 1973 allowed different claims, description and drawings for different states both in the case of an earlier European patent application which was part of the state of the art under Art. 54(3) and (4) EPC 1973 and when a prior national right existed, while R. 138 EPC 2000 only provided for the latter case. The board held that R. 87 EPC 1973 applied to European patents granted before the entry into force of EPC 2000 because it is an implementing regulation to Art. 54(4) EPC 1973 and admitted a separate set of claims.

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

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

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

In **T 557/13** of 17 July 2015 several questions concerning partial priorities were referred to the Enlarged Board (**G 1/15**, OJ 2017, A82), see in particular question 1 and 5: 1. Where a claim of a European patent application or patent encompasses alternative subject-matters by virtue of one or more generic expressions or otherwise (generic "OR"-claim), may entitlement to partial priority be refused under the EPC for that claim in respect of

alternative subject-matter disclosed (in an enabling manner) for the first time, directly, or at least implicitly, and unambiguously, in the priority document? 5. If an affirmative answer is given to question 1, may subject-matter disclosed in a parent or divisional application of a European patent application be cited as state of the art under Art. 54(3) EPC against subject-matter disclosed in the priority document and encompassed as an alternative in a generic "OR"-claim of the said European patent application or of the patent granted thereon? See chapter II.D.6.3. "Multiple priorities or partial priority for one claim". Question 1 was answered in the negative by **G 1/15** (OJ 2017, A82). As a consequence, questions 2, 3, 4 and 5 did not need to be dealt with.

2.4.3 Excluded national prior rights

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

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

2.4.4 PCT applications as state of the art

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

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

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

In **T 404/93** the European patent application was limited to the contracting states Italy (IT), Netherlands (NL) and Sweden (SE) in view of an earlier international application, published after the filing date of the former. The board noted that the earlier

PCT application had mentioned several EPC contracting states, including IT, NL and SE, as being designated for a European patent. However, when the earlier application had entered the European phase, no designation fees had been paid for IT, NL and SE. Accordingly, the board found that the earlier international application was not comprised in the state of the art under Art. 54(3) EPC 1973 for IT, NL and SE (see also **T 623/93**).

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

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

2.5. Non-prejudicial disclosures under Article 55 EPC

Article 55 EPC specifies that a disclosure of the invention shall not be taken into consideration for the application of Art. 54 EPC, if it occurred no earlier than six months preceding the filing of the European patent application and if it was due to, or in consequence of: (a) an evident abuse in relation to the applicant or his legal predecessor, or (b) the fact that the applicant or his legal predecessor has displayed the invention at an official, or officially recognised, international exhibition.

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

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

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

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

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

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

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

2.7. Prior art acknowledged in a patent application

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

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

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

In **T 413/08** the board stated in the absence of any indication to the contrary, an acknowledgment of prior art by a patent proprietor might be accepted at face value. If a patent proprietor resiled from an acknowledgment of prior art at a point in time which did not give rise to any procedural problems, the acknowledgement could no longer be relied upon.

2.8. Common general knowledge

2.8.1 Definition of "common general knowledge"

Determining what constitutes common general knowledge plays an important role in the assessment of **novelty, inventive step and sufficiency of disclosure**. In the assessment of inventive step and sufficiency of disclosure however, the skilled person's knowledge is taken to be one and the same, see chapters I.D.8.3. "Skilled person – level of knowledge" and II.C.4. "Knowledge of skilled person relevant for assessing sufficiency of disclosure" for other decisions on common general knowledge.

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

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

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

In **T 786/00** the board stated that, according to established case law, when considering the question of novelty, a prior art document must be interpreted in the light of common general knowledge available at its publication date. Common general knowledge which did not exist at this date, but which only became available at a later date, could not be used to interpret such a document (see **T 229/90**, **T 965/92**).

In **T 1117/14** the application was silent about how the claimed biodegradable implant was to be produced. The board stated that, according to established case law, the skilled person may use his common general knowledge to supplement the information contained in the application. It was convinced that the method formed part of the common general knowledge in the field. Although it had not yet made its way into textbooks or monographs, it had been published in both the scientific and the patent literature and those skilled in the art relied on such articles and patent documents.

In **T 2101/12** in the board's view the most suitable starting point was common general knowledge. The common general knowledge was the non-technical process of the signing of a contract at the notary's office. The board in **T 2101/12** considered that the interpretation of Art. 54(2) EPC given in **T 172/03** was incorrect. It held that the wording of Art. 54(2) EPC was clear and required no interpretation. Art. 54(2) EPC itself contains no limitation according to which a **non-technical process**, such as the signing of a contract at the notary's office, may not be considered state of the art.

2.8.2 Patent specifications as common general knowledge

Common general knowledge does not normally include patent literature and scientific articles (**T 206/83**, OJ 1987, 5; **T 171/84**, OJ 1986, 95; **T 307/11**, **T 1641/11**, **T 571/12**, **T 1000/12**). By way of exception, however, patent specifications and scientific publications may be considered to be common general knowledge (see **T 51/87**, OJ 1991, 177; **T 892/01**; **T 26/13**; **T 2196/15**). In **T 412/09** the board stated that this is so in particular when a series of patent specifications provides a consistent picture that a particular technical procedure was generally known and belonged to the common general knowledge in the art at the relevant date (see also **T 151/05**, **T 452/05**, **T 1000/12**). Special conditions also prevail when a field of research is so new that the technical knowledge is not yet available in textbooks (see **T 51/87**, OJ 1991, 177; **T 772/89**; **T 892/01**; **T 890/02**, OJ 2005, 497; **T 1347/11**). Going back as far as **T 206/83** (OJ 1987, 5) it was held that information which could only be obtained after a comprehensive search was not to be regarded as common general knowledge (see also **T 654/90**, **T 924/03**). **T 1634/15** and **T 1540/14** (patent documents not entirely unambiguous) summarised the case law.

2.8.3 Specialist journals as common general knowledge

In **T 475/88** the board's view was that the content of specialist journals, or "standard magazines", such as the content of patent specifications did not usually belong to the common general knowledge of the average skilled person because it was not normally part of that person's active knowledge and had to be acquired through a comprehensive search (see also, e.g. **T 2773/18**, point 5.4 of the Reasons). In **T 676/94** the board concluded that the question of whether the contents of a specialist journal formed part of the average knowledge of a skilled person depended on the facts of the case (see also **T 1727/14**). In **T 595/90** (OJ 1994, 695), an article in a specialist journal reporting on the results of a classic test was regarded as common general knowledge.

Numerous publications in the specialist press over a fairly short time, reporting on meetings and research in a particularly active field of technology, could reflect common

general knowledge in this field at that time (**T 537/90**). The board in **T 26/13** observed that, although articles appearing in specialist journals were not, strictly speaking, part of the common general knowledge, the skilled person did read them for their own person development and so, taken together, they could permit inferences as to what that knowledge covered. See also **T 2196/15** and **T 2138/14** for examples of decisions in which a scientific article was considered in establishing common general knowledge.

2.8.4 Databases as common general knowledge

In **T 890/02** (OJ 2005, 497) the board pointed out that the skilled person did not necessarily have knowledge of the whole technology. Having regard to the case law, the board established three criteria for correctly assessing the common general knowledge of skilled persons. First, the skills of such a person included not only having basic general knowledge of the particular prior art, but also knowing where to find such information, be it in a collection of relevant studies (see **T 676/94**), a scientific publication or a patent specification (see **T 51/87** and **T 772/89**). Second, it could not be expected that, in order to identify this common general knowledge, the skilled person would carry out a comprehensive search of the literature covering virtually the whole state of the art. No undue effort in the way of such a search could be required of the skilled person (see **T 171/84**, OJ 1986, 95; **T 206/83**, OJ 1987, 5; **T 676/94**). Third, the information found had to be unambiguous and usable in a direct and straightforward manner without doubts or further investigation (see **T 149/07**).

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

2.8.5 Proof of common general knowledge

Where an assertion that something is common general knowledge is challenged, the person making the assertion must provide proof that the subject-matter in question is in fact common general knowledge (**T 438/97**, **T 329/04**, **T 941/04**, **T 690/06**, **T 2132/16**). In the case of any dispute as to the extent of the relevant common general knowledge this, like any other fact in contention, has to be proved, for instance by documentary or oral evidence (**T 939/92**, OJ 1996, 309, see also **T 766/91**, **T 1242/04**, OJ 2007, 421; **T 537/90**, **T 329/04** and **T 811/06**). The proof is regularly supplied in citing literature (**T 475/88**). According to **T 766/91** and **T 919/97**, evidence of general technical knowledge need be submitted only if the latter's existence is disputed. Exceptionally, it is enough to give cogent reasons based on readily verifiable facts, e.g. for knowledge that is "notorious", indisputably forms part of the common general knowledge or belongs to the "mental furniture" of the skilled person (**T 415/21**).

In ex parte case **T 1090/12** the appellant drew attention to the Guidelines (G-VII, 3.1 – November 2016 version) that reads: "an assertion that something is common general knowledge need only be backed by documentary evidence (for example, a textbook) if this is contested" and submitted that this passage was binding on the boards of appeal when exercising the power of the examining division. In the case at hand, the board denied that it was obliged to provide written evidence and explained during the oral proceedings that its members knew from their work on previous cases that the features at issue were known to the person skilled in the art. It would therefore have been for the appellant to show an error in the board's appreciation, e.g. that one of the features at issue was in fact introduced into the art after the priority date of the application under appeal. There is also no general obligation on a board to provide documentary evidence for the existence of a piece of common general knowledge. In proceedings before the EPO, a board of appeal has to respect the right to be heard and to give reasons for its decision. In cases where a board refers to common general knowledge as state of the art, it is not obliged to provide documents in every conceivable case. It is also possible for a board to state what it deems to be known, and possibly where it is known from, in a way that puts the appellant in a position to try to convince the board that its findings are erroneous. Proceeding that way respects the party's right to be heard. In this respect, the request for referral of questions to the Enlarged Board was refused. According to **T 1370/15** this also applies in **inter partes** proceedings.

In **T 1540/14**, another ex parte case, the board, after giving detailed reasons and summarising the case law on ascertaining the common general knowledge, concluded that there was not enough conclusive evidence to support the examining division's reasons for refusing the application for lack of inventive step because the features distinguishing its claim 1 from the closest prior art were obvious in view of the common general knowledge illustrated by two patent literature documents.

In ex parte case **T 2101/12** the common general knowledge was the non-technical process of the signing of a contract at the notary's office. According to the appellant, the EPO has the burden of proving the content of the common general knowledge it relies on. The appellant had at no point disputed that the process mentioned by the board was indeed common general knowledge. No documentary evidence was required to prove the extent of the cited common general knowledge.

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

on the issue of enabling disclosure of a prepublished document and hence on the novelty of claimed subject-matter (**T 1625/06**, **T 608/07**, **T 777/08**).

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

See also **T 2196/15** for an example of difficulties in providing the common general knowledge.

3. Availability to the public

3.1. General

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

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

3.2. Ways of making information available to the public

3.2.1 Publications and other printed documents

a) General

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

b) Company papers

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

In **T 278/09**, when examining whether a product data sheet had been available to the public, the board observed that such a sheet merely described the components and features of newly developed or improved products, but as such contained no evidence in relation to marketing or any public availability. The decision whether and when to market a product could depend on other circumstances, such as the economic climate and the relevant firm's marketing policy. In any event, product data sheets did not necessarily become information destined for the public when it was decided to market the product they described, as customers to whom the sheet was distributed could be obliged to treat it as confidential. It was therefore insufficient in such a case to decide on the mere balance of probabilities that simple suppositions that an allegedly novelty-destroying product data sheet had been made available to the public were accurate (see also **T 738/04**). A product data sheet thus does not provide the same level of information as an advertising brochure (**T 184/11**, see below).

c) Advertising brochure

T 804/05 concerned the public availability of an advertising brochure usually distributed amongst interested specialists and bearing a date on its cover. The board decided that, in the absence of any evidence to the contrary, it had to be assumed that this brochure had been made available to interested customers, without any obligation to keep it secret, in the months following the cover date (see also **T 1589/13** (internet publications) which stated that this presumption was supported by an affidavit and an invoice for printing of the advertising brochure).

In **T 743/89** the board held that it was in the respondent's (patent proprietor) own interest to ensure widespread distribution of the commercial pamphlet in order to inform as many potential customers as possible of this latest development in a highly competitive field. Here, it had been proved that a leaflet disclosing the invention had been printed seven months before the date of priority, but it was uncertain when the leaflet had been distributed. The board took the view that, although the date of distribution could no longer be ascertained, it was reasonable in any event to assume that distribution had occurred within the seven-month period (see also **T 1748/10**).

In **T 146/13** the proprietor maintained that the opponent had not supplied proof that a commercial brochure (D6) had been distributed before the priority date of the patent in suit. The board noted that there was a gap of more than 24 months between the date of

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

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

In **T 353/14** the board decided that D10 could not be considered a commercial brochure of a company which was intended to inform potential customers about particular products of the company as in cases **T 743/89**, **T 253/02**, and **T 804/05**. Rather, document D10 had the nature of an applied electrical engineering paper. As such, the **copyright notice** and the revision mark could not be regarded as the date of printing of a stack of copies of D10 for their subsequent public distribution. D10 was not considered as having been made available to the public as a commercial brochure before the priority date. The public availability of D10 was then considered as to its availability on the internet (on the balance of probabilities).

In **T 523/14** it was highly probable that the opponent distributed the advertising newsletter in Fall 2007, given its strong interest in attracting as many customers as possible for the new equipment in the emerging and highly competitive field of solar power. Furthermore the board considered that even not drafted in a manner as rigorous as a scientific publication, the information given in the advertising newsletter was sufficient to enable a skilled reader to practise the technical teaching.

d) Report available in the specialist field

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

In ex parte case **T 1130/11** the appellant (applicant) contested that D3 was publicly available and argued that it did not belong to the prior art because it was marked as internal report. Before the oral proceedings, the board performed a limited investigation on the internet about D3 and presented its results to the appellant during the oral proceedings. The board concluded that in the field of universities "Interner Bericht" did not mean confidential, but something like "technical report", and that D3 was publicly available prior art at the priority date.

e) Books

In **T 842/91** the subject-matter of the claimed invention was included in a **book** to be published. Shortly before the priority date, the patent proprietor gave permission to the publisher to disclose the contents of the book The board held that although the patent proprietor had clearly given the publisher permission to make the claimed subject-matter available to the public, this could not of itself amount to actually making it available.

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

In **T 915/12** the board considered that there was not sufficient evidence to prove that D16 – an extract from an encyclopedia – was made available to the public before the priority date (5 February 2001). The printing (2000) and **copyright** (1999) years indicated in D16 could not alone prove accessibility before early 2001. The handwritten annotation made by the head of Collections Department University on the cover page did not fulfil the requirements of form and content for affidavits. See **T 1950/16** on dating documents using an ISBN number in conjunction with a copyright notice.

f) Instruction manual

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

In **T 2105/12**, concerning the public availability of a user guide and a testing guide for the same diabetes management system, carrying a **copyright date** (2002) which predated the earliest priority date (2006) of the patent in suit by about four years, the board concluded that like case **T 861/04** (copyright of television user manuals), the present case concerned a device which was free to be marketed. Therefore, as in decision **T 861/04**, the board found it highly unlikely that it would have been kept in stock for about four years following Food and Drug Administration (FDA) approval.

See also **T 1262/15** for a detailed discussion on public availability and date thereof, concerning an instruction manual.

g) Patent and utility models

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

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

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

h) Trade names

In **T 2020/13**, which concerned a catalyst composition and availability to the public of products defined by trade names, the board stated that where a technical term such as a **trade name** was known to have been abandoned between the filing or priority date and the publication date, this circumstance was to be taken into account in order to attribute to that technical term its proper meaning and to understand the technical teaching meant to be conveyed by that prior art document. The change of trade name did not render, in the circumstances of the case, the disclosure of example 6 of D1 unenabling. The board concluded that the nature of the catalysts behind the trade names was available to the public at the date of publication of D1 and that claim 1 lacked novelty.

On this issue in relation to Art. 83 EPC and its relationship to Art. 54 EPC, see **T 842/14** (chemical composition of a product designated by a **trade mark**).

i) Abstracts of documents

In **T 160/92** (OJ 1995, 35) the board held that the teaching of a previously published abstract of a Japanese patent document, considered per se without its corresponding original document, formed prima facie part of the prior art and might be legitimately cited as such if nothing on the file pointed to its invalidity (**T 462/96**).

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

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

3.2.2 Lectures and oral disclosure

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

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

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

In **T 1212/97** the opponent had submitted that the invention had been made available to the public at a lecture given some days before the priority date to an audience of some 100 to 200 persons. The question to resolve was whether there was any safe and satisfactory evidence regarding the content of what had been made available to the public at the lecture. The board did not consider **evidence from the lecturer alone** to be satisfactory evidence as to what had been made available to the public at the lecture. Even an audio or video tape recording made of the lecture, unless publicly available, would have to be treated with caution, if several hearings or viewings were necessary to extract all the information. Information appearing in each of the contemporary written notes made at the lecture by at least two members of the audience could usually be regarded as sufficient, whereas information in the notes of a single member of the audience might be inadequate, as it reflected the thoughts of the listener rather than solely the content of the lecture. If the lecturer read his lecture from a typescript or manuscript, or the lecturer wrote up his lecture subsequently, and the lecture was subsequently published in that form as part of the proceedings, then the written version might be taken as some evidence of the contents of the lecture, though with some caution as there would be no guarantee that a script was completely and comprehensibly read, or that a write-up had not been amplified. Most useful would be a handout given to the public at the lecture, containing a summary of the most important parts of the lecture and copies of the slides shown. None of those types of evidence were available in this case (see also **T 1057/09**, **T 428/13**, applying the principle,

stated that the affidavit of the lecturer was not sufficient to give proof what was actually disclosed orally).

In **T 2003/08** of 31 October 2012 the board observed that, in contrast to a written document the contents of which are fixed and can be read again and again, an **oral presentation is ephemeral**. Therefore, the standard of proof for ascertaining the contents of an oral disclosure is high. What has been said, or to use the terms of Art. 54(2) EPC, what has been "made available to the public" has to be put beyond reasonable doubt. The board noted that in case **T 1212/97** the board had expressed the view that "written notes made at the lecture by at least two members of the audience can usually be regarded as sufficient" for that purpose. A fact also indicated by the board was that the amount of evidence necessary to establish the content of an oral presentation beyond reasonable doubt was to be judged on a case-by-case basis, i.e. it depends on the quality of the evidence in each case. In the current board's view, decision **T 1212/97** could not be interpreted as setting an absolute standard for the amount of evidence necessary to prove the contents of an oral disclosure. The board considered that there may be circumstances where evidence from the lecturer and only one member of the audience is convincing enough to reach the standard of proof – i.e. beyond reasonable doubt. In the case at issue, however, evidence from the lecturer and a member of the audience, provided by them in the form of both affidavits and oral testimony, was not considered by the board to prove beyond reasonable doubt that the subject-matter of the claim was disclosed during the lecture. Both **T 1212/97** and **T 2003/08** were cited in **T 843/15**, in which doubts led the board to conclude that a diagram shown in a conference speaker's slideshow had not been made available to the public, and to distinguish the case from **T 335/15**.

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

3.2.3 Internet disclosures

a) General

Disclosures on the internet are generally regarded as part of the state of the art within the meaning of Art. 54(2) EPC. Information disclosed on the internet or in online databases is considered to be publicly available as of the date it was publicly posted.

The appropriate standard of proof for internet disclosures is the balance of probabilities (**T 286/10**, **T 2227/11**).

See also chapter III.G.4.2.4 "Archives and internet publications".

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

Both **T 1553/06** and **T 2/09** dealt with the question of the public availability of documents saved on the World Wide Web. These two cases concerned test-cases. These two decisions were taken before **T 286/10** (which established the law now applicable with respect to the standard of proof for internet publications).

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

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

In **T 2/09** the board had doubts as to whether e-mails transmitted over the Internet could be accessed and searched in a way comparable to that of webpages, independent of whether or not access to and disclosure of the content of the e-mail were lawful. The board was rather of the opinion that the differences between webpages and such e-mails make a strong prima facie case against public availability of the latter. The board decided that the content of an e-mail did not become available to the public within the meaning of Art. 54(2) EPC 1973 for the sole reason that the e-mail was transmitted via the internet before the filing date (see also **T 523/14** concerning an advertising newsletter sent by Email – see in this chapter I.C.3.2.1 c)).

In **T 2284/13** (Wayback machine as prior art) the board accepted a combination of D5, an incomplete archive version of a web page (on the Wayback Machine web.archive.org; publicly available on 2004 with only small images), with D5', a recent download (2009) of the webpage (with full images) as evidence of a prior art publication. Accordingly, when considering the prior art disclosure of D5, also the expanded figure "the MRTT fuel system" shown in D5' had to be regarded as forming part of that disclosure.

c) Publication date

(i) General

The case law on internet publications is chiefly concerned with dating the information found and the applicable standard of proof. The law on this seems now to have been established by the decisions in **T 286/10** and **T 2227/11**, which were endorsed more recently in **T 1711/11**, **T 353/14**, **T 545/08**, **T 1589/13** and **T 1066/13**. Those decisions also cited the EPO practice set out in its notice concerning internet citations (OJ 2009, 456 to 462) and the relevant section of the Guidelines. The appropriate standard of proof for internet citations is the **"balance of probabilities"** and not "beyond reasonable doubt".

The conclusion reached in the earlier decision **T 1134/06** (followed by **T 19/05** and **T 1875/06**) that the stricter standard of proof "beyond reasonable doubt" had to be applied to internet disclosures has been refuted. Nevertheless, examining a source's reliability as described in that decision has not become entirely obsolete; see, for instance, **T 545/08** (points 15 and 18 of the Reasons), **T 353/14** (point 2.2.7 of the Reasons) and **T 286/10**, in which the board found that, the Times Union newspaper's *www.jacksonville.com* was, prima facie, a known and reliable source of information. While the board in **T 2227/11** agreed with the detailed reasoning in **T 1134/06** that internet citations of prior art entail a number of difficulties in assessing the authenticity of notably the publication date and the content, there was no reason to impose a stricter standard of proof. These difficulties may require some far-reaching investigations into the matter and the provision of supporting evidence.

Observing that documents published on the internet presented a special problem not encountered with conventional publications, in that changes might be made to them over time that were not readily traceable, the board in **T 286/10** endorsed the approach taken in **T 2339/09** and **T 990/09** and applied the principle of free evaluation of evidence as explained in **T 750/94** (OJ 1998, 32).

According to **T 545/08**, it was correctly stated in the Guidelines (G-IV, 7.5.2– November 2016) with respect to internet disclosures: "The standard for assessing these circumstances is the balance of probabilities. According to this standard, it is not sufficient that the alleged fact (e.g. the publication date) is merely probable; the examining division must be convinced that it is correct."

The burden of proof generally lies with who asserts. In the specific case of internet citations of prior art cited by the EPO, the burden of proof thus lies with the EPO. If the EPO, however, is satisfied that, on the balance of probabilities, an internet citation constitutes prior art, it is then up to the party to prove otherwise (**T 2227/11**, **T 1589/13**, see also on burden of proof **T 545/08**, points 12 and 13 of the Reasons; **T 1066/13**, "directory listing").

(ii) Illustrative case law

The facts on which any finding of public availability is based must be established with a sufficient degree of certainty in order to convince the competent organ of the EPO in view

of all the relevant evidence that they have indeed occurred. This holds true even if the determination is made on the basis of probabilities and not on the basis of absolute certainty ("beyond any reasonable doubt") (**T 545/08**, point 11 of the Reasons, applied in **T 1236/13** in the context of the date of finding a webpage, as displayed in the URL as a date stamp).

It is well-recognised policy of the Internet Archive's Wayback Machine to crawl the internet and archive crawled web pages using the date and time when the web page was crawled as part of the URL. The board did not see how the URL used by the Wayback Machine for archiving purposes can be considered to be dynamic, as argued by the appellant (applicant), nor did the appellant substantiate this argument any further. The board in **T 523/13** was therefore of the view that the date stamp was established with a sufficient degree of certainty (see **T 545/08**, point 11 of the Reasons), unless proven otherwise (ibid., points 12 and 13 of the Reasons). See also **T 884/18**.

In **T 286/10** (*www.jacksonville.com* / *www.archive.org*) the board stated that internet publications presented a special problem compared to conventional publications, given the potential for making changes that were not easily traceable. Internet publications did not in principle call for a different standard of proof; any uncertainty linked to such disclosures had to be overcome in a way that ensured a sufficient degree of probability and established a presumption of availability that would convince the judge.

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

In ex parte case **T 1961/13** the board noted that it should not have been necessary for the appellants to investigate the relevance of Google's date indications. It was the task of the examiner to make an objective assessment of what a particular date indication was intended to represent and how reliable it was, and to make further investigations if necessary. If it was not understood how a particular date reported by a search engine was generated, it could not be used as evidence of a publication date. A date reported by Google was inherently unsuitable to serve as evidence of the publication date of a document.

The reliability of the information contained in the extracts of Wikipedia cited by the opponent could not be assessed and/or there was no evidence that the content of those documents was made available to the public before the effective date of filing of the patent. Accordingly, and independently from the question whether or not there was any

justification to submit those documents on appeal, those documents could not be used to prove common general knowledge available at the effective date of the patent (**T 378/15**).

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

3.2.4 Public prior use

a) General

The state of the art is held to comprise everything made available to the public by means of a written or oral description, **by use**, or in any other way, before the date of filing of the European patent application (Art. 54(2) EPC). Use can take the form of producing, offering or marketing or otherwise exploiting a product, offering or marketing a process or its application or applying the process. Marketing may be effected, for example, by sale or exchange.

Instances of public prior use or availability in any other way will typically be raised in opposition proceedings. Under established case law (see e.g. **T 194/86**; **T 232/89**; **T 78/90**; **T 600/90**; **T 602/91**; **T 522/94**, OJ 1998, 421; **T 927/98**; **T 805/05**), the following has to be clarified to determine whether an invention has been made available to the public by prior use: (i) when the prior use occurred, (ii) what was made available to the public through that use and (iii) the circumstances of the use, i.e. where, how and by whom the subject-matter was made public through that use.

See also: chapter IV.C.2.2.8 i) "Alleged public prior use" and various sections in chapter III.G. "Law of evidence".

Although prior use is dealt with here in this chapter on novelty, specifically in its section on determining the prior art, it should be borne in mind that, whilst chiefly important in that context, what can be regarded as prior art is also relevant in examining inventive step (see e.g. **T 1464/05** – public prior use as closest state of the art; **T 23/11**; **T 2170/12**).

Under Art. 114 EPC the EPO has only a limited obligation to undertake an examination of its own motion with regard to public prior use (**T 129/88** (OJ 1993, 598) and **T 34/94**, on which see chapter V.A.3.3. "Facts under examination – applying Article 114 EPC in appeal proceedings").

b) Public prior use occurred

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

In **T 945/09** (patient – administration of a substance in hospital) the board found that there had been a novelty-destroying prior use.

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

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

In **T 2440/12** the invention was a method to be performed by a computer. The board came to the conclusion that prior use of a software product in the form of sales made the method implemented by the software part of the state of the art since, in principle, the skilled person could have executed the software line-by-line on a computer, and, in doing so, would have not only carried out the method, but also gained knowledge of the method steps performed by the computer. The board concurred with the appellant that even a different "disclosure" of the method, as could be obtained by executing it on a computer line-by-line without infringing copyright protection, was sufficient to take away the novelty of the method as claimed. Hence, the subject-matter of claim 1 was not new following the prior use of a software product which undisputedly embodied the claimed subject-matter.

In **T 2210/12**, the appellant (patent proprietor) contended that the installation of machinery on Volkswagen's private factory premises could not result in its having been made publicly available (see, in relation to shipyards, **T 245/88** and **T 901/95**). The board, however, considered it established that the machinery's delivery had not been subject to any duty of confidentiality. Since Volkswagen itself already counted as part of the public, it made no difference whether or not third parties had access to its premises. See also **T 2273/11**.

In **T 1647/15**, in which one of the parties objected to the language the opposition division's Chair had used to silence its representative, the board, having dealt with this objection itself and taken into account how long the proceedings had already lasted, decided not to remit the case to the opposition division and ruled that the alleged prior use (sale of three types of Scheuerle trailer – photographs produced) had been established. As regards the photos, the patent proprietor hinted at the possibility that the trailers might have been modified since the priority date of the patent. However, taking common wisdom into account and considering that the claimed subject-matter referred to the basic design of the trailer, it seemed very unlikely that these very special vehicles had undergone significant design modifications impacting features of the claim.

c) No public prior use

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

In **T 208/88** (OJ 1992, 22) the board held that an effect (in this case, growth regulation) not previously described, but actually occurring during the execution of a known teaching (in this case, use as a fungicide) and intended as the basis of a use invention, had in any event not been made available to the public, if it was not revealed so clearly during such execution as to disclose the invention's essential character, at least potentially, to an unlimited number of skilled persons (see **G 6/88**).

In **T 245/88** several vaporisers had been installed in a fenced-off area of a shipyard. The public did not have unrestricted access to this area. The board was of the view that the vaporisers had not been made available to the public. See **T 2028/16** for a decision concerning a sale to the German military, which in itself did not constitute a public prior use.

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

In **T 801/98** the board, having found that an alleged **prior use by sale**, in the form of a delivery of locks to a psychiatric clinic before the contested patent's priority date, had been

established, considered that there was insufficient evidence to overcome the doubts as to whether it had been public.

In **T 1410/14** it was common ground between the parties that a vehicle ("City Runner") with the claimed features had been test driven on a route forming part of a town's public transport network on a particular date, but also that the coupling joint in question could have been seen only from above, namely from an overhead pedestrian bridge. For the board, it was not proven that this prior use would have enabled a skilled person to identify all the features of the invention. In particular, the appellant had failed adequately to show that a specific feature (a bracket forming part of the pivot bearing and held displaceably on the coach body) had been apparent to the skilled person during the test drives. Summing up, the board held that features of subject-matter that had been visible only briefly could be considered to have been made publicly available only if it could be shown beyond doubt that they had been clearly and directly apparent to the skilled person for that short time. In **T 1551/14**, the patentee relied on **T 363/90** and **T 1410/14**. The board considered that these decisions did not apply to the case in hand.

In **T 1217/01** an invoice was the only document bearing a date earlier than the contested patent's priority date that had been adduced by the appellant (opponent) in support of an alleged prior use, but it did not disclose the composition of the product sold. The board found that the product's composition could therefore be deduced only by "reverse reasoning", working back from the invoice to the product's production (packaging, mixture, weight, elaboration) and, from there, to the formula used. However, owing especially to changes in product names and numbering, which made it impossible to reconstruct where the cited product fitted into the product family, the board ultimately ruled that the evidence was not conclusive enough.

In case **T 1534/16** the appellant (patent proprietor) raised doubts concerning the public availability of the installations in accordance with the alleged prior uses, in particular by referring to the presence of an obligation to maintain secrecy. The board, regarding the appellant's doubts as justified and considering that further investigations would require the co-operation of the opponent, who withdrew its opposition, concluded that the allegations of prior use were to be disregarded.

In **T 72/16** the board held that a shipment of 48 pipe sections was subject to at least an implied confidentiality agreement. The recipient was not a mere customer; the relevant companies had contracted to develop and deliver prototypes and products for test purposes.

d) Internal structure or composition of a product

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

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

In **G 1/92** (OJ 1993, 277) the Enlarged Board held that the chemical composition of a product forms part of the state of the art when the product as such is available to the public and can be analysed and reproduced by the skilled person, irrespective of whether or not particular reasons can be identified for analysing the composition. The same principle applies mutatis mutandis to any other product. It also stated that "[a]n essential purpose of any technical teaching is to enable the person skilled in the art to manufacture or use a given product by applying such teaching. Where such teaching results from a product put on the market, the person skilled in the art will have to rely on his general technical knowledge to gather all information enabling him to prepare the said product. Where it is possible for the skilled person to discover the composition or the internal structure of the product and to reproduce it without undue burden, then both the product and its composition or internal structure become state of the art". However, the Enlarged Board added that "a commercially available product per se does not implicitly disclose anything beyond its composition or internal structure. **Extrinsic characteristics**, which are only revealed when the product is exposed to interaction with specifically chosen outside conditions, e.g., reactants or the like, in order to provide a particular effect or result or to discover potential results or capabilities, therefore point beyond the product per se as they are dependent on deliberate choices being made. Typical examples are the application as a pharmaceutical product of a known substance or composition (see Article 54(5) EPC) and the use of a known compound for a particular purpose, based on a new technical effect (see **G 2/88**, OJ 1990, 93). Thus, such characteristics cannot be considered as already having been made available to the public". See below on **T 472/92**, **T 834/15**, **T 1409/16** and **T 1666/16** which (among other things) discuss the issue of extrinsic characteristics.

In **T 438/19**, the board identified diverging approaches to applying the criteria of **G 1/92** as to analysability and reproducibility of a product that has been put on the market, and when and to what extent it should be considered part of the state of the art. As a result, the board referred the following questions to the Enlarged Board:

1. Is a product put on the market before the date of filing of a European patent application to be excluded from the state of the art within the meaning of Art. 54(2) EPC for the sole

reason that its composition or internal structure could not be analysed and reproduced without undue burden by the skilled person before that date?

2. If the answer to question 1 is no, is technical information about said product which was made available to the public before the filing date (e.g. by publication of technical brochure, non-patent or patent literature) state of the art within the meaning of Art. 54(2) EPC, irrespective of whether the composition or internal structure of the product could be analysed and reproduced without undue burden by the skilled person before that date?

3. If the answer to question 1 is yes or the answer to question 2 is no, which criteria are to be applied in order to determine whether or not the composition or internal structure of the product could be analysed and reproduced without undue burden within the meaning of Opinion **G 1/92**? In particular, is it required that the composition and internal structure of the product be fully analysable and identically reproducible?

The Enlarged Board issued its decision **G 1/23** on 2nd July 2025.

(i) Structure or composition made available to the public

In **T 390/88** a photographic film had been made available to the public by announcement at a press conference three weeks before the priority date. The board held that this relatively short time interval was sufficient to enable interested parties to become fully aware of the film's composition.

In **T 969/90** and **T 953/90** the board ruled that the internal structure of a product in prior use had been made available to the public because a skilled person relying on the normal means of investigation available to them would have been able to analyse the product.

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

In **T 947/99** the alleged public prior use concerned a visit to an ice-cream factory. Although it had not been established that a feature of the manufacturing process had been explicitly explained to the visitors, the board decided that information about the procedure had been publicly disclosed. The board observed that, in accordance with the principles set out in **G 1/92**, it was the fact that direct, unlimited and unambiguous access to any particular

information regarding the manufacturing processes known per se was possible which made these processes available to the public within the meaning of Art. 54(2) EPC 1973, whether or not there was any reason to look or ask for such information.

In **T 2068/15** (chemical composition – analysability), the board considered in the case at issue that the skilled person analysing the film with the techniques known at that time (electron microscopy) would not have overlooked the first top layer. And the board stated also that it was common practice at the priority date of the patent to apply more than one analytical method in order to obtain information about the composition of a material.

In **T 1409/16** the board decided that commercial composition only accessible by subjecting said prior art composition to a kind of **reverse engineering** (by fractionation) based on hindsight revealed "extrinsic characteristic" within the meaning of **G 1/92** (see also similar case **T 834/15**).

In **T 1452/16** (alleged prior use of Amano lactase) the board stated that in order to assess whether a prior-art product falls within the terms of the claim, one obviously has to assess the claimed parameters, even if these have never been used before. Furthermore, the board explained in detail why the present cases differed from **T 946/04**, **T 1457/09**, **T 2048/12** and **T 2068/15**. Contrary to the patent proprietor's arguments, the board noted firstly that **T 952/92** did not stipulate that structural assays had to be used, and second that the skilled person did not have to test for all possible impurities. As to reproducibility, **T 952/92** also clarified that no complete reproducibility was needed. The board came to the conclusion that the evidence on file convincingly demonstrated that a lactase preparation fulfilling the parameters (given ratio) recited in claim 1 of the main request was publicly available, that an **enzyme** with the characteristics as claimed was commercially available in the prior art and that its use in a process as claimed had also been made available to a member of the public, and hence was state of the art. See also **T 1540/21**.

(ii) Structure or composition not made available to the public

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

In **T 472/92** (OJ 1998, 161) the board referred to **G 1/92** and concluded that the printability characteristic of the material was not a property that became available to the public by their mere delivery, since this was clearly an extrinsic characteristic requiring interaction with specifically chosen outside conditions. Thus, such characteristic could not be considered as already having been made available to the public (see also **T 267/92**).

The board in **T 1217/01** found that, since the perming product allegedly in prior use was a fast-moving consumer good, it could be presumed that it had gone on sale, and so been publicly available, soon after payment of the invoice the appellant (opponent) had adduced

as supporting evidence. For the board, the case turned on the composition of the oxidising agent (fixer) in the invoiced product. But, as no product or even packaging dating from the time was available, its exact composition could be deduced only by **"reverse reasoning"**, working back from the process of its elaboration and production. The board ultimately found that the evidence was not conclusive enough; owing especially to changes in the product names and numbers, it had not been shown that the sold product had also been made of the claimed composition.

In **T 2048/12** the board stated that opinion **G 1/92** did not imply that in each and every case the commercial availability of a chemical product as such necessarily amounted to a disclosure of (also) all the impurities contained therein merely because it was possible to identify and quantify these impurities by analytical means. Conclusion 1 of **G 1/92** was to be read by attributing a technically reasonable meaning to the technical expression "chemical composition". In the present case there was no direct or indirect pointer to the possible technical relevance of further impurities (besides water) in the commercial product.

T 1833/14 dealt with the **condition of reproducibility** laid down in **G 1/92**. It could not be concluded that the skilled person was able to reproduce the product Rigidex®P450xHP60 without undue burden. In order to be part of the prior art pursuant to Art. 54(2) EPC, a public prior use must amount to an enabling disclosure (**T 977/93**, OJ 2001, 84; **T 370/02**, **T 2045/09**, **T 23/11** and **T 301/94**). It is generally known in the field of polymers that the **nature of the catalyst system**, the type of reacting system and the process conditions significantly affect the properties of the produced polymer. In the polymer field, in which products and compositions are often defined by means of parameters, the requirements of sufficiency of disclosure is analysed with particular care and the same criteria must apply to the reproducibility without undue burden of a product on the market. In order for the product to be state of the art, the question was whether or not the skilled person would have been in a position to prepare the product as such, i.e. a sample identical to Rigidex®P450xHP60 in all its properties (not only those specified in claim 1). This was however not shown by the appellant (opponent). To the contrary, the appellant stated that "what may be more difficult (if the catalyst used for the original product is not known) is obtaining the same mechanical properties as the Rigidex product". **T 1833/14** cited by **T 842/14** and **T 2916/19** in connection with Art. 83 EPC.

In **T 1666/16** (powders – angle of repose), the board could not conclude that the skilled person was able to determine the internal structure of the sold products and to reproduce them without undue burden at the date of their sale; the internal structure of these products did not form part of the prior art. The issue of extrinsic characteristics in view of **G 1/92** was also at stake.

3.2.5 Biological material

In the field of microbiology, the board, in **T 576/91**, conceded that an unwritten rule may exist within the scientific community, whereby biological material referred to in a scientific publication can be freely exchanged. However, this does not amount to an obligation, so that any biological material which is the subject of a publication can be considered as being

publicly available. The board further stated that if contractual obligations between parties resulted in access to biological material being deliberately restricted to a group of persons bound either by a research contract or a licence, it could not be concluded that this material had been made "available to the public" within the meaning of Art. 54(2) EPC 1973 (see also **T 351/98**). In **T 128/92** the board stated that, for a complex biochemical to be made available to the public, the minimum that would seem to be required for publication was a notice to those in the field that samples of the biochemical could be obtained on request, and clear evidence of exactly what the biochemical was.

3.3. The concept of "the public"

The boards considered the concept of "the public" in several decisions. According to their case law, information is generally to be regarded as having been made public if even just one single member of the public is in a position to gain access to it and understand it, and if there is no obligation to maintain secrecy (**T 1081/01**, **T 229/06**, **T 1510/06**, **T 1309/07**, **T 2/09**, **T 834/09**, **T 1168/09**, **T 239/16**).

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

3.3.1 Sale to a single customer

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

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

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

3.3.2 Making available to a person not skilled in the art

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

3.3.3 A limited circle of people

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

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

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

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

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

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

3.3.4 Public library

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

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

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

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

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

In **T 1050/12** the question of availability to the public of meeting **abstracts of presentations for a future conference** published in a supplement to a regular volume of a scientific journal was disputed. There was corroborating evidence in the form of date-stamped copies for the dates of receipt and/or cataloguing, and the board had no reason to doubt the usual routines described by librarians in their declarations. On the contrary there was no evidence on file supporting the allegations of the respondent (patent proprietor) that the journal supplement was not to be disseminated freely. The board did not agree that the conclusions of **T 834/09** contradicted the earlier jurisprudence and refused the respondent's request for referral to the Enlarged Board. The board considered that, regardless of whether or not the librarian is considered a member of the public (as was the issue in decision **T 834/09**), there was persuasive evidence that documents at issue were made available to the public before the priority date of the present patent.

3.4. Obligation to maintain secrecy

3.4.1 General

A disclosure is regarded as made available to the public if, at the relevant date, it was possible for members of the public to gain knowledge of its contents and there was no bar of confidentiality restricting the use or dissemination of such knowledge (**T 877/90**; see also **T 2239/15**).

If the person who was able to gain knowledge of the invention was under an obligation to maintain secrecy, the invention cannot be said to have been made available to the public, provided the person did not breach that obligation. If the obligation to maintain secrecy stems from an **express** agreement that has been observed, the information has not been made available to the public. Less clear cut are cases of **tacit** secrecy agreements. Whether a tacit secrecy agreement between parties exists, depends on the peculiar circumstances of the specific case (**T 1081/01**, **T 972/02**, **T 1511/06**), e.g. the commercial inter-relationship between and the commercial interests of the companies involved (**T 913/01**; see also **T 830/90**, OJ 1994, 713, **T 782/92**, **T 37/98**, **T 72/16**).

In **T 1081/01** the board held that information provided subject to a confidentiality agreement did not become available to the public merely by reason of the expiry of the obligation to keep it confidential. Some separate act of making it available to the public would be needed. This conclusion was in agreement with the conclusion reached in **T 842/91**, where permission to publish a text was considered merely as permission to make the text available to the public, and not as actually making the text available to the public. In **T 833/99** the board observed that there was no law to the effect that the confidentiality governing tender procedures ends when they do.

3.4.2 Parts for serial production

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

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

3.4.3 Distribution of prospectuses, technical descriptions

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

The board in **T 2056/13** held, in relation to an operating manual with a **copyright notice**, that such notices did not normally imply an obligation to maintain secrecy. That there had been none in this particular case was anyway clear from the manual itself, which mentioned the possibility of its sale and dissemination and was therefore prior art for the purposes of Art. 54(2) EPC. (Argument of the opponent that copyright protection does not necessarily imply that the content is confidential rejected by the board in the circumstances of the case **T 1570/14** – a joint development project.)

3.4.4 Commercial relationships and interests

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

In **T 1085/92** the board took the view that, where contractual relations and development agreements existed, a secrecy agreement could be assumed to exist. Such an agreement does not necessarily have to be a contract made in writing, as an implicit or implied agreement could also be taken into account (**T 838/97**, **T 818/93**). On implicit confidentiality obligations and their duration, see e.g. **T 830/90** (OJ 1994, 713), **T 201/13** and **T 72/16**. In **T 2/09** the board took the view that, where a party's own interest in secrecy could be established, then the situation would be analogous to that of a non-disclosure agreement between the parties involved. In this particular case (test case on public availability of an e-mail transmitted via the internet) the board held that an internet service provider had a business interest of its own in keeping secret (i.e. not forward to third parties) the emails to which it had access.

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

In **T 1829/12** it was not in dispute that an explicit non-disclosure agreement had been entered into, but the appellant (opponent) contended that it had been of limited scope and had not covered the sensor unit at issue. The board rejected its contention as being at odds with normal business practice. No convincing reasons had been put forward as to why the sensor unit, of all things, should not have been covered by the explicit non-disclosure agreement.

In **T 2170/12**, in which the public availability of a project report was in dispute, the opponent had produced a statement by one of the report's authors that there had been no confidentiality obligation restricting the use or dissemination of any project information.

The board, however, found that the report appeared to have been circulated only among people working on the project (which, the proprietor maintained, implied its confidentiality). It did not seem to have been sent to a wide circle and there was no specific evidence to support what the author had said in his statement. Considering also the short interval in question (less than four months), the board held that the report's public availability during this time had not been sufficiently proven and ultimately disregarded it as prior art for the purposes of examining inventive step.

In **T 833/99**, during invitations to tender, the municipal employees had been required to observe confidentiality. The appellant (opponent) said they might have breached that confidentiality, e.g. by informing repair workers of certain steps in the process, but did not back this up with firm facts such as dates, circumstances, etc., or with other evidence. Mere suppositions could not be entertained; they were not proof, and the onus was on the appellant to show that its allegations were well founded. Lastly, the board observed that there was no law to the effect that the confidentiality governing tender procedures ends when they do.

In **T 2702/18** the board, considering what standard business practice would normally dictate, was convinced that a supplier and the patent proprietor as its customer had been bound by a relationship of trust of the kind typical in the sector and forbidding the supplier from disclosing the customer's trade secrets which came into its possession in the course of their co-operation to just any third party. The supplier had thus been obliged on principle to treat the patent proprietor's development results not intended for public consumption as confidential. However, that did not mean it had equally been obliged to maintain secrecy as regards what it knew, or learned through the co-operation, about devices its customer had already made publicly available in the past.

Finally, contrasting with the above, a particular example of the absence of an implied obligation of confidentiality in case **T 1798/14** took the form of a witness's visit to a firm's premises. It was in dispute whether he had been subject to an obligation to maintain secrecy, something he had repeatedly denied in his testimony. The respondent (patent proprietor) argued that he might nonetheless have been under such an obligation without knowing it. The board observed that it was not normally possible to furnish positive proof of the **non-existence of a fact** (here, an obligation). However, the non-existence of an agreement could instead be proven by showing that those who ought to have been informed were unaware of it. The business relationship between the witness and the company in question concerned a technical field that was not related to the said site visit. The board concluded that there had been no tacitly agreed obligation.

3.4.5 Demonstrating products for presentation purposes

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

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

In **T 823/93** of 18 October 1996, according to the board, the development of a new apparatus is usually kept secret from competitors. In the case at issue, the development of the apparatus had to be regarded as the result of co-operation between the opponent and the client. The board therefore took the view that, on the basis of these facts, it could be assumed that none of the parties had an interest in disclosing any information about the apparatus and it was likely that the technical reports exchanged between the parties were tacitly required to be treated as confidential. The board also held that the general conditions of business, which had become the conditions of contract and required the plans, designs and other documents to be handled confidentially, also extended to verbal information and details given during the presentation of the apparatus.

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

3.4.6 Presenting the product in writing

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

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

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

In **T 480/95** the document relied upon by the opposition division as a prepublication decisive for the evaluation of inventive step was a letter from the opponent to a customer written in connection with a contractual relationship between the two firms. The board

considered this letter to be a typical example of correspondence between contracting firms, which was confidential by its very nature.

3.4.7 Making samples/products available for test purposes

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

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

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

According to the board in **T 1847/12**, the relationship between a firm and another that it contracted to develop and deliver prototypes could not be treated as equivalent to that between a dealer and a customer. General experience showed that a vehicle became publicly available when the manufacturer delivered it to a dealer, because then anyone could buy it. But the same did not go for a delivery under a development contract. The development itself takes place in a confidential way. The board on this occasion made some observations on the status of third party. The board found that the written statement made by an employee of the contractor (Schrick GmbH) that, "as far as [he] knew", the prototypes had been delivered to the client (Opel) without any duty to maintain confidentiality was irrelevant because it was the client placing a contract, not the contractor, that decided whether confidentiality applied, i.e. here it had been for Opel, as client, not Schrick, as contractor, to decide whether the prototypes' development was to be treated as secret.

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

In **T 945/09** the teaching according to claim 1 of the patent in suit was used by a patient while having "home parenteral nutrition" (HPN). The opposition division had concluded that all information concerning the use of taurolidine as a catheter lock available to the acting medical team, to the patent proprietor (supplier of taurolidine) and to the patient, was covered by an implicit obligation of confidentiality which stemmed from the specific circumstances of the case. The board held that there was no reason for the patient to treat

that knowledge as a secret, because at that time the acting doctors simply tried to apply taurolidine of whatever provenance using a technique they derived freely and easily from the state of the art common to them at that time.

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

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

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

In **T 1054/92** of 20 June 1996 the opponent had alleged and proved that the claimed invention, an absorbent structure for diapers, had been tested in public tests carried out by several hundred members of the public at several places in the USA over several weeks. The board was convinced in the light of common experience that it was very unlikely that these tests had been kept confidential, particularly since some of the used diapers had not been returned to the appellant.

In **T 2068/15** the board accepted that, if joint development projects are agreed, they often are – explicitly or implicitly – combined with an obligation of confidentiality. In the case at hand, the board did however not see enough indications from which it could be convincingly concluded that a joint development project existed. The circumstances were

suggestive of ordinary sales rather than the sending of samples in the framework of a joint development project.

3.4.8 Conferences

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

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

3.4.9 Public availability of documents submitted for standardisation

In **T 202/97** the board held that a draft standard sent together with an agenda to the members of an international standards working party as part of the preparations for a meeting on standards was not normally confidential and was thus available to the public. Even though only a particular group of persons had been invited to take part in the meeting on standards, it was the task of a standards committee to draw up, with the experts in the field, proposals for standards which had been agreed upon, on as broad a basis as possible, and which were based on the current state of developments. This task precluded any obligation to maintain confidentiality. See also **T 2239/15** on the question of the public availability of documents (D1/D2), which the board stated was directly linked to the procedures of MPEG when elaborating new standards. The board held that in the absence of an explicit confidentiality agreement, a bar of confidentiality could not be seen to have been in place in the case in hand. The working group was small enough to make the explicit signing of confidentiality agreements possible, if "absolute" confidentiality (to keep it strictly limited to this group of members present in the meetings) had been intended.

In ex parte case **T 1440/09** the appellant did not contest that D1 had been on the internet before the earliest priority date of the application. D1 was a contribution submitted to the Joint Video Team (JVT) for its 15th meeting in Busan, KR, which took place from several months before the earliest priority date. Furthermore, the board noted that none of the

documents on file indicated that contributions to JVT meetings were to be kept confidential even after the meeting in question. The appellant alleged however the confidential nature of D1 based on the understanding that one of the purposes of the "JVT Patent Disclosure Form" was to protect the submitter from its contribution to the JVT meeting being held against its own later patent application. The board stated that the standard, preprinted "JVT Patent Disclosure Form" did not comprise any explicit indication that the technical contribution of the paper it accompanied should be kept confidential. The mere fact that the submitter of contribution D1 might have ticked the box that it was "not aware of any granted, pending or planned patents associated with the technical content of the Recommendation | Standard or Contribution" in point 2.0 of said form did not imply that the contribution D1 was to be kept confidential by any person to whom it was available. The board found that D1 constituted prior art under Art. 54(2) EPC 1973 for the application in the case in hand.

T 738/04 concerned standards institutes too, but confidentiality was in the end not decisive; it is mentioned here because it deals with these institutes' practices.

This question also arises in the context of Art. 83 EPC (see **T 1155/12**, **T 1049/11**).

3.4.10 Joint venture and other commercial agreements

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

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

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

In **T 163/03** the appellant (opponent) contended that the technical details of the apparatus as shown in the drawing D2 became state of the art when this drawing was given, without any confidentiality restriction, to BMW in May 1990, i.e. before the priority date of the patent in suit. The board held that where, as there, the terms and conditions of a technical co-operation, including related obligations of secrecy, had been explicitly specified and agreed upon by the partners of the co-operation by way of a written contract, the contractual provisions prevailed and left no room for construing implicit obligations of the parties which differed from or were incompatible with anything which the partners, on

proper interpretation of the contract, had fixed therein. The board found that there was no reason whatsoever to assume, in the absence of any explicit secrecy obligation, that BMW could nevertheless have been under an implicit obligation to keep secret the manufacturing technology disclosed to it by the opponent within the framework of the SE project.

3.4.11 Paper submitted to obtain an academic degree

In **T 151/99** the board held that, in general, it appeared highly plausible that a paper submitted to obtain an academic degree (in this case a master's thesis) was not confidential, and that became a virtual certainty if the paper was referred to in published scientific work. If the reference was in a document published before the priority date of the patent in suit, it could be assumed that the paper had also been made available to the public before that date (see also **T 451/00**, **T 538/09**, **T 1817/08**, **T 1266/11** and **T 1057/09**).

3.4.12 Medical field including clinical trials

In **T 670/20** clinical trials were carried out in accordance with the EMA Guidelines for Good Clinical Practice, which explicitly require adherence to the prescribed protocol and assurance of drug accountability. This set-up of the trials implied that the patients who decided to participate in the trials agreed, following their informed consent, to use the provided medication according to instruction or to return the unused medication. Accordingly, the participating patients who were provided with the tablets under investigation entered into a special relationship with the investigators of the trials and were with regard to the provided tablets not members of the public that could freely dispose over these tablets.

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

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

maintain confidentiality, given the need for patient confidentiality and the need to protect the development and testing of prototype devices, and that any evidence proving the contrary was important and had to be produced as soon as possible. See also **T 2395/22**.

Decision **T 239/16** dealt with the availability to the public of **clinical trials documents**. The board came to the conclusion that the contents of document (55) had been made available to persons neither being bound by any confidentiality agreement nor being in a special relationship to the study sponsor. However, document (55) did not directly and unambiguously disclose the effective treatment of osteoporosis as defined in the independent claims of the main request.

The sale of a product for a commercial purpose is not compatible with the concept of an implied obligation to maintain confidentiality. The board in **T 505/15** noted that **T 152/03** and **T 906/01** referred to a prima facie assumption that any person involved in the medical process was obliged to maintain confidentiality, given the need for patient confidentiality and the need to protect the development and testing of prototype devices. **T 505/15** differed in that the prior use occurred in a commercial context; the product had been delivered in the context of a commercialisation that occurred before the granting of the marketing authorisation (albeit with special regulatory approval) and delivery had not taken place in the context of a clinical study. The board concluded that there was no obligation to maintain confidentiality.

3.4.13 Notary

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

3.5. Evidence

3.5.1 Burden of proof

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

3.5.2 Standard of proof

a) General

The boards of appeal have developed in their case law certain principles as to the standard of proof required to establish the facts on which a decision is to be based. In some decisions the boards of appeal have applied the standard of "the balance of probabilities", which means that in relation to, for example, the question of when a document was first made available to the public, the board must decide what is more likely than not to have happened (see **T 381/87**, OJ 1990, 213; **T 296/93**, OJ 1995, 627; and **T 729/91** of 21 November 1994). In other decisions the boards have taken the view that a fact has to be proved "beyond reasonable doubt" or "up to the hilt" (see **T 472/92**, OJ 1998, 161; **T 97/94**, OJ 1998, 467; **T 750/94**, OJ 1998, 32). More recent decisions dealing with the implications in practice of applying these two different standards of proof are **T 2451/13** (for "up to the hilt") and **T 545/08** (for "balance of probabilities"). See also **T 842/14** (novelty and standard of proof).

b) Public prior use

As far the standard of proof to be applied is concerned, the boards' established legal practice is to apply as a rule the same standard of proof to public prior use objections as to other objections under Art. 100 EPC: the balance of probabilities. In cases of public prior use for which the evidence lies entirely within the sphere of the opponent the higher standard of proof "beyond any reasonable doubt" (also called in English "up to the hilt") applies (see **T 472/92**, OJ 1998, 161, **a**nd chapter III.G.4.3.2 "Public prior use" for more details of the case law in this area and on the implications of the "up to the hilt" standard of proof; on this latter point see e.g. **T 2451/13**).

c) Internet – proof of the date of availability

The law on this seems now to have been established by the decisions in **T 286/10** and **T 2227/11**, which were endorsed more recently in **T 1711/11**, **T 353/14**, **T 545/08** and **T 1589/13**. Those decisions also cited the EPO practice set out in its notice concerning internet citations (OJ 2009, 456 to 462) and the relevant section of the Guidelines: when a document retrieved from the internet is cited against an application or patent, the same facts are to be established as for any other piece of evidence, including standard paper publications. This evaluation is made according to the principle of "free evaluation of evidence". That means that each piece of evidence is given an appropriate weight according to its probative value, which is evaluated in view of the particular circumstances of each case. The standard for assessing these circumstances is the balance of probabilities. According to this standard, it is not sufficient that the alleged fact (e.g. the publication date) is merely probable; the examining division must be convinced that it is correct.

In short, the appropriate standard of proof for internet citations is the **"balance of probabilities"**.

The conclusion of the earlier decision **T 1134/06** that the stricter standard of proof "beyond reasonable doubt" had to be applied to internet disclosures has been refuted.

For further information, see in this chapter I.C.3.2.3 "Internet disclosures" and in chapter III.G.4.2.4 "Archives and internet publications".

4. Determining the disclosure of the relevant prior art

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

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

4.1. General rules of interpretation

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

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

In **T 312/94** the board held that for the interpretation of any document, in particular a patent application or patent, in order to determine its true meaning and thus its content and disclosure, no part of such a document should be construed in isolation from the remainder of the document: on the contrary, each part of such a document had to be construed in the **context of the contents of the document as a whole**. Thus, even though a part of a document appeared to have a particular meaning when interpreted literally and in isolation from the remainder of the document, the true meaning of that part of the document could be different having regard to the remainder of the document (see also **T 546/07**, **T 860/06**, **T 456/10**).

According to established case law, it is a prerequisite for the acceptance of lack of novelty that the claimed subject-matter is "directly and unambiguously derivable from the prior art". In other words, it has to be "beyond doubt – not merely probable – that the claimed subject-matter was directly and unambiguously disclosed in a patent document" (**T 450/89**, **T 677/91**, **T 988/95**, **T 1029/96**, **T 218/00**). This also means that the novelty of the claimed

subject-matter over a prior art document cannot be opposed only on the basis of equivalents to the features directly and unambiguously disclosed in the cited document (**T 167/84**, OJ 1987, 369; **T 928/93**, **T 1387/06**).

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

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

In **T 2397/11** the objection of lack of novelty based on prior art D1 failed. The board noted that it was a generally applied principle for concluding lack of novelty that there must be a direct and unambiguous disclosure in the state of the art which would inevitably lead to subject-matter falling within the scope of the claim. Where gaps in experimental detail exist, these may be filled by the skilled person with his common general knowledge using conventional techniques within reasonable limits, provided that the choices made are not material to the end results (see, for example, **T 1753/06**, in particular, points 4.11, 4.13, 4.16.1 and 4.17 of the Reasons).

In **T 412/91** the board decided that in principle, what constituted the disclosure of a prior art document was governed not merely by the words actually used in its disclosure, but also by what the publication revealed to the skilled reader as a matter of technical reality. If a statement was plainly wrong, whether because of its inherent improbability or because other material showed that it is wrong, then although published it did not form part of the state of the art. Conversely, if the skilled reader would not recognise that the teaching was wrong, it did belong to the state of the art (see also **T 410/99**).

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

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

It is a well-established principle laid down by the boards' case law that a non-specific definition in a claim should be given its broadest technically sensible meaning (see **T 79/96**, **T 596/96**). For a feature defined in a negative manner, which excludes the presence of a specific element, the broadest scope of the claim corresponds to the narrowest (i.e. most limited) technically sensible definition of the element to be excluded (**T 1553/19**).

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

The board in **T 1658/12** stated that, in determining what is made available to the public within the meaning of Art. 54(2) EPC by a prior art patent document, it must be borne in mind that it is the description which chiefly serves to disclose the invention in a manner that it may be carried out, whereas the chief function of the claims is to define the subject-matter for which protection is sought. Where a combination of features is found only in the claims (or only in the claims and a "Summary of the Invention" which merely recites the features of the claims), it must be very carefully considered whether this combination truly corresponds to the technical teaching of the document as it would be understood by a skilled person, or whether it is merely an artefact of the claim drafting process aimed at obtaining maximal scope of protection (see point 3.8 of the Reasons; also **T 312/94**, Catchword; **T 969/92**, point 3 of the Reasons, and in particular, page 4, first paragraph; **T 42/92**, "Orientierungssatz").

In **T 2020/13** the board stated that where a technical term such as a **trade name** is known to have changed, this circumstance is to be taken into account in order to attribute to that technical term its proper meaning and to understand the technical teaching meant to be conveyed by the prior art document (see abstract of this decision in this chapter I.C.3.2.1 h)).

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

In **T 1859/08** the board first observed that independent claims 1 and 10 were in the form of medical-use claims, the novelty of which was derived from the intended medical use. As a consequence, all the technical features of the therapeutic indication specified in the claims had to be taken into account when considering whether or not the claimed subject-matter was novel. The board noted that prior art document D1 did not involve humans, whereas the claims before the board were directed to the treatment of breast cancer in a human patient. Further, D1 stated that the combination therapy disclosed in

the study was "currently being explored". The board held that a mere statement that a combination therapy was being explored did not amount to a novelty-destroying disclosure. The "currently being explored" situation, where no clinical benefit was disclosed, fell within the rationale of decisions **T 158/96** and **T 715/03**. According to these decisions, if a prior art document disclosed clinical investigations such as phase I, II or III studies (or stated that these investigations were ongoing), but failed to disclose the final result of these studies, it was not novelty-destroying. The board concluded that there was no description in the prior art documents of the treatment of a human patient, nor any disclosure of the biological effect. Therefore, the claims satisfied the requirements of Art. 54 EPC.

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

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

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

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

4.2. Combinations within a prior art document

It is not permissible to combine separate items of prior art together. It is also not permissible to combine separate items belonging to different embodiments described in one and the same document, unless such combination has specifically been suggested (**T 305/87**). In **T 1988/07** the board emphasised that for the examination of novelty different passages in a document can only be combined if there is a clear teaching combining them. If, however, there is a specific reference in one prior document (the "primary document") to a second prior document, when construing the primary document (i.e. determining what it means to the skilled person) the presence of such a specific reference may necessitate part or all of the disclosure of the second document being considered as part of the disclosure of the primary document, i.e. incorporation by reference (see **T 153/85**,

OJ 1988, 1; **T 645/91**; **T 942/91**; **T 422/92**; **T 866/93**; **T 239/94**; **T 221/05**; see also below on **T 610/95**).

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

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

In **T 305/87** (OJ 1991, 429) the board considered it expedient to state that, in order to assess novelty, it was not sufficient to limit oneself to the contents of a single document taken as a whole, but rather it was necessary to consider separately each entity described therein. It was not permissible to combine **separate items belonging to different embodiments** described in one and the same document merely because they were disclosed in that one document, unless of course such combination had been specifically suggested there. In the case at issue, the two shears known from the catalogue were therefore definitely two separate entities forming two independent bases for comparison which ought to be considered in isolation when assessing novelty, and it was not admissible to piece together artificially a more relevant state of the art from features belonging to one or both of these entities, even if they were both disclosed in one and the same document (see **T 901/90**, **T 931/92** and **T 739/93**, **T 763/07**).

In **T 332/87** the board, after having recalled that the disclosure of a document normally had to be considered as a whole, held that, when examining novelty, different passages of one document might be combined, provided that there were no reasons which would prevent a skilled person from making such a combination. In general, the technical teaching of examples might be combined with that disclosed elsewhere in the same document, e.g. in the description of a patent document, provided that the example concerned was indeed representative of, or in line with, the general technical teaching disclosed in the respective document (see also **T 1630/07**, **T 2188/08**, **T 1239/08**, **T 568/11**).

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

In **T 42/92** it was explained, in accordance with the boards' established case law, that a pre-published patent specification formed part of the state of the art under Art. 54(2) EPC 1973 only as regards those elements which the person skilled in the relevant art would incontestably infer from the document as a whole. The disclosure of a

prior-art patent specification did not however cover combinations of individual features arising from **reference back to the claims** if those features were claimed separately for patent-law considerations and combining them was not supported by the description, or even – as here – was at odds with the embodiments described.

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

4.3. Taking implicit features into account

According to the boards' established case law, a prior art document anticipates the novelty of claimed subject-matter if the latter is directly and unambiguously derivable from that document, including any features implicit to a person skilled in the art. However, an alleged disclosure can only be considered "implicit" if it is immediately apparent to the skilled person that nothing other than the alleged implicit feature forms part of the subject-matter disclosed (**T 95/97**, **T 51/10**). In other words, a prior art disclosure is novelty-destroying if the subject-matter claimed can be inferred directly and unequivocally from that disclosure, including features which for the skilled person are implicit in what is explicitly disclosed (see **T 677/91**; **T 465/92**, OJ 1996, 32; **T 511/92**; and **T 2170/13**, which is a more recent decision finding that the feature at issue was implicitly disclosed in the prior art and devoting lengthy technical arguments to the point.

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

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

In **T 1523/07** the board observed that it is a generally applied principle that for concluding lack of novelty, there must be a direct and unambiguous disclosure, either explicit or implicit, in the state of the art which would inevitably lead the skilled person to subject-matter falling within the scope of what is claimed. In this context "implicit disclosure" means disclosure which any person skilled in the art would objectively consider as necessarily implied in the explicit content, e.g. in view of general scientific laws. In this respect, the term "implicit disclosure" should not be construed to mean matter that does not belong to

the content of the technical information provided by a document but may be rendered obvious on the basis of that content. Whilst common general knowledge must be taken into account in deciding what is clearly and unambiguously implied by the explicit disclosure of a document, the question of what may be rendered obvious by that disclosure in the light of common general knowledge is not relevant to the assessment of what is implied by the disclosure of that document. The implicit disclosure means no more than the clear and unambiguous consequence of what is explicitly mentioned (see **T 823/96**, **T 297/11**). Implicit disclosure means disclosure which any person skilled in the art would objectively consider as necessarily implied in the explicit content (**T 2522/10** of 16 April 2015). **T 1523/07** was cited in **T 1085/13** (novelty of higher degree of purity).

In **T 51/10** the board held, in summary, that, for a feature to be "implicit", it was essential that it could be unequivocally gathered from the overall context of a cited document (**T 701/09**) or necessarily followed from that context (**T 1523/07**). In particular, the skilled person had to be unable to conceive of any realistic alternative to the allegedly implicit feature (**T 287/16**).

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

In **T 666/89** (OJ 1993, 495) the board stated that the term "available" clearly went beyond literal or diagrammatical description, and implied the communication, express or implicit, of technical information by other means as well. One example of the available **information content of a document** extending beyond this literal descriptive or diagrammatical content was the case where the carrying out of a **process**, specifically or literally described in a prior art document, **inevitably resulted in a product** not so described. In such a case the prior art document would deprive a claim covering such a product of novelty. It was thus content, express and implied, rather than mere form, that was decisive for the issue of novelty in general, and "selection" novelty in particular (**T 793/93**).

In **T 270/97** the opposition division considered the claimed product to be anticipated by the agent produced and inevitably obtained by repeating examples 1 and 2 of a prior art document. The board noted that it was a well-established principle laid down in the case law since **T 12/81** (OJ 1982, 296) that the product inevitably resulting from a process properly defined as to its starting substance and reaction conditions was considered to be disclosed even if it was not cited *expressis verbis* in the prior art document. The board, however, found that the method disclosed in the text of example 2 implied a way of acting not envisaged in the method according to the patent in suit. The parties' attempts to show that the particles obtained according to example 2 were, or were not, identical to the products of the patent in suit, produced highly contradictory results. Therefore, the board could only conclude that depending on experimental conditions not disclosed in example 2 different products might be obtained. Thus, the claimed product was not inevitably obtained by following the method of example 2.

In **T 583/01** the board, following **T 270/97**, stated that novelty was a question of inevitability and not a question of probability (see also **T 1170/19**).

The patent at issue in **T 1456/14** was for a vacuum cleaner with a filter and its claim 1 was directed to the proportion of total length to area. That no total length was disclosed in the cited prior art document was, the board held, irrelevant for the purposes of assessing novelty if it could be demonstrated that it undoubtedly covered the claimed proportion nonetheless. To do so, it sufficed to show that even a smaller numerical value necessarily exceeded by the prior-art device would be in keeping with the claimed proportion, as this meant the prior art document definitely had to encompass that proportion too. Whether a known device had an implicit (or even explicit) feature did not depend on whether or not the skilled person's attention was likely to be drawn to precisely that feature but on whether, from a purely objective perspective, it had to have that feature. For the criterion of "direct and unambiguous disclosure" to be met, it was not essential that the skilled person would realise the feature was included even without knowing about the patent. EPO departments were to examine disclosure with the eyes and understanding of the skilled person, but that did not mean they did not do so purposively, in full knowledge of the feature they were looking for. Such an approach did not amount to an impermissible consideration of equivalents.

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

In **T 2387/13** (no implicit disclosure of a possible use) the board stated that the mere fact that the disclosed electrical transmission line in D2 could be used as a sensor did not mean that a sensor was disclosed. In order for such a use to be possible, there would have to be further installations. Such installations were, however, not disclosed.

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

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

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

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

4.4. Taking intrinsic features into account

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

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

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

4.5. Taking equivalents into account

The case law of the boards of appeal is based on a narrow concept of novelty, i.e. the disclosure of a prior document does not include equivalents of the features which are explicitly or implicitly disclosed; equivalents can only be taken into account when it comes to considering inventive step (**T 517/90**). This narrow concept of novelty, which excludes equivalents, is of particular importance for the application of Art. 54(3) EPC. In **T 167/84** (OJ 1987, 369) the board commented that conflicting applications within the meaning of Art. 54(3) EPC 1973 were included in the state of the art solely from the point of view of novelty, but were considered in the light of their "whole contents". In order to mitigate the harsh effects of the "whole contents approach", its application was confined to novelty. Further, in order to reduce the risk of "self-collision", it had always been considered justified to adopt a strict approach to novelty. The Guidelines expressly state that "when considering novelty, it is not correct to interpret the teaching of a document as embracing well-known equivalents which are not disclosed in the document; this is a matter of obviousness" (see Guidelines G-VI, 2 – April 2025 version). According to the case law of the boards of appeal the "whole contents" of an earlier document did not also comprise features which were equivalents of features in the later document (see also **T 928/93**, **T 1387/06**). **T 167/84** and **T 517/90** were applied in **T 1657/14**.

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

4.6. Taking drawings into account

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

In **T 204/83** (OJ 1985, 310) the board held that features shown solely in a drawing formed part of the state of the art when a person skilled in that art was able, in the absence of any other description, to derive a technical teaching from them. Dimensions obtained merely by measuring a diagrammatic representation in a document did not, however, form part of the disclosure (see **T 857/91**, **T 272/92**, **T 1488/10**, **T 1943/15**).

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

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

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

In **T 2052/14**, the board observed that, even though the examining division had had the impression that drawings in a prior art document showed the feature in the characterising portion of claim 1, that did not amount to a direct and unambiguous disclosure for the skilled person, who would know that those drawings were merely schematic views from which, in the absence of any specifications, no specific sizes or proportions could be derived. Since the drawings at issue were not marked as true to scale, they could only be standard schematic views.

In **T 141/16** the board found that although the figures of the prior art document E4 were merely schematic and no measurements could therefore be directly taken from such drawings, some information could be unambiguously derived from them. Figure 3 of the prior art document E4 represented a clear and unambiguous disclosure of a particular angle, in the sense that the components were shown "slanted". For a similar example in connection with a bend, see **T 1999/22**.

4.7. Taking examples into account

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

In **T 290/86** (OJ 1992, 414) the board decided that what was "made available to the public" by specific detailed examples included in a document was not necessarily limited to the exact details of such specific examples but depended in each case upon the technical

teaching which was "made available" to a skilled reader. The amendment of a claim by including a disclaimer in respect of such specific detailed examples could not render the claim novel.

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

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

4.8. Broad claims

In **T 607/93** the board decided that when novelty and inventive step were being assessed, there was no reason to use the description to interpret an excessively broad claim more narrowly, if it was a question not of understanding concepts that required explanation but rather of examining an excessively broad request in relation to the state of the art. This was applied in e.g. **T 2487/12**, **T 5/14** and **T 1173/17**.

4.9. End-values

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

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

4.10. Deficiencies and mistakes in a disclosure

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

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

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

In **T 412/91** the board took the view, having regard to Art. 54 EPC 1973, that the incorrect teaching of document (1) was not comprised in the state of the art. It stated that, in principle, what constituted the disclosure of a prior art document was governed not merely by the words actually used in its disclosure, but also by what the publication revealed to the skilled person as a matter of technical reality. If a statement was plainly wrong, whether because of its inherent improbability or because other material showed that it was wrong, then – although published – it did not form part of the state of the art. Conversely, if the skilled person could not see the statement was wrong, then it did form part of the prior art. The board in **T 523/14**, in which an advertising newsletter was alleged to be prior art, found that the case was not comparable to **T 412/91**, which one of the parties had cited.

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

In **T 230/01** the board noted that a document normally forms part of the state of the art, even if its disclosure is deficient, unless it can unequivocally be proven that the disclosure of the document is **not enabling**, or that the literal disclosure of the document is manifestly erroneous and does not represent the intended technical reality. Such a non-enabling or erroneous disclosure should then not be considered part of the state of the art.

In **T 428/15** the objection that D3 anticipated the subject-matter of claim 1 was based on passages of a **computer-generated translation** whose quality did not allow the board to understand with a sufficient degree of certainty what was in fact described in D3. Furthermore, the appellant did not submit a human translation of the relevant passages, which would have clarified the issue, or provide technical explanations which would have rendered credible that the true meaning of the vague passages concerning the use of chloroform and the apparently described rinsing step was immaterial to the conclusion to be drawn in respect of the nature of obtained product A1. Compare with **T 655/13**, in which the board considered the examining division's failure both to identify in its decision the relevant passage of a Japanese technical journal it had cited as prior art allegedly disclosing one of the claimed features and to provide a translation of that passage amounted to a breach of the duty to give reasons (R. 111(2) EPC).

4.11. Accidental disclosure

An anticipation is accidental if it is so unrelated to and remote from the claimed invention that the person skilled in the art would never have taken it into consideration when making the invention. When an anticipation is taken as accidental, this means that it appears from the outset that the anticipation has nothing to do with the invention (**G 1/03** and **G 2/03**, OJ 2004, 413 and 448; **T 134/01**, **T 1911/08**). This concept is relevant primarily in relation to disclaimers, which under certain circumstances are allowable to restore novelty of an invention over an accidental disclosure (see chapter II.E.1.7. "Disclaimers" and in particular chapter II.E.1.7.3(a) "Accidental anticipation").

In accordance with Art. 54(2) EPC, all state of the art, and so also that disclosed accidentally, must be taken into consideration when assessing novelty (**T 1170/19**).

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

4.12. Reproducibility of the content of the disclosure

According to the established case law a disclosure destroys novelty only if the teaching it contains is reproducible, i.e. can be carried out by the skilled person (**T 1437/07**, **T 1457/09**, **T 1045/21**). Subject-matter described in a document can only be regarded as having been made available to the public, and therefore as comprised in the state of the art pursuant to Art. 54(1) EPC, if the information given therein to the skilled person is sufficient to enable him, at the relevant date of the document, to practise the technical teaching which is the subject of the document, taking into account also the general knowledge at that time in the field to be expected of him (see **T 26/85**, **T 206/83**, **T 491/99**, **T 719/12**).

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

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

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

In **T 310/88** the board of appeal had to consider a discrepancy between what actually happened in practice when carrying out a technical teaching in a prior document according to the letter of its description, and what this prior document said would happen. The board held that the invention was novel over the prior document because the latter did not contain a sufficiently clear teaching for that conclusion not to be reached (see **T 23/90**).

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

In **T 1437/07** the board pointed out that a disclosure in a prior art document is novelty-destroying only if the teaching it contains is reproducible. This need for an enabling disclosure is in conformity with the principle expressed in Art. 83 EPC. Thus, the requirements of sufficiency of disclosure are identical for a prior art document and a patent. The board followed the principles developed by the case law in the framework of the

evaluation of the requirements of Art. 83 EPC in the case of a medical use, i.e. that the skilled person should not only be able to carry out the teaching of the prior art document, but it should also be credible that the effect at issue – here, relief of pain – has been achieved (see also **T 491/08**).

In **T 578/12** the appellant contested that claim 1 of the main request was not new in view of prior art document D1, an Australian patent application; its main argument was that D1 had no drawings or any description of a detailed embodiment of any dispensing machine and could not be regarded as an enabling disclosure. The board noted inter alia that the fact that D1 did not contain any figures did not hinder the skilled person from understanding the described method or from carrying it out. The decision in this case gives an example of a detailed set of reasons for the outcome of examining features disclosed by a prior art document.

In **T 1457/09** claim 4 was drafted as a second medical use claim. In the decision under appeal the opposition division held that the subject-matter of the corresponding claim was anticipated by the intermediate document (D1). The opposition division considered that both documents (D1) and (D1a, the priority document of D1) disclosed pharmaceutical compositions comprising the peptide RMFPNAPYL and their use as a cancer vaccine. The board found that for the requirement of reproducibility to be considered as fulfilled in relation to a medical use it is necessary that the disclosure in the prior art document is such as to make it credible that the therapeutic effect on which the disclosed treatment relies can be achieved (**T 609/02**). The board held that in the case at issue a prior art document was novelty-destroying only if it disclosed not only the product referred to in the claim – here RMFPNAPYL – for the claimed therapeutic application – here treatment of cancer – but also that the claimed product was indeed suitable for the claimed therapeutic application. The board concluded that the experimental results disclosed in document (D1a) were not sufficient to make it credible that the RMFPNAPYL peptide was suitable for the treatment of cancer. Therefore document (D1) did not destroy the novelty of the subject-matter of claim 4.

5. Ascertaining differences

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

5.1. Comparing each individual item from the prior art

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

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

In **T 291/85** (OJ 1988, 302) the board noted that the disclosure in a prior publication always included not only what it presented as the teaching of the invention but also what it referred to as the prior art. In the board's view, however, when examining for novelty, to read into an account of the state of the art couched in very general terms specific details of the inventive teaching of the same document was permissible only where a person skilled in the art would in fact have made this combination when reading this document. Thus, the board concluded that if a citation gave detailed information about a further development of a prior art described only in very general terms without quoting a specific source, it was not permissible in examining for novelty to combine these general statements with the specific statements made solely in order to explain the said development, unless a person skilled in the art would have made the combination when reading the citation.

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

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

5.2. Distinguishing features

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

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

5.2.1 Difference in wording

In **T 114/86** (OJ 1987, 485) the board held that a mere difference in wording was insufficient to establish novelty (see **T 12/81**, OJ 1982, 296; **T 198/84**, OJ 1985, 209; **T 248/85**, OJ 1986, 261). In **T 565/90** the appellant submitted that only preferred ranges or examples amounted to a technical disclosure destructive of novelty, and that generic ones could not anticipate the more specific teaching of the patent in dispute. The board

did not agree and confirmed earlier case law that the definition of an invention which differed from the prior art only in its wording was insufficient to establish novelty. The board stated that what had to be established was whether or not the state of the art made the subject-matter of the invention available to the skilled person in the form of a technical teaching.

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

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

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

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

5.2.2 Differences in values

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

and that the objection of lack of novelty relied on an ambiguity introduced artificially by the appellant.

In **T 1186/05** the board drew a distinction between the case before it and the case before the board in **T 74/98**. In the latter case, the board had considered that rounding up to the next integer (thus matching the lower limit of the claimed "inventive" range) of a component's molar percentage having two decimal places, calculated by conversion from its weight proportion, was not justified because (i) this would lead to a broadening of the claimed range and (ii) reconversion of the rounded molar percentage to the corresponding weight proportion would also imply a modification of the latter, i.e. would alter the true meaning of this specific disclosure. However, in the case before it, the board in **T 1186/05** pointed out that rounding up was required, in order to enable two density values to be compared, each one reflecting a "true" density value having three (or more) decimal places, but expressed to a different degree of accuracy, i.e. one having three and the other one having only two decimal places. Thus, the rounding exercise put the claimed and the prior art density values on the same level by using the mathematical rule existing for that purpose. This exercise had no impact on the density value as disclosed in the prior art document (see also **T 708/05**).

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

In **T 871/08** of 8 December 2011 prior art document D9 related to a method for hydrogen peroxide production by an anthraquinone method. The respondent had argued that the claimed subject-matter was novel, because the value 2.996 was lower than the lower limit of 3:1 defined in claim 1 at issue. This argument was not accepted by the board. When comparing a value from the state of the art (the value "2.996") with those claimed (the range of values "from 3:1 to 9:1"), the state of the art value had to be given the same accuracy as the one claimed. In the case at issue, the values in the claims had been quoted without any digit after the comma, which meant that for comparison purposes, the value 2.996 had to be rounded up to 3, which thus fell into the range of the claimed values (see, in particular, **T 1186/05**, **T 708/05**).

In **T 686/96** claim 1 related to a composition with a feature (iv) requiring a Perspex® abrasion value (PAV) in the range from about 12 to about 20 PAV. A prior art document disclosed in example 2 a composition having features (i) to (iii) of claim 1. With respect to novelty it had to be decided whether the known composition also had an abrasion value as required by feature (iv) of claim 1. The board established that the abrasion value of the known composition was somewhat below the lower value indicated in feature (iv) of the claim. Since the lower limit in the claim 1 was defined as "about 12", some interpretation was necessary. The board held that, when deciding on the novelty of the subject-matter of a claim, the broadest technically meaningful interpretation of a claim should be taken into account. In the board's view the scope of claim 1 was to be construed to mean that the indicated lower limit corresponded to the value disclosed in the prior art. Claim 1 was then considered to lack novelty. By contrast, in **T 2437/13** (nucleic acid sequences), the degree of sequence identity as defined in claim 1 represented the ratio (expressed in %) of identical nucleotides between a query nucleotide sequence that is pairwise aligned with a target nucleotide sequence, and the total number of aligned bases. Both numbers were integers which could be counted with absolute precision. Two bases either matched or did not. There was no error possible in calling two bases a match or not. The counting of matches could be repeated and would have led to the exact same result every time. There was no error of measurement or estimation and no error propagation in the calculated percentage sequence identity and hence no reason for rounding up the calculated ratio when it came to calculating the degree of sequence identity.

In **T 594/01** the board stated that it was common general knowledge that every experimental measurement in quantitative analytical chemistry as well as any result of any physical measurement could not be dissociated from the margin of uncertainty attached to the measurement. Normally, the uncertainty of a measured experimental value was irrelevant for the assessment of novelty. However, when a specific experimental value was disclosed in an example of prior art, seeking to distinguish the claimed subject-matter therefrom only in terms of an upper limit to be required to be "lower than" the experimental value must fail, as the claimed subject-matter is still not distinguishable from the prior art within the margin of experimental error (see also **T 708/05**; **T 386/17** – angle of "more than 0 degrees").

5.2.3 Difference in parameters

In **T 1764/06** the board noted that the only expressed distinction between the definition of the claimed photocatalyst and the photocatalyst of D1 relied on a parameter feature that was not usual, let alone common, for the skilled person. The onus of proof in that respect lay on the applicants, but no proven distinction had been shown. As regards the benefit of the doubt, which in the applicant's view was to be accorded to applicants in complex situations without direct disclosure, the position of the board was that in a situation where the applicants have used an unusual parameter feature to define their product, which unusual parameter feature represents the only distinction over otherwise identical known products, and the applicants have decided not to provide evidence that the parameter feature as such represents a difference in the claimed products from the known products, no benefit of the doubt could be accorded (see also **T 1764/06**, **T 1995/15**). The same applies in inter partes proceedings (**T 131/03**, **T 740/01**, **T 1666/16**).

See also chapter III.G.5.2.2 "Cases in which the burden of proof was reversed".

5.2.4 Difference in composition

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

5.2.5 Functional features

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

According to the established case law, where a claim concerns an apparatus differing from a known apparatus only as regards the use indicated, then the use is not an apparatus feature, meaning that two apparatuses (differing only in the intended use) are identical in terms of structure. If the known apparatus is suitable for the claimed use, the claimed invention lacks novelty. If, however, the claim is for a process, the situation is not comparable. In such a case, the use feature is a functional process feature comparable in category with the other features (steps) of the process (**T 848/93** cited by **T 1931/14**). The opponent in **T 1931/14** also referred to decision **T 304/08**, but the board stated that the situation in **T 304/08** was quite different. The board in **T 1931/14** concluded that **T 848/93**

and **T 304/08** demonstrated that in the context of a method it was important to differentiate between different types of stated purpose, namely those that define the application or use of a method, and those that define an effect arising from the steps of the method and implicit therein. Where the stated purpose defines the specific application of the method, in fact it requires certain additional steps which are not implied by or inherent in the other remaining steps defined in the claim, and without which the claimed process would not achieve the stated purpose. In this manner the stated application represents a genuine technical limitation of the method and the claimed method must be applied in that manner. On the other hand, where the purpose merely states a technical effect which inevitably arises when carrying out the other remaining steps of the claimed method and is thus inherent in those steps, such a technical effect has no limiting effect because it is not suitable for distinguishing the claimed method from a known one. In **T 1930/14** the board considered that this finding in **T 1931/14** (point 2.2.4 of the Reasons) could only hold in cases where it was unambiguously clear that the purpose implied such steps and where it was also unambiguously clear what those steps in fact were. In **T 1930/14**, the board could identify no indication, either in the claim itself or in the description, that would lead the skilled person to understand that the stated purpose "for purifying a monoclonal antibody from aggregates thereof" implied that the claimed method contained additional steps. See also **T 1399/16**.

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

T 2170/13 dealt with the re-drafting of claim 1 as a method claim (auxiliary request). The board endorsed the approach in **T 1822/12** that **G 2/88** (in relation to functional technical features) related only to a use claim, namely to a claim for the new use of a known compound, that the case law had constantly interpreted **G 2/88** in a very restrictive manner and that there was no possibility to expand the ruling in **G 2/88** and **G 6/88** to a claim worded otherwise. Hence the undisclosed purpose could not be considered to be a distinguishing functional technical feature of the claim. Following long technical arguments, the board also concluded (on the main request) that the final claimed feature was implicitly disclosed in prior art D1.

The term "means" is frequently used in the plural in the wording of patent applications, especially for functional definitions, but this does not actually rule out that there is only a single structural element (**T 1794/12**).

5.2.6 Generic disclosure

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

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

The disclosure "rastered halftone images, such as portraits" of prior art document D3 necessarily included portraits which fall under the understanding of the feature "at least one digitised mark made of at least one set of dots appearing as a three-dimensional mark when viewed in transmitted light" as defined in the patent in suit. The fact that, in addition, there might be portraits which fall under the disclosure of document D3 but which did not correspond to the claimed feature did not invalidate the existence of those that do: the wording of the claimed feature was even more generic than the disclosure in document D3 and was thus anticipated by it (**T 687/14**).

5.2.7 Product claim with process features

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

In **T 32/17** the board found that a process feature in a product-by-process claim only contributes to the novelty of a product claim insofar as it gives rise to a distinct and identifiable characteristic of the product (see also **T 179/03**). From hybridomas' deposit information the skilled person derived that hybridomas producing the claimed antibodies had been deposited and had been assigned deposit numbers. This deposit information however did not convey any technical information about the chemical composition or molecular structure of the antibodies produced by these hybridomas, such as their amino acid sequence, either explicitly or implicitly. The board thus concluded that the deposit of a hybridoma under R. 31 EPC for compliance with the disclosure requirement of Art. 83 EPC did not in itself convey any technical information about the molecular structure of the monoclonal antibody produced by said hybridoma, such as its amino acid sequence.

5.2.8 Non-technical distinguishing features

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

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

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

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

In **T 2191/13** the board observed that novelty could not be established on the basis of a distinction **made only mentally**, i.e. derived solely from pre-existing knowledge and not reflected in the technical features of the claimed subject-matter. It cited the Enlarged Board's ruling in **G 2/88** that a claimed invention lacked novelty unless it included at least one essential technical feature distinguishing it from the prior art. It followed from that decision that a feature of a merely mental nature could not be a new technical feature for the purposes of Art. 54 EPC and, therefore, that a claim containing only already known technical features could not be considered novel. This approach was also taken in **T 959/98**, **T 553/02**, **T 154/04** and **T 868/17**.

6. Chemical inventions and selection inventions

6.1. General

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

general term in the state of the art, the question arises whether the general term makes the claimed matter fully or partially accessible to the public. In other words, it has to be established whether the general term used in the citation discloses the subject-matter defined by the special term in the claim. The prior-art disclosure needs to be identified particularly carefully in such cases. General terms of this kind occur particularly frequently in the chemical literature, which is why the relevant case law usually relates to this field. For instance, in **T 2350/16** (see also **T 712/16**), concerning an application in the field of Mechanics, the board observed that the case law on selections from lists could not be applied because it did not concern (long) lists of the kind commonly encountered in Chemistry but, in each instance, merely a selection from among two or three elements at most. There are two types of cases here:

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

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

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

6.2. Novelty of chemical compounds and groups of compounds

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

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

The applicant argued that the novelty of the claimed product was based on a selection. The board used the opportunity to comment on this argument and develop **criteria for selection inventions** that have frequently been adopted in later decisions: a substance selection can come about if an unmentioned compound or group of compounds having a formula covered by the state of the art is found, in the absence of any information as to the starting substance or substances. The subject-matter in the case in question, however, did not involve a selection of that kind in an area which, although marked out by the state of the art, was nonetheless virgin territory. However, the disclosure by description in a cited document of the starting substance as well as the reaction process is always prejudicial to novelty because those data unalterably establish the end product. If, on the other hand, two classes of starting substances are required to prepare the end products, and examples of individual entities in each class are given in two lists of some length, then a substance resulting from the reaction of a specific pair from the two lists can nevertheless be regarded for patent purposes as a selection and hence as new.

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

6.2.1 Anticipation of certain compounds

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

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

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

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

sequence of IL-1 that would provide definitive proof of the homogeneity of IL-1 preparations" was found in the prior art (see also **T 90/03**, **T 29/05**).

b) Selection of starting substances from different lists

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

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

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

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

c) Selection on the basis of a general formula

In **T 181/82** (OJ 1984, 401) the board confirmed that the products of processes which were the inevitable result of a prior description of the starting materials and the process applied thereto formed part of the state of the art. This was true even if one of the two reactants manifested itself as a chemical entity (C_1 alkyl bromide) from a group of generically defined compounds (C_1 - C_4 alkyl bromides). The board took the view that the description of the reaction of a certain starting material with C_1 to C_4 alkyl bromides disclosed only the C_1-

substituted product, and was not prepared to recognise the disclosure of a particular butyl substituent on the grounds that four isomeric butyl radicals existed.

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

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

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

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

6.2.2 Novelty of groups of substances

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

families having a large number of products in common. The board pointed out that a distinction had to be drawn between two situations:

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

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

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

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

In **T 133/92** the question to be answered in examining novelty was whether the selection of the alkyl group as defined in claim 1 of the disputed patent had been made available to the public with regard to the disclosure of a prior document. By citing **T 666/89** (OJ 1993, 495), the patent proprietors contended that the legally correct approach for deciding selection novelty was identical or very similar to that employed in determining obviousness. In particular, they argued that in cases of overlapping ranges of compounds, a claim to a narrower range as compared with a broader prior art range was always selectively novel if it could be demonstrated that the narrow range was inventive over the broader range. However, the board observed that in the case cited the board had repeatedly emphasised that selection novelty was not different from any other type of

novelty under Art. 52 and 54 EPC 1973, so that the proper approach was to consider availability in the light of a particular document. Thus the board found that a claimed group of compounds, essentially resulting from omitting those parts of a larger group of compounds which a skilled person would have immediately considered as being less interesting than the rest, could not be selectively novel. In addition, in the board's opinion, a skilled person would, having regard to these considerations, have seriously contemplated applying the technical teaching of this prior art document in the range of overlap.

6.2.3 Novelty of enantiomers

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

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

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

6.2.4 Achieving a higher degree of purity of a compound

In **T 1085/13**, the board decided that a claim defining a compound as having a certain purity lacks novelty over a prior-art disclosure describing the same compound only if the prior art discloses the claimed purity at least implicitly, for example by way of a method for preparing said compound, the method inevitably resulting in the purity as claimed. Such a claim, however, does not lack novelty if the disclosure of the prior art needs to be supplemented, for example by suitable (further) purification methods allowing the skilled person to arrive at the claimed purity (see also **T 1914/15**). Whether such (further) purification methods for the prior-art compound are within the common general knowledge of those skilled in the art and, if applied, would result in the claimed purity, is not relevant to novelty, but is rather a matter to be considered in the assessment of inventive step. Further, the board was convinced that the rationale of **T 990/96** and **T 728/98** was not in line with **G 2/88** and **G 2/10**. See also **T 43/18**.

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

In **T 728/98** (OJ 2001, 319) the applicant (appellant) argued that the situation was such an exceptional one as mentioned in **T 990/96**. The claimed pharmaceutical composition differed from the state of the art because the particularly high purity level of the compound it contained could not be achieved by conventional methods. The board found, however, that the applicant, who bore the burden of proving this allegation, had not provided the necessary evidence. Where the claimed purity level of a low molecular chemical compound (here a terfenadine derivative) turns out to be successfully achieved by applying a conventional purification method on a reaction mixture disclosed in the prior art, an exceptional situation such as addressed in decision **T 990/96** does not exist. This would have required evidence that conventional methods could not achieve that purity level. Therefore the general rule applies that the level of purity of that low molecular compound cannot entail novelty. That general rule is valid also in the case of a product-by-process claim where that purity level is the inevitable result of the preparation process indicated in the claim.

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

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

chlorine ion of the claimed latex was an essential feature of the claimed latex, since, according to the patent in suit, only the latexes having this low level of chlorine ions enabled the production of films having the desired properties in terms of oxygen barrier properties and boil blushing properties. This implied that the claimed degree purity in terms of chlorine ion content could not be considered as an arbitrary degree of purity but that it amounted to a purposive selection. Thus, for this reason the considerations made in decision **T 990/96** and, by way of implication, in decision **T 803/01**, did not apply to the case before the board.

6.3. Selection from parameter ranges

6.3.1 Selection of a sub-range

a) Requirements for novelty: narrow, far removed and the "gold standard"

The principles applied by the boards of appeal on novelty of selection inventions were initially developed in particular in **T 198/84** (OJ 1985, 209) and summarised briefly in **T 279/89** as three criteria, of which the third one ("requirement (c)") regarding purposive selection has been abandoned in more recent case law. With **T 261/15**, the criteria according to which a selection of a sub-range of numerical values from a broader range is new were set out as:

(a) the selected sub-range should be narrow;

(b) the selected sub-range should be sufficiently far removed from the known range illustrated by means of examples.

Since 2019, the Guidelines too reflect this (G-VI, 8 (ii) – November 2019 version; with reference to **T 261/15**).

In **T 1688/20**, the board also explained that in cases where under application of the "gold standard" it could be established whether the skilled person, using common general knowledge, directly and unambiguously derived a claimed sub-range from a particular disclosed range of the prior art, no supporting test or criteria was necessary to reach a conclusion. Thus, in that particular instance, none of the three criteria initially developed in **T 198/84** needed to be applied (see also **T 337/22**).

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

b) Purposive selection: a requirement for inventive step rather than novelty

As evoked above, initially a third criterion was required, namely that "(c) the selected area should not provide an arbitrary specimen from the prior art, i.e. not a mere embodiment of the prior description, but another invention (purposive selection)". This criterion is now considered relevant in the assessment of inventive step rather than novelty (see **T 1233/05**, **T 1131/06**, **T 230/07**, **T 913/07**, **T 1130/09**, **T 2041/09**, **T 492/10**, **T 1948/10**, **T 423/12**, **T 378/12**, **T 1404/14**, **T 261/15**). Some isolated counter-examples do exist: see for example decision **T 66/12**, in which the board left it open as to whether the first two criteria were satisfied in light of its conclusion that the third criterion was not met. See also **T 673/12** and **T 2438/13**, which recalled the three criteria for the examination of novelty.

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

In **T 1130/09** the "selection invention" principle had been applied in the contested decision for the purpose of assessing novelty, regard being had to the three criteria developed in **T 198/84** (see OJ 1985, 209). The board observed that this principle was applicable where a narrow sub-range was selected from a broader range. The passage on page 9, lines 5 to 7, of document (2) disclosed that the dimensions of the structures were measured in nanometres or micrometres. Therefore, as had already been established in the contested decision, the range specifically claimed was a narrow selection which, in the absence of examples in document (2), had to be considered far removed from the central embodiments in that document. The board thus held that the first two of the criteria defined in **T 198/84** were met. The third – that a technical effect of the narrower sub-range claimed had to be demonstrated – could not, however, be considered for the purpose assessing novelty, because novelty and inventive step were two distinct requirements for patentability. A technical effect within the more narrowly claimed range did not confer novelty on a numerical range which was already novel per se, but merely confirmed its already established novelty. Whether or not there was a technical effect nevertheless remained **a matter of inventive step** (many decisions have applied this approach; see **T 1233/05**, **T 1131/06**, **T 230/07**, **T 913/07**, **T 2041/09**, **T 492/10**, **T 1948/10**, **T 423/12**, **T 378/12**, **T 1404/14** and **T 261/15**). Indeed in **T 378/12**, concerning criterion (c), the board was of the view that purposive selection was relevant for assessing inventive step but not novelty. Consequently, since the claimed sub-range met the criteria (a) and (b), the board judged that the subject-matter of claim 1 was new.

c) Earlier case law: three requirements for novelty

With regard to this third criterion (arbitrary or purposive selection) when it was first formulated, the board in **T 198/84** was of the opinion that this view of novelty really entailed

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

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

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

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

For a decision in which the prior art under consideration was taken into account pursuant to Art. 54(3) EPC, see **T 847/07**. In that case the board applied the "purposive selection" requirement in its assessment of novelty.

6.3.2 Overlapping ranges and multiple selection

For inventions which consist of parameter ranges that overlap with ranges disclosed in the prior art or of multiple selections (e.g. with sub-ranges, overlapping ranges and/or selection(s) from one or more lists), novelty is not assessed by looking at the various parameters and their nature, ranges, or values separately from each other. Provided the claimed subject-matter is not disclosed explicitly in the prior art, novelty is acknowledged unless there is a **pointer** in the prior art to the particular combination claimed.

This was established in case **T 653/93**, in which the appellant argued that the process of claim 1 was novel as it referred to a combination of three process features with selected ranges and product features with specific limits, a combination not disclosed in the prior art document. The board of appeal emphasised that in such situations the question of novelty could not be answered by contemplating the ranges of the various parameters separately. This would, in the board's judgment, be an artificial and unjustified approach, since it was not the specified ranges of the three parameters or their agglomeration that formed the subject-matter of claim 1, but the group of processes defined by the combination of these ranges, which was rather small when compared with the group of processes disclosed in the prior art document. Thus the claimed group of processes, characterised by the combination of three specific process parameters, was not explicitly disclosed in the prior art document which contained no pointer to the particular combination of ranges, and therefore could be said to result from a "multiple (i.e. threefold) selection". The novelty of the technical teaching of claim 1 was corroborated by experimental evidence showing that the products resulting from the claimed processes could not have been obtained by processes which were close to but nevertheless outside the range of the processes claimed. It followed that the subject-matter of claim 1 was not considered as having been disclosed in the prior art document (see also **T 1095/18**). The board distinguished the situation in this case from **T 198/84** (selections from a numerical range of only one single parameter) and that in **T 666/89** (clear teaching in the prior art regarding the claimed particular combination of features).

In **T 929/00**, the board stressed that the situation in which an area of overlap with the prior art can only be constructed by a combination of several selections from a plurality of lists, is to be distinguished from a situation in which the claimed subject-matter represents a single selection – of a sub-range – within a piece of prior art (on which see the above chapter I.C.6.3.1). The board reiterated that only what can be directly and unambiguously derived from a prior art document is relevant for the assessment of novelty, be it explicitly or by necessary implication. After examining the prior art document at issue including each of its examples cited, the board concluded that there was no indication in that document that would have necessarily led the skilled person to modify the explicitly disclosed compositions to arrive at the claimed subject-matter.

In **T 261/15**, the claimed composition overlapped with the generic composition of the pearlitic rail disclosed by D1. Since the different alloying elements interacted with each other to form precipitates and solid solutions their content ranges were not to be considered in isolation but in combination. Hence, the range of overlap was narrow in respect of the composition of D1. Considering the preferred ranges for some elements

(such as C) while disregarding them for other elements (such as S for which the preferred range did not overlap with the claimed range) constituted cherry-picking within D1, which created a novel combination of features. See also **T 2623/19** for another example with respect to a claim to a type of steel.

In **T 1132/22**, the board endorsed the reasoning in **T 261/15, T 2623/19** while highlighting (with reference to **T 1688/20**) that the criterion to be applied when evaluating the novelty of ranges is the "gold standard" of whether there is a direct and unambiguous disclosure in the prior art. It also noted that in the case of multiple ranges, the concept of "seriously contemplating" as described in **T 26/85** is not in line with this standard and is a concept that belongs to the inventive-step assessment (see also **T 989/22**).

In **T 1571/15** the overlap between the composition as claimed and the broad composition of D1 was narrow. D1 disclosed a preferred composition range and there was no pointer to work outside this range. The board stated that while it was true that the person skilled in the art might seriously contemplate working in the centre region of a prior art range when no other pointer (for instance in the form of examples of preferred ranges) to another region was present, this was no longer true if, as in the present case, such a pointer was present and was directed to another region.

In **T 1834/13** the appellant argued that D7 destroyed the novelty of claim 1 because it described all its features, which meant that an embodiment, although not literally disclosed, had been made publicly available (implicit disclosure). Conceding that there was some overlap, the board nonetheless held that, although D7 encompassed the tapes according to claim 1 as a concept, it did not disclose them directly and unambiguously. The subject-matter of claim 1 was a specific combination resulting from a multiple selection from among the alternatives proposed in D7 but there was no incentive in D7 to choose that combination. **T 198/84** and **T 65/96** did not apply because they did not concern multiple selections.

The earlier case law on novelty of overlapping ranges was based on decision **T 666/89** (OJ 1993, 495) (and further refined in **T 245/91**), in which the board gave a ruling on novelty assessment in cases of overlapping numerical ranges. The patent related in particular to a shampoo comprising 8-25% anionic surfactant and 0.001-0.1% cationic polymer. In an earlier patent application a shampoo composition had been disclosed containing 5-25% anionic surfactant and 0.1-5.0% cationic polymer. The board held that the composition was not new. In the board's view, there was no fundamental difference between examining novelty in situations of so-called "overlap" or "selection", and in doing so in other situations, although it might be helpful, in order to verify a preliminary conclusion of a novelty examination in cases of overlap, to investigate whether or not a particular technical effect was associated with the narrow range in question. It needed to be stressed, however, that such a particular effect was neither a prerequisite for novelty nor could it as such confer novelty; its existence could merely serve to confirm a finding of novelty already achieved. The term "available" in Art. 54(2) EPC 1973 clearly went beyond literal or diagrammatical description, and implied the communication, express or implicit, of technical information by other means as well. Thus it was clear that matter that was hidden, not in the sense of being deliberately concealed but rather in the sense of being

reconditely submerged in a document, would not have been "made available" in the above sense. In the case of overlapping ranges of physical parameters between a claim and a prior art disclosure, what would often help to determine what was "hidden" as opposed to what had been made available was whether or not a skilled person would find it difficult to carry out the prior art teaching in the range of overlap. Provided the information in the prior art document, in combination with the skilled person's common general knowledge, was sufficient to enable him to practise the technical teaching, and if it could reasonably be assumed that he would do so, then the claim in question would lack novelty. Novelty was carefully analysed on the basis of comparable considerations in **T 366/90** and **T 565/90**.

For further decisions in the wake of **T 666/89**, see CLB, 10th edn. 2022, I.C.6.3.

6.4. Subject-matter group

T 763/89 considered the issues raised by making a selection from a generically defined group of multilayer materials. The patent related to a reversal colour photographic material comprising three layers having differing colour sensitivity, each layer comprising a further three layers having the same colour sensitivity but differing photographic sensitivity. The closest prior art consisted of a reversal material with "at least two" layers. The opponent had argued that the multilayer materials disclosed by this prior art also included the three-layer material claimed, therefore causing lack of novelty. The board, however, held that it was new: although "at least two" was synonymous with a multilayer material and set the lower limit in the form of a double-layer material (the description related to any multilayer material without specifying an upper limit for the number of possible layers), the only theoretical examples given for such multilayer materials were double-layer materials. Nor did the documents cited in support of the opposition as much as hint at a three-layer material. It might appear logical for a three-layer material to form part of the group of multilayer materials in the cited documents, but this did not mean that it was thereby disclosed. On the contrary, it was a new material forming part of this group and selected from it. The board handed down this ruling in the context of previous case law on selection inventions involving chemical substances. This had provided that a technical teaching was prejudicial to novelty if it disclosed a substance in individualised form, i.e. one clearly distinguishable from structurally similar substances. This principle for assessing the novelty of individuals as distinct from a group could be applied to things such as the photographic material in question, which was clearly distinguishable from other things forming part of the same generically described group.

7. First and second medical use

7.1. First medical use

7.1.1 Introduction

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

Art. 54(4) EPC (former Art. 54(5) EPC 1973) provides that the general rules of law relating to novelty do not exclude the patentability of any substance or composition, comprised in the state of the art, for use in a method referred to in Art. 53(c) EPC (former Art. 52(4) EPC 1973), provided that its use for any method referred to in that paragraph is not comprised in the state of the art. Thus, in addition to the general concept of novelty, this article introduces, in respect of substances and compounds used in surgical and therapeutic treatment and in diagnostic processes carried out on humans and animals, a **special concept of novelty** unknown in other technical fields (**T 128/82**, OJ 1984, 164).

The new Art. 54(4) EPC, which corresponds to the former Art. 54(5) EPC 1973, was not intended to introduce any fundamental change. Both provisions relate to what is known as a "first medical indication of a per se already known substance or composition" (**G 2/08**, OJ 2010, 456). Either a product for use in a method under Art. 53(c) EPC is new per se and can be the subject-matter of a product claim under Art. 53(c), second sentence, EPC or a product (substance or composition) is already known per se but can nevertheless be patented under Art. 54(4) EPC, provided it has not yet been used in a method under Art. 53(c), first sentence, EPC. The first medical indication of a known substance or composition is generally the object of broad generic claims in the form of **use-related product claims**. In **G 5/83** (OJ 1985, 64) the Enlarged Board observed that the inventor of a "first medical indication" could obtain purpose-limited product protection for a known substance or composition, without having to restrict himself to the substance or composition when in a form technically adapted to a specified therapeutic purpose. The appropriate protection for him was, therefore, in its broadest form, a purpose-limited product claim.

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

7.1.2 Scope of a purpose-related product claim

In **T 128/82** (OJ 1984, 164) the board considered the question of a first medical indication with regard to the breadth of the purpose-related product claim. The examining division had refused the application on the grounds that it failed to fulfil the requirements of Art. 52(4) and 54(5) EPC 1973 (now Art. 53(c) and 54(4) EPC), as the claims were not limited to the specific therapeutic use of the known compounds as first discovered. The board had to consider whether the broad version of the claims was allowable having regard to Art. 54(5) EPC 1973 and, in particular, whether the EPC 1973 offered a basis for a limited statement of therapeutic purpose susceptible of narrow interpretation. In the opinion of the board the EPC 1973 neither prohibited nor required an unlimited statement of purpose. It held that Art. 54(5) EPC 1973 permitted a purpose-limited substance claim stating a general therapeutic purpose and found that where a known compound was for the first time proposed and claimed for use in therapy, the fact that a specific use was

disclosed in the specification did not in itself call for a restriction of the purpose-limited product claim to that use (see also **T 43/82** and **T 36/83**, OJ 1986, 295).

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

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

It is the boards' settled case law that a "kit-of-parts" described the juxtaposition of separate but functionally interacting individual components.

In **T 9/81** (OJ 1983, 372) the board held that combined preparations, the individual components of which represented known therapeutic agents, might be protected in a formulation corresponding to Art. 54(5) EPC 1973 (now Art. 54(4) EPC) even when claimed as a kit-of-parts, providing those components formed a functional unity (true combination through a purpose-directed application. Claim 1 referred to a combined preparation containing an oxazaphosphorin cytostatic agent and the sodium salt of 2-mercapto-ethane-sulphonic acid as therapeutic active ingredients. The first-mentioned component of the product was known, and the second was a known mucolytic agent. According to the documentary prior art available to the board, the two active ingredients had never been used together for a **new joint effect** and were **unknown as a composition**. The active ingredients which were administered preferably at the same time according to the invention did not therefore represent a mere aggregate of known agents, but a new combination with the surprising, valuable property that the severe side-effects to be expected when administering the cytostatic agents were absent as a result of the detoxifying effect of the sodium 2-mercapto-ethane-sulphonate.

7.1.4 Further technical information as compared with the state of the art

In **T 1031/00** claim 1 was directed to the first medical use of (-) amlodipine, namely the treatment of hypertension. However, the prior art document already showed the ability of (-) amlodipine to inhibit calcium ion influx into rat aorta tissue in vitro as indicative of its effectiveness in the treatment of hypertension. It also disclosed that amlodipine was then undergoing phase III clinical trials for the treatment of hypertension. The board found that the description **provided no further evidence or data** showing the actual antihypertensive effect of the (-) isomer of amlodipine in humans or animals than did the prior art. The board concluded that the subject-matter of the patent application was anticipated by the disclosure in that document; in other words, document (3) disclosed the same medical use as the application at issue.

7.2. Second (or further) medical use

7.2.1 Introduction

A substance or composition for which a first medical use is already known may nevertheless be patentable under Art. 54(5) EPC for a second or further use in a method under Art. 53(c) EPC if that use is novel and inventive. According to **G 5/83** (OJ 1985, 64), a further medical use claim is a claim directed to the use of a substance or composition for the manufacture of a medicament for a specified therapeutic application. Such a claim is novel if the therapeutic application, i.e. the therapeutic effect obtained by the claimed use, is novel. The Enlarged Board explained the legal and historical background to the patentability of further medical uses in **G 2/08** (OJ 2010, 456).

Under the EPC 1973 a patent for a further medical application could, pursuant to a line of case law first set out in decision **G 5/83** (OJ 1985, 64), be granted for a claim directed to the use of a substance or composition for the manufacture of a medicament for a specified therapeutic application (**"Swiss-type claim"**). The novelty of the subject-matter of such a claim could be derived not only from the novelty of the substance or of the method of manufacture, but also from the new therapeutic application (**G 5/83**). This "special approach to the derivation of novelty" constituted a narrow exception to the general novelty requirement and was not to be applied in other fields of technology.

Under Art. 54(4) EPC (former Art. 54(5) EPC 1973), known substances or compositions are deemed to be new, provided they are used for the first time in such a medical method ("first use in a medical method"). In the early 1980s, the Enlarged Board was asked to decide whether any further medical use could receive patent protection under the EPC in spite of the wording of Art. 54(5) EPC 1973 (now Art. 54(4) EPC) which seemed to limit patentability to the first medical use. The Enlarged Board extended the notional novelty provided for in former Art. 54(5) EPC 1973 to apply to each further medical use in the so-called "Swiss type claim", i.e. to a claim "directed to the use of a substance or composition for the manufacture of a medicament for a specified new and inventive therapeutic application" (**G 5/83**, OJ 1985, 64; legal advice from the Swiss Federal Intellectual Property Office, OJ 1984, 581).

During the course of the revision of the EPC 2000, former Art. 54(5) EPC 1973 ("first use in a medical method") was renumbered to become Art. 54(4) EPC and a new Art. 54(5) EPC was introduced to provide protection for second medical uses. The new Art. 54(5) EPC eliminates any legal uncertainty on the patentability of further medical uses. It unambiguously permits purpose-related product protection for each further new medical use of a substance or composition already known as a medicine.

Claims to a second medical use would be drafted as product claims relating to a specific second or further medical use (see **T 1599/06**).

In **T 1758/07** the board stated that **G 5/83** only applies to second (and further) medical indications. It followed from this that the legal fiction behind **G 5/83**, namely that the therapeutic treatment according to Art. 52(4) EPC 1973 was a limiting feature, was

applicable only if a therapeutic treatment was indeed a second (or further) medical indication. If, however, the claimed subject-matter related to the first medical indication, **G 5/83** provided no legal basis for additionally claiming the same subject-matter as a second medical indication.

In **T 558/20** the board had to decide on the proper assessment of novelty under Art. 54(5) EPC, in particular when a claim defines a combined surgical and therapeutic method. The board stated that Art. 54(5) EPC did not, as such, define any criteria to be applied for assessing whether a claim drafted according to the wording of the article was novel or not. It held that novelty of the claim over the prior art must be assessed in the usual way, i.e. by comparing the features of the claim, the nature of the substance or composition as well as the use and method steps, with the disclosure of the prior art. The board held that the claim defined a method for treating a patient suffering from a degenerative bone disease comprising two steps, firstly creating a void in an intact bone, and secondly filling the void with bone regenerative material. This was the "specific use in a method" referred to in Art. 54(5) EPC, and this use needed to be compared with the prior art. The surgical step was clearly a part of the therapeutic method. Without it, the bone grafting material could not deploy its therapeutic activity. The method defined in the present claim had to be assessed as a whole. Thus, the surgical method steps could not be ignored when assessing novelty of the claim. Novelty was established in the case in hand.

7.2.2 Restriction to substances and compositions

In **T 1314/05**, the board stated that decision **G 5/83** made it quite clear that its special approach to the derivation of novelty was applicable only to inventions or claims relating to the use of substances or compositions in a method of treatment referred to in Art. 52(4) EPC 1973, where that method did not yet form part of the state of the art. The board decided that **G 5/83** did not imply that the special approach to novelty assessment which was associated with the Swiss-type claim for substances or compositions could be applied to the use of a device to produce an appliance intended for medical purposes. Extension of that special approach to the production of such appliances ran counter to the general legal principle that exceptions are to be construed narrowly. This was confirmed by the fact that the EPC 2000 legislator in Art. 54(5) EPC expressly restricted the exception concerning the second medical use to substances or compositions.

The board in **T 1099/09** found that it followed clearly and directly from the EPC that Art. 54(4) and (5) EPC applied only to products which were substances or compositions and that no other products were patentable under them. The therapeutic effect of a medicinal product usually resulted from at least one substance or composition used in it and generally known as its active ingredient.

For the "Formulation of claims under the EPC 1973", see CLB, 6th edn. 2010, I.C.5.2.2.

7.2.3 Interpretation of the term "substance or composition"

In **T 2003/08** of 31 October 2012 the board allowed a claim directed to a new use of a column for an extracorporeal treatment. The appellant (opponent) argued, relying on

decisions **T 227/91** (OJ 1994, 491), **T 775/97** and **T 138/02**, in which the boards defined the term "medicament", that claim 1 did not fulfil one prerequisite to qualify as a second medical-use claim, namely that a "medicament" was used in the treatment. Indeed the means used in the treatment were a "column", which was not a "medicament", but a "device". In the board's view, it emerged from the whole reasoning of decision **G 5/83** (i) that the Enlarged Board intended to allow the special second medical use-form of protection only for those uses in the medical domain which concerned a "substance" or "composition", (ii) that it was the "substance" or "composition" which achieved the medical effect and (iii) that the terms "substance" or "composition" referred at least to products which were chemical entities or compositions of chemical entities. In the case at issue the medical effect on which the treatment according to claim 1 was based was the removal of immunoglobulin from the plasma of patients suffering from dilated cardiomyopathy. This effect was achieved by the "specific ligand for human immunoglobulin", which was undisputedly a chemical entity. The "column" only served as a carrier for the ligand and was not instrumental in achieving the therapeutic effect. Accordingly, the board held that the means used for the treatment in accordance with claim 1 was to be considered as a "substance" or "composition" within the meaning of decision **G 5/83**.

In **T 1758/15** the patent related to a biocompatible, biodegradable, injectable filler material (e.g. collagen or hyaluronic acid) for use in a specific method. Said use comprised the injection of the filler material into a space between a first tissue of the body and a second tissue, the first tissue being subsequently treated by radiation, whereby the filler within the space reduced the exposure of the second tissue to radiation. The filler "human collagen" was known in the art. In the interpretation of the term "substance or composition" the board referred to **G 5/83** (OJ 1985, 64) and **T 2003/08** which interpreted the term "substance or composition" as being "the active agent or ingredient" of the particular specific medical use. Accordingly, the following must be established: (a) the means by which the therapeutic effect is achieved and (b) whether that which achieves the therapeutic effect is a chemical entity or composition of chemical entities. In the present case, the effect of the use of the filler material was the reduction of radiation-treatment-induced side-effects on sensitive organs. This effect was constantly ascribed to the physical displacement of the sensitive tissue, i.e. to the 3D structure achieved within the body. The accumulated mass of the filler material did not, however, qualify as a chemical entity or composition of chemical entities in the sense of **G 5/83**. Therefore, the filler material was not a substance or composition in the sense of Art. 54(5) EPC and its specific use could not be regarded as a differentiating feature. The undisputedly commercially available collagen was thus novelty-destroying.

In **T 773/10** claim 1 was directed to a new use of a dialysis membrane for the treatment of multiple myeloma. It was undisputed that document D1 disclosed all the structural features of the dialysis membrane. Referring to the "travaux préparatoires" for the EPC 2000 the board had no doubt that decision **G 5/83**, had focused on new uses of compounds or "substances", i.e. products of the pharmaceutical industry generally referred to as "medicaments" or "drugs". However, in order to justify an extension of the ordinary meaning of "substance or composition" to include any product, it would have rather been necessary to prove that the parties to the EPC intended to do so but failed to reflect this in the wording of Article 54(5) EPC. The board came to the conclusion that the scope of

the term "substance or composition" in Art. 54(5) EPC did not extend to all products for a specific use in a method referred to in Art. 53(c) EPC.

The board referred to **T 2003/08** (see above) where a new use of a "column" for an extracorporeal treatment was allowed, although the column as such was not regarded as a "substance or composition", the new use of which could confer novelty according to Art. 54(5) EPC. Rather, the column contained a ligand constituting the "active" ingredient responsible for the "therapeutic effect". In the board's view, the case before it was different. The claimed dialysis membrane did not contain any further substance or composition which might constitute an "active" ingredient within the meaning of decision **T 2003/08**. It followed that for the claimed dialysis membrane the exceptional novelty assessment as set forth in Art. 54(5) EPC did not apply. The application was refused.

In **T 468/20**, the board was also of the view that the case differed from that in **T 2003/08**. The claim was for an "Apheresis column comprising an aptamer according to one of claims 1 to 6 for use in therapy of …" The board assessed whether or not (i) the means used in the treatment of the disease constituted a "substance or composition" i.e. "chemical" substances or compositions and whether (ii) the means achieving the therapeutic effect was a "chemical" substance or composition within the meaning of decision **G 5/83** and **T 2003/08**. The board stated that the therapeutic effect in **T 2003/08** was based on the specific ligand, for which the column merely served as a carrier. The claim in **T 2003/08** clearly related to the use of a substance or composition (the specific ligand for human immunoglobulin) for the manufacture of a medicament (in the form of a column having said ligand coupled thereto) for a specified new and inventive therapeutic application. By contrast, in the case at hand, the apheresis column is clearly a device and neither a substance nor a composition. It is a carrier for the aptamer through which the therapeutic effect is actually achieved.

In **T 2136/15** too, the board took a restrictive view. Here, the board found that an alginate for treating a dilated left ventricle of a heart of a patient suffering cardiomyopathy was not a substance or composition. The appellant had argued that the effect of the invention was a combination of biochemical and physical properties, but the board rejected this, stating that the beneficial effect of the created patterned superstructure is independent of the material from which the space-occupying elements in the pattern are made, as long the space-occupying elements are arranged in the particular therapeutically effective pattern and as long as they are biocompatible, making it a device rather than a substance or composition.

In other decisions, the boards were of a different view.

In **T 2369/10** the independent claim was formulated as a use-related product claim, in particular for a device for use in a method of treatment of the human or animal body by therapy. The main issue to be resolved was whether a second (or further) medical use could confer novelty on a known device. The board held that, having regard to the wording of Art. 54(4) and (5) EPC, the ordinary meaning of those provisions could not be extended so as to include something which was not explicitly provided for. It consequently considered that there was no basis on which to contemplate that novelty might be

conferred on products other than substances and compositions by virtue of the provisions of Art. 54(4) and (5) EPC.

In **T 264/17** the board found that the claimed lubricant for replacing synovial fluid was a substance or composition within the meaning of Art. 54(4) and (5) EPC. The therapeutic effect of the claimed perfluorinated polyethers lay in their acting as a replacement for synovial fluid in diseased joints. In the board's view, this effect was achieved as a result of the claimed lubricant's material properties.

In **T 1252/20** the board decided to depart from the previous case law, which distinguished between substance or composition and device based on the "mode of action" of the claim in question, since it saw no legal basis for it. The previous case law (**T 2003/08**, **T 1758/15**) had taken **G 5/83** as a starting point. However, the mode of action as the relevant criterion for judging whether a material is a "substance or composition" was not derivable from **G 5/83** according to the board. The case underlying **G 5/83** had related to the use of a specific chemical compound, so the definition of "substance or composition" and generally the scope of this expression had not been addressed in the decision in any detail. Furthermore, for the Enlarged Board, the subject-matter deserving protection was the invention that the known substance could be used for new therapies. The use of the mode of action as the decisive criterion was also deemed problematic by the board for several reasons:

First of all, the material defined in the claim and the material acting inside the body may differ in composition or in some other relevant property. However, second medical use claims are generally directed to the administered substance. Since it is this substance which is used in a method excluded under Art. 53(c) EPC, such a claim drafting is entirely in line with Art. 54(4) and (5) EPC.

Secondly, the mechanism of action may not be understood in detail, or original assumptions about the mechanism of action may later turn out to be wrong. Even classical medicaments may trigger a therapeutic physiological reaction without the mechanism for it being fully understood. Nevertheless, this is no hindrance for the application of Art. 54(4) and (5) EPC to such medicaments or to doubt their nature as a "substance or composition".

Thirdly, a material may behave in different ways according to its mode of administration. The board held that it appeared odd to classify the very same material as a "substance or composition" or not depending on extrinsic factors not related to the material itself, but to its way of administration.

Lastly, the result of such a restriction does not achieve the legislative purpose, namely, to provide at least a complementary form of protection for an otherwise recognisably useful invention in a field where, despite its excluded nature, technical development is otherwise highly desirable and beneficial and therefore patent protection should also be available for such development (similarly in **T 1020/03**).

The board noted that distinguishing devices from substances for the purposes of Art. 54(5) EPC was required, and this article should not be used to circumvent the usual assessment

of novelty of devices. The board held that whether a material or an object is a substance or composition in the sense of Art. 53(c) and 54(4) or (5) EPC should be decided, in the first place, on the basis of the claimed material or object as such. If this analysis leads to the conclusion that indeed a substance or composition is present, this requirement of Art. 54(4) or (5) EPC is fulfilled. No additional restrictions relating to its mode of action are derivable from the EPC.

7.2.4 Transitional provisions

In **G 2/08** (OJ 2010, 456), the Enlarged Board considered the consequences of the revised EPC for claims in the Swiss-type format. It decided that, where the subject-matter of a claim is rendered novel only by a new therapeutic use of a medicament, such claim may no longer have the format of a so-called Swiss-type claim as instituted by decision **G 5/83** (OJ 1985, 64). As Art. 54(5) EPC now permits purpose-related product protection for any further specific use of a known medicament in a method of therapy, the loophole existing in the provisions of the EPC 1973 is now closed – when the reason for the law ceases, the law itself ceases. In view of the fact that patents had been granted for claims of this (Swiss) type and many applications seeking such patent protection were still pending, the Enlarged Board considered that a transitional arrangement was necessary to ensure legal certainty and to protect the legitimate expectations of applicants. It therefore set a time limit of three months from publication of its decision in the Official Journal of the EPO for future applications to comply with the new situation. In this respect the relevant date for future applications was ordered to be their date of filing or, if priority had been claimed, their priority date.

G 2/08 is discussed in further detail in this chapter I.C.7.2.6 e) "New dosage regimen".

According to Art. 1, No. 3 of the decision of the Administrative Council of 28 June 2001 under Art. 7 of the Act revising the EPC of 29 November 2000, revised Art. 54(5) EPC is applicable to European patent applications pending at the time of the EPC 2000's entry into force, insofar as a decision on the grant of the patent has not yet been taken (see decision **T 1127/05**, **T 406/06**, **T 1599/06**; see also OJ SE 4/2007).

Article 54(5) EPC was introduced into the Convention as part of the revision of the EPC. Under the transitional provisions for EPC 2000, Art. 54(5) EPC shall apply to pending applications in so far as a decision on grant has not been taken (**T 1599/06** and **T 1127/05**).

In **T 1599/06** the board considered it already necessary to take the new situation under the EPC 2000 into account when examining the claims at issue. Claim 1 was interpreted as a product claim for a second medical use in accordance with Art. 54(5) EPC (see also **T 385/07**, a case involving similar circumstances).

7.2.5 Purpose-limited product claims and Swiss-type claims – scope of protection

In **T 1780/12** the board examined in the context of the issue of double patenting whether the subject-matter of a claim directed to a new medical use of a known compound was the same, irrespective of whether the claim was in the "Swiss-type" format or in the format

according to Art. 54(5) EPC. The decision related to a divisional application with a main claim in the form of a purpose-limited product claim under Art. 54(5) EPC. Claim 1 of the parent application was granted in the "Swiss-type" format. The examining division held that the claims of the parent and the divisional applications were directed towards the same subject-matter "in the sense that both these claims concern the same invention claimed in a different format." It refused the application on the basis that double patenting was prohibited. The board held that there was no double patenting. The decisive issue was whether the claims of the patent granted on the divisional and that granted on the parent had the same subject-matter. The category of a claim and its technical features constitute its subject-matter and determine the protection conferred (see **G 2/88**, OJ 1990, 93). The claims in question were of different categories: Swiss-type claims were purpose-limited process claims (use of X for the manufacture of a medicament for the treatment of Y) and claims formulated in accordance with Art. 54(5) EPC were purpose-limited product claims (X for use in the treatment of Y). As regards the technical features, the board concluded that both sets of claims defined the same compound and the same therapeutic use, but that the Swiss-type claims comprised in addition the feature of manufacturing a medicament whereas the claim in accordance with Art. 54(5) EPC did not. The claimed subject-matter was thus different. This outcome has been followed in decision **T 879/12**. As regards the scope of protection, the board considered that a purpose-limited process claim, such as a Swiss-type claim, also conferred less protection than a purpose-limited product claim, such as a claim in accordance with Art. 54(5) EPC (see also **T 13/14**; for further details with regard to the scope of protection, see chapter II.G. "Prohibition of double patenting").

In **T 1570/09** the set of claims of the main request contained two independent claims, claim 1 in Swiss-type form and claim 4 as a purpose-limited product claim under Art. 54(5) EPC. The claims aimed to seek protection for one and the same medical use of one and the same active drug. The purpose-limited product claim 4 sought protection for the same medical indication of the same substance as the Swiss-type claim 1, and the notional novelty of claim 1 was not derived from the "medicament" itself. The board stated that there was no longer an objective reason for justifying the simultaneous presence of both claims in the set of claims to be proposed for grant. Allowing such a set of claims would cause the contradictory legal situation that the old provisions in Art. 54 EPC 1973 together with Art. 52(4) EPC 1973, and the new provisions in Art. 54 EPC together with Art. 53(c) EPC, would apply simultaneously to one and the same set of claims. Art. 54(5) EPC applied to the case at issue and thus the purpose-limited product claim 4 of the main request was allowable in view of a new medical indication of a known substance. The Swiss-type form was conceived as an exception under the old law (EPC 1973). Therefore, in the board's view, there was no longer any legal reason for allowing Swiss-type claim 1 in the set of claims of the main request. Accordingly, the main request was not allowable.

In **T 1021/11** too, the main request comprised two independent claims for the same medical indication of the same substance, one claim drafted in the Swiss-type format and the other claim following the provisions in Art. 54(5) EPC. The application had been pending when decision **G 2/08** (OJ 2010, 456) was issued and therefore belonged to the category of applications in which the Swiss-type format could, as a general rule, still be

used. As both claim formats were available for the application and claims in both formats were present in the main request, the question arose whether both claim types could be present in a single set of claims. The board concurred with the conclusion reached in **T 1570/09** that decision **G 2/08** did not give applicants an absolute right to draft two independent claims in one single set of claims for one and the same medical indication of one and the same substance, one of those claims being in the Swiss-type format and the other in the format in accordance with Art. 54(5) EPC. However, it appeared to the board that no prohibition of the coexistence of such claims in one claim set could be deduced from **G 2/08** either, as it was silent in this respect. Having carefully examined the reasoning given in decision **T 1570/09**, the board found that several factors prevented it from objecting to the presence of claims in the two formats in one single set of claims in the case before it. Firstly, it noted that a single set of claims could be governed by provisions of the EPC 1973 and the revised EPC at the same time. Secondly, the continued existence of the Swiss-type format, in parallel to the provisions of Art. 54(5) EPC, was a direct consequence of the transitional arrangement provided for by the Enlarged Board in decision **G 2/08**. Thirdly, the board saw no reason to prevent an applicant from choosing both available formats during the interim period and considered it justified to do so in one set of claims. Even though the claims in both formats provided patent protection for the same medical indication, there was a difference in the subject-matter of the claims due to their category, in combination with their technical features (see above **T 1780/12**, **T 879/12**). Thus, by filing two patent applications having the same effective date (two parallel applications or parent/divisional or priority/subsequent application) it was possible for an applicant to obtain patent protection for the same second or further medical indication in both available claim formats. The board therefore did not object to the presence of both formats in a single set of claims, as both formats were applicable to the present application. The board noted that no objections had been raised in similar previous cases (see **T 396/09** and **T 1869/11**), even if the issue had not been discussed in those decisions.

7.2.6 Novelty of the therapeutic application

a) General

The cases decided following decision **G 5/83** throw some light on the categories of novel and inventive therapeutic use for which the manufacture of a known substance or compound may be considered patentable. Manufacture of a known composition has been considered patentable for use in a new therapy where the target group to be treated was different (seronegative pigs instead of seropositive pigs; **T 19/86**, OJ 1989, 25), and in the case of a new therapy with a different technical effect (prevention of tooth decay by means of a known substance, but by removing plaque instead of by reducing the solubility of tooth enamel; **T 290/86**, OJ 1992, 414) or a new therapy with a different mode of administration (subcutaneous instead of intramuscular injection; **T 51/93**, see also **T 1554/11**).

b) New therapeutic application based on the group of subjects to be treated

According to the established case law of the boards of appeal, the use of the same compound in the treatment of the same disease for a particular group of subjects, can

nevertheless constitute a novel therapeutic application, provided that it is carried out on a new group of subjects which is distinguished from the former by its physiological or pathological status (see **T 19/86**, OJ 1989, 24; **T 893/90**, **T 233/96**, **T 1399/04**, **T 734/12**).

In **T 19/86** (OJ 1989, 25) the board had to decide whether the application of a known medicament for the prophylactic treatment of the **same disease** in an **immunologically different** population of animals of the same species could be considered a new therapeutic application from which novelty for the claims could be derived. According to decision **T 19/86** the question of whether a new therapeutic use was in accordance with decision **G 5/83** should not be answered exclusively on the basis of the ailment to be cured but also on the basis of the subject (in the case in question, the new group of pigs) to be treated. A therapeutic application was incomplete if the subject to be treated was not identified; only a disclosure of both the disease **and** the subject to be treated represented a complete technical teaching. The proposal according to the application to protect animals which could not hitherto be protected from the disease in question, by intranasally administering to them a known serum, could not be considered disclosed in the prior art and therefore constituted a novel therapeutic application in accordance with **G 5/83**.

In **T 233/96** the board held that if the use of a compound was known in the treatment or diagnosis of a disease of a particular group of subjects, the treatment or diagnosis of the same disease with the same compound could nevertheless represent a novel therapeutic or diagnostic application, provided that it was carried out on a new group of subjects which was **distinguished** from the former **by its physiological or pathological status** (**T 19/86**, OJ 1989, 25; **T 893/90**). This did not apply, however if the group chosen overlapped with the group previously treated, or the choice of the novel group was arbitrary which meant that no functional relationship existed between the particular physiological or pathological status of this group of subjects (here humans who were unable to exercise adequately) and the therapeutic or pharmacological effect achieved.

In **T 694/16** the board held that if a claim is directed to a known compound or composition for use in a therapeutic method of treatment or prevention of a disease, and the claim specifies that the subject to be treated displays a clearly defined and detectable marker, which is not displayed by all subjects affected by or likely to develop that disease, then the purposive selection of the patients displaying the marker for the specified treatment is a functional feature characterising the claim. When reading the claim in a technically sensible and constructive manner, the skilled person would promptly understand that the purpose of the treatment is to target selectively prodromal patients identified by the CSF markers, rather than other subjects that do not display the markers. This implies that there is a functional relationship between the markers that characterise the patients and the therapeutic effect which is sought. The presence of this functional relationship confirms that the purposive selection of patients is an essential technical feature qualifying the claim. This has to be taken into account when assessing novelty. The situation in **T 3122/19** was different. The board held that the claim did not define a new therapeutic use of a compound based on a new patient group, but merely provided more information about the known therapeutic use in the same patient group. The later characterisation of the SW780 tumours as expressing an FGFR3-BAIAP2L1 fusion polypeptide as disclosed in the patent merely provided more information regarding the underlying genetic make-up

of the tumour, but was of no consequence for the treatment of the tumours, and hence the patient group, with PD173074.

In **T 1991/17** a compound for use in the treatment or prevention of bone metabolic diseases associated with osteopenia by inducing osteogenesis was claimed. The respondent had relied on two aspects that would constitute a new specific use of a known compound in a method of treatment: 1) the term "by inducing osteogenesis" as a technical effect and 2) the sub-group of patients to be treated, distinguished on the basis of this technical effect. The term "by inducing osteogenesis" did not form part of the definition of the disease, but qualified the treatment of the disease. The question arose of whether it was to be considered a mere mechanistic explanation of the treatment, or whether this feature linked the treatment to a physiological effect suitable for establishing novelty. The board considered that the patent in suit provided information on a new mechanism of action of peptide D, one of the claimed compounds. This mechanism of action was closely and inseparably linked to the known activity of peptide D of inhibiting bone resorption. No evidence of complete uncoupling of these two activities had been shown. The claimed use could not be distinguished from the known use of peptide D. The technical effect of inducing osteogenesis was therefore not apt to constitute a new specific use.

In **T 2232/17** the board did not see any evidence that patients suffering from MS and who are "dependent on steroids" differed in their physiological or pathological status from the general group of MS patients, in particular with respect to their suitability for being treated with natalizumab. The patent contained no data on the treatment of MS patients with steroids and/or natalizumab. Moreover, even if the patent were taken as disclosing a sub-group of "steroid dependent" patients, no special therapeutic or pharmacological effect of natalizumab in this sub-group was disclosed in the patent.

In **T 1491/14**, during the course of the oral proceedings before the board, the patent proprietors put forward that the criteria for a patient group rendering a previously known therapeutic method novel are that:

i) The patient group is not disclosed in the relevant prior art.

ii) The patients belonging to the group can be distinguished from those of the prior art by their physiological or pathological status.

iii) There is a functional relationship between their characterising physiological or pathological status and the therapeutic treatment and thus the selection of the patients is not arbitrary.

The opponent did not contest this, and the board agreed that - although the case law of the board of appeal does not seem to provide fixed criteria for a patient group - a patient group fulfilling those three criteria is anyhow suitable to render the claimed subject-matter novel.

In **T 910/21** the board was not convinced by the opponent's argument that in view of the considerations in decisions **T 233/96** and **T 1491/14** (above) the treatment defined in claim

1 lacked novelty, because it did not explicitly define the treatment of a new group of patients. In line with the considerations in **T 836/01** (see section 10) the purpose of the claim at hand distinguishes the treatment defined in claim 1 as granted from the treatment of patients as described in the prior art even without the explicit definition of a new patient group.

In **T 1390/22** the board held that contrary to the opponent's argument, the considerations in **G 2/08** did not imply any limited framework in terms of the type of technical features of a method of treatment by therapy that may characterize a specific use as intended in Art. 54(5) EPC. The opponent's argument regarding such a limited framework also found no support in **T 2056/17**. In **T 2056/17** the deciding board had concluded that a pharmaceutical combination for a defined therapeutic use lacked novelty in view of the known use of that combination for the same therapeutic purpose in the same patients by the same route of administration and with the same dosage regimen. In line with the considerations in **G 2/08** the deciding board in **T 2056/17** had held that the definition of the co-marketing or co-promoting of the individual compositions in the combination was not a technical feature characterizing the defined therapeutic use, because the definition of the co-marketing or co-promoting did not change the clinical situation nor contribute to the therapeutic effect.

In **T 1437/21**, the prior art cited against the patent had been the patentee's own press releases reporting the success of a phase III clinical trial of the drug in the broader patient population. The board considered that in accordance with the precise wording of the press releases, the announced efficacy of treatment with the 25 mg dose of empagliflozin in the study may well have been understood as relating to the patient population having mild, moderate or severe renal impairment as a whole. Therefore, from these press releases the skilled person could not directly and unambiguously derive the information that the treatment was effective in each of the subgroups of patients defined by the mentioned levels of renal impairment.

c) New technical effect

In decision **T 290/86** (OJ 1992, 414) the board considered the claimed invention new. The grounds for its decision were as follows: "When a prior document and a claimed invention are both concerned with a similar treatment of the human body for the same therapeutic purpose, the claimed invention represents a further medical indication as compared to the prior document within the meaning of decision **G 5/83** if it is based upon a different technical effect which is both new and inventive over the disclosure of the prior document". In this case the technical effect considered new was the removal of dental plaque, whereas the prior art only disclosed the depression of enamel solubility in organic acids (see also **T 542/96** and **T 509/04**).

In **T 836/01** the board accepted that claims directed to the use of IL-6 to directly influence tumour growth and differentiation were novel over a prior art disclosure of the use of IL-6 to indirectly treat cancer by activating T cells, finding that a new technical effect resided in the medical indication of the treatment of cancer vs. enhancement of the immune system. Applying the principles of decision **G 5/83** (OJ 1985, 64), the board concluded that the

technical effect relied upon in the claimed invention identified a **new clinical situation**. Since a new clinical situation was inseparable, as an abstract concept, from a patient suffering under it, it had to be concluded that this new clinical situation also identified a new sub-group of subjects being treated (**T 1642/06**).

In **T 2251/14** the board referred to **T 836/01** and stated that a second medical use of a known substance can only be considered novel if the new technical effect leads to a truly new industrial/commercial application arising from the healing of a different clinical situation. It held that in the case in hand, the new technical effect of "enhancing the balance of beneficial and deleterious bacteria in the gastrointestinal tract of an animal having or at risk for inflammatory bowel disease (IBD)" defined a new medical use, since the claimed new technical effect identified a new clinical situation, namely one where it was possible to target the gastrointestinal flora of an animal having or at risk for IBD.

In **T 1955/09**, the board needed to decide whether the use claimed represented a further and different therapeutic use from the disclosure in document (D1). It stated that the conclusion could not be drawn that the technical effect relied upon by the claimed invention, i.e. the antibiotic effect, was a mere explanation of how the compounds inhibited or neutralised toxins. Rather, this effect identified a new clinical situation, namely one in which it could be preferable to target the infection itself, not merely the toxins produced by the bacteria or fungi causing the infection. The board decided that this reasoning was based on the differentiation of a direct and indirect effect on claims relating to second or further medical uses of a known substance (see above **T 836/01** and **T 1642/06**). In view of the foregoing, the board was satisfied that the subject-matter of claim 1 at issue fulfilled the requirements of Art. 54(1) and (3) EPC vis-à-vis the disclosure in document D1.

In **T 1972/14**, the claim in question was a Swiss-type claim directed to the preparation of a certain infant formula so as to continuously reduce the circulating level of IGF-1 in the first few months of the life of an infant and thereby reduce the risk of development of obesity later in life. Reducing the risk of developing obesity later in life represented the therapeutic effect to be achieved, while the continuous reduction of the circulating level of IGF-1 represented the mechanism underlying this effect. A Swiss-type claim can derive novelty from the claimed therapeutic effect, but not from the mechanism underlying it. The prior art used the same formulation and the board held that the effect was thereby disclosed since the prior art in question started from the premise that there was a link between reduced protein content and obesity later in life.

d) Same illness

In **T 108/09** the claims were drafted in the second medical use format according to decision **G 5/83**. The board noted that according to decision **G 2/08** (OJ 2010, 456), Art. 54(5) EPC does not exclude a medicament already known to be used in the treatment of an illness from being patented for use in a different treatment by therapy of the same illness. It considered it appropriate to evaluate whether the breast cancer of claim 1 as granted was identical to the breast cancer according to document D2. The board noted that the tumours of document D2, being only resistant to tamoxifen, could be distinguished from the tumours of claim 1 as granted, which were additionally resistant to an aromatase inhibitor. This

distinction meant that in the case at issue two different diseases or two subsets of a disease (tumour) were concerned. As a consequence, in analogy to the findings in **T 893/90**, the board established novelty. The subject-matter of claim 1 as granted was therefore novel over D2.

e) New dosage regimen

Some boards of appeal have considered recognising specific therapeutic uses as patentable in principle to be problematic where they differ from the prior art merely in terms of the dosage regimen. In **G 2/08** (OJ 2010, 456), the Enlarged Board addressed this issue in detail.

With reference to the case law and the danger of a collision with Art. 52(4) EPC 1973, decision **T 584/97** denied patentability for a claim directed essentially to the administration of nicotine in increasing doses. In **T 317/95**, **T 56/97** and **T 4/98** (OJ 2002, 139) the issue was discussed, with answers tending towards the negative, but ultimately left undecided. In all of these cases, the grant of a patent would anyway have been refused on other grounds – i.e. lack of novelty or inventive step – so that the outcome of a decision on this issue was immaterial (see also **T 1319/04**, OJ 2009, 36)

In **T 1319/04** (OJ 2009, 36), the board referred to the Enlarged Board the question whether medicaments for use in methods of treatment by therapy, where the only novel feature was a dosage regime, are patentable under Art. 53(c) and 54(5) EPC. The Enlarged Board answered in **G 2/08** (OJ 2010, 456) as follows:

1. Art. 54(5) EPC does not exclude a medicament which is already used in the treatment of an illness being patented for use in a different treatment by therapy of the same illness. Art. 53(c) EPC, which lists as an exception to patentability 'methods for treatment of the human body ... by therapy' is clear and unambiguous and draws a borderline between unallowable method claims directed to a therapeutic treatment on the one hand and allowable claims to products for use in such methods on the other. The two concepts of a method of treatment by therapy and of a product to be used in such a method are so close to each other, that there is a considerable risk of confusion between them unless each is confined to its own domain as allocated to it by the law. Art. 53(c), second sentence, EPC, is not therefore to be interpreted narrowly; on the contrary, it is appropriate to give both provisions (Art. 54(5) and Art. 53(c) EPC) the same weight and conclude that, in respect of claims directed to therapy, method claims are absolutely forbidden in order to leave the physician free to act unfettered, whereas product claims are allowable, provided their subject-matter is new and inventive. By virtue of a legal fiction, Art. 54(4) and (5) EPC acknowledge the notional novelty of substances or compositions even when they are already comprised in the state of the art, provided they are claimed for a new use in a method which Art. 53(c) EPC excludes from patent protection. The notional novelty, and thus, non-obviousness, if any, is not derived from the substance or composition as such, but from its intended therapeutic use. Art. 54(5) EPC refers to "any specific use" [emphasis added] and thus, in conjunction with the stated intention of the legislator to maintain the status quo of the protection evolved in the case law of the boards of appeal under **G 5/83**

(OJ 1985, 64) in this respect, this use cannot be ex officio limited to a new indication stricto sensu (approving **T 1020/03**, OJ 2007, 204).

2. The Enlarged Board went on to hold that such patenting is also not excluded where a dosage regime is the only feature claimed which is not comprised in the state of the art. Given the answer to the first question, and, since Art. 54(5) EPC may be used in cases of the treatment of the same illness, the "specific use" in the sense of that provision may reside in something other than the treatment of a different illness, the Enlarged Board held that there is no reason to treat a feature consisting in a new dosage regime of a known medicament differently from the one given to any other specific use acknowledged in the case law. However, it stressed that the whole body of jurisprudence relating to the assessment of novelty and inventive step also applies. The jurisprudence on this continues to apply (see **T 290/86**; OJ 1992, 414; **T 1020/03**, OJ 2007, 204; **T 836/01**; **T 1074/06**).

In **T 1020/03** (OJ 2007, 204) a pure dosage regimen was for the first time recognised as not excluded from patentability. The claims were directed to the use of insulin-like growth factor-I in the preparation of a medicament for administering to a mammal in a specific discontinuous administration pattern. In the Headnote, the board stated that any use to which Art. 52(4) EPC 1973, first sentence, applies in circumstances where the composition has already been suggested for some therapeutic use, allows a second medical use claim to the preparation of the composition for that second medical use, irrespective of in what detail that use was specified, subject to the use being novel and inventive. For the purposes of novelty also under Art. 54(5) EPC this depends on whether use for therapy is novel, irrespective of the detail with which the therapy is stated in the claim.

In **T 1356/21** the concentration feature in the claims at hand defined the composition itself, i.e. the amount of insulin glargine in the composition, and not the use of the composition, i.e. the dose given to a patient at particular times or time intervals. Neither decision **G 2/08** nor its reference to **T 1074/06** (where the claims related to doses, and not concentration) justified reading the word "concentration" of the claims in question as a dosage regimen. The board referred to point 6.3 of **G 2/08** where the Enlarged Board had stated that "the claimed definition of the dosage regime must therefore not only be verbally different from what was described in the state of the art but also reflect a different technical teaching". However, under the same point of the Reasons the Enlarged Board had explained that "for the assessment of novelty and inventive step of a claim in which the only novel feature would be the dosage regimen, the whole body of jurisprudence relating to the assessment of novelty and inventive step generally also applies". In the board's view, this indicated that **G 2/08** did not seek to establish different novelty criteria for numerical ranges in the case of dosage regimen. Thus, the case law in the general situation of numerical ranges, as it has evolved over the years, must apply also in the case of dosage regimen (see also **T 1437/21**, **T 1357/21**).

f) New therapy with a different mode of administration

In **T 51/93** the only difference between the invention as claimed and the disclosure of D(4) was that the claim was directed to an intended method of **subcutaneous administration**.

The board stated that a different mode of administration for a pharmaceutical could render a medical use claim drafted according to decision **G 5/83** novel. Patentability should be treated as depending only on whether this modification was in fact novel and inventive. Thus, it was possible to acknowledge novelty over D(4) (see **T 143/94**, OJ 1996, 430).

g) Statement of purpose of surgical use for a known instrument

In **T 227/91** (OJ 1994, 491) the board held that the purpose of a surgical use alone could not render novel the subject-matter of a claim relating to the use of the components of a known instrument for its manufacture, i.e. assembly. The claim under consideration related to the "use" of intercepting of a laser beam of substrate means and coating means in the manufacture of a laser surgical instrument (the use). The indication of the purpose, i.e. intercepting the laser beam, was a characteristic of the surgical use of the instrument and did not affect the structure or composition of the entity itself. This kind of functional reference could not normally impart novelty to an otherwise known article unless the function implied a necessary modification of the article itself. The surgical use of an instrument was not analogous to a therapeutic use, since the instrument was not consumed in the application and could be used repeatedly for the same or even for other purposes (**T 138/02**, **T 1099/09**).

h) Discovery of a previously unknown property of a compound underlying the known effect

In **T 254/93** (OJ 1998, 285) an application relating to the use of a retinoid compound in association with the use of corticosteroids in the prevention of skin atrophy was refused by the examining division. The board noted that it was a basic consideration in **G 2/88** (OJ 1990, 93) that the recognition or discovery of a previously unknown property of a compound, such property providing a new technical effect, could involve a valuable and inventive contribution to the art. The board stated that it had no difficulty in accepting that the prevention of skin atrophy had to be regarded as a pharmaceutical feature and, following the conclusions of the Enlarged Board, that the effect underlying this feature was not made available to the public in written form by any of the cited literature. Nevertheless, the question arose whether, in the case at issue, this effect was a technical effect within the meaning of decisions **G 2/88** and **G 6/88** (OJ 1990, 114), which was necessary to establish novelty, under Art. 54(1) EPC 1973, of the claimed subject-matter over the prior art. Although it concerned a specific aspect of the known use, the use specified in claim 1 (prevention of skin atrophy) was not actually different from the known use (treatment of dermatoses). The board observed that when a second medical indication was claimed in relation to the use of a constituent in the preparation of a known composition and the final effect was apparent in **using the known composition for the known purpose**, a technical problem could be seen neither in the obtaining of the final effect nor in the preparation of the composition. The only remaining question could be the explanation of the phenomenon underlying the treatment according to the known process. However, the **mere explanation of an effect** obtained when using a compound in a known composition, even if the explanation related to a pharmaceutical effect which was not known to be due to that compound in the known composition, could not confer novelty on a known process if the skilled person was already aware of the occurrence of the desired effect when

applying the known process (see also **T 669/01**, **T 605/09**, improvement of activity in a pet is not a new technical effect in terms of **G 2/88**; **T 433/11**).

Similarly, in **T 486/01** the physiological effects highlighted by the patent proprietor were only regarded as additional items of knowledge about a further mechanism of action underlying the known therapeutic application.

In **T 385/07** claim 1 was drafted in the form of a second/further medical use of aplidine for making a medicament for the treatment of a mammal affected by pancreatic cancer. The relevant issue was whether or not this use related to a novel medical use within the meaning of decision **G 5/83** (OJ 1985, 64). The board found that, following decision **T 158/96**, the information in a citation that a medicament was undergoing a clinical phase evaluation for a specific therapeutic application was not prejudicial to the novelty of a claim directed to the same therapeutic application of the same medicament if the content of said citation did not allow any conclusion to be drawn with regard to the actual existence of a therapeutic effect or any pharmacological effect which directly and unambiguously underlay the claimed therapeutic application. It was true that the present application related to in vivo results in mice, not humans. However, it was an accepted principle of the case law that, for the purpose of patent protection of a medical application of a substance, a pharmacological effect or any other effect such as an effect observed on animal models was considered to provide sufficient evidence of a therapeutic application if, for the skilled person, this observed effect directly and unambiguously reflected such a therapeutic application (see e.g. **T 241/95**, OJ 2001, 103). Applying this principle, the board accepted in the case at issue that, in the absence of any data on human patients, the in vivo experiment was sufficiently predictive of the in vivo anti-tumour activity in humans (see also **T 2118/21**).

7.2.7 Whether there is a therapeutic method

In **T 454/08** the board confirmed that if a claim formulated as a Swiss-type claim was not directed to the use of any therapeutic method or was de facto directed to a non-therapeutic use, the feature defining the use was purely illustrative and could not be used to establish novelty over the prior art. In effect, this specific novelty approach applied only to claims directed to the use of a substance or composition intended for use in a method referred to in Art. 52(4) EPC 1973 (now Art. 53(c) EPC). Claim 1 of the main request was based on the model proposed by **G 5/83**, namely the application of a substance to produce a composition for a particular use. However, nothing in the wording of claim 1 implied use in any of the therapeutic methods within the meaning of Art. 53(c) EPC. The specific novelty approach created by **G 5/83** thus did not apply to claim 1 of the main request, the subject-matter of which amounted to a process claim. The step of administering the tablet had to be seen as an illustrative feature of the tablet and not as a limiting feature for a specific mode of administration.

In **T 1278/12** the board had to decide whether the main claim constituted a second medical use claim (Swiss-type claim). The appellant argued that the reference to "an infant delivered via caesarean section" implicitly indicated a therapeutic effect. The board stated that an enteral administration to an infant delivered via caesarean only specified the mode

of delivery to the patient, but did not relate to any therapeutic effect obtained thereby. The appellant argued that, according to **T 1020/03**, the therapeutic effect did not need to be specified in a claim for it to qualify as a further medical use claim. The board did not share the appellant's view and observed that the board in **T 1020/03** had explicitly stated that the further medical indication had to be specified in the claim with some degree of specificity. Since claim 1 of the main request did not specify any therapeutic effect at all, it represented a non-medical use claim. Therefore, the wording "for enteral administration to an infant delivered via caesarean section" limited claim 1 only in so far as the composition had to be suitable for the enteral administration to caesarean section infants. Since this suitability was given in some documents, these were novelty-destroying for the subject-matter of claim 1.

In **T 182/16** the composition was an "infant formula or growing up milk for toddlers" enriched with sn-2 palmitic acid for improving body composition with regard to lean body mass and muscle mass. The board held that irrespective of the fact that the wording of claim 1 did not actually restrict the group of subjects to whom the composition was to be administered to infants and toddlers, and in line with decision **T 1278/12**, simply referring to infants does not imply a therapeutic use, since feeding an infant is not a therapeutic step within the meaning of Art. 53(c) EPC.

The board in **T 884/23**, where the claim was directed to a milk fortifier for use in prevention of visceral adiposity and/or decreasing the ratio visceral adipose tissue to subcutaneous adipose tissue in a preterm infant human, the board held that decreasing the ratio of visceral adipose tissue to subcutaneous adipose tissue in a preterm infant was not a method of treatment by therapy pursuant to Art. 53(c) EPC. Consequently, it could not establish novelty over prior art disclosing a composition as defined in claim 1 suitable for the same purpose.

8. Second (or further) non-medical use

8.1. Novelty criteria for use claims and process claims containing a purpose feature

8.1.1 General issues decided before the Enlarged Board

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

The Enlarged Board dealt in detail with the novelty of second non-medical uses in **G 2/88** (OJ 1990, 93) and **G 6/88** (OJ 1990, 114). The questions referred to it concerned use claims, i.e. claims defining a "use of compound X for a particular purpose", or similar wording, where the only novel feature was the purpose of that use. They were not about medical inventions but were of a general nature and primarily concerned interpretation of Art. 54(1) and (2) EPC 1973. The patentability of a second non-medical use of a product

had already been recognised in principle in **G 5/83** (OJ 1985, 64), which concerned the second medical use of a substance.

In the non-medical field use claims are admissible and not subject to special conditions.

In **G 2/88** (OJ 1990, 93) and **G 6/88** (OJ 1990, 114), the Enlarged Board had to decide whether a claim for the use of a compound for a particular non-medical purpose was novel under Art. 54 EPC 1973, having regard to a prior publication which disclosed the use of that compound for a different non-medical purpose, so that the only novel feature in the claims was the purpose for which the compound was used. The specific problem in these cases was that the previously disclosed use of the substance, although specifically stated to be for another purpose, would **inherently** comprise the use as claimed in the new application (**T 59/87**, OJ 1988, 347; **T 208/88** of 20 July 1988).

The Enlarged Board cited **T 231/85** (OJ 1989, 74), a case concerning an application for use as a fungicide of a compound already disclosed in the prior art as a growth regulator. The use according to the claimed invention and the use disclosed in the prior art were both carried out in the same way (i.e. the means of realisation was the same, namely the spraying of useful plants). The board had nevertheless concluded that the claimed invention was novel because the technical teaching in the application differed from that in the citation, and that, even if means of realisation was the same, the use was not yet known.

In **G 2/88** and **G 6/88**, therefore, it was pointed out that a claimed invention lacked novelty unless it included **at least one essential technical feature** which distinguished it from the state of the art. A basic initial consideration, when deciding upon the novelty of a claim, was therefore to analyse it in order to determine its technical features. The Enlarged Board took the view that the proper interpretation of a claim whose wording clearly defined a new use of a known compound would normally be such that the attaining of a new technical effect on which the new use was based was a technical feature of the claimed invention. Thus, where the particular technical effect underlying such use was described in the patent, the proper interpretation of that claim would require a **functional feature** to be implicitly contained in the claim as a technical feature – e.g. the compound actually achieved the particular effect.

The Enlarged Board thus concluded that, with respect to a claim to a new use of a known compound, such new use might reflect a newly discovered technical effect described in the patent. The attaining of such a technical effect should then be considered as a **functional technical feature** of the claim (e.g. the achievement in a particular context of that technical effect). Had that technical feature not previously been made available to the public by any of the means set out in Art. 54(2) EPC 1973, then the claimed invention was novel, even though such technical effect might have inherently taken place in the course of carrying out what had previously been made available to the public. The final decisions in cases **T 59/87** (OJ 1991, 561) and **T 208/88** (OJ 1992, 22) both held that the claimed use inventions were novel and inventive.

In **T 1385/15**, the board considered that the legal interpretation in the contested decision was not in line with **G 6/88** itself, which stated, in point 8 of the Reasons, that, for a finding of lack of novelty, all the technical features of the claimed invention had to have been made publicly available together. Summing up, **G 6/88** had held that the functional technical feature conferring novelty could lie in achieving a technical effect in a particular context. Thus, in the case at issue, the functional technical feature was the anti-microbial activity in the context of the claimed mechanical disinfection of articles. This feature was not disclosed in the prior art. A claim directed to a further non-medical use could not be found to lack novelty if the prior art did not disclose the claimed technical effect of the substance and the claimed use in combination.

In **T 1099/16** the board held that in order to decide whether a claim to the use of a known compound for a particular purpose, based on a technical effect which is described in the patent, should be interpreted as including that technical effect as a functional technical feature according to **G 2/88**, it is not a requirement that the technical effect is described in the patent in a manner sufficiently clear and complete to make the actual achievement of that technical effect credible.

8.1.2 Non-therapeutic treatment of animals

In decision **T 582/88** the board applied the principles set out in decision **G 2/88** in slightly different circumstances. The invention's subject-matter was a method of non-therapeutic treatment of animals for the purpose of improving their milk production and comprising oral administration of a propionate-increasing amount of glycopeptide antibiotics. In the board's view the technical effect produced by the invention – in this case an improvement in milk production – was new and had to be construed as a new technical feature sufficient to make the invention novel. The claim's subject-matter was a method of non-therapeutic treatment of animals, not – as in decision **G 2/88** – use of a known product to achieve a new effect (see also **T 848/93**).

a) Non-therapeutic application

In **T 469/94**, the set of claims had been worded as a second non-medical use of a product (choline or a choline derivative) to alleviate muscle fatigue. The examining division had considered that the known treatment with choline of muscle diseases and hardness was equivalent to, or even a synonym for, the treatment for reducing muscle fatigue which was claimed in the application in suit. The board concluded that the ability of choline to reduce the perception of fatigue had not been made available to the public. The first use of choline, in the therapeutic field, was known from two prior art documents. The board held that an independent invention could be based on the newly discovered effect, if such an effect led to a new technical application which was clearly distinguishable from the previous known application. The prior-art documents did indeed describe the use of choline on groups of patients having manifest diseases: either epilepsy or muscle diseases and injuries. The board observed that fatigue arising from major exercise was not of a pathological nature, and that the performance itself of major exercise appeared to be quite incompatible with the situations envisaged in the prior art documents, specifically that of muscle injuries. The non-therapeutic use of choline according to the invention was therefore independent of,

and distinguishable from, the known therapeutic use, because it was **directed to a distinct group of persons**. The subject-matter of the claim at issue was therefore found to be novel.

8.1.3 Applicability of G 2/88 and G 6/88 to process claims

a) General

In several decisions, the boards have taken the view that the criteria set out by the Enlarged Board in **G 2/88** and **G 6/88** (OJ 1990, 93 und OJ 1990, 114) cannot readily be applied to process claims. Particularly in the more recent case law, they have found that those criteria can be applied only to claims directed to the use of a substance for achieving an effect and cannot be extended to claims directed to a process for producing a product characterised by process steps wherein the purpose of carrying out said process steps is indicated in the claim (**T 1049/99**, **T 1343/04**, **T 1179/07**, **T 304/08**, **T 2215/08**, **T 1039/09**, **T 1140/09**). The case law has constantly interpreted **G 2/88** in a restrictive manner, i.e. to mean that only claims relating to the use of a known compound for a particular purpose, based on a technical effect described in the patent, should be interpreted as including that technical effect as a functional technical feature, provided that such technical feature has not previously been made available to the public (**T 1822/12**).

b) Different treatment of use and process claims

In **T 1049/99** the board took the view that the criteria set out in decisions **G 2/88** and **G 6/88** (OJ 1990, 93 and 114) could not simply be transferred to process claims. The board pointed out that, according to those decisions, a new purpose related to a new technical effect could render novel the claimed use of a product already known, even though the means of realisation making it possible to achieve the new purpose was identical to the known means of realisation, given that a use claim in reality defined the use of a particular physical entity to achieve an effect. The board distinguished this situation from that of a process claim which defined the use of a particular physical entity to achieve a product and, therefore, fell within the scope of Art. 64(2) EPC 1973. An extension of the criteria set out in the decisions of the Enlarged Board referred to above would result in protection of a product obtained by a process already known on the basis of the new effect discovered in the process itself, even though that process was identical to that already known (see also **T 910/98**).

In **T 1179/07** the board found that the central findings in **G 2/88** und **G 6/88** concerned a claim to the use of a known compound for a previously unknown purpose. No findings were made in those decisions with respect to process claims for a specific use. Although the "use of a compound" could be regarded as a process including the compound use as a procedural step, a use claim could not normally be treated as equivalent to a process claim because Art. 64(2) EPC was not, as a rule, applicable to use claims. According to the Enlarged Board in **G 2/88**, Art. 64(2) EPC was generally not directed to patents whose claimed subject-matter was the use of a process to achieve an effect (this normally being the subject of a use claim) but rather to European patents whose claimed technical subject-matter was a process of manufacture of a product. Despite the indicated purpose,

the process claimed in this case was clearly aimed at manufacturing a product: a procedural treatment of the source product resulted in an end product differing from the source product. Were the board to extend the findings made in **G 2/88** and **G 6/88** to the granted process claim, this would confer fresh protection under Art. 64(2) EPC on the product resulting from granted process claim 1 even though that product was already known from D1 and obtained by precisely the same process as that described in D1. It could not, however, be in keeping with the object and purpose of Art. 64(2) EPC to extend its protection to a product obtained by a known process. It was, in particular, this difference in the treatment of process and use claims in the context of Art. 64(2) EPC which, in the board's view, left it no scope to extend the principles laid down by the Enlarged Board in **G 2/88** and **G 6/88** with regard to the use of a known compound for a previously unknown purpose to process claims (see also **T 684/02**, **T 910/98** and **T 1049/99**).

In **T 304/08** the board noted that **G 6/88** and **G 2/88** (OJ 1990, 93) contained no finding concerning claims to a method (or process, these two terms being used synonymously in this decision) wherein the purpose of carrying out the method was defined in the claim. However, **G 2/88** stated that there were basically two different types of claim, namely a claim to a physical entity (e.g. product, apparatus) and a claim to a physical activity (e.g. method, process, use) and that the technical features of a claim to an activity were the physical steps which defined such activity. Decision **G 2/88** further distinguished, in the context of defining the extent of protection conferred under Art. 64(2) EPC, between claims which defined the use of a particular physical entity to achieve an "effect" and the use to produce a "product" and concluded that, providing that the use claim in reality defined the use of a substance to achieve an effect and did not define such a use to produce a product, the use claim was not a process claim within the meaning of Art. 64(2) EPC. Thus, the criteria set out by the Enlarged Board in the aforementioned decisions could only be applied to claims directed exclusively to the use of a substance for achieving an effect.

In **T 1092/01** the board held that the rationale of decision **G 2/88** was applicable to a claim directed to a known process by which a previously unknown technical effect (conversion of lutein to its isomeric form zeaxanthin) was achieved. It considered that the relevant question to be answered was whether the skilled person would use the claimed process for a purpose different from that for which the processes in the prior art had been used. In the board's judgment, in view of its starting material and its procedural steps, the claimed process could only serve the same final purpose of production of pigments for food industry. The disclosure of the purpose did not open the way to a new activity and occurred inherently when carrying out the process in the prior art. Hence the board concluded that the statement of such an effect could not confer novelty on the claimed process (see **T 1039/09**). Observing that the board in **T 1092/01** had not given any detailed reasons for the above-mentioned finding (in point 17 of the decision) that the rationale of **G 2/88** could also be applied to a process claim, the board in **T 1179/07** likewise held that stating the purpose in the process claim could not establish novelty.

In **T 1930/14**, claim 1 was directed to a method of producing an antibody. The claim recited active method steps, as well as the effect that "wherein said IgG2 antibody [...] elutes as several separate forms on RP-HPLC and said method [...] alters the relative distribution of

said several separate forms on said RP-HPLC". The board concluded that this feature did not provide for novelty. It held that the second non-medical use claims considered in decisions **G 2/88** and **G 6/88** of the Enlarged Board were directed to the use of a substance for achieving an effect but not to methods/processes/uses for the production of a product. For the former type of claim [use of a substance], attaining of a "newly discovered technical effect" should be considered as a functional technical feature of the claim, whereas for the latter type of claim [methods/processes/uses for the production of a product] it should not. A disclosure in the state of the art of a method for producing a product having the same process steps as the claimed process would anticipate the claimed subject-matter even if that disclosure did not explicitly mention the effect of carrying out said process steps, since the effect would necessarily be achieved by following the steps of the method. It was not relevant in the assessment of novelty whether the prior art recognised that this effect was taking place in the method that they disclosed.

c) Interpretation of process claims

Where a process claim begins with wording such as "method for remelting galvanic layers", the part "for remelting" is not to be understood as meaning that the process is merely suitable for remelting such layers, but rather as a functional feature concerning the remelting of galvanic layers and, hence, defining one of the steps in the claimed process (see **T 848/93** below). Such a case has to be distinguished, however, from those where the claim is directed to a process aimed at a particular purpose and comprises physical steps resulting in the production of a product (i.e. the claim is in fact directed towards the production of a product).

In **T 848/93** the application claimed a process which differed from the prior art only in its use (remelting instead of vapour phase soldering). The board considered the process feature "remelting galvanic layers" to be a functional technical feature which established novelty. If a claim concerned e.g. an apparatus which differed from a known apparatus only as regards the use indicated, then the use was not an apparatus feature. This meant that the two pieces of apparatus were identical in terms of structure. If the known apparatus was suitable for the claimed use, the application lacked novelty. If the claim was directed to an object, a substance or a composition, the same applied. If however the claim was for a process, the situation was not comparable. In such a case, the use feature was a functional process feature comparable in category with the other features (steps) of the process.

See also **T 1399/16**, with further references.

d) Use of a known process for a particular purpose

The board in **T 461/07** observed that it was settled case law that there was no basis for regarding the purpose of carrying out a process as having the effect of a functional technical feature distinguishing the process from others carried out using identical features but for a different purpose (**T 210/93** and **T 1343/04**).

In **T 210/93** the originally claimed process for the production of a rubber product was held not to be novel by the examining division because the claimed temperature range was already disclosed in D1. With reference to **G 2/88** and **G 6/88**, the applicants thereupon claimed the use of this known process for the purpose of preparing the rubber product having a certain maximum ratio of constituent X. They argued that in the absence of a disclosure of this mole ratio in D1, this constituted a "specific technical purpose of achieving the previously unknown chemical structural arrangement". The board observed that decisions **G 2/88** and **G 6/88** related to claims to the use of a known compound for a particular purpose, in contrast to the appellants' claim, which was directed to the use of a known process for a particular purpose, the purpose being the preparation of a particular product naturally resulting from such process. In the board's view, the **use of a process for the purpose of preparing its product(s)** could be said to be nothing but that very same process, and the scope of protection appeared to be the same for a claim to the process as such and a claim to such use (confirmed in **T 684/02** and **T 2215/08**).

In **T 684/02** the board noted that claim 1 was directed to the use of the fluorination reaction process in order to remove the unstable end groups from the starting polymer. The effect of this process manifested itself in its result, i.e. in the product together with all its internal characteristics and the consequences of its particular history of origin (see **T 119/82**; OJ 1984, 217) but not in an effect observed in a particular use of the product. Moreover, in the board's view, a claim to the use of a process or to the process itself addressed the producer of a product, irrespective of any conceivable later applications, methods of further processing or uses of the product, whilst a claim to the use of a product clearly addressed the customer/user of that product. In other words, the asserted advantage or purpose could not be taken into account as a functional technical feature in claim 1 because of the jurisprudence of the boards of appeal as well as for technical reasons, because the asserted advantage or purpose was related only to the product (manufactured in some process or other) when used in certain circumstances and marginal conditions.

In **T 1039/09** the physical steps of the claimed method were the same as in the prior art. However, it was submitted that the purpose of the method, namely producing bovine milk having a reduced level of saturated fatty acids relative to the level of unsaturated fatty acids, was also a technical feature to be taken into account in the assessment of the novelty of claim 1. The board stated that the claim at issue related to a known method for a particular purpose, namely the production of a product, wherein the product is the necessary result of the known method and indistinguishable from the product obtained in the prior art. The question arose whether the purpose could be considered a functional technical feature of a claim directed to a process for producing a product characterised by process steps wherein the purpose of carrying out said process steps was indicated in the claim. In the board's judgment the skilled person would not in the present case use the process for any purpose other than the production of its inevitable product, namely milk containing only beta-casein having a proline at position 67 and therefore also having a reduced level of saturated fatty acids relative to the level of unsaturated fatty acids. The board concluded that the relevant technical features for the purpose of assessment of the novelty of the method of claim 1 were its physical steps and that document (D3), which disclosed these physical steps, anticipated the subject-matter of claim 1 of the main request.

In **T 1822/12** the appellant submitted that the prior art did not disclose the purpose of the method steps, which was defined in claim 1 as "a method for reducing acrylamide formation in thermally processed foods", or the step of "cooking said food to form a cooked food with a reduced concentration of acrylamide". According to the appellant, the above purpose and step were features limiting the scope of claim 1 and distinguishing it from the disclosures in the prior art. With regard to the above purpose, the appellant submitted that the principles established by **G 2/88** and **G 6/88** concerning limiting functional features of a claim should apply equally to the method claim in question. The board, however, stated that **G 2/88** related only to a use claim, namely to a claim for the new use of a known compound. It concluded that claim 1 of the main request relating to the known method of thermally processing foods for the unknown purpose of reducing acrylamide formation could not be construed to include that purpose as a distinguishing functional technical feature.

e) Discovery of new properties/technical effects underlying the known use

In **T 958/90** the board mentioned that a known effect could not be novel for the sole reason that the patent provided the information that it was present to a hitherto unknown extent. The board in **T 1338/18** took the same view. It held that the discovery of the extent of an effect arising during the use of a prior art product and already known to be exerted by that product did not warrant permitting this extent, as compared with that obtained using another product known to have the same effect, to be taken on its own as a basis for a functional technical feature.

In **T 279/93** a claim directed to the use of a first compound in a process for preparing a second compound was revoked by the opposition division for lack of novelty. In particular, the claims were directed to the use of the alkanolamines for reducing the formation of isomelamine impurities. According to the appellant, this purpose, even if it might have been inherently attained by following the teaching of a prior art document, should have rendered the subject-matter of the claims novel, since, in application of the reasoning in decision **G 2/88** (OJ 1990, 93), inherency did not destroy the novelty of the new use, which had to be regarded as a functional technical feature of the claims. In the board's judgment, the use of a compound in a process for preparing another compound in order to reduce the formation of impurities was not necessarily a functional technical feature within the meaning of decision **G 2/88**, and did not therefore in all circumstances confer novelty on the subject-matter of a claim containing it. The facts of the case at issue differed significantly from those underlying decision **G 2/88**, since the claim did not appear to contain any new technical effect or technical purpose in the sense required by that decision. In the board's view, noticing that an old product had the property of containing fewer isomelamine impurities was a mere discovery. To convert this into a patentable invention, and to show the characteristics of a new technical effect, the use referred to in the claim would have to be some **new use of the product** which exploited the discovery that the isomelamine impurities were low for some new technical purpose.

In **T 1855/06**, the board held that novelty of a use of a known compound for the known production of a known product could not be deduced from a new property of that product. In such a case, the use of a compound to produce a product had to be interpreted as a

process for producing the product with the compound and could be regarded as novel only if the production process as such was novel. Similarly, where its stated purpose was merely to improve an already known property of the product to be produced, the use could not be regarded as a new technical activity within the meaning of **G 2/88** and **G 6/88**, unless the claim required that the improvement be exploited in some form. In line with **T 279/93**, the board held that a finding that a known product had a particular property was a mere discovery and could not establish novelty of a use claim.

In **T 892/94** (OJ 2000, 1) the board noted that according to **G 2/88**, novelty within the meaning of Art. 54(1) EPC 1973 could be acknowledged for a claim directed to the use of a known substance for a hitherto unknown, i.e. new, non-medical purpose reflecting a newly discovered technical effect. However, a newly discovered technical effect did not confer novelty on a claim directed to the use of a known substance for a known non-medical purpose if the newly discovered technical effect **already underlay the known use of the known substance**. The disclosure in citation (1) was, in the board's judgment, prejudicial to the novelty of the claim in question. It was immaterial for the purposes of prejudice to novelty that the actual technical effect exhibited by "aromatic esters" in deodorising compositions was not described in the cited document. The ex post facto discovery that the deodorising effect of "aromatic esters" when used as an active ingredient in deodorising products could result from their capability of inhibiting esterase-producing micro-organisms might possibly be regarded as a (potentially surprising) piece of knowledge about the known use or application of such esters but could not confer novelty on a claim, since the latter would require that the newly discovered effect did indeed result in either a new technical application or use of the "aromatic esters", which was not necessarily correlated with the known application or use and could be clearly distinguished therefrom (see also **T 1913/21**). In **T 638/21** the technical effect (non-reprotoxicity) was inherently available to the public in view of the specific use of the solvent in the prior art and could therefore not confer novelty.

In **T 706/95** the board held that the discovery that the **same known means** led to an additional effect when they are used for the **same known purpose** (i.e. known use) of reducing the concentration of nitrogen oxides in the same effluent could not confer novelty on this known use (see also **T 934/04**).

In **T 189/95** the board ruled that a new property of a substance, i.e. a new technical effect, did not necessarily signal or give rise to a new use for that substance. For example, the new property might **merely explain the mechanism behind the use already described in the prior art**, as in **T 892/94** (OJ 2000, 1). Here again the board ruled that discovering a new property or activity did not in itself render novel a claim for the use of a known substance for a known non-medical use, if the discovery only showed what formed the basis of the known use of the known substance.

In **T 151/13** the board stated that the purpose of a particular reagent in a known chemical process is not a functional technical feature in the sense of **G 2/88** and does not render said process novel.

On the issue of the discovery of a previously unknown property of a compound underlying a known use, see further **T 1073/96**, referring to **T 254/93** (OJ 1998, 285). In **T 2090/15** the board cited **T 892/94** and found that the implied recognition in claim 1 that the boron compound contributed to a reduction of corrosion represented nothing more than a newly discovered property or capability underlying the claimed effect or purpose. There was consequently no "new effect" on the basis of which claim 1 could be considered to comprise a functional technical feature distinct from that disclosed in the prior art. By contrast, it was found that there was a new use in e.g. **T 319/98**, **T 952/99**, **T 966/00**, **T 326/02** and **T 1090/02**.

f) Use of a substance to achieve a technical effect only attained in special circumstances

In **T 977/02** the claim in suit was directed not to a device per se but to use of a specific component (an electric machine carcase) to attain a technical effect (to facilitate the recycling of the electric machine). Applying **G 2/88** and **G 6/88** (OJ 1990, 93 and 114), the board held that a claim to the use of a component having a specific property (material that can be crushed into fragments) for a specific purpose (to facilitate the recycling of an electric machine) stated in the said claim and based on a technical effect described in the patent (flow of the material that can be crushed into fragments through the turns of the winding during recycling) should be interpreted as comprising a functional technical feature by virtue of that technical effect. According to the board, this was still valid when, as in the case before it, the technical effect was attained only in special circumstances (when the electric machine was recycled). The board also held that the choice of the specific material for manufacture of the carcase covered by the use defined by the claim in suit constituted a novel selection.

8.1.4 Statement of purpose in non-medical use claims in view of Article 52(4) EPC 1973

In **T 36/83** (OJ 1986, 295) the board stated that having discovered for the first time the surprising properties of a chemical product already known in the state of the art and having shown those properties in various uses, the applicant had the right to have those uses protected. In the particular case the uses were presented in the description as two methods; a method of medical treatment and a method of non-medical treatment. Under Art. 52(4) EPC 1973 a method of medical treatment was not patentable but a product for use in that method certainly was. Claims 1 to 7 had been worded accordingly. The method of non-medical treatment was one falling within the general field of patentable inventions. There could be no objection to the patentability of either use or method claims in general (see **G 5/83**, OJ 1985, 64). The applicants had chosen the phrase **"use as a cosmetic product of thenoyl peroxide"**. The board considered that this form of claim was **acceptable** in the case in suit. The board noted that when considering the exclusions from patentability under Art. 52(4) EPC 1973 the wording of the claim was important. In reaching this conclusion the board held the use of the word "cosmetic" in the context of that application to be sufficiently precise to exclude therapeutic uses, without the need for a specific disclaimer of such uses.

8.1.5 Novelty criteria for product claims with purpose characteristics

It is long-standing office practice that a formulation such as "apparatus for" is to be interpreted as meaning an apparatus which is suitable for the stated use, see for example Guidelines F-IV, 4.13 – April 2025 version; **T 1389/10**). As explained in the Guidelines, as e.g. in the case of a mould for molten steel, the stated use may imply certain physical limitations (size, material) without which the apparatus could not be used for that purpose. Any prior art apparatus which, in addition to features expressly mentioned in the claim also possesses these implicit physical features and can thus reasonably be used for the stated purpose will then take away novelty of the claimed apparatus. This is irrespective of whether or not the prior art mentions the stated use or purpose or whether the stated use is obvious or not. This is because the claim is directed at the apparatus, not its use. Nor can stating a use that is new and not-obvious render an apparatus which is already known novel and inventive.

In **T 215/84** the board held that the discovery that the known equipment might be used in a new manner could not render the entity itself novel.

In **T 523/89** a particular prior art document disclosed a container having all the structural features defined in claim 1 of the contested patent. Hence, the only outstanding issue was the fact that D1 nowhere indicated that the container disclosed therein was intended to be used for ice-cream. The board noted that the question of anticipation of a claim to an article for a particular use was dealt with in the Guidelines (Guidelines F-IV, 4.13 – April 2025 version), from which it was clear that, with the exception of medical uses of known substances, the indication of intended use was only to be seen as **limiting to the extent that the article had to be suitable for that use**. In other words, disclosure of an equivalent article without an indication of the particular use claimed – although the article was nevertheless suitable for it – would cause lack of novelty of a claim to the article for that particular use. The board saw no reason to disagree with this general principle of interpretation laid down in the Guidelines.

In **T 15/91** the board ruled that, according to the case law of the boards of appeal, the discovery that known apparatus could be used in a manner not hitherto described did not substantiate the novelty of that apparatus, if the hitherto unknown use did not require any modification to the technical design of the known apparatus (see **T 523/89**).

In decisions **T 303/90** and **T 401/90** the main claims related to a contraceptive composition comprising known pharmaceutical compounds. The board was of the opinion that the composition as claimed could not be considered novel and the added word "contraceptive" did not change the product claim into a use claim. **Only in the case of first medical use** could the addition of a purpose characteristic render a product claim new, if the product as such was known in other technical fields (see also **T 1200/03**).

In **T 637/92** the board held that, according to established case law, the statement of purpose of a claimed device (or product) was to be interpreted as meaning that the device was **suitable for the stated purpose** and that a known device that served another purpose but otherwise possessed all the features listed in the patent claim was not

prejudicial to the novelty of the subject-matter of the claim if the known device was unsuitable for the purpose referred to in the claim (see also **T 287/86**). In the case in question, however, these conditions had not been met since the device known from the citation did not possess one of the features of claim 1.

In **T 116/14** the board held that a device's suitability for its stated purpose had to arise from the interaction of its claimed features alone. It could not depend on features not claimed, even if they were not excluded because the claim's wording was open-ended − for example because it used expressions such as "comprising" and "containing". Otherwise, the claim would lack clarity. This meant a citation could be considered to disclose a feature worded using an indication of purpose ("purpose feature") only if the interaction of the attributes of the device it described, as identified from the claimed features other than the purpose feature, was already enough on its own to give rise to suitability for the indicated purpose.

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1. Introduction

An invention shall be considered as involving an **inventive step** if, having regard to the **state of the art**, it is not **obvious** to a **person skilled in the art** (Art. 56, first sentence, EPC). The "state of the art" for the purposes of considering inventive step is as defined in Art. 54(2) EPC. It does not include later published European applications referred to in Art. 54(3) EPC. Such earlier applications are part of the state of the art only when considering novelty and not when considering inventive step (see Guidelines G-IV, 5.1 and G-VII, 2 – April 2025 version).

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

T 317/88; **T 385/94**; **T 662/96**; **T 850/02**). Technical progress is relevant – to a limited degree – only if it can be seen as an indication of inventive step (**T 1074/96**).

The extent of the monopoly conferred by a patent should correspond to and be justified by the technical contribution to the art. This general principle of law, applied in **T 409/91** (OJ 1994, 653) and **T 435/91** (OJ 1995, 188) (albeit to determine the scope of protection justified under Art. 83 and Art. 84 EPC 1973), also applies to decisions under Art. 56 EPC 1973, because everything covered by a legally valid claim has to be inventive (see also **T 1060/11**). Otherwise the claim has to be amended, by deleting anything obvious to ensure that the monopoly is justified (**T 939/92**, OJ 1996, 309; **T 930/94**; **T 795/93**; **T 714/97**).

2. Problem-solution approach

2.1. Objective assessment of inventive step

Article 56 EPC gives a negative definition of the "inventive step" required under Art. 52(1) EPC, by setting out that an invention shall be considered as involving an inventive step "if, having regard to the state of the art, it is not obvious to a person skilled in the art". In order to assess inventive step in an objective and predictable manner, the so-called "problem-solution approach" was developed, consisting of the following stages:

(a) determining the "closest prior art",

(b) assessing the technical results (or effects) achieved by the claimed invention when compared with the "closest state of the art" determined,

(c) defining the technical problem to be solved, the object of the invention being to achieve said results; and

(d) considering whether or not the claimed solution, starting from the closest prior art and the objective technical problem, would have been obvious to the skilled person (**G 1/19**, OJ 2021, A77, point 26 of the Reasons; see also **G 2/21**, OJ 2023, A85; **T 939/92**, OJ 1996, 309; **T 15/93**; **T 433/95**; **T 917/96**; **T 631/00**; **T 423/01**; **T 215/04**; **T 1621/06**; **T 1183/06**; **T 824/07**; see also Guidelines G-VII, 5 – April 2025 version).

On application of the problem-solution approach to claims comprising technical and non-technical aspects (especially in the case of computer-implemented inventions), see in this chapter I.D.9.2., and for its application to claims directed to chemical inventions, see in this chapter I.D.9.9.1.

The boards frequently cite R. 42(1)(c) EPC as the basis for the problem-solution approach. R. 42(1)(c) EPC requires that the invention be disclosed in such terms that the technical problem (even if not expressly stated as such) and its solution can be understood. Problem and solution are thus component parts of any technical invention. The problem-solution approach was primarily developed to ensure objective assessment of inventive step and avoid ex post facto analysis of the prior art (see for example **T 2679/19**). As long ago as

T 26/81 (OJ 1982, 211), R. 27(1)(d) EPC 1973 (in the version in force until 31 May 1991; the predecessor of current R. 42(1)(c) EPC) was recognised as clearly binding.

A solution claimed as non-obvious is patentable **only if** it actually has the alleged effect. According to **T 2001/12**, a doubt that the invention as claimed is capable of solving the problem defined in the application may have the following consequences: a) If the claim fails to specify those features which are disclosed in the application as providing the solution to the problem, then an objection under Art. 84 EPC 1973 may properly arise that the claims do not contain all the essential features necessary to specify the invention; b) if this is not the case, but, having regard to the prior art, and irrespective of what may be asserted in the description, it does not appear credible that the invention as claimed would actually be capable of solving the problem, then an objection under Art. 56 EPC 1973 may be raised, possibly requiring a reformulation of the problem. See also **T 862/11** which also dealt with the distinction between the requirements of sufficiency of disclosure (Art. 83 EPC), clarity of the claims (Art. 84 EPC), and inventive step (Art. 56 EPC).

In **T 967/97** the board stated that the problem-solution approach was essentially based on actual knowledge of technical problems and ways to solve them technically that the skilled person would, at the priority date, be expected to possess objectively, i.e. without being aware of the patent application and the invention that it concerned (see also **T 970/00**, **T 172/03**).

According to the board in **T 270/11**, the problem-solution approach does not require that the application specify what feature is responsible for producing precisely what advantage or technical effect. All that is required for inventive step is that the claimed subject-matter is not obvious to the skilled person in the light of the prior art (Art. 56 EPC). It is common practice to take features from dependent claims or the description and insert them into an independent claim with a view to rendering the subject-matter patentable and to cite the effects and advantages associated with those features as a basis for (re-)formulating the technical problem. To determine the objective technical problem, the technical results and effects achieved by the claimed invention as compared with the closest prior art must be assessed.

In **T 2517/11** the board held – with regard to "hidden" features – that the problem-solution approach developed in the boards' case law entailed consideration of all technical features comprised in the closest prior art, regardless of whether they were **directly identifiable or hidden**, since even hidden features were publicly available. For more on this topic see chapter I.D.3.6 "Implicit features".

The board in **T 1761/12** held that the problem-solution approach involved analysing the steps the skilled person would have taken to solve the predefined objective technical problem, and nothing else. Any further reflection on whether the associated changes to the closest prior art identified in this analysis made sense had the effect, in practice, of adding the related aspects of other problems to the objective technical problem initially defined.

In **T 320/15** the board held that the problem-solution approach did not consist of a forum in which the appellant (opponent) could freely develop various attacks based on diverse prior art documents in the hope that one of them would succeed.

Instructive summaries of the case law on the problem-solution approach can be found in a number of decisions; see e.g. **R 9/14**, **T 519/07**, **T 698/10**.

2.2. Departing from the problem-solution approach

Very early in its case law, the boards emphasised the obligation of objectivity when assessing inventive step; it is the objective rather than subjective achievement of the inventor which has to be assessed (see **T 1/80**, OJ 1981, 206; **T 20/81**, OJ 1982, 217; **T 24/81**, OJ 1983, 133; **T 248/85**, OJ 1986, 261). Starting out from the objectively prevailing state of the art, the technical problem is to be determined on the basis of objective criteria and consideration given to whether or not the disclosed solution is obvious to the skilled person. Although the problem-solution approach is not mandatory (see e.g. **R 8/19**), its correct application facilitates the objective assessment of inventive step. The correct use of the problem-solution approach rules out an **ex post facto analysis** which inadmissibly makes use of knowledge of the invention (**T 564/89**, **T 645/92**, **T 795/93**, **T 730/96**, **T 631/00**). In principle, therefore, the problem-solution approach is to be used; however, if exceptionally some other method is adopted, the reasons for departing from this generally approved approach should be stated.

In **T 465/92** (OJ 1996, 32) the board did not take the problem-solution approach when assessing inventive step, and said this was merely one of several possible approaches, each with its advantages and drawbacks. There was no legal basis for prescribing a particular method for the assessment of inventive step under Art. 56 EPC. It took the view that all of the seven relevant citations came equally close to the invention. See also **T 967/97** in the chapter I.D.3.1. "Determination of closest prior art in general".

In **T 188/09** the board noted first that whatever approach was applied as an auxiliary means for the evaluation of inventive step of claimed subject-matter, in a given evidential situation it had to provide the same result, be it either in favour of or against inventive step. Therefore, even if the problem-solution approach was applied, the decision on inventiveness should be the same as if it had not been used. Citing **T 465/92** (OJ 1996, 32), the board observed: "if an invention breaks new ground it may suffice to say that there is no close prior art rather than constructing a problem based on what is tenuously regarded as the closest prior art."

In case **R 5/13** (as well as **R 9/13**, **R 10/13**, **R 11/13**, **R 12/13** and **R 13/13** which were all directed against **T 1760/11** of 16 November 2012), the petitioners argued that they should have been allowed to discuss all the issues of inventive step of any stage of the problem-solution approach in respect of all possible starting points that they wished to rely on, despite the fact that the board had structured the discussion by first establishing which document or documents constituted the most promising starting point. The Enlarged Board in **R 5/13** held that the board had not only followed the sequence for the debate announced in its communication annexed to the summons to oral proceedings, but by doing so it had

also systematically applied the standard method of the problem-solution approach. The examination whether or not the subject-matter of a patent claim involved an inventive step according to the well-established problem-solution approach was a matter of substantive law. That was equally true for the determination of the closest prior art as the first step of the problem-solution approach, whether one document alone or a plurality of documents was taken as the starting point or most promising springboard aiming at the invention.

In **T 68/16** the board stated that, as a rule, a division that does not use the problem-solution approach should indicate its reasons for doing so, if only to dispel the impression that it was acting arbitrarily. Although an opposition division should indeed keep in line with the established jurisprudence (i.e. by following the problem-solution approach), it was not formally binding on the departments of first instance. Only the department whose decision was appealed is bound by the ratio decidendi of the board (Art. 111(2) EPC). The board noted that the Guidelines in the version then applicable, stated at point G-VII, 5, that any "deviation from this approach should be exceptional". Consequently, it held that a division that, in an exceptional situation, chooses not to use the problem-solution approach and does not explain its choice, did not commit a substantial procedural violation. The board noted however that in the case in hand using the problem-solution approach might have prevented the opposition division from presenting a defective reasoning. The Guidelines have since been amended and as of the 2018 version, the cited wording has been removed. The corresponding passage in G-VII, 5 (April 2025 version) reads: "In order to assess inventive step in an objective and predictable manner, the problem-solution approach is applied."

In **T 2679/19** the opponent argued that the problem-solution approach was not the exclusive method for dealing with the consideration of inventive step and that, regardless of the differing features and of the objective problem, the skilled person was always looking for improvements. The board saw no reason to depart from the problem-solution approach in the case in hand, and found if it were assumed that the skilled person was always simply looking for "improvements" and recognised that an easy assembly was desirable (in fact also a problem to be solved), the skilled person would anyway not arrive at the subject-matter of claim 1. The further adaptations which would be required to arrive at the structure in claim 1 were based on purely subjective or hindsight considerations.

3. Closest prior art

3.1. Determination of closest prior art in general

The determination of the closest prior art is the first step in the multi-stage method of the problem-solution approach, whether one document alone or a plurality of documents is taken as the starting point or most promising springboard aiming at the invention (**R 5/13**).

The boards have repeatedly pointed out that the closest prior art for assessing inventive step is normally a prior art document disclosing subject-matter conceived for the same purpose or aiming at the same objective as the claimed invention and having the most relevant technical features in common, i.e. requiring the minimum of structural modifications (see in this chapter I.D.3.4.). A further criterion for the selection of the most

promising starting point is the similarity of the technical problem (see in this chapter I.D.3.5.). In a number of decisions, the boards have explained how to ascertain the closest prior art constituting the easiest route for the skilled person to arrive at the claimed solution or the most promising starting point for an obvious development leading to the claimed invention (see in this chapter I.D.3.7.).

As closest prior art, a "bridgehead" position should be selected, which the skilled person would have realistically taken under the circumstances of the claimed invention. Among these circumstances, aspects such as the designation of the subject-matter of the invention, the formulation of the original problem and the intended use and the effects to be obtained should generally be given more weight than the maximum number of identical technical features (**T 870/96**; see also **T 66/97**, **T 314/15**, **T 553/23**).

There is no requirement in the case law that an embodiment of the state of the art must be exemplified for it to be considered in the assessment of inventive step. There is likewise no requirement that the prior art contains any pointer, suggestion or incentive to select a particular embodiment for further development for this embodiment to qualify as a starting point in the problem-solution approach (**T 1654/22**; see also chapter I.D.4.2.1).

3.2. Approaches to selecting the closest prior art

According to the board in **T 24/81** (OJ 1983, 133), the closest prior art must be assessed from the skilled person's point of view on the day before the filing or priority date valid for the claimed invention (see **T 772/94**; **T 971/95**; see also Guidelines G-VII, 5.1 – April 2025 version).

In **T 1212/01** the board held that the determination of the closest prior art was an **objective and not a subjective exercise**. It was made on the basis of the notional skilled person's objective comparison of the subject-matter, objectives and features of the various items of prior art leading to the identification of one such item as the closest.

In **T 2759/17**, however, the board highlighted two different approaches in the case law with regard to the choice of starting point. In a first approach, it is the deciding body that selects the closest prior art (see e.g. **T 1241/18**, **T 1450/16**, **T 855/15**). In a second approach, the skilled person comes into play as early as when the closest prior-art disclosure is being selected (see also e.g. **T 254/86**, **T 2148/14**).

The board in **T 1450/16** did not agree that, according to the basic problem-solution approach, the person skilled in the art may be entrusted with the task of selecting the closest prior art or a suitable starting point for the assessment of inventive step. This would mean that the same (fictitious) person who assesses the obviousness of a certain claimed subject-matter would have already selected their "favourite" prior art document in order to conduct that assessment, which would further imply that this skilled person could pose the objective problem to themselves. This would, according to the board, be at odds with the aim of the problem-solution approach to provide an objective method of evaluating inventiveness, avoiding as far as possible an inadmissible hindsight analysis. The board, following the conclusions drawn in **T 422/93**, thus expressed the view that the person

skilled in the art within the meaning of Art. 56 EPC entered the stage only when the objective technical problem had been formulated in view of the selected "closest prior art". Only then could the notional skilled person's relevant technical field and its extent be appropriately defined (see chapter I.D.8.1). Therefore, it could not be the "skilled person" who selected the closest prior art in the first step of the problem-solution approach. Rather, this selection was to be made by the relevant deciding body (whose members could not be equated with the skilled person as a notional entity: **T 1462/14**; see also chapter I.D.8.1.1), on the basis of the established criteria, in order to avoid any hindsight analysis.

In **T 154/17** the board confirmed the selection of a starting point served the purpose of assessing inventive step and was thus not selected by the person skilled in the art, but by the body deciding on inventive step, from among the prior-art disclosures that were eligible under Art. 56 EPC. The notional person skilled in the art entered the scenario of the problem-solution approach only after the objective technical problem had been determined. What teaching the skilled person or team seeking to solve the objective technical problem would have derived from the starting point and any supplementary prior-art disclosures, must then be assessed from their point of view before the effective date. In this way, obviousness is assessed without hindsight.

The board in **T 2759/17** observed with regard to the first approach, in which the deciding body selects the closest prior art, that the skilled person and their expectations, prejudices, knowledge and abilities did not play any role in the selection, but came into play later on when the closest teaching had been identified and the problem formulated. It would not be possible under this approach to disregard a technical teaching on the ground that the skilled person would not have considered it to be the most promising – or at least an otherwise realistic – starting point. In the second approach identified by the board, the technical teaching from which the skilled person would have realistically started as the most promising springboard towards the invention therefore needed to be determined (see e.g. **T 254/86**, **T 2148/14**). Under this approach, the skilled person was held to generally look for a disclosure that aimed at a purpose or effect that was the same as or at least similar to the one underlying the patent in question (see e.g. **T 710/97**). Following this approach, it was possible to reject an inventive-step attack on the ground that the skilled person would not have realistically selected the specific disclosure on which the attack in hand relied as a starting point (see e.g. **T 1307/12**, **T 2114/16**).

It was the board's firm conviction in **T 2759/17** that, in line with the established case law, the skilled person was the relevant point of reference right from the start of any inventive-step assessment. Determining whether an invention was inventive involved technical considerations, and those had to be made through the eyes of the skilled person. Excluding the skilled person for part of the inventive-step assessment would lead to artificial and thus technically meaningless results. Under this premise, at least in the field of chemistry, with which the case in hand was concerned, the skilled person normally did not arbitrarily pick any existing prior-art disclosure and only then start to think about the technical field in which it might be applied and what effect it could possibly achieve. The board found that unlike the first approach, the second approach was based on a technically meaningful and thus realistic scenario. More specifically, the skilled person was normally confronted with a certain purpose or effect to be achieved in a certain technical field. With

this in mind, the skilled person would then look for a prior-art disclosure that was in the same technical field and aimed at the same or a similar purpose or effect. This, in the board's view, was what was meant by the "most promising springboard" (see chapter I.D.3.7.2). Applying this second approach thus avoided the drawback of using hindsight when selecting the starting point for assessing inventive step.

Further decisions in which the boards of appeal at least implicitly indicate that the skilled person may select the closest prior art include **T 1841/11**, **T 2057/12**, **T 1248/13**.

See also chapter I.D.8.1.2 "Point at which the skilled person enters the stage"

3.3. Several workable routes to the invention

If the skilled person has a choice of several workable routes, i.e. routes starting from different documents, which might lead to the invention, the rationale of the problem-solution approach requires that the invention be assessed relative to all these possible routes, before an inventive step can be acknowledged (**T 967/97**, Catchword I**;** see also **T 323/03**, **T 21/08, T 1437/09**, **T 308/09**, **T 1742/12, T 1261/14**, **T 1339/14**, **T 259/15**, **T 62/16**, **T 1076/16**, **T 1750/19**, **T 397/20**, **T 2029/21**, **T 1654/22**). This principle stems from the fact that the inventive step requirement under Art. 56 EPC applies to the state of the art as a whole, as defined in Art. 54(2) EPC (see e.g. **T 72/18**, **T 865/21**).

Conversely, if the invention is obvious to the skilled person in respect of at least one of these routes, then an inventive step is lacking (**T 967/97**, Catchword II**;** see also **T 558/00**, **T 308/09**, **T 1437/09**, **T 2418/12**, **T 1570/13**, **T 62/16**, **T 64/16**, **T 2443/18**, **T 2411/18**, **T 1012/19**, **T 1654/22**). In **T 967/97** it was further stated that, if an inventive step was to be denied, the choice of starting point needed no specific justification. In **T 261/19** the board stated that this was because the claimed invention must then, as a general rule, be non-obvious having regard to any prior art (see also **T 696/19**, **T 138/21, T 981/22**).

The board in **T 1742/12** held that a piece of prior art may be so remote from the claimed invention, in terms of intended purpose or otherwise, that it could be argued that the skilled person could not conceivably have modified it so as to arrive at the claimed invention. Such prior art might be referred to as "unsuitable". However, this did not prohibit the consideration of an inventive-step assessment starting from a piece of prior art with a different purpose (see also **T 855/15**, **T 2304/16**, **T 1294/16**, **T 2443/18**, **T 1112/19**). In **T 1733/21** the board stated that while prior art directed to the same technical effect as the invention might seem promising initially, this did not necessarily mean that the prior art should be taken into account. Otherwise, prior art which was silent on the intended effect would never constitute a valid starting point, and that would go against established practice.

If a piece of prior art is **"too remote**" from an invention, it should be possible to show that the invention is not obvious to a skilled person having regard to this piece of prior art (**T 855/15**, **T 2057/12**, **T 2304/16**, **T 154/17**). A generically different document cannot normally be considered as a realistic starting point for the assessment of inventive step (**T 870/96**, **T 1105/92**, **T 464/98**, **T 2383/17**).

In **T 176/89** the board concluded that the closest prior art comprised two documents in combination with each other. It found that, **exceptionally**, the two documents had to be **read in conjunction**; they had the same patentee, largely the same inventors, and clearly related to the same set of tests. As a rule, however, when assessing inventive step, two documents should not be combined if, in the circumstances, their teaching is clearly contradictory (see also **T 487/95**).

The board in **T 2579/11** ruled that there was no justification for disregarding a priority application and choosing a subsequent application as the closest prior art simply because the description in the subsequent application was by and large more detailed.

Public prior use may be used as the closest state of the art (**T 1464/05,** see also **T 1054/18**).

In **T 172/03** the board held that the term "state of the art" in Art. 54 EPC 1973 should be understood as "state of technology", and that "everything" in Art. 54(2) EPC 1973 was to be understood as concerning the information which was relevant to a field of technology. It could hardly be assumed that the EPC envisaged the notional person skilled in the (technological) art would take notice of everything in all fields of human culture and regardless of its informational character.

However, the board in **T 2101/12** considered that the interpretation of Art. 54(2) EPC given in **T 172/03** was incorrect. According to the board in **T 2101/12**, the legislator would have used a different term if such meaning had indeed been intended. It held that the wording of Art. 54(2) EPC was clear and required no interpretation. Art. 54(2) EPC itself contains no limitation according to which a non-technical process, such as the signing of a contract at the notary's office, may not be considered state of the art (see also **T 1049/19**).

In **T 1148/15** the board pointed out that the assumption that the **remaining prior art** was less relevant than the item of prior art identified as the closest may turn out to be wrong, for instance if it could be convincingly shown that the skilled person would have arrived at the claimed subject-matter in an obvious manner when starting from another item of prior art but not when starting from the identified closest prior art. In that situation, or even in case of doubt, the problem-and-solution approach may have to be repeated for any prior art that also qualifies as a suitable starting point**.**

In **T 405/14** the board stated that the notion of "closest prior art", as it had been developed by the case law of the boards of appeal, appeared to encompass two different meanings, depending on the outcome of the objection raised under Art. 56 EPC. On the one hand, when concluding that a claimed invention was inventive, the notion of "closest prior art" seemed to rely on the assumption that there existed a metric defining the distance between items of prior art and the invention, and that an invention which was not obvious from the "closest prior art" would a fortiori not be obvious with regard to all other items of prior art which, by definition, were not so close. The second meaning was often formulated in terms of a requirement for the "closest prior art" to deal with the same problem as the invention. This was intended to avoid hindsight leading to a finding that inventive step was lacking. The board concluded that here there was no requirement that the "closest prior art" be

unique, because the basic rule was that an invention lacked inventive step if it would have been obvious to the skilled person, without hindsight, for any starting point (see also **T 1012/19**).

In **T 97/14** the board held that a reasoned objection of lack of inventive step must establish the state of the art and set out, in a clear and complete manner, which features of the claimed invention were known from the prior art and where those features could be found in the prior art. In other words, a proper feature mapping was required. This was all the more important when the objection relied on non-documentary prior art, because such evidence was more difficult to verify.

In **T 1012/19** the board noted that the established practice in some fields of technology was indeed to cut down a plurality of feasible starting points to a single closest prior art. Nevertheless, this was often an ideal situation and that, in praxis, more documents may actually be considered in the first step of the problem-solution approach. The board subscribed to the view taken in a consistent line of decisions that if the skilled person had a choice of several workable routes, i.e. routes starting from different documents which might lead to the invention, the rationale of the problem-solution approach required that the invention be assessed relative to all these possible routes, before an inventive step could be acknowledged.

In **T 335/20** the board stated that when applying the problem-solution approach in the assessment of inventive step, information that was not disclosed in the prior art was considered in determining the distinguishing features, the resulting technical effect, and the formulation of the objective technical problem to be solved. To what extent the claimed subject-matter differed from the disclosure(s) in the prior art was thus relevant when determining the distinguishing features. The teaching towards the distinguishing features might then come from another prior art document or from the common general knowledge of the skilled person. In the case in hand, D9's lack of disclosure as regards implementation of the proposed PGRN replacement therapy did not therefore disqualify it from being the starting point for the assessment of inventive step.

In **T 1090/21** highlighted that the number of suitable prior-art documents might depend on the breadth of a claim, so that a broad claim might lead to a situation where several documents were equally valid starting points. The same was true in a highly competitive technical field where many closely related prior-art documents had been published. However, the fact that several documents might be proposed as the closest prior art was not incompatible with the problem-solution approach.

The board in **T 1888/21** adhered with the view of the board in **T 405/14**, at least insofar the selection of a single starting point as a matter of principle would not correspond to the real situation encountered by the notional skilled person. On the contrary, an inventor seeking to achieve a given goal would rather find it natural to maximise their chances of success by trying more than one promising and realistic starting point.

3.4. Same purpose or effect

According to established case law (see for example **T 2057/12**, **T 1148/15**, **T 96/20**, **T 2443/18**, **T 335/20**, **T 485/21**, **T 553/23**), a central consideration in selecting the closest prior art is that it must be directed to the same purpose or effect as the invention, otherwise it cannot lead the skilled person in an obvious way to the claimed invention. In **T 14/17** the board held that if this purpose was not explicitly set out or could not be inferred from the claims, the question to be answered was what, in the light of the application or patent as a whole, was to be achieved by the claimed invention.

According to **T 606/89** the closest prior art for the purpose of objectively assessing inventive step is generally that which corresponds to a **similar use** requiring the minimum of structural and functional modifications (see also **T 574/88**, **T 686/91**, **T 834/91**, **T 482/92**, **T 59/96**, **T 650/01**, **T 1747/12**, **T 529/20**).

In **T 273/92** the board confirmed the established case law that a document could not qualify as the closest prior art to an invention **merely because of similarity** in the composition of the products; its suitability for the desired use of the invention also had to be described (see also **T 327/92**). According to **T 506/95** the closest prior art was the art most suitable for the purpose claimed by the invention, not the art superficially showing structural similarities. Ideally, that purpose should already be mentioned in the prior art document as a goal worth achieving (**T 298/93**, **T 859/03**, **T 1666/16**, **T 58/19**). The aim was that the assessment should start from a situation as close as possible to that encountered by the inventor, avoiding ex post facto considerations. The real-world circumstances had to be taken into account. If it was not clear what the closest prior art was, the problem-solution approach should be repeated taking possible alternative starting points (**T 710/97**, **T 903/04**, **T 2123/14**).

In **T 2255/10** the board (with reference to **T 482/92**) stated that in establishing the closest prior art, the question to be asked was, what, in the light of the application as a whole, would be achieved by the invention as claimed. Statements of purpose must be read in conjunction with the claims. Merely inserting such a statement into the description does not entitle an applicant effectively to "veto" any inventive-step objection based on a document which is unrelated to this purpose, if it is not plausible that the invention as claimed would actually achieve the stated purpose.

In **T 53/08** the board, in deciding whether document (1) or document (10) had to be regarded as the closest prior art, considered the patent's objective, which was to develop the highly effective herbicidal ingredient of formula (A1) in such a way that it did not significantly damage crops when used in a concentration with herbicidal effect. The natural starting point for the invention was therefore the document disclosing the active ingredient of formula (A1).

In **T 2571/12** the board held that, in the case of claims directed to medical uses, the closest prior art is usually a document disclosing the same therapeutical indication.

In **T 1076/16** the board considered that a piece of prior art could not be immediately ruled out as a possibly suitable starting point merely because it had a different purpose from the invention or fewer technical features in common with the invention than other, seemingly "closer" prior art. Depending on how the criteria "similar purpose" and "common features" were weighed up against each other, there were often several reasonable starting points, each offering a different route that might lead to the invention without the need for hindsight. The board endorsed the case law developed in a number of decisions (**T 405/14**, **T 2057/12** and **T 1742/12**) that, for a finding of a lack of inventive step, it was enough that the invention was obvious to the skilled person from the prior art in the light of just one of those routes (see also **T 335/20**).

In **T 1148/15** the board held, in response to a misunderstanding of the case law by the appellant, that if the closest prior art also had to disclose the purpose or effect of the distinguishing feature(s), it would mean that only items of prior art which contained a teaching towards the distinguishing feature(s) would qualify as the closest prior art. This was not required by the problem-and-solution approach because the teaching towards the distinguishing feature(s) may come from another item of prior art or from the skilled person's common general knowledge. In other words, the closest prior art does not have to disclose all the problems solved by the claimed invention. In particular, it does not have to disclose the objective technical problem, which is determined only in the next step of the problem-and-solution approach.

In **T 513/19** the board was of the opinion that when assessing the suitability of a document as the closest prior art, the criterion of having the same purpose also included that the patent and the closest prior art should deal with the same product. In the case in hand D1 and the patent shared the same purpose of providing a cappuccino beverage, whereas D4 related to a chocolate beverage and was not cited by the appellant to be combined with D1. In view of the similarity of the purpose and the objective when comparing the patent and D1, D1 was a suitable starting point in the discussion of inventive step.

In **T 1188/20** the appellant had selected D2 as the closest prior art essentially because it required the minimum of structural modifications to arrive at the subject-matter of claim 1. The board held this approach would be allowable if D2 were a realistic starting point for a further development in the field of insulating materials. However, D2 had no connection whatsoever to the technological field of the opposed patent and was thus not considered to be a reasonable starting point.

3.5. Similarity of the technical problem

A document serving as the starting point for evaluating the inventive merits of an invention should relate to the same or a similar technical problem or, at least, to the same or a closely related technical field as the patent in suit (**T 495/91**, **T 570/91**, **T 989/93**, **T 1203/97**, **T 263/99**, **T 1634/06**).

In **T 439/92** the board pointed out that one of the criteria for determining the closest prior art was the problem already stated in the patent. In many cases it was reasonable for there

to be a link between this problem and the prior art chosen as being closest. See also in this chapter I.D.4.2.2 "Problem formulated in the patent application as starting point".

In **T 698/10** the board held that the closest prior art did not have to disclose all the problems solved by the claimed invention. In particular it did not have to disclose the objective technical problem, which was only determined in the second step of the problem-solution approach based on the technical effect(s) provided by those features distinguishing the invention as claimed from the closest prior art. See also **T 638/16**, **T 1148/15**, **T 1112/19**.

In **T 325/93** the board stated that the problem addressed by the application was neither derivable nor indeed recognisable from the disclosure of D2 which, according to the department of first instance and the appellant, represented the closest prior art. As early as **T 686/91**, another board had observed that a document not mentioning a technical problem which was at least related to that derivable from the patent specification did not normally qualify as the closest prior art for inventive step purposes, however many technical features it may have in common with the subject-matter of the patent concerned (see also **T 410/93**, **T 708/96**, **T 59/96**, **T 827/00**, **T 979/00**, **T 496/02**, **T 1666/16**).

In **T 644/97** the board concluded that a technical problem arising from a "closest prior art" disclosure which was irrelevant to the claimed subject-matter (in the sense that it did not mention a problem that was at least related to that derivable from the patent specification) had a form such that its solution could practically never be obvious, because any attempt by the skilled person to establish a chain of considerations leading in an obvious way to the claimed subject-matter was bound to fail (see also **T 792/97** and **T 599/03**). However, according to the board in **T 1408/09**, it is not a requirement for obviousness that the starting point in the prior art addresses the same technical problem as the claimed invention.

In **T 835/00** D1 did not mention any of the problem aspects addressed by the claimed invention. As a consequence, a technical problem was created which was unrelated to the actual disclosure of D1 but whose solution was then found to be obvious in the light of the disclosure of D2. The board referred to **T 686/91** and stated that it was a fatal defect that a prior art disclosure from which no relevant technical problem could be formulated without inappropriate hindsight had been chosen as a starting point for the application of the problem-solution approach, because without such hindsight any attempt to establish a logical chain of considerations which might lead to the claimed invention inevitably ran into difficulties at the start, for want of a relevant identifiable goal or object. If the relevant problem was not derivable from the alleged closest prior art, the measures for its solution were a fortiori not derivable. In other words, the invention was not obvious in the light of such art. See also **T 548/03**, **T 1898/07**, **T 638/16**.

In **T 25/13** D4 related to tumble dryers and so came under domestic appliances, a field neither the same nor even closely related to that of the invention, namely automotive technology. For that simple reason, it could not be "the closest prior art". The board, however, held that opponents were essentially free to choose the starting point for assessment and that their choice then had implications for the technical knowledge of the relevant skilled person.

3.6. Implicit features

For consideration of implicit features with regard to Novelty, see chapter I.C.4.3 "Taking implicit features into account".

In **T 2517/11** the board held that the fact that a technical feature of a known method was "hidden" – i.e. implicit in a prior art document and not identifiable on a mere reading of that document – and could be detected only by way of a mathematical analysis did not mean that it could not be taken into account as a disclosed feature. If an analysis revealed such a "hidden" feature, that showed it was publicly available; whether there had been any objective reason to carry out the analysis was irrelevant (with reference to **G 1/92**, OJ 1993, 277). This followed from the objective nature of the problem-solution approach developed in the boards' case law, which entailed consideration of all technical features comprised in the closest prior art, regardless of whether they were **directly identifiable or hidden**, since even hidden features were publicly available.

In **T 1779/19** the board, with reference to **T 12/81**, OJ 1992, 296; **T 666/89**, OJ 1993, 594; and in particular **T 270/97**, stated that the key requirement of an implicit disclosure was inevitability. To implicitly anticipate a given product (from a chemical reaction), the prior art document must disclose a reaction carried out under specific conditions which would inevitably lead to the product in question. The board did not contest in the case in hand that ferrous sulphate was oxidised to ferric sulphate in the presence of air. There was however no basis to conclude how far this reaction would go in D5, which did not disclose a reaction but a solution of ferrous sulphate, and there was no information in D5 how this solution was made and how long and under which conditions it should be stored. The presence of ferric sulphate was thus highly likely or even certain, but there was no way to conclude that this presence would go beyond trace levels.

In **T 1501/19** the board decided that a particular hypothetical embodiment (a procedure not described) referred to by the opponent was not directly and clearly apparent from the teaching of citation D1, so it could not be taken as a starting point for the assessment of inventive step or for the formulation of the objective technical problem at issue.

In **T 674/21** the board held that the fact that D17 might not explicitly disclose or distinguish between tinting systems for interior or exterior use, nor mention the use of non-infrared-absorptive pigments in that context, did not disqualify it as a suitable closest prior art document. Similarly to the claimed subject-matter, D17 disclosed in-store paint tinting systems and the possibility of interior and exterior application was implicit in the use of decorative paint tinting systems mentioned in D17. The relevant field of application in D17 was thus closely related to the claimed subject-matter, and there was no reason to dismiss it as a suitable starting point.

3.7. Most promising starting point

3.7.1 General

The boards have consistently held that, where more than one document is cited as the closest prior art, the one which must be deemed the closest is that which provides the skilled person with the most promising springboard to the invention, i.e. the one starting from which the subject-matter of the invention is rendered most obvious (**T 656/90**, **T 824/05**, **T 1755/07**, **T 698/10**, **T 1940/16**). If the claimed subject-matter is deemed non-obvious even starting from one or, as the case may be, several such "promising" starting points, it may be expected that the claimed subject-matter also involves an inventive step when the assessment is based on more remote starting points (**T 816/16**, **T 154/17**). There may be reasons why certain prior art never constitutes a promising starting point for a development leading to the claimed invention – for example when its teaching is incompatible with the invention, deviates from the invention or presents insurmountable difficulties. But citing the number of common features is not always enough (**T 865/21**).

In **T 698/10** the board held that the expression "closest prior art" did not mean that it must be sufficiently close to the claimed invention on an absolute basis, but only that it must be relatively closer to the claimed invention than the other prior-art disclosures, i.e. it was selected as the most promising starting point - or the most promising springboard towards the invention.

In **T 694/15** the board was of the opinion that the terminology "closest prior art" was somewhat misleading and that it was perhaps preferable to use the terminology "starting point (in the prior art)". It could be economical to start from prior art that is in some sense close to the invention, in the hope that the consideration of this single starting point would be enough to establish whether the claimed subject-matter would have been obvious. However, if this failed, before arriving at the conclusion that the subject-matter would not have been obvious, it was necessary to consider other possible starting points. The board considered that what was decisive for establishing obviousness was not the closeness of the starting point but the overall likelihood of the path, given the starting point.

However, when assessing inventive step, care must be taken to avoid an ex-post-facto approach. A skilled person endeavouring to arrive at a simple construction is unlikely to begin by using prior art relating to an exceptional embodiment with a complex mechanism, and then to omit this mechanism from the invention (**T 871/94**). In **T 2114/16** the board found that an inventive-step objection based on selecting a clearly disadvantageous starting point from prior art document E22 would necessarily be contaminated by hindsight, since this choice could only be motivated by the previous knowledge of the claimed invention. Following the problem-solution approach, the skilled person would start from the teachings of the exemplary embodiments of E22 (see also **T 626/22**).

In **T 1599/14** the board considered that there was nothing to prevent the appellant (opponent) from choosing as a starting point for its argument a piece of prior art or an embodiment that was less promising than other disclosures or embodiments which, on the face of it, were closer to the claimed subject-matter. See also **T 405/14** in which the board

concluded that every objection of lack of inventive step had to be assessed on its own merits and that a document selected as starting point could not be excluded only because some seemingly more promising item of prior art was available.

In **T 1841/11** the board stated that even if prior art relating to the same purpose was available, it was not excluded that a document relating to a similar purpose might be considered to represent a better – or at least an equally plausible – choice of closest prior art, provided that it would be immediately apparent to the skilled person that what was disclosed in the document could be adapted to the purpose of the claimed invention in a straightforward manner, using no more than common general knowledge. See also **T 1160/12**, **T 1518/17**.

In **T 816/16** the board held that the question of whether a particular disclosure was closer or further removed in relation to the subject-matter claimed was irrelevant. Starting the assessment of inventive step from the "closest prior art" served the purpose of avoiding the need to consider a multitude of potential starting points as it could be assumed that wherever a particular claimed subject-matter involved an inventive step having regard to this "closest prior art", it would all the more involve an inventive step when the assessment was based on a disclosure which was not the "closest" prior art. Likewise, in **T 1459/20**, on the basis that the inventive-step objections based on the closest prior art had been unsuccessful, the board held that the discussion regarding documents that were further removed could only lead to the same result.

In **T 1518/17** the board held that where two documents were both suitable to serve as the closest prior art, it was necessary that an inventive step be demonstrated with respect to each. A finding of obviousness in respect of one document would necessarily lead to the conclusion that the requirements of Art. 56 EPC were not met even if the same exercise on the basis of the other document would lead to a different conclusion. See also **T 23/17**.

In **T 787/17** the board held there was **no need for special justification**, e.g. on the basis of the skilled person's considerations. In particular, whether such an element gave any indication as to how to solve the objective technical problem was irrelevant to its selection as a starting point, for the simple reason that the objective technical problem could only be defined on the basis of the starting point. Nor was there any need to justify why the skilled person would proceed from one particular embodiment among a large number of embodiments in a pre-published document. Each of the embodiments constituted an element of the prior art that was known per se to the (notional) skilled person and could therefore equally serve as a starting point (see also **T 2147/21**).

In **T 2562/17** the board found that the **"notorious" prior art** was so commonly known in the art that no written evidence was required to establish it. See also chapter IV.B.4.1.3a) "Notoriously well-known technical features".

3.7.2 Most promising springboard

The concept of "the most promising springboard towards the invention" is to be found in the case law to describe the objectively closest prior art as early as decision **T 254/86** (OJ 1989, 115); see also **T 282/90**, **T 70/95**, **T 644/97**, **T 1939/12**, **T 369/12**, **T 1888/21**.

In **T 824/05** the board was faced with the situation of two alternative starting points equally suitable for the assessment of inventive step, whereby one starting point, i.e. D11, lead to the conclusion that the claimed subject-matter was obvious and the other starting point, i.e. D1, gave the opposite result. The board held that in this situation D1 did not qualify as the closest state of the art because it did not represent the most promising springboard towards the invention.

In **T 1742/12** the board held that if a piece of prior art could be identified as the "closest" prior art or the "most promising springboard" and it could be shown that, starting from this prior art, the claimed invention was non-obvious, then the claimed invention could only be even less obvious starting from any other piece of prior art, and therefore a detailed inventive-step assessment starting from the other prior art could be dispensed with. However, the choice of the closest prior art may not always be unambiguous and, in such a case, the problem-solution approach may have to be repeated starting from other pieces of prior art (see **T 710/97**).

In **T 64/16** the board expressed the view the problem-and-solution approach did not require a selection of the "most promising" springboard to the exclusion of any other document. In practice, it makes sense to limit this investigation to prior-art items that are at least "promising" in that potentially a realistic path exists from the prior-art item towards the invention. In many cases, only one "closest" prior-art item needs to be considered because all other available documents are objectively further removed from the invention (see also **T 570/91**, **T 1742/12**).

In **T 1571/19** the board found the most promising springboard to be "too short" to take into account D3 starting from D5. The skilled person starting from D5 would barely have considered the teaching of D3 and even if they had, they would not have endeavoured to test the utility of this composition for the claimed therapeutic uses.

In **T 207/20** the board held that the closest prior art was intended to represent any background art which might realistically be developed into something falling within the scope of protection – in the case in hand a comparative example. It did not need to be particularly preferred or advantageous but merely one which was **not unrealistic from a technical point of view**, i.e. one which is not far removed from the technical context of the invention.

3.8. Further criteria for determining the closest prior art

3.8.1 Defective disclosure

In **T 211/01** the board stated that, apart from the fact that a skilled person would normally not consider an obviously defective disclosure at all, it would in particular be artificial to select a defective disclosure as a starting point for evaluating inventive step when there existed other prior art which was not doubted with regard to its disclosure, but was also directed to the same purpose or effect as the patent in suit. A document which is so obviously defective as to be readily recognised as such by those skilled in the art when trying to reproduce its disclosure cannot be taken as the most promising and appropriate starting point for the assessment of inventive step. The board highlighted that according to the case law of the boards of appeal, the starting point for the assessment of inventive step should be one which is at least "promising" in the sense that there was some probability of a skilled person arriving at the claimed invention (see also **T 228/23**).

3.8.2 Confidential disclosure in the application

In **T 211/06** the examining division used as a starting point for the assessment of inventive step background art indicated in the application, which according to the applicant comprised confidential information. The board stated that prior art meant publicly available art at the priority date, and not some internal prior art known only within the company employing the inventors. A disclosure in the application as filed which turns out not to be prior art under Art. 54(2) EPC 1973 cannot be used as a starting point for assessing inventive step, nor can subjective "laboratory practice" put forward by the examining division without any objective evidence that this was knowledge available to the public be used as a starting point for assessing inventive step.

3.8.3 Speculative character

In **T 1764/09** the board noted that D1 was no more than a speculative review of what might be potentially feasible in the future. No concrete realisation of a fully adapted lens for a contact or intraocular lens was described in D1. Therefore, for this reason alone, D1, the document selected by the examining division, could not objectively be considered as a realistic starting point or the most promising springboard towards the claimed invention.

In **T 184/10** the board noted that the author of document (14) gave an outlook into future trends, which were of course not yet verified by experimental evidence. In view of the fact that this outlook was based on the data available at the time, the skilled person would not dismiss it as pure speculation. Instead, they would regard it as a serious attempt to interpret the existing state of the art. As a consequence, the content of document (14) qualified as closest prior art.

In **T 725/11** the invention was directed to a pharmaceutical co-formulation in the form of a tablet comprising two active ingredients for HIV therapy. The board did not acknowledge an inventive step over an announcement by the patentee of a clinical trial of that combination therapy in an industry journal article. The patentee argued that this journal

article was not the closest prior art because it was silent on efficacy and did not provide any technical details. The board disagreed and stated that the journal article amounted to a concrete plan to develop a commercially viable product with a usable level of efficacy. Furthermore, the article was a public statement of intent made by the patentee's CEO and its executive vice president of research and development which would not be dismissed by the skilled person as mere speculation.

3.8.4 Old prior art documents

In principle, any document that is state of the art under Art. 54(2) EPC may be a candidate for the closest prior art, without time restriction. The case law acknowledges, however, that in some cases a document may not be a realistic starting point because it either relates to outdated technology, and/or is associated with such well-known disadvantages that the skilled person would not even consider trying to improve on it.

In **T 69/94** the board pointed out that Art. 54(2) EPC 1973 defined the state of the art as comprising everything made available to the public, clearly without any time restriction. Thus a document which related to an antiquated technology no longer used in industry comprising a teaching disapproved by those skilled in the art at the filing date of the patent in suit could not simply be disregarded as the closest prior art only because of its publication date about 20 years before the filing date of the application documents. In **T 1408/04** the board held, however, that a document's age as such was not a ground for excluding it as closest prior art and as a starting point for the assessment of inventive step (see also **T 153/97**).

In **T 334/92** the board held that a document that had been disregarded for more than 20 years by those skilled in the art, had never been used during that period as a basis for further development, was moreover completely silent about the extent of the indicated activity and, finally, did not even mention, let alone discuss, the relevant state of the art, did not represent the closest state of the art and could not therefore be used to define a realistic technical problem. However, in **T 964/92**, filed as a divisional application to **T 334/92**, the board held that the same document could be considered as a realistic starting point for the determination of the relevant technical problem.

In **T 1000/92** the board did not agree to the selection of document (1) as the closest state of the art because the disadvantages of the process it described, which had been published about 30 years before the priority date of the application, were so evident and well known that a skilled person would not have tried to improve and develop such an old process (see also **T 616/93**).

In **T 479/00** the board did not regard a 65-year-old document as a realistic starting point for the evaluation of inventive step. It was unrealistic to assume that, without hindsight, somebody of average skill in the art of colouring ceramic articles in 1994 would have had the intention to improve a technique which had not received any attention during the previous 65 years. Furthermore, the teaching of this document, published in 1929, had never been put into practice on a commercial scale.

In **T 113/00** the board said that resurrecting very old teaching (in the case in hand 31 years old) with an obvious modification did not make known subject-matter inventive. In **T 1397/07** the board added that there was no legal basis in the EPC to preclude a particular state of the art from being taken into account when assessing inventive step, merely because of being published some years earlier than another one.

3.8.5 Improvement of a production process for a known product

Where the invention concerns improving a process to manufacture a known chemical compound, then the closest prior art is confined to documents describing that compound and its manufacture. Comparison with these alone shows whether an improvement has been achieved which can thus be taken into account in formulating the problem the invention sought to solve (**T 641/89**, **T 961/96**, **T 713/97**, **T 948/01**, **T 833/02**, **T 339/03**). In the case of inventions concerning a special process for use with a particular chemical substance having necessarily specific characteristics, determining the closest prior art must involve, above all, considering only those documents which describe a generically corresponding process for using precisely this particular chemical substance with its specific characteristics (**T 1285/01**, **T 354/03**, **T 1652/08**). This accurately and objectively reflects the actual situation in which the skilled person finds themselves on the priority date of the contested patent (**T 793/97**).

In **T 325/97** the board saw no reason why the above considerations regarding the closest prior art should not also apply to production processes for subject-matter other than a chemical compound and in the case in hand identified the problem to be solved as providing an improved method for the manufacture of a patch for the controlled transdermal delivery of nicotine. In **T 373/94** the board also applied the principles and conclusions laid down in **T 641/89** where the invention related to the improvement of a manufacturing process for prefilled plastic syringes.

In **T 2210/19** the board defined the problem as the provision of a further process for producing a chromium catalysed ethylene copolymer powder. It explained that the skilled person, looking for a further process, would consider variations of the process already known from the closest prior art, taking into account the common general knowledge in the field and the knowledge made available in the prior art. This included variations of any of the parameters of the process that could be expected to be suitable to carry out alternative processes without exercising any inventive activity. As the problem was simply the provision of a further process, no further motivation was needed by the skilled person to perform the modified process.

The board in **T 442/22** found that the above case law, in particular **T 641/89** and **T 713/97** relied on by the appellant, was not applicable where the invention did not concern the manufacture of a known chemical compound, but the manufacture of a composition.

3.9. Consequences of choosing a certain starting point

In **T 570/91** the board emphasised that although a person skilled in the art was completely free in choosing a starting point, they would of course be bound afterwards by that choice.

If, for instance, the skilled person preferred and decided to start from a specific compressor piston, they could further develop that piston but at the end of that development the normal result would still be a compressor piston and not an internal combustion engine piston. In **T 439/92** it was explained that a conscious choice of starting point, made in the knowledge of the respective benefits and drawbacks of the various types concerned, not only determined the subject-matter serving as a starting point but also defined the framework for further development, i.e. a further development within this particular type. A change of type during the further development of the consciously chosen type, to another type, which was previously known but had not been chosen, could then only be seen as the result of an ex-post-facto analysis (see also **T 1040/93**, **T 35/95**, **T 739/95**, **T 255/03**). It is unlikely, and normally not obvious, for the invention type originally chosen to be changed during development (**T 817/94**, **T 749/11**, **T 535/10**).

Following **T 439/92**, the board stated in **T 1228/08** that, although D1 disclosed the use of hierarchical coding, which was a major aspect of the invention, this document did not represent a realistic starting point for an attack on inventive step. A conscious choice of a starting point not only determines the subject-matter serving as a starting point but also defines the framework for further development. Thus, using D1 as a starting point would mean that any further development would be carried out in the context of multicasting: it was unrealistic to suggest that, starting from this disclosure, the skilled person would go outside this framework – indeed take a technical step back – to develop a non-multicasting system.

In **T 487/95** the board chose a military protective helmet as the closest prior art, pointing out, however, that this did not mean that documents describing protective helmets of a different kind (such as workers' safety helmets) could not form part of the knowledge of a person skilled in the art. The information contained in the patent which related to a known military protective helmet (D9) represented the **primary** source of information, i.e. the most promising point of departure, from which the skilled person would attempt to arrive at the claimed subject-matter. The other documents could, however, represent important **secondary** sources of information (in this case: workers' safety helmets) from which the skilled practitioner could obtain indications and suggestions with regard to the problem addressed (see also **T 149/00**).

The invention in **T 25/13** related to a device for fastening an actuator and a housing, for use in a motor vehicle. D4, the only document cited by the opponent, which bore the burden of proof for lack of inventive step, described a fastening device for a tumble dryer. The board explained that opponents were essentially free to choose the starting point for assessment, but their choice then had implications for the technical knowledge of the relevant skilled person.

4. The technical problem

Following the selection of the closest prior art and the assessment of the technical effects achieved by the claimed invention in comparison with the closest prior art, the next step of the problem-solution approach is to define the objective technical problem (see in this chapter I.D.4.1 and I.D.4.2).

The "subjective" technical problem as originally presented by the applicant (R. 42(1)(c) EPC) might require reformulation on the basis of objectively more relevant elements originally not taken into account by the applicant or patentee, or where the combination of features in the claim do not solve this problem over the whole area defined in the claim. This reformulation then defines the "objective" technical problem. Reformulation might lead to the objective technical problem being less ambitious than originally envisaged by the application. See in this chapter I.D.4.4.

See also the Guidelines G-VII, 5.2 – April 2025 version.

4.1. Determination of the objective technical problem in general

4.1.1 Objective criteria

According to the problem-solution approach, **objective criteria** must be used to determine the technical problem (see e.g. **T 1/80**, OJ 1981, 206; **T 24/81**, OJ 1983, 133; **T 39/93**, OJ 1997, 134), i.e. the problem which can be seen to have been actually solved in the light of the closest prior art which may be different from the prior art which was at the disposal of the inventor (**T 576/95**, **T 420/14**, **T 1148/15**, **T 1491/20**). This requires the assessment of the technical effect vis-à-vis the closest state of the art (**T 148/05**, **T 1422/12**, **T 141/16**).

A comparison of the problem indicated in the application with that indicated in a prior document must avoid an unduly abstract approach far removed from the practical thinking of the person skilled in the art (**T 5/81**, OJ 1982, 249; **T 150/89**; **T 417/94**; **T 177/98**; **T 263/99**; **T 1093/04**).

The definition of artificial and technically unrealistic problems is to be avoided (see **T 495/91**, **T 741/91**, **T 334/92**, **T 708/96**, **T 257/98**, **T 1967/08**, **T 98/16**).

For the purpose of the problem-solution approach, the problem must be a technical one that a skilled person in the particular technical field might be asked to solve at the priority date (see e.g. **G 1/19**, OJ 2021, A77; **T 385/89**; **T 641/00**, OJ 2003, 352; **T 154/04**, OJ 2008, 46). That did not mean however that the notional skilled person under Art. 56 EPC was expected to formulate their own technical problem which the same person had subsequently to solve (**T 2622/19**). In identifying the problem it is not permissible to draw on knowledge acquired only after the date of filing or priority (**T 268/89**, OJ 1994, 50; **T 365/89**). However, see in this chapter I.D.4.3.3 "Post-published evidence and reliance on a purported technical effect for inventive step ("plausibility")".

4.1.2 Technical effect encompassed by the technical teaching of the application documents and actually provided/achieved

In **G 2/21** (OJ 2023, A85), the Enlarged Board dealt with the question to what extent a technical effect relied upon by the applicant/proprietor needed to be reflected in the application as originally filed and whether post-published evidence could be taken into account to establish that the problem formulated based on this effect was credibly solved.

The Enlarged Board determined that the relevant standard for the reliance on a purported technical effect when assessing whether or not the claimed subject-matter involved an inventive step concerned the question of what the skilled person, having the common general knowledge in mind, and based on the application as originally filed, would **derive said effect as being encompassed by the technical teaching** and embodied by the same originally disclosed invention. The technical effect relied upon, even at a later stage, needed to be encompassed by that technical teaching and to embody the same invention (point 93 of the Reasons and Headnote II).

The Enlarged Board affirmed that the technical problem must be derived from effects directly and causally related to the technical features of the claimed invention. An effect cannot be validly used in the formulation of the technical problem if the effect requires additional information not at the disposal of the skilled person even after taking into account the content of the application in question (**G 2/21**, OJ 2023, A85, points 25 of the Reasons; see also e.g. **T 1045/21**).

At the same time the EBA confirmed that evidence submitted by a patent applicant or proprietor to prove a technical effect relied upon for acknowledgement of inventive step of the claimed subject-matter may not be disregarded solely on the ground that such evidence, on which the effect rests, had not been public before the filing date of the patent in suit and was filed after that date (**G 2/21**, OJ 2023, A85, Headnote I).

Post-published evidence is considered further in chapter I.D.4.3.3.

a) Decisions before G 2/21

In reaching its decision on "Reliance on a purported technical effect for inventive step (plausibility)" the Enlarged Board referred to a selection of more recent decisions as examples for different approaches taken by the boards with regard to the acceptance of a patent applicant's or proprietor's reliance on an asserted technical effect (point 64 of the Reasons), which the development of the earlier case law appeared to culminate in. The Enlarged Board found that while these decisions used the terminological notion of "plausibility", the cited decisions appeared to show that the particular board of appeal focussed on the question whether or not the technical effect relied upon by the patent applicant or proprietor was **derivable for the person skilled in the art from the technical teaching of the application documents** (**G 2/21**, OJ 2023, A85, point 72 of the Reasons).

In **T 1639/07** the board held that the objective technical problem must be derived from physical, chemical etc. effects directly and causally related to the technical features of the claimed invention (see also **T 584/10**, **T 2297/10**, **T 1199/16**, **T 1341/16**, **T 2622/19**, **T 2217/19**). The board in **T 2622/19** stated that otherwise the notional skilled person could virtually pose their own "objective problem". This could lead to an inadmissible hindsight bias whereby the "person skilled in the art" within the meaning of Art. 56 EPC could then confront themselves with their "subjective" technical problem to be solved (see also chapter I.D.6 "Ex post facto analysis").

In **T 377/14** the board, referring to **T 344/89**, held that the problem did not have to be explicitly disclosed in the application as filed; it sufficed if it was foreshadowed therein (see also **T 478/17**)

In **T 31/18** the board held that the technical effect or problem being solved by the claimed subject-matter must either be explicitly mentioned in the application as filed **or at least be derivable therefrom**, but **not necessarily originally supported by experimental evidence**. It could indeed not be expected from a patent applicant to include an extensive amount of experimental evidence corresponding to all technical features which could possibly be claimed in the application as filed and which could possibly constitute a future distinguishing feature over the closest prior art, since said closest prior art and its technical disclosure may not be known to the applicant at the filing date of the application.

In the context of reliance on post-published evidence, a number of decisions had also already considered whether an alleged effect could be derived from the application as filed. In **T 861/08** the board found that post-published evidence could only be used to support information that was already derivable from the original application (see also e.g. **T 1329/04**, **T 716/08**). For the jurisprudence concerning post-published evidence see also chapter I.D.4.3.3 "Post-published evidence and reliance on a purported technical effect for inventive step ("plausibility")".

b) Decisions following G 2/21

In **T 116/18** of 28 July 2023 the board held that when deciding whether a purported technical effect may be relied upon for inventive step, it was the requirement(s) defined by the Enlarged Board in Order no. 2 of **G 2/21** that had to be applied, rather than simply using any rationale developed in the previous plausibility case law. Interpreting the legal principles stated in **G 2/21**, it concluded that Order no. 2 set out two separate requirements that must both be met to rely on a technical effect: (i) that the effect was "encompassed by the technical teaching" and (ii) that it was "embodied by the same originally disclosed invention" (see also **T 1989/19**). For requirement (i) to be met, the board found the "purported technical effect together with the claimed subject-matter need only be conceptually comprised by the broadest technical teaching of the application as filed". Requirement (ii) would be met "unless the skilled person, having the common general knowledge on the filing date in mind, and based on the application as filed, would have legitimate reason to doubt that the purported technical effect can be achieved with the claimed subject-matter." The board concluded that for requirement (ii) to be satisfied, experimental proof of the purported technical effect or a positive verbal statement was not necessarily required in the application as filed.

The board in **T 314/20** pointed out that although the board in **T 116/18** of 28 July 2023 had stated that it was the new requirements defined by the Enlarged Board in **G 2/21** that were to be applied rather than any rationale developed in the previous plausibility case law, in its interpretation of requirement (ii) of point 2 of the Order the same board had effectively adopted what it had defined in the referral as the "ab initio implausibility" standard. Nowhere in **G 2/21** did the Enlarged Board state that requirement (ii) was met unless the person skilled in the art would have had legitimate reasons to doubt that the purported

technical effect would have been achieved on the filing date. The present board highlighted a second inference in **T 116/18**, that a positive verbal statement of the technical effect relied upon by the patent applicant or proprietor in the patent application as originally filed was not necessary for requirements (i) and (ii) of point 2 of the Order of **G 2/21** to be met. However, such a statement was also not to be found in **G 2/21**. In relation to the reasoning provided in **T 116/18** for this latter inference, the current board considered that it was not possible to infer from the verb "derive" in point 2 of the Order of **G 2/21** any specific meaning for the terms "embodied" or "encompassed". It was also not immediately clear to the present board how it could be concluded that for requirement (i) in point 2 of the Order to be met the purported technical effect together with the claimed subject-matter need only be "conceptually encompassed" by the broadest technical teaching and that this in turn meant that "said effect need not be literally disclosed in it by way of a positive verbal statement". The present board considered that the passages of **G 2/21** referred to by **T 116/18** thus did not lead to the conclusion that the standard of disclosure that applied to Art. 87 EPC (concept of "same invention"), Art. 123(2) EPC or Art. 54(1) EPC was excluded when applying the requirements of point 2 of the Order of **G 2/21**. It considered that the purpose of the two requirements set out in point 2 of the Order of **G 2/21** was to prevent patents from being granted for inventions that were not complete at the filing date (speculative applications).

The board refused the respondent's request for a referral to the Enlarged Board , in which it sought clarification of the terms referred to in point 2 of the Order of decision **G 2/21** and claimed there was there was divergence in the case law. The board found the Enlarged Board had deliberately chosen not to define the aforementioned requirements and it was thus uncertain whether the Enlarged Board would introduce further definitions if asked for additional guidance. Further, the board found that there was no apparent divergent lines of case law and believed that any tenable interpretation of the requirements introduced in decision **G 2/21** would have led to the conclusion it reached in the case in hand.

In **T 1203/19** the subject of dispute between the parties was whether the technical effect associated with the distinguishing features specified in claim 13 (oncolytic adenovirus) was derivable from the application as filed. The board found the technical problem to be solved starting from document (6) was the provision of an oncolytic adenovirus with improved antitumour efficacy. As was shown in post-published document (21), an adenovirus with the features of claim 13 (VCN-01) showed improved antitumour activity compared to the adenovirus described in document (6). Hence, the problem was solved by the oncolytic adenovirus of claim 13.

In **T 2465/19** the board noted with reference to Headnote II of **G 2/21** that the technical effect of an invention over the closest prior art need not be explicitly stated in the application, as long as it was **derivable from the original application**, in particular since the closest prior art may not have been known to the applicant when drafting it (see also from the earlier jurisprudence: **T 861/08**, **T 716/08** amongst others).

In **T 681/21** the formulation of the technical effect differed from that identified in the patent. the board concluded the alleged synergistic effect would not have been considered by the

skilled person as being encompassed by the technical teaching of the application as filed and had to be disregarded.

In **T 1446/21** the board found that a skilled person would not infer that the allegedly improved foaming characteristics were encompassed by the technical teaching and embodied by the same originally disclosed invention. Thus, the respondent could not rely on improved foaming characteristics in the present case, which in any event were merely an unfounded allegation not supported by any evidence.

In **T 1602/21** the board observed that the condition stated by **G 2/21** that "the skilled person ... based on the application as originally filed, would **derive** said effect as being encompassed by the technical teaching" (board's emphasis) was not equivalent to the "gold standard" disclosure required normally for Art. 123(2) EPC. It was sufficient that the skilled person was satisfied that the advantageous technical effect was indeed achieved by the claimed solution, on the basis of the teaching of the application, and once the technical effect had been brought to its attention, possibly from another source as the application. It was not required that the technical effect relied on was also disclosed so explicitly and clearly that the skilled person would recognise it only on the basis of the application and without knowing the later evidence.

In **T 1698/21** the respondent defined the problem as the provision of an alternative synergistic combination having an improved activity or potency on the integrase enzyme. The board considered that this alleged technical effect was based on data relating to the use of dolutegravir as monotherapy whereas the invention disclosed in the original application and claimed in the granted patent related to a combination of compounds. Thus, this effect was not relevant to the double combination claimed. Moreover, it was not encompassed by the teaching of the application as filed in the sense of **G 2/21**. Thus the improved potency on the integrase enzyme could not be taken into account in the definition of the technical problem.

Many of the decisions that deal with the issue of reliance on a purported technical effect when assessing whether or not the claimed subject-matter involves an inventive step also deal with the question of whether the technical problem was credibly/actually solved and what role post-published evidence may play therein. As such the majority of the case law regarding reliance on a technical effect for inventive step is presented in chapter I.D.4.3.3 "Post-published evidence and reliance on a purported technical effect for inventive step ("plausibility")".

4.1.3 Whole scope of the claim

It is a general principle that the question whether a feature contributes to the technical character of the claimed subject-matter is to be assessed in view of the whole scope of the claim (**G 1/19**, OJ 2019, A50, point 82 of the Reasons). When defining the objective technical problem, an effect cannot be retained if it is not credible that the promised result is attainable throughout the entire range covered by a claim (**T 626/90**; **T 583/93**, OJ 1996, 496; **T 25/99**; **T 71/09**; **T 824/07**; **T 447/10**; **T 1837/13**, **T 340/13**). In **T 939/92** (OJ 1996, 309) the board concluded that a technical effect which justified the selection of

the claimed compounds in the case in hand must be one which could be fairly assumed to be produced by substantially all the selected compounds (see also **T 489/14** of 22 February 2019, OJ 2019, A86; **T 41/16**, **T 1764/16**, **T 23/22**).

In **T 161/18** the claimed method was distinguished from the prior art only by an artificial neural network; however, the training of this network was not disclosed in detail. The board was not convinced that the asserted effect was achieved by the claimed method across the whole scope of the claim. This effect therefore could not be taken into account as an improvement over the prior art when assessing inventive step.

In **T 1841/11** the board held that a problem which is not mentioned in the application in relation to the claimed feature, and which would not arise over the whole ambit of the claim, or even for those embodiments described in detail in the application, cannot be considered to be a suitable choice.

In **T 943/13** the board came to the conclusion that the causal relationship between the substance or composition on the one hand and the therapeutic effect achieved on the other hand was decisive for the assessment of inventive step of further-medical-use claims. This causal relationship constitutes the claim's contribution over the prior art. Accordingly, the inventive step of such a claim hinges on the question as to whether this causal relationship, and not just the substance or composition as defined in the claim, is obvious. Hence, in the case in hand the board considered that the objective technical problem was the provision of the claimed therapeutic effect by a different means.

In **T 814/20** the board held that the claimed method for the re-identification of objects captured by image cameras would not "work" under **all imaginable circumstances**. It was probably safe to say that no computer vision method did. However, the skilled person would understand, from the present claims and the description, the kind of situations and its parameters for which the method was designed. The method credibly worked over that range of situations. In the board's judgment, this was sufficient to satisfy the requirement that a technical effect be present over substantially the whole scope of the claims

In **T 629/22** the board noted the findings of the Enlarged Board in **G 1/03** (OJ 2004, 413) that where there were a large number of conceivable alternatives and the specification contained sufficient information on the relevant criteria for finding appropriate alternatives over the claimed range with reasonable effort, the inclusion of non-working embodiments was of no harm. Applying this principle to the case in hand the board found that the allegedly non-working embodiment related to a rather peculiar case combining the lowest foreseen wt.% waxy potato starch and the highest foreseen 35 wt.% sunflower oil. The skilled person would have realised that these conditions were extreme and would find in the patent the teaching that compositions having the desired properties could be obtained by increasing the amount of potato protein and/or decreasing the amount of the oil. Therefore, the presence of a single non-working embodiment was of no harm.

4.2. Formulation of the objective technical problem

The objective technical problem determines the angle of vision that the skilled person will adopt when considering the remaining prior art in the third step of the problem-and-solution approach. For a fair and objective assessment of inventive step, it is therefore important that the objective technical problem is formulated neither too narrowly nor too broadly. In most cases, the objective technical problem can be formulated as how to achieve the technical effect. It is usually a problem the skilled person is familiar with because it relates to known drawbacks of the prior art in the technical field of the invention (**T 1148/15**).

The technical problem may be formulated using an aim which is to be achieved in a **non-technical field**, and which is thus not part of the technical contribution provided by the invention to the prior art (see e.g. **G 1/19**, OJ 2021, A77; **T 641/00**, OJ 2003, 352; **T 154/04**, OJ 2008, 46). See also in this chapter I.D.9.1. "Assessment of inventive step in the case of mixed-type inventions".

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

It must be examined whether the problem defined by reference to the closest prior art has indeed been solved the claimed invention. If not, the problem must be reformulated. See also in this chapter I.D.4.4 "Reformulation of the technical problem". It rests with the patent applicant or proprietor to properly demonstrate that the purported advantages of the claimed invention have successfully been achieved (**G 2/21**, point 26 of the Reasons; see also **T 1045/21**).

See also Guidelines G-VII, 5.2 – April 2025 version.

4.2.1 No pointer to the solution

According to the established case law, the technical problem addressed by an invention has to be formulated in such a way that it does not contain pointers to the solution or partially anticipate the solution, since including part of a solution offered by an invention in the statement of the problem necessarily results in an ex post facto view being taken of inventive step when the state of the art was assessed in terms of that problem (see e.g. **T 229/85**, OJ 1987, 237; **T 99/85**, OJ 1987, 413; **T 289/91**, OJ 1994, 649; **T 986/96**; **T 799/02**; **T 2461/11**; **T 1252/14**; **T 1230/15**; **T 2690/16**, **T 686/18**, **T 3016/18**).

In **T 800/91** the board emphasised that the formulated problem should be one which the skilled person knowing only the prior art would wish to solve. It should not be tendentiously formulated in a way that unfairly directed development towards the claimed solution. The board in **T 605/20** did not recognise any divergence, as alleged by the appellant-opponent, between the considerations in **T 800/91** and the more recent decision in **T 1087/15** in which it was considered that knowledge of the claimed invention was indispensable in

order to formulate the objective technical problem irrespective of the choice of the starting point in the prior art (see also I.D.6 "Ex post facto analysis").

In **T 1019/99** the board stated that the correct procedure for formulating the problem was to choose a problem based on the technical effect of exactly those features distinguishing the claim from the prior art that was as specific as possible without containing elements or pointers to the solution (cited as established case law in e.g., **T 698/10**, **T 826/10**, **T 143/12**; see also **T 1557/07**, **T 97/13**, **T 1230/15**, **T 67/16**, **T 1861/16**).

In **T 910/90** the board stated that the technical task of an invention must be formulated in such a way that it does not contain any solution ideas; when assessing the objective problem, the closest prior art and any technical progress achieved by the characterising features of the invention had to be taken into account. In so doing, it was not important whether the objective problem had already been mentioned in the closest prior art; what mattered was what the skilled person objectively recognised as the problem when comparing the closest prior art with the invention. See also **T 214/01**.

4.2.2 Problem formulated in the patent application as starting point

According to the established case law, an objective definition of the problem to be solved by the invention should normally start from the problem described in the application/contested patent. Only if examination shows that the problem disclosed was not solved or if inappropriate prior art was used to define the problem, is it necessary to investigate which other problem objectively exists (see e.g. **T 495/91**, **T 881/92**, **T 419/93**, **T 606/99**, **T 728/01**, **T 1708/06**, **T 1146/07**, **T 1060/11**, **T 204/16**, **T 1001/18**). In **T 400/98**, the technical problem set out in the patent had to be reformulated because it had **not been credibly solved**.

In **T 2341/13** the invention related to the hardware implementation of an interleaver. The examining division had considered it problematic that the application suggested that the invention could be used in a communication system based on a standard that was neither publicly available at the priority date nor fully disclosed in the application. The board observed that knowledge of any communication standard was not necessary to carry out the claimed invention and that it was perfectly valid to pose the problem of obtaining interleavers for frame sizes that were not a multiple of 2**(m). The board found that whether the application sufficiently disclosed the advantages of such frame sizes was irrelevant, unless it was argued that the mere idea of using such frame sizes was itself inventive (in which case it could not be included in the problem formulation).

In **T 1861/17** the board conceded that some decisions had taken the problem set out in the patent ("subjective problem") as their starting point for defining the objective technical problem (see e.g. **T 246/91**, **T 495/91**, **T 606/99**) but considered that this "objective problem" should normally be formulated only once the closest prior art had been identified. It was only on the basis of the features distinguishing the claimed invention from the closest prior art that the objective technical problem could actually be established in accordance with the established problem-solution approach (see e.g. **R 9/14**).

In **T 1099/16** the board stated that the extent to which a new technical effect underlying the claimed new purpose must be "described in the patent" for the exercise of construing the wording of a claim did not involve considerations of whether the technical effect was sufficiently credibly or plausibly described in the patent, but merely whether it had been described in the sense that a skilled person could recognise what technical effect was underlying the new purpose claimed. The decision whether a technical feature of a claim could be considered to be described in the patent therefore remained to be decided on the facts of the individual case.

In **T 1001/18** the board stated that since the problem-solution approach defines the problem based on the effect of the differences from the closest prior art, and the effect is derived primarily from the disclosure of the invention, the effect documented in the present application documents alone was taken as the basis for the problem formulation, Any further, undocumented effects would be speculative and should not be additionally included in the problem formulation.

In **T 605/20** the board found that the undesired phenomena observed in the patent with the use of the compositions comprising mannitol or glycerol of document D3 would not inevitably manifest themselves upon the practical implementation of the teaching of document D3. It held that the recognition of the relevance of these phenomena should therefore be considered to form part of the technical contribution described in the patent. A specific reference in the formulation of the objective technical problem to the avoidance of these phenomena would risk to unfairly direct development towards the claimed solution, which was not permissible, as it would introduce aspects of hindsight in the assessment of obviousness of the solution (see in particular **T 800/91**)

In **T 547/21** the deemed objective technical problem was to provide a process that led to a further increase in the solids content in milk or whey on the basis of common general knowledge. The board found that the appellant's argument that recirculating the UF permeate to the RO step was not disclosed in D2, and that the skilled person would thus not have contemplated returning the UF permeate to the RO in the system since doing so would have deprived the prior-art processes of one of their purposes, was an attempt to replace the objective technical problem with the one allegedly aimed at in the closest prior art. The objective technical problem is the problem solved by the distinguishing feature of the claimed invention over the closest prior art, not a problem allegedly aimed at in that closest prior art.

4.2.3 Formulation of partial problems – lack of unity

In **T 314/99** the three different embodiments which were covered by claim 1 did not belong to the same single general inventive concept (Art. 82 EPC 1973). According to **G 1/91** (OJ 1992, 253) lack of unity is not an issue in opposition (or opposition appeal) proceedings. In the case in point the board stated that the consequence of this conceptual lack of unity was that different aspects of the problem applied to the three embodiments and that where conceptual non-unity arises between different embodiments covered by a claim, this may necessitate the formulation of corresponding partial problems, the respective solutions of which must be assessed separately for inventive step. With respect

to the requirements of Art. 56 EPC 1973 the inventiveness of the subject-matter of a claim must be denied as a whole in the event that only one of its embodiments is obvious.

4.3. Solving the technical problem

The boards have regularly considered in the context of the evaluation of inventive step whether or not the problem is credibly solved. A great number of decisions address the assessment of alleged advantages, comparative tests and post-published documents.

4.3.1 Sufficient evidence for alleged advantages

According to the established case law of the boards of appeal, alleged advantages to which the patent proprietor/applicant merely refers, without offering sufficient evidence to support the comparison with the closest prior art, cannot be taken into consideration in determining the problem underlying the invention and therefore in assessing inventive step (see e.g. **T 20/81**, OJ 1982, 217; **T 181/82**, OJ 1984, 401; **T 1051/97**; **T 632/03**; **T 1211/07**; **T 736/12**; **T 2400/12**; **T 1764/16**, **T 225/18**, **T 825/18**; **T 2210/19**). In **T 1027/08** the board added that there was no reason to deviate from this case law as it was based on the understandable rule that a patent could only properly be granted for a solution claimed as non-obvious if it actually achieved the alleged effect.

If the patent proprietor/applicant alleges the fact that the claimed invention improves a technical effect, then the burden of proof for that fact rests upon them (**T 355/97**, **T 1213/03**, **T 1097/09**, **T 2418/10**, **T 1487/16**). In the absence of any data confirming the alleged improvement, such an effect cannot be taken into account in the formulation of the technical problem (**T 2044/09**). In **T 1616/22**, the respondent (patent proprietor) argued that it was up to the appellant to show that the effect was not achieved over the whole scope. The board held that while it was usually up to the party alleging a fact in opposition to provide evidence for it, if the patent proprietor alleged the fact that the claimed invention improved a technical effect, the burden of proof for that fact rested upon them. The appellant had moreover provided, inter alia, a document representing common general knowledge to raise serious doubts that the effect could be achieved over the whole scope claimed. It was therefore up to the respondent to dispel those doubts.

In **T 524/17** the board found it was not credible that the problem was solved over the whole range claimed. It held that where the closest prior art already showed improved values for certain properties which were said in the patent to be improved, it was up to the proprietor to show by means of suitable evidence that there was indeed such an improvement. In the absence of such evidence, it must be concluded that there was no such improvement and, thus, the problem was not solved. In **T 1346/16** the board concluded that the claimed subject-matter could be plausibly considered to have solved the technical problem ("technically plausible").

In **T 946/16** the board rejected the patent proprietor's formulation of the problem because it defined the quality of the copolymers obtained by the claimed method purely in absolute terms ("high quality"). To arrive at a an objective definition of the problem actually solved as compared with the closest prior art (D2), it instead had to be established whether the

copolymer quality achieved using the claimed method was higher, similar or lower than that achieved in D2. In view of the technical arguments and the evidence adduced, the board considered that the patent proprietor had failed to show that the alleged improvement in copolymer quality over that achieved using the prior-art method was credible.

In **T 2514/16** the board found that the respondent had demonstrated with D16 that an effect was achieved for at least part of the claim at issue and that the burden of proving that this effect was not achievable across the whole breadth of the claim thus lay with appellant 1. Appellant 1 contended that, according to **T 1188/00**, it was for the patent proprietor to prove this. The board, however, considered that the reason that conclusion had been reached in **T 1188/00** was that the effect (improvement) alleged by the patent proprietor there had been found to be not credible, and so the circumstances were not comparable with those now at issue. In the absence of relevant comparative tests, appellant 1's objection was held to be unconvincing.

In **T 575/17** the board held that, where there was no direct or plausible disclosure in the application as a whole of how the envisaged effect of the invention was achieved or of why the problem was solved by the claimed features, how this worked could also be deduced from the **teaching of other (pre-published) documents**. In the case in hand, the board, referring to documents E1 to E3 and E5, observed that using prefabricated implants for better thermal conductivity had long been known in detail. The skilled person would have no technical difficulty in applying the teaching of these documents to the "insulated metal substrate" technology that had later become established. It did not matter that the documents recorded an "old technology"; they contained the general technical teaching that an object inserted into the metal (substrate) could be used to improve the conduction of an electrical component's heat.

In **T 2524/19** the board rejected the respondent's arguments based on decisions **T 716/08** and **T 578/06** that there was no requirement for an absolute proof for a technical effect in a patent. **T 716/08** was concerned with whether the claimed solution actually solved the technical problem, but not as to whether the technical differences between the claimed subject-matter and the closest prior art imparted a technical effect. **T 578/06** highlighted that the disclosure of experimental data was not always required to establish that the claimed subject-matter solved the objective technical problem. Neither decision supported the respondent's argument that a technical effect did not need to be attributed to the distinguishing features between the claimed subject-matter and the closest prior art. Moreover, the board disagreed that it was on the appellant to prove that the technical difference failed to provide any improved protein titer yield in the case in hand. Rather, it was on the respondent, who wanted to rely on this effect mentioned in the patent to show that the claimed method led to this advantageous effect when compared to the closest prior art.

In **T 1289/22** the board stated that the conclusion in **T 578/06** that experimental data and results were not required by the EPC to demonstrate that the claimed subject-matter solved the objective technical problem did not mean that a technical effect attributed to the

distinguishing features in relation to the closest prior art did not have to be made "plausible" by means of comparative examples or in some other way.

4.3.2 Comparative tests

An applicant or patentee may discharge their onus of proof by voluntarily submitting comparative tests with newly prepared variants of the closest state of the art identifying the features common with the invention, in order to have a variant lying closer to the invention so that the advantageous effect attributable to the distinguishing feature is thereby more clearly demonstrated (**T 35/85**, **T 40/89**, **T 191/97**, **T 496/02**, **T 765/15**, **T 1323/17**, **T 524/18**).

According to the established case law, an unexpected effect (advantageous effect or feature) demonstrated in a comparative test can be taken as an indication of inventive step (**T 181/82**, OJ 1984, 401). In **T 197/86** (OJ 1989, 371) the board supplemented the principles laid down in **T 181/82**, according to which, where comparative tests were submitted as evidence of an unexpected effect, there had to be the closest possible structural approximation in a comparable type of use to the subject-matter claimed. It stated that if comparative tests are chosen to demonstrate an inventive step on the basis of an improved effect over a claimed area, the nature of the comparison with the closest state of the art must be such that the alleged advantage or effect is convincingly shown to have its origin in the distinguishing feature of the invention compared with the closest state of the art (see also **T 234/03**, **T 568/11**, **T 1962/12**, **T 1457/13**, **T 1521/13**; **T 1401/14**; **T 710/16**, **T 990/17**, **T 2406/18**, **T 816/16**, **T 2217/19**, **T 397/20**, **T 1045/21**, **T 1445/21**, **T 1359/22**, **T 1639/22**).

For this purpose it might be necessary to modify the elements of comparison so that they differed only by such a distinguishing feature (see e.g. **T 197/86**, **T 292/92**, **T 819/96**, **T 369/02**, **T 2043/09**, **T 183/12**, **T 710/16**, **T 990/17**).

To be of relevance in demonstrating that a technical improvement is achieved in comparison with the closest state of the art, any comparative test presented must be reproducible on the basis of the information thus provided, thereby rendering the results of such tests directly verifiable (**T 494/99**, **T 234/03**, **T 236/09**, **T 1962/12**, **T 383/13**). This requirement implies, in particular, that the procedure for performing the test relies on quantitative information enabling the person skilled in the art to reproduce it reliably and validly (**T 234/03**, **T 236/09**, **T 383/13**, **T 1962/12**, **T 532/14**, **T 795/14**). Vague and imprecise operating instructions render the test inappropriate and thus irrelevant (**T 234/03**, **T 236/09**, **T 383/13**, **T 1962/12**, **T 795/14**).

In **T 1871/19** the board emphasised that if comparative tests were chosen to demonstrate an inventive step on the basis of an improved effect over a claimed area, it should be credible that this effect was achieved over the whole range claimed. However, the board in **T 2363/22** found that in a situation where an opponent lodges several inventive-step attacks from various starting points, the patent proprietor was not expected to provide comparative tests with respect to each and every starting point. Rather, the question to be answered was whether the set-up chosen supported the conclusion that a technical effect

was credibly achieved, and in particular whether the comparative test was representative of the disclosure used as a starting point.

In **T 2923/19** the board set out the following **potentially relevant criteria**: (a) the comparative sample must be adequately representative of the closest prior art, and the "inventive" sample must be adequately representative of the claimed subject-matter; (b) a technical effect cannot be convincingly attributed to a particular technical feature if several features are varied in the comparative test; (c) it must be credible that the effect can be obtained over the entire scope claimed for it to be taken into account in determining the objective technical problem.

In **T 390/88** the board stated that where an alleged invention was prima facie obvious having regard to the prior art, it was however sometimes possible to prove inventiveness by comparative tests showing a significant improvement over the closest prior art. That situation was to be contrasted with other cases, in which it was not prima facie obvious to make the claimed compounds at all, and therefore comparative tests were not essential to establish inventiveness. See also **T 656/91**, **T 60/95**, **T 930/99**.

In **T 172/90** the comparative examples produced did not constitute suitable evidence of inventive step. The board said that the products adduced as a basis of comparison were commercially available and had evidently been selected at random. Technical progress shown in comparison with products of this kind could not be a substitute for the demonstration of inventive step with regard to the closest prior art (referring to **T 164/83**, OJ 1987, 149). See also **T 730/96**.

In **T 702/99** the board stated that in cases concerning products such as cosmetics, in which applicants or patentees seek to establish that their inventions have an improved "feel" over the prior art, or opponents seek to deny such an improved "feel", it is common for one or more parties to file evidence of comparative tests conducted by a number of persons. It is essential for such tests to be made under conditions which ensure maximum objectivity on the part of those conducting the tests and who may be required at a later date to give evidence in proceedings. It is always desirable that such tests can be shown to be "blind" and that they have been conducted in the strictest conditions; that the testers have had no part in the making of the claimed invention or research leading up to the invention or the patenting procedure. See also **T 275/11**, **T 1962/12**, **T 165/14** **T 2304/16**.

In **T 2579/11** the patent proprietor had not divulged the details of the test protocol applied, citing commercial reasons. The board found that the test results were neither verifiable nor plausible and therefore insufficient to establish that the problem had been solved successfully (see also **T 1265/17**).

In **T 2319/14** the board disagreed with the respondent's argument that comparative tests always had to be carried out using the closest prior art and that intrinsic comparative tests were not allowed. It was true that, according to the boards' established case law, tests comparing the invention with the prior art had to be conducted in such a way that any effect could be attributed to the distinguishing feature. However, it was also permitted – and

might even be necessary – to modify prior-art embodiments in line with the invention to such a degree that the only remaining difference was the feature distinguishing the claim.

In **T 1323/17** what counted in the board's opinion was not only whether a causal link between a distinguishing feature over the closest prior art and an effect was demonstrated within the framework of a comparative test submitted by the applicant or patentee. It also counted whether the variant of the closest prior art selected as a reference (or comparative) example for the comparative test was representative of the closest prior art, in the sense that the effect shown to be caused by the distinguishing feature in the context of the comparative test could also be expected to take place within the framework of the closest prior art despite the existence of differences vis-à-vis the reference example of the comparative test.

In **T 524/18** the board found a comparison of test results obtained by immersion of coated panels in a marine environment was only meaningful if the coatings one wished to compare had been tested under identical conditions, which in the case in hand included the time of the year and the geographical location, since fouling depended on various factors such as population and species of fouling organisms, temperature, nutrient levels, flow rates and the intensity of solar radiation. A comparison of data obtained in two different test reports was only meaningful if it could be ensured that conditions influencing fouling were reasonably comparable.

In **T 1994/20** the material used in the comparative example of the specification differed in many aspects from the material of the closest prior art. This in itself did not invalidate the respondent's arguments based on the comparison made in the specification, since the possibility of using a comparison made with a variant of the closest prior art had been recognised by the boards of appeal as early as in **T 35/85**. However, since the question to be answered concerned the problem successfully solved over the closest prior art by the claimed subject-matter, the board held it was per se not sufficient to demonstrate that an effect or advantage resulting from the distinguishing feature was observed in the context of a variant of the closest prior art used as reference example in the comparative test. It had to additionally be credible that the same effect or advantage took place in the context of the closest prior art, i.e. irrespective of the modification of the closest prior art operated to prepare the reference example of the comparative test.

4.3.3 Post-published evidence and reliance on a purported technical effect for inventive step ("plausibility")

a) General principles

According to the established case law of the boards of appeal, the assessment of inventive step is to be made at the effective date of the patent on the basis of the information in the patent together with the common general knowledge then available to the skilled person (**G 2/21**, OJ 2023, A85; see also e.g. **T 1329/04**, **T 1545/08**, **T 1433/14**, **T 488/16**, **T 1322/17**).

It is often necessary to provide post-published evidence (i.e. evidence that was not public before the filing date of the patent in suit and was filed after that date) as proof that the problem has been solved (i.e. that the alleged technical effect is actually achieved). This applies in particular when the objective technical problem has to be reformulated, e.g. with regard to a closest prior art document previously unknown to the patent proprietor (**T 116/18** of 11 October 2021).

In the view of the board in **T 116/18** of 11 October 2021 there were, where the proof that a problem had been solved rested on such post-published evidence, **three diverging lines of case law** from the boards regarding the circumstances under which this evidence could or could not be taken into account. These encompassed: a strict application of the "ab initio plausibility" standard, according to which post-published evidence could be taken into account only if, given the application as filed and the common general knowledge at the filing date, the skilled person would have had reason to assume the purported technical effect to be achieved; the "no plausibility" standard which seemed to reject the concept of plausibility; and the "ab initio implausibility" standard, according to which post-published evidence could only be disregarded if the skilled person would have had legitimate reasons to doubt that the purported technical effect would have been achieved on the filing date of the patent in suit. In a referral pursuant to Art. 112 EPC, the board asked the Enlarged Board in particular whether the standards "ab initio plausibility" or "ab initio implausibility" should be applied.

The Enlarged Board in **G 2/21** (OJ 2023, A85) departed from the concept of "plausibility" however**.** It held that the term "plausibility" that is found in the case law of the boards of appeal and relied upon by the referring board (**T 116/18** of 11 October 2021) **did not amount to a distinctive legal concept** or a specific patent law requirement under the EPC, in particular under Art. 56 and 83 EPC. It rather described a generic catchword seized in the jurisprudence of the boards of appeal, by some national courts and by users of the European patent system (point 92 of the Reasons). The Enlarged Board ruled that:

"I. Evidence submitted by a patent applicant or proprietor to prove a technical effect relied upon for acknowledgement of inventive step of the claimed subject-matter may not be disregarded solely on the ground that such evidence, on which the effect rests, had not been public before the filing date of the patent in suit and was filed after that date.

II. A patent applicant or proprietor may rely upon a technical effect for inventive step if the skilled person, having the common general knowledge in mind, and based on the application as originally filed, would derive said effect as being encompassed by the technical teaching and embodied by the same originally disclosed invention."

Applying these principles to the case law of the Boards of Appeal the Enlarged Board had analysed in reaching its decision, the Enlarged Board was satisfied that the outcome in each particular case would not have been different from the actual finding of the respective board of appeal. Irrespective of the use of the terminological notion of plausibility, the decisions appeared to show that the particular board of appeal focussed on the question whether or not the technical effect relied upon by the patent applicant or proprietor was

derivable for the person skilled in the art from the technical teaching of the application documents.

b) Decisions prior to G 2/21

In the following decisions, which were all made before the decision in **G 2/21** (OJ 2023, A85) and comprise also (in large part) those which were analysed in that decision by the Enlarged Board, reference is still made to the notions of plausibility and implausibility, concepts the Enlarged Board **G 2/21** found to have no legal basis under the EPC (see point 92 of the Reasons). However, as noted above in chapter I.D.4.3.3a), the Enlarged Board emphasised that it understood from this case law as common ground that the core issue rested with the question of what the skilled person, with the common general knowledge in mind, understood at the filing date from the application as originally filed as the technical teaching of the claimed invention. Applying this understanding to the analysed decisions, in an attempt to test the Enlarged Board's understanding, the Enlarged Board was satisfied that the outcome in each particular case would not have been different from the actual finding of the respective board of appeal.

(i) General considerations

In **T 1329/04** the board did not take into consideration post-published evidence and ultimately denied an inventive step of the claimed subject-matter because the application as originally filed lacked enough evidence to make it at least plausible that a solution had been found to the purportedly solved problem (that GDF-9 was indeed a growth differentiation factor). Since the post-published evidence was considered to be the first disclosure going beyond speculation, it could not be taken into consideration. The board held that even if supplementary post-published evidence might in the proper circumstances also be taken into consideration, it **may not serve as the sole basis** to establish that the application indeed solves the problem it purports to solve (see also **T 861/08**, **T 778/08**, **T 415/11**, **T 1791/11**, **T 1285/13** **T 488/16**, **T 1099/16**, **T 212/17**, **T 1322/17**).

Numerous other decisions have held that post-published evidence could only be used to back up the teaching **derivable from the application** (see e.g. **T 716/08**, **T 578/06**, **T 861/08**, **T 1196/12**, **T 235/13**, **T 377/18**).

In **T 716/08** the board stated that as to the **quality of the evidence** in the application, "absolute proof" of the achievement of an effect was not required for the effect to be "plausible". See also **T 266/10**, in which the board similarly held that whether the effect of proposed modifications could be regarded as plausible did not depend on such absolute proof in the disclosure of the disputed patent that the effect was actually achieved.

In **T 578/06** the board stated that the EPC required **no experimental proof for patentability** and considered that the disclosure of experimental data or results in the application as filed and/or post-published evidence was not always required to establish that the claimed subject-matter solved the objective technical problem. This was in particular true in the absence of any formulated substantiated doubt. The board re-

emphasised in this context however that the case law (with specific reference to **T 716/08**, **T 1329/04**, **T 893/02**) considered the establishment of plausibility only relevant when examining inventive step if the case in hand allowed the substantiation of doubts about the suitability of the claimed invention to solve the technical problem addressed and when it was thus far from straightforward that the claimed invention solved the formulated problem. See also **T 2197/09**.

In **T 2371/13**, however, the board held that the fact that an effect had to be regarded as implausible because it was not backed up in the application was not a good enough reason to disregard comparative tests filed later with a view to proving it. To do so for that reason would run counter to the problem-solution approach, which required that a technical problem be defined in light of the closest prior art, which was not necessarily that cited in the application. It was common, the board observed, to try to demonstrate inventive step on the basis of a technical effect not explicitly mentioned in the application as filed. The objection that the invention had yet to be achieved when the application was filed was anyway more a matter for consideration under Art. 83 EPC. On "Reformulation of the technical problem", see also chapter I.D.4.4 below.

In **T 31/18** the board of appeal held that the technical effect relied upon for inventive step according to the problem-solution approach must either be explicitly mentioned in the application as filed or at least be derivable therefrom (see also chapter I.D.4.1.2), but not necessarily originally supported by experimental evidence.

(ii) Decisions taking into account post-published evidence only if the purported technical effect is "plausible"

– Post-published evidence taken into account

In **T 1336/04** the board pointed out that the situation in the case in hand was different from that underlying the decision **T 1329/04** as to the quality of evidence provided in the patent in suit relating to the claimed invention being a bona fide solution to the problem to be solved. In the case in hand the subject-matter of claim 1 related to novel cellulose- or hemicellulose-degrading enzymes as characterized by the homology of their CBDs to that of known cellulases. On this basis, the board accepted that the problem was satisfactorily solved, also taking into consideration the disclosure in a post-published document.

In **T 108/09**, in acknowledging plausibility, the board contrasted the case underlying that decision with that in **T 1329/04**, in which decision there had been prima facie serious doubts that the subject-matter solved the problem of the invention. The patent in suit, however, contained detailed information as to how fulvestrant had to be formulated and administered in order to obtain the desired effect as a third-line agent in the treatment of breast cancer. The post-published evidence was far from being the only source of information regarding the question whether fulvestrant was useful as a third-line agent, so that the data contained therein may be used in the evaluation of whether or not the problem underlying the present invention has been plausibly solved.

Some further examples of cases, in which the board took into account the submitted post-published evidence, are: **T 433/05**, **T 294/07**, **T 2134/10**, **T 872/13**, **T 1898/15**, **T 212/17**.

– Post-published evidence not taken into account

In **T 1791/11** the board stated it was apparent from the patent application itself that it was not yet known which variants solved the problem and that a test still had to be performed to confirm the alleged advantage. The board thus came to the conclusion that the patent did not render it plausible that the claimed subject-matter solved the technical problem as formulated by the appellant-proprietor, and the experimental post-published evidence was in fact the sole basis allowing to conclude that said problem has been plausibly solved.

In **T 787/14** the board held that the verification of whether or not the claimed solution actually solved the problem, i.e. whether the claimed subject-matter actually provided the desired effect, had to be based on the data in the application in order to avoid that an invention is based on knowledge available after the effective date only. Post-published evidence to support that the claimed subject-matter solved the underlying technical problem could only be taken into account if it was already credible from the disclosure in the patent that the problem was indeed solved. See also **T 1442/18.**

In **T 488/16** the board stated that the question of whether an invention was plausible could not be answered in general, as this assessment depended upon the individual circumstances, namely the nature of the invention, the disclosure of the specification and common general knowledge. In the case in hand the board found that the post-published documents were the first disclosure showing that at least for certain thiazole, in particular dasatinib, the purported technical problem had actually been solved. In accordance with established case law, these documents were therefore not taken into consideration in the assessment of inventive step.

In **T 1322/17** the board noted that experimental evidence was not always necessary to render a certain effect plausible. A mechanistic explanation and/or common general knowledge could be sufficient in certain instances. However, results only known to the inventors derived from studies of unknown set-up (e.g. dosage regimen) could not be considered when assessing the plausibility of certain effects. A mere statement that a certain effect arises (under conditions that were not reflected by the technical features of the claim), in the absence of any supporting circumstances, did not render the achievement of the effect plausible. The board found in the case in hand that since a technical effect related to higher fracture reduction had not been made plausible for the specific dose of 150 mg ibandronic acid administered in any dosing interval in the application as filed, the post-published evidence could not be taken into consideration.

In **T 235/13** the board found that post-published evidence could not be taken into account as evidence for a further, previously undisclosed, effect, such as a hitherto unknown specific advantage for which there was no suggestion at all in the application as filed. The present application failed to indicate, in either the disclosure of the invention or the discussion of the prior art, any improvement to a therapy, let alone improved bioavailability

of the therapeutic compound. Hence, the further effect changed the character of the invention and for this very reason could not be taken into account.

In **T 377/18** the board held that in the absence of any indication in the application as filed that regorafenib could be used upon failure of treatment with other actives of the same chemical class, i.e. diaryl ureas discussed in the background section with reference to document (5), the post-published evidence showing that "regorafenib was even effective in patients who showed insufficient response to the treatment with sorafenib" could not be taken into account for assessing inventive step.

Some further examples of cases, in which the board did not consider the submitted post-published evidence, are: **T 1306/04**, **T 125/12**, **T 1433/14**, **T 1099/16.**

(iii) Decisions taking into account post-published evidence on the basis the purported technical effect is not "implausible"

In **T 1642/07** the board observed that there was no requirement in the EPC, let alone in Art. 56 EPC, that a patent application should include experimental evidence in support of patentability or a claimed technical effect. Hence, the fact that the disclosure in a patent application was merely theoretical and not supported by experimental data was in itself no bar to patentability or to the presence of a technical effect being acknowledged. The board found that the post-published documents could be viewed as being a mere confirmation of the technical effect already announced (albeit at a theoretical level) in the application as filed. It saw no reasons for doubting the described technical effect, and held the post-published evidence could be taken into account.

In **T 536/07** the board noted that although there were no working examples for the claimed subject-matter in the contested patent and it was not disclosed as a preferred embodiment, there was a priori no reason for the skilled person to consider it not to be a plausible solution to the technical problem. There was no indication of a possible prejudice in the art or of foreseen difficulties in carrying out the proposed solution. The board in the case in hand took into account the post-published evidence on file demonstrating the feasibility of the proposed solution.

In **T 1677/11** the board noted the facts of the present case differed substantially from those underlying decision **T 1329/04**. In the case in hand the structure of the claimed sodium salt of (-)-omeprazole was fully consistent with that of the known class of gastric acid secretion inhibitors, whereas in **T 1329/04** the structural features of the polypeptide were found to be inconsistent with that expected of the superfamily. Moreover, the patent in suit disclosed a synthesis of the claimed salt and provided a clear statement that it provided "an improved therapeutic profile such as a lower degree of interindividual variation". The board thus saw no reason a priori for the skilled person to regard it as being implausible and considered it appropriate to take into account the post-published evidence submitted for the purpose of assessing whether or not the effect identified was indeed observed.

In **T 919/15** the board found that, in the absence of any indications to the contrary in common general knowledge, a synergy between the herbicide combinations containing

herbicide (A) which had not been tested in the application as filed could not be regarded as implausible per se. This finding was line with the decision in **T 863/12**, in which one of the reasons for considering an effect plausible had been that there was nothing in common general knowledge to cast doubt on its plausibility. See also **T 2097/15**.

In **T 184/16** the application as filed did not contain any experimental evidence as regards the plausibility of the claimed compounds being SGLT2 inhibitors. It was thus necessary to determine whether plausibility could nevertheless be acknowledged in view of the common general knowledge and the prior art. The board had no indication that there was prima facie any serious doubt that the claimed therapeutic effect could be obtained, nor had the appellant (opponent) argued that there existed any. Furthermore, there was no a priori reason or any indication in the common general knowledge that the claimed therapeutic effect could not be obtained. In view of the above, the board considered it plausible that the therapeutic effect defined in claim 12 was indeed obtained and the board found post-published evidence D4 could be taken into consideration to support the disclosure in the patent application.

In **T 2015/20** the board held that the approaches developed in the jurisprudence of the Boards of Appeal of the EPO for the assessment of sufficiency of disclosure and inventive step specifically took account of the technical contribution actually disclosed in a patent application to avoid patent protection resulting from unreasonable speculation on the basis of propositions that are prima facie implausible. In the case in hand the board considered the statement in the application, that the treatment of respiratory disorders, particularly asthma and COPD, with aclidinium was most effective upon administration by inhalation in a dosage of about 400 myg metered nominal dose to represent a significant technical teaching, which was far from an invitation to perform a research programme and which did not prima facie lack plausibility.

c) Decisions following G 2/21

(i) Post-published evidence taken into account

In **T 116/18** of 28 July 2023, proof or similar proof of the purported technical effect shown in post-published evidence was not contained in the application as filed. The board concluded that for requirement (ii) of Order no. 2 of **G 2/21** to be satisfied, experimental proof of the purported technical effect or a positive verbal statement was not necessarily required in the application as filed. The board applied its interpretation of the legal principles stated in Order 2 of **G 2/21** (see I.D.4.1.2) to the case in hand, finding that the skilled person would have no legitimate reason to doubt that the purported technical effect could be achieved with the subject-matter of claim 1 as granted. The purported technical effect was thus embodied by the same originally disclosed invention and the respondent could rely on the purported technical effect based on the application as filed.

According to the board in **T 1989/19,** once the criterion of derivability of a technical effect within the meaning of point 2 of the Order in **G 2/21** was met, this also applied equally to any improvement of that effect. As the board explained, the skilled person, even if they have no inventive skill, will strive for further developments or technical improvements in

every field of technology. Thus if a certain technical effect, such as storage stability in this case, is derivable for the skilled person within the meaning of point 2 of the Order from the application as originally filed (in this case from the described use as an inhalation product), the improvement of this technical effect can also be regarded as implicitly derivable. The board in **T 840/22** highlighted that such an improvement of the derivable effect regularly occurred in the field of chemistry where claimed subject-matter had to be limited at the expense of subject-matter disclosed in the application as filed as part of the invention, because the effect relied on for inventive step over the closest prior art was not achieved across the entire breadth of the claimed subject-matter.

In **T 1525/19** the board held that the effect shown in post-published D62 and D64 was encompassed by the teaching of the application as filed, and that in the light of common general knowledge and Example I of the application as filed, the skilled person would consider it likely that the overadditive glucose excursion observed in Example I of the patent was at least partially due to an increase in the effect on GLP-1 levels compared with linagliptin monotherapy. D62 and D64 merely confirmed this effect. Consequently, decision **G 2/21** did not preclude taking into account the effect confirmed by D62 and D64. The board rejected the request to refer questions to the Enlarged Board on the interpretation of **G 2/21** to avoid divergent case law on the basis that another board in a related case had allegedly decided **G 2/21** did not allow taking D64 into account; a decision by a different board in a different case does not constitute exceptional circumstances justifying the reopening of the debate, the decision in one appeal case is not binding on the other.

In **T 2716/19** the board applied Order no. 1 of **G 2/21**, rejecting the argument by the opponent that the application as filed did not include any evidence that the claimed bases would result in an improved PMPA yield, and that the opposition division was thus incorrect to allow the respondent to rely on post-published evidence. It found the skilled person would have immediately recognised an improvement in the yield of the desired product, here PMPA, as a fundamental objective of the disclosed method. In line with **G 2/21** (Order), this technical effect could thus be relied on by the respondent, and post-published evidence confirming this technical effect could not be disregarded.

In **T 728/21** the board found that the application as originally filed explicitly addressed the dissolution of tablets comprising a solid dispersion as an aspect of the disclosed invention and specifically described the claimed tablet composition as an embodiment of the disclosed invention. The effect of the optimization of the dissolution associated with the specific tablet composition defined in claim 1 of the main request, demonstrated with post-published evidence, could therefore in accordance with the principles established in **G 2/21** be taken into account for the assessment of inventive step (see also **T 1515/20)**.

In **T 873/21** the board found that the therapeutic synergistic effect substantiated in D16 was **derivable from the original application**, and that the data of D16 only provided a quantification of the obtained improvement in insulin sensitivity described in the original application. Accordingly, the board considered that the synergistic effect relied upon by the appellant was encompassed by the technical teaching of the original application in light of the common general knowledge and was embodied by the present combination since it

was clearly the preferred combination in the original application. In line with **G 2/21**, the technical effect demonstrated by the post-published experimental data provided in D16 was thus to be taken into account when assessing the inventiveness of the claimed subject-matter.

In **T 885/21** the board found the post-published experimental results in document D51 confirmed that conjugates in accordance with the main request indeed exhibited with respect to conjugates resulting from oxidation-hydrazone ligation, as well as conjugates resulting from linking an azide-modified sugar to terminal N-acetylglucosamine residues of untrimmed antibodies, optimised characteristics in terms of inter alia homogenicity, reduced Fc-gamma binding, reduced susceptibility to elastase cleavage, pharmacokinetic profile and in vivo efficacy. Taking account of the disclosure of the invention in the patent the board considered that the effects described in document D51 were encompassed by the technical teaching and embodied by the disclosed invention and could in accordance with the principles confirmed in **G 2/21** be relied upon by the proprietor for inventive step.

In **T 1329/21** the board noted that achieving improved sensory characteristics had already been disclosed as an objective in the original application. In addition, various sensory properties, including the absorption, stickiness and oiliness, of claimed formulations had been evaluated in the original examples in comparison to formulations without cellulose or with microcrystalline cellulose. The effect reported in the post-published comparative test was therefore clearly covered by the technical teaching disclosed in the original application. In the light of decision **G 2/21**, the board was consequently of the opinion that the post-published comparative test had to be taken into account.

In **T 1891/21** the indicated technical effect of increasing the actual initial coulombic efficiency in comparison with the predicted value could be derived from the patent in suit and the underlying application as originally filed. The respondent's submission in their reply to the appeal, which included the calculation of additional values of some of the provided examples, merely made explicit what the skilled person would have derived from the patent in suit. The board found there was no doubt that the requirement formulated in **G 2/21** (Headnote II) had been met.

In **T 1445/21** the board found the post-published evidence showing a better olfactive performance for the compositions having 9% or 8.5% by weight of water in comparison to the compositions comprising 60% by water encompassed by the technical teaching of the originally disclosed invention. The comparison however was not suitable in the present case to substantiate the presence of an improvement over the prior art. Accordingly, the experimental data of the patent and of the post-published experimental report did not credibly demonstrate the existence of a technical effect linked with an amount of water not above 10% by weight.

In **T 318/22** the board found it was credible on the basis of the application as filed that the claimed compounds possessed the alleged herbicidal activity. Hence, the requirement in **G 2/21** that the skilled person would derive the technical effect as being "encompassed by the technical teaching" and "embodied by the same originally disclosed invention" was met. Considering whether post-filed data D9 and D10 could be taken into account in view

of **G 2/21**, the board further found that referral **T 116/18** of 11 October 2024 and **G 2/21** appeared to be irrelevant to the present case, since the question to be answered in those cases was whether post-published data in relation to a particular technical effect could be relied on for inventive step when evidence for said effect relied exclusively on said post-published data (see question 1 posed by the referring board in **T 116/18**). This did not correspond to the present situation. Hence, D9 and D10 could be relied on in the assessment of inventive step for the claimed subject-matter.

In **T 228/23** the board considered whether the effect substantiated by the post-published experimental data was embodied by the same originally disclosed invention. Although the original application disclosed the preparation of tablets by direct compression or dry granulation without indicating whether one of these methods was preferred over the other, the fact that all the examples of the original application concerned dry granulation indicated that dry granulation would be preferred over direct compression in general in the context of the application. The board considered that in this specific case of a very limited number of embodiments defined in the original application, one of these being also the subject-matter of the closest prior art and the other one being generally preferred, and in the absence of any legitimate reason at the effective date to doubt that the alleged effect could be achieved with the claimed subject-matter (see **T 116/18** of 28 July 2023), that the appellant-patent proprietor should be entitled to specify a preference for one of said originally disclosed embodiments over the other in connection with said effect. In the present case, the alleged effect of faster and more complete release profile for tablets obtained by dry granulation compared to direct compression thus did not change the nature of the claimed invention, as defined in **G 2/21** (point 93 of the decision), so that it was embodied by the same originally disclosed invention.

Other decisions in which the boards of appeal have concluded that the skilled person, having the common general knowledge in mind, and based on the application as originally filed, would derive an alleged effect as being encompassed by the technical teaching and embodied by the same originally disclosed invention include: **T 681/21**, **T 1602/21**, **T 2086/21**, **T 1551/22**, **T 1354/23**.

(ii) Post-published evidence not taken into account

In **T 258/21** claim 1 of the patent at dispute described a medicament comprising an effective amount of a short acting dihydropyridine compound for use in a method of reducing ischemic stroke damage. The original application did not provide any experimental data. The board noted with reference to **G 2/21** (OJ 2023, A85), point 2 of the Order, that the effect substantiated in post-published evidence had neither been contemplated nor even suggested in the original application. It followed that the technical effect therein relied upon by the applicant could not be taken into account for the assessment of inventive step in accordance with **G 2/21**. Even if the technical effect had been derivable from the original application, the board observed that the post-published evidence were merely abstracts reporting results of "ongoing" studies. These documents did not provide any detailed results nor any details on the protocols used. The meaningfulness of the appellant's exploitation of the data provided in these abstracts was therefore prima facie questionable.

In **T 852/20** the board held that the purported technical effect evidenced by post-published data of increased water solubility and bioavailability of Form 1 over Form 2 was not disclosed or taught anywhere in the application as filed. By no means could the skilled person derive from the application as filed that one particular crystalline form, namely the claimed Form 1, had good solubility and bioavailability, let alone solubility and bioavailability that was better than that of another crystalline form (Form 2). It followed that based on the application as filed, and having the common general knowledge in mind, the skilled person would not have derived the purported technical effect as being encompassed by the technical teaching of the application as filed, let alone that the skilled person would have derived it as being embodied by the same originally disclosed invention.

An invention cannot be based solely on knowledge made available only after the effective date. In **T 887/21** the board held that it was not sufficient that a technical effect could be achieved by a composition which in terms of technical features corresponded to compositions in the application as filed. In order to be taken into account in the formulation of the objective technical problem, the alleged technical effect that was supposedly shown by the post-filed evidence (in the present case, the inhibition of Salmonellae outside the context of epithelial adherence) also had to be encompassed by the technical teaching of the application as filed, i.e. the technical effect in question had to in the first place be disclosed or be at least derivable from the technical teaching of the application documents.

In **T 1994/22** the board acknowledged that the mere fact that photostability or improved photostability was not contained in terms of a positive verbal statement in the application as filed and that the application as filed did not contain any data as regards photostability, as such, did not imply that the effect of improved photostability could not be relied on in terms of **G 2/21** or **T 116/18** of 28 July 2023. However, the board did not consider a sweeping statement regarding "high quality" and "easy industrial handleability" to encompass photostability, let alone improved photostability. If such a sweeping statement were sufficient, a reference to high quality would be sufficient to invoke whatever technical effect as being encompassed by an application as filed in the sense of **G 2/21**. This would essentially render the first criterion of Order no. 2 of **G 2/21** meaningless. In the case in hand the board found the effect of photostability was not encompassed by the teaching of the application as filed.

In **T 2046/21** the board considered that the alleged effect relied upon by the appellant substantiated by post-published evidence D13, D35, and D37 was derivable from the original application. The technical effect was thus encompassed by the technical teaching of the original application as required by **G 2/21** and the post-published evidence was thus to be taken into account when assessing inventive step. However, the appellant could not rely on a further very specific effect highlighted in post-hoc analysis in D36 that was neither mentioned or even suggested in either the original application or patent. The fact that the effect would reside in a further improvement of an effect allegedly already occurring in the remaining patients did not change the fact that the effect supported by document D36 applied only to a subgroup of patients not previously identified or suggested in the patent.

In **T 601/22** the board was of the opinion that no synergistic effect resulting from features (c) and (f) were disclosed in or derivable from the application and that the alleged synergistic effect (possibly described in post-published evidence D7) was not related to the technical problem initially suggested in the application as filed. While the invention related to the mechanical stability of the metal support member with its porous metal foil and its (optional) graphene layer, D7 described a different invention. Thus the alleged synergistic effect "alter[ed] the character of the invention" and said effect was not hinted at in the application or foreshadowed in the application. The board found it also questionable whether the alleged technical effect was "conceptionally comprised" by the teaching of said passage or relevant for an electron microscopy sample grid having a porous metal foil and a support member, as it was not mentioned at all in the application or derivable therefrom.

Chapter II.C.6.8 "Post-published documents" deals with the topic of post-published evidence with regard to sufficiency of disclosure (Art. 83 EPC). See also chapter II.C.7.2.3 "Evidence of therapeutic effect".

4.4. Reformulation of the technical problem

In accordance with the case law of the boards, the technical problem can be reformulated, and in certain circumstances actually has to be reformulated, since the only factor of importance in determining the problem objectively is the result actually achieved in relation to the closest state of the art (see e.g. **T 1397/08**, **T 2406/18**). The problem as first formulated can be modified even at the appeal stage (see e.g. **T 162/86**, OJ 1988, 452, **T 1397/08**; **T 2371/13**; **T 659/15**) as long as the spirit of the original disclosure of the invention is respected. See also **T 2371/13**, **T 659/15**. However, a reformulation of the technical problem is conditioned by certain limitations (see in this chapter I.D.4.4.3).

4.4.1 Reformulation if the problem is not solved

The technical problem may have to be reformulated, in particular in **less ambitious terms**, if the combination of features in the claim does not solve this problem over the whole area defined in the claim (**T 39/93**, OJ 1997, 134; **T 400/98**; **T 235/04**; **T 96/06**; **T 1159/12**; **T 2001/12**; **T 1279/14**; **T 44/17**, **T 1349/21**).

In **T 87/08** the board stated that Art. 56 EPC required that the assessment of inventive step was made "having regard to the state of the art". The board stated it was established in the case law of the boards of appeal that a decision was not sufficiently reasoned in the sense of R. 68(2) EPC 1973 (R. 111(2) EPC) if the chain of reasoning to justify the finding of lack of inventive step merely stated that a purported effect had not been achieved, i.e. this technical problem had not been solved, without reformulating the problem in a less ambitious way and without assessing obviousness of the claimed solution to that reformulated problem in the light of the cited prior art. See also **T 306/09**, **T 2375/10**, **T 1212/11**, **T 2186/11**.

In **T 143/13** the board observed that, according to the problem-solution approach, it was the problem described in the patent application that was normally used as the starting

point for assessing inventive step. It noted that in the appealed decision, the step of assessing whether the problem defined in the application had been solved had been omitted. Nevertheless, the problem had been reformulated in terms that had not been invoked by the appellant (applicant). The justification provided for the reformulation of the problem was that the originally defined problem was artificial. However, the board could not see why and considered the reformulation of the problem in the appealed decision was not appropriate.

4.4.2 Reformulation of the "subjective" into an objective technical problem

According to **T 39/93** (OJ 1997, 134), although it is desirable to take the same approach as the applicant regarding the definition of the technical problem (see in this chapter I.D.4.2.2), the technical problem as originally presented in the application or patent, which was to be regarded as the "subjective" technical problem, might require reformulation on the basis of objectively more relevant elements originally not taken into account by the applicant or patentee. This reformulation yields a definition of the "objective" technical problem. The latter represented the ultimate residue (effect), corresponding to the objective contribution provided by the subject-matter defined in the relevant claim.

It is established case law of the boards of appeal that where a specific problem is identified in the description, the applicant or patentee may be allowed to put forward a modified version of the problem particularly if the issue of inventiveness has to be considered on an objective basis against a new prior art which comes closer to the invention than that considered in the original application or granted patent specification (see e.g. **T 386/89**; **T 39/93**, OJ 1997, 134; **T 165/05**; **T 716/07**).

As a matter of principle, any effect provided by the invention may be used as a basis for reformulating the technical problem, as long as that effect is derivable from the application as filed (**T 452/05**, **T 698/08**, **T 188/09**, **T 2483/11**, **T 605/14**, **T 1196/12**, **T 1406/15**). A reformulation of the problem also may be appropriate if an alleged effect of a described feature could be deduced by the skilled person from the application in the light of the prior art or if new effects submitted subsequently during the proceedings were implied by or related to the technical problem initially suggested. In relation to new effects it was not permissible to change the nature of the invention (**T 13/84**, OJ 1986, 253; **T 344/89**; **T 767/02**; **T 698/08**).

4.4.3 Limitations to the reformulation of the technical problem

a) General principles and relationship with Article 123(2) EPC

As has been established in the case law of the boards of appeal (see in this chapter at I.D.4.4.2), any technical effect provided by the invention may be used as a basis for reformulating the technical problem, as long as that effect is derivable from the application as filed.

A reformulation of the problem is thus not precluded by Art. 123(2) EPC 1973 if the problem can be deduced by the skilled person from the application as filed when

considered in the light of the closest prior art (**T 13/84**, OJ 1986, 253; **T 469/90**; **T 530/90**; **T 547/90**; **T 39/93**, OJ 1997, 134; **T 375/93**; **T 687/94**; **T 877/06**).

In **T 818/93** the board added that it sufficed if the reformulated problem could be deduced later by comparing the application with the closest prior art. Since features from the drawings might be incorporated into the claims, and also into the description in support of the claims (referring to **T 169/83**, OJ 1985, 193), those features' effects and advantages might also be used as a basis for reformulating the problem, provided this problem could clearly be deduced from the above comparison.

In **T 184/82** (OJ 1984, 261) doubt was cast on the general validity of the statements in the specification and examples (hot bacon test) which suggested that the specific problem had been successfully solved by the invention. Nevertheless, the board found the person skilled in the relevant art would have recognised that the original problem was not unrelated to the more general aim of improving the heat and solvent resistance of materials for containers. The board stated in its Headnote that technical success at a general level could replace failure at a more specific level when assessing the effect of the invention provided the skilled person could recognise the same as implied or related to the problem initially suggested. See also **T 732/89**, **T 106/91**, **T 767/02**.

In **T 1422/12** claim 1 related to crystalline forms of tigecycline. The formulation of the technical problem to be solved fell well within the framework of the invention as disclosed in the application in suit. The board noted that any effects may be taken into account, so long as they concerned the same field of use and do not change the character of the invention (see **T 440/91**). That a more specific problem of improved stability with respect to epimerisation was not mentioned in the application as originally filed was irrelevant since improvement of stability by avoidance of epimerisation, and, as a consequence, improved biological activity was clearly recognisable by the skilled person as a desirable effect for a tetracycline antibiotic from the application as originally filed (see also **T 39/93**, OJ 1997, 134).

In **T 564/89** the appellant (opponent) submitted that any amendment of the technical problem had to be in line with Art. 123(2) EPC 1973. The board stated that this article was not concerned with the issue of whether or not an objectively reformulated technical problem could be used in the course of the so-called problem-solution approach. Art. 123(2) EPC 1973 would only come into play if an amended technical problem were incorporated into the description itself. See also **T 284/98**, **T 276/06**.

b) Subsequently invoked technical effect

As a rule, additional advantages not mentioned in the application as originally filed but relating to a mentioned field of use can also be considered for the purpose of assessing inventive step, provided such advantages do not alter the character of the invention (**T 440/91**; see also **T 1062/93**, **T 1983/07**, **T 1422/12**, **T 1450/14**, **T 321/16**). The character of the invention is not altered if the technical problem specified in the application as filed is supplemented by such advantages, since the skilled person could consider them

on account of their close technical relationship to the original problem (**T 440/91**, **T 1062/93**, **T 1983/07**, **T 1450/14**, **T 321/16**).

On the other hand, an alleged technical effect of a described feature cannot be taken into account when determining the problem underlying the invention for the purpose of assessing inventive step, if it cannot be deduced by the skilled person from the application as filed considered in relation to the nearest prior art (**T 386/89**), or if it is not at least hinted at in the originally filed documents (**T 321/16**; in **T 344/89** "foreshadowed in the originally filed application"). See also **T 440/91**, **T 532/00**, **T 867/13**.

In **T 1188/00** the board found that a reformulation relating to an effect first alleged in appeal proceedings (a more ambitious problem) could not be used to substantiate inventive step unless it was credibly demonstrated that the alleged effect could be achieved across the whole scope of the claim. The burden of proof for this lay with the patent proprietor. See also **T 134/00**, **T 815/16** (referred to in terms of plausibility in **T 253/02**, **T 172/07**, **T 366/12**, **T 438/16**, **T 815/16**, **T 987/17**).

In **T 235/04** the board did not accept the formulation of the technical problem since the purported improvement had not been demonstrated to arise within the whole area that was claimed. The abord explained that when defining the technical problem, an effect could not be retained if the promised result was not attainable throughout the entire range covered by the claimed subject-matter. Therefore, the technical problem needed to be redefined in a less ambitious way (**T 626/90**, **T 1057/04**, **T 824/07**).

In **T 259/05** too the board held the claimed improvement to be unproven; it had not been substantiated by tests or plausibly shown in any other way. The ambitious problem formulated could therefore not be considered successfully solved. As a result, the claimed improvement in the method's efficiency could not be taken into account for assessing the objective problem which the patent in suit sought to solve, or the inventiveness involved. The technical problem therefore had to be reformulated less ambitiously.

According to **T 155/85** (OJ 1988, 87), it was not acceptable to rely on an effect which had previously been described as undesirable and of no value by the applicant, to present it suddenly as possibly representing an advantage from another point of view, and thereby to imply that the technical problem and the considerations of inventive step should take this reversal into account. A redefinition of the technical problem should not contradict earlier statements in the application about the general purpose and character of the invention. See also **T 115/89**, **T 2245/10**.

4.5. Alternative solution to a known problem

Article 56 EPC does not require that the problem to be solved should be novel in itself. The fact that the underlying problem of the patent have already been solved by the prior art does not necessarily require redefinition of the problem for the assessment of inventive step, if the subject-matter of the patent represents an alternative solution to this problem. (**T 92/92**, with reference to **T 495/91**; see also **T 1074/93**, **T 780/94**, **T 323/03**, **T 78/05**, **T 2039/18**).

For an inventive step to be present, it is not necessary to show improvement – substantial or gradual – over the prior art (**T 100/90**, **T 588/93**, **T 620/99 T 1791/08**). An earlier solution to a given technical problem does not preclude later attempts to solve the same problem in another, non-obvious way (**T 588/93**, see also **T 615/05**).

In **T 2081/15** the non-obvious alternative solution was "technically plausible" and involved an inventive step, albeit a small one, over D1 and the skilled person's common general knowledge. On the other hand, in **T 1179/16** the board noted that if the only contribution of the invention was to propose something different from the prior art (i.e. the provision of an alternative), then it was usually appropriate to consider that the skilled reader would take into account any alternative known in the underlying technical field (unless the closest prior art teaches away from it). The board stated that in such cases it might not be required to justify the selection of a particular solution, because it was assumed that an invention based on incorporating known features for the sole purpose of establishing novelty must be rendered obvious by a corresponding step of selecting any alternative known in the art. See also **T 471/21**.

In **T 144/16** the board found the technical problem needed to be reformulated in a less ambitious way, and in view of the teaching of document (1), as the provision of alternative adhesive compositions. It noted that when looking for alternative compositions, the skilled person does not restrict the teaching of document (1) to its preferred embodiments, but takes into consideration all features taught in that document. In **T 148/10** the board stated that the skilled person required no inventive skill to make a selection from known alternatives. The skilled person was able to consider advantages and disadvantages of their selection and would weigh them against each other.

In **T 652/20** the board stated that there was no general requirement that all initially claimed compositions had to achieve a non-claimed technical effect to exactly the same level. Some of the initially described compositions might achieve this technical effect to a greater extent than others.

In **T 1518/20** the board held that for providing an alternative method, no particular pointer from the prior art was needed to combine the teaching of secondary sources of information with that of the closest prior art. In such a scenario, in the absence of any counter-indicators that would provide teaching leading away from applying the relevant disclosure in order to modify the solution proposed in the closest prior art, a skilled person would apply such teaching rather than being conceptually and notionally confined to the disclosure of the provided examples.

In **T 2004/21** the board noted that although the chewing gum of D2 had "inherent" mouthwatering properties, D2 disclosed neither these properties nor the problem of providing a mouthwatering effect in a user. "Mouthwatering" was not mentioned in any of the cited prior art documents. The claimed chewing gum which provided a "hydration or mouthwatering sensation" could therefore not be considered an alternative solution to a known problem.

5. "Could-would approach" (obviousness)

To determine whether the claimed invention, starting from the closest prior art and the objective technical problem, would have been obvious to the skilled person, the boards apply the **"could-would approach"** (see also Guidelines G-VII, 5.3 – April 2025 version). This means asking not whether the skilled person **could** have carried out the invention, but whether they **would have done** so in the expectation of solving the underlying technical problem or in the expectation of some improvement or advantage (**T 2/83**, OJ 1984, 265; **T 90/84**; **T 7/86**, OJ 1988, 381; **T 200/94**, **T 885/97**, **T 1148/15**). When considering whether or not claimed subject-matter constitutes an obvious solution to an objective technical problem, the question to be answered is whether or not the skilled person, in the expectation of solving the problem, would have modified the teaching in the closest prior art document in the light of other teachings in the prior art so as to arrive at the claimed invention (**T 1014/07**, **T 867/13**). The answer to this question depends on the result the skilled person wished to obtain (**T 939/92**, OJ 1996, 309; see also e.g. **T 1249/20**). The point is thus not whether the skilled person could have arrived at the invention by modifying the prior art, but rather whether, in expectation of the advantages actually achieved (i.e. in the light of the technical problem addressed), they would have done so because of promptings in the prior art (**T 219/87**, **T 455/94**, **T 414/98**, **T 2197/19**).

In **T 1014/07** the board stated that since this question involved determining whether or not the skilled person would – and not could – have made a particular modification, it was necessary for answering the question to identify conclusive reasons on the basis of tangible evidence that would have prompted the skilled person to act in one way or the other. The board in **T 1045/12** found that its decision, being based on prior art documents D4 and D3, was based on "tangible evidence" (referring to **T 1014/07**).

It has been held that once an invention existed, it could often be shown that the skilled person could have made it by combining different elements in the prior art, but such arguments had to be disregarded as the product of ex post facto analysis (**T 564/89**).

According to **T 939/92** (OJ 1996, 309), the answer to the question what a skilled person would have done depended in large measure on the technical result they had set out to achieve. In other words, the notional "person skilled in the art" was assumed to act not out of idle curiosity but rather with a specific technical purpose in mind (see also **T 28/20**, **T 2029/21**).

In **T 2197/11** the board held that the selection of a potentially less advantageous size-reduced L-carnitine acid fumarate did not require inventive ingenuity, if, as in the present case, it merely amounted to tolerating clearly predictable disadvantages. It belonged to the routine work of a person skilled in the art to decide under the given circumstances whether the potential advantage outweighed potential disadvantages and which of the potential disadvantages were acceptable. Inventive skills are not required in this respect.

In **T 867/13** the board pointed out that what the skilled person, starting from the closest prior art and faced with the objective technical problem, would or would not do depends

not solely on the disclosure of the closest prior art document, but also on the state of the art in the relevant technical field (see also **T 3016/18**).

In **T 1126/09** the board pointed out that, in accordance with the "could-would" approach, the assessment of inventive step must involve establishing, in each individual case, to what extent the skilled person had good reason, in the light of the closest state of the art or the objective problem derivable from it, to adduce further prior art and apply its teaching to the process/apparatus of the closest prior art – or, in other words, whether any factor is discernible which points towards a combination of the teachings of the citations addressed.

Technical feasibility and the absence of obstacles were only necessary requirements for reproducibility but were not sufficient to render obvious **what was actually achievable** for the skilled person (**T 61/90**). The fact that the inherent properties of a technical means were known to the skilled person, so that they had the intellectual possibility to apply this means in a conventional device, merely established the **possibility** of using such technical means in such a manner, i.e. that the skilled person **could** have used it. However, if it was to be established that such intellectual possibility was also a technical measure which it was obvious for the skilled person to use, it was necessary to show that there was a recognisable pointer in the state of the art to combine the known means and conventional device for achieving the intended technical aim, i.e. that the skilled person **would** have made such a combination. The existence of such a technical reason was dependent on the known properties not only of the means but also of those of the device (**T 203/93**, **T 280/95**). That it was theoretically possible for the skilled person to arrive at the invention simply means that they could have used the requisite technical means. If, however, it was to be established that the skilled person would actually have used them, it must be possible to ascertain a pointer in the prior art which would have prompted them to do so (**T 1317/08**).

In **T 905/17** the board did not find persuasive the opposition division's dismissal of a line of argument on the basis that there was no "hint in document D4 to suppress the liner (3) and then to search for appropriate material in the prior [sic] for the pressure armours (5,6) then subjected to corrosion". The skilled person starting from one element of the state of the art and faced with the need to solve a given problem did not necessarily need a "hint" associated with that element. Otherwise, it would never be possible to establish a lack of inventive step based on the object of a public prior use, which usually does not come with any hints. In the absence of a hint, the skilled person might still take the steps leading to the claimed subject-matter on the basis of their common general knowledge or documents belonging to the state of the art that explicitly teach a solution to the problem to be solved.

In **T 555/18** the board observed that when the only feature distinguishing the invention from the closest prior art was a range of an unusual parameter, the assessment of obviousness might be clouded by the fact that such parameters were by definition rarely described in the relevant prior art. The board concluded that in such circumstances a similar approach to that proposed in **T 131/03** and **T 740/01** should be applied to decide on the question of obviousness. In particular, once it had been established that it would be obvious for the skilled person to solve the underlying technical problem in ways that could be presumed to inherently lead to values within or close to the claimed range, it was the

proprietor who should carry the burden of proof to demonstrate that implementing such solutions would not lead to the claimed parametrical range. For more on the reversal of the burden of proof with regard to unusual parameters see chapter III.G.5.2.2d).

In **T 894/19** the board noted that in cases such as the case in hand, whereby the configuration of features represented a mere obvious and consequently non-inventive selection among a number of known and equally likely possibilities, the "could-would approach" normally did not apply (see also **T 1968/08**, **T 12/07**). It held that to consider all of the solutions that were equally obvious, it was sufficient that the skilled person could recognise the solutions concerned without inventive efforts: a separate pointer was then not required for this purpose.

In **T 3255/19** the board held that the person skilled in the art had **no reasonable expectation of success** that replacement of the asparaginase of document D8 by an asparaginase from Erwinia chrysanthemi having 90% identity to the amino acid sequence of SEQ ID NO:1 would yield a therapeutically active conjugate. The appellant's argument to the contrary did not take account of the unpredictability of the activity of the enzyme after pegylation.

In **T 1231/20** the board held that once a convincing argument had been made why the claimed invention would have been obvious to the skilled person, i.e. an obvious solution to an objective technical problem which could be assumed to have arisen, the identification of a different, more specific ("subjective") technical problem as a solution to which the claimed invention might not appear to be obvious did not suffice to invalidate the finding of obviousness.

In **T 149/22** the claimed invention foresaw the adding of phospholipase A to a cake batter to lower the amount of fat while preserving the resulting cake's properties. The board found that the arguments the skilled person would have arrived at the claimed solution without the need for an inventive step were based on cherry-picking and an oversimplified interpretation of the information presented in the cited documents. The ingredients of the batter could not be expected to have the same properties and be interchangeable; if a different enzyme were included in the batter, the complexity of the resulting system did not allow any reasonable prediction to be made on the properties of the obtained product. The opponent's arguments were thus tainted by hindsight.

In **T 1383/21** the board confirmed that a plurality of different features did not constitute inventive step if each feature was obvious in its own right even though each feature contributed independently of the others to solving the same problem (in this case making the apparatus more effective).

6. Ex post facto analysis

Many decisions of the boards of appeal warn against an ex post facto approach when assessing inventive step (see also the Guidelines G-VII, 8 – April 2025 version). This applies especially to inventions which at first sight seem obvious, to combination inventions and where the proposed solution is supposedly "simple". Correct application of

the problem-solution approach avoids this inadmissible ex post facto analysis which draws on knowledge of the invention (**T 24/81**, OJ 1983, 133; **T 564/89**; **T 645/92**; **T 795/93**).

When assessing inventive step, an interpretation of the prior art documents as influenced by the problem solved by the invention, where the problem was neither mentioned or even suggested in those documents, must be avoided, such an approach being merely the result of an a posteriori analysis (**T 5/81**, OJ 1982, 249; **T 63/97**, **T 170/97**, **T 414/98**, **T 2622/19**, **T 2004/21**).

In **T 970/00** the board stated that any ex post facto analysis, and in particular any conclusion going beyond what the skilled person would have objectively inferred from the prior art, without the benefit of hindsight knowledge of the invention, is of necessity at variance with a proper application of the problem-solution approach. Any attempt to interpret the disclosure of the closest prior art so as to distort or misrepresent, based on hindsight knowledge of the invention, the proper technical teaching of the disclosure in such a way that it artificially meets specific features recited in the claim under consideration must fail, especially as this would risk unfairly and tendentiously concealing the technical contribution of the invention and prejudice the subsequent objective determination of the technical problem solved by the claimed invention (see also **T 266/07**, **T 1486/10**).

In **T 2201/10**, the board found that the examining division had taken an ex-post-facto approach to analysing the facts. Even assuming that the proposed solution could be derived from common general knowledge, it went against the very essence of the teaching in the closest prior art and, therefore, would not realistically have been chosen. The problem-solution approach required that documents not relating to the technical field of the invention be disregarded, and it also precluded any analysis according to which the skilled person would have modified the closest prior art in a manner contrary to its very purpose. In other words, a finding that a claimed invention deviated from what was, in light of the aim pursued, the essence of a prior-art disclosure was enough by itself to conclude that it was inventive over that prior art (see also **T 2057/12**).

In **T 855/15** the board considered that for the assessment of obviousness a consideration as to what the skilled person would do, in particular whether the skilled person "would select" a particular document in order "to arrive at the invention as claimed" would amount to hindsight reasoning, because the skilled person would have to be assumed to know the invention before an argument could be made as to what they would do in order "to arrive at" it. The board in **T 2057/12** agreed with the board in **T 855/15** insofar as the closest prior art belonged to the same or a neighbouring technical field of the skilled person or to their common general knowledge. Argumentation or evidence should be provided as to why the skilled person in a specific technical field would have indeed envisaged selecting a document in a remote field of technology as closest prior art or whether they would indeed have considered adapting a prior-art disclosure originating from their technical field to implement it in a remote technical field.

In **T 1087/15** the board pointed out that knowledge of the claimed invention was absolutely necessary in order to formulate the objective technical problem, irrespective of how 'close' the prior art document was to the claimed invention; the features differentiating the claimed

subject-matter from the starting document must be identified, their technical effect determined and thus the problem to be solved formulated. In as far as such knowledge of the claimed invention was labelled as 'hindsight', this particular type of hindsight was indeed a necessity in order for the technical problem to be formulated on an objective basis. As long as there was no reason (primarily a technical reason) why the content of the document selected as the closest prior art would itself not be suitable or compatible for use with respect to the subject-matter claimed, any analysis of 'how close' the prior art starting document was judged to be to the claimed invention was not something which should exclude it from being the closest prior art.

In **T 1349/19** the board found that the appellant's (opponent's) arguments involved a **convoluted set of sequential steps** conceived starting from the compositions defined in claim 1 and working backwards, in an attempt to bridge the considerable gap with the composition described in D19 (closes prior art). Since these steps were not suggested by the prior art, they could only be taken by exercising hindsight. See also **T 1750/19** in which the board found the combination of incompatible prior art documents was only possible with hindsight, and **T 2643/16** of 16 February 2023 in which a necessary two-step combination of prior art documents was found to be based on hindsight, with numerous other instances of hindsight identified with regard to alternative combinations of prior art documents.

In **T 1126/19** the closest prior D1 disclosed a list of about 60 pharmaceutically acceptable salts of rucaparib that could be used in therapy, including camsylate, although this was not preferred. The invention was based on the finding that crystalline rucaparib camsylate was particularly suitable for the preparation of solid dosage forms. The board held that the starting point should be the whole list in D1 rather than the specific option of the camsylate salt. As explained in **T 970/00**, the disclosure of the closest prior art had to be considered on the basis of its technical information, without distorting or misrepresenting it by the knowledge of the invention. The isolation of one of the non-preferred options (camsylate) would distort the teaching of D1, putting an inappropriate weight on that option.

In **T 2196/21** the board defined the objective technical problem to be "how to enable a reliable verification of the warning messages of D9 at the receiving device in a bandwidth-efficient way". It found that D9 **taught away from the invention** and thus in order to arrive at the claimed invention, the skilled person would have had to dismiss the explicit teaching of this document and make impermissible use of hindsight. Thus the subject-matter of claim 1 involved an inventive step starting from D9.

In **T 1888/21** the board did not agree that in order to avoid hindsight an inventive-step analysis should necessarily start from the general teaching of a document as e.g. specified in the claims. This was case dependent. A preferred embodiment such as a specific example of a patent document which unambiguously described a combination of concrete and promising measures toward the achievement of the goals set out in the patent under examination constituted a realistic approach of the skilled person.

7. Expectation of success, especially in the field of genetic engineering and biotechnology

7.1. Reasonable expectation of success

In accordance with the case law of the boards of appeal, a course of action can be considered obvious within the meaning of Art. 56 EPC if the skilled person would have carried it out in expectation of some improvement or advantage (**T 2/83**, OJ 1984, 265). In other words, obviousness is not only at hand when the results are clearly predictable but also when there is a reasonable expectation of success (**T 149/93**). It is not necessary to establish that the success of an envisaged solution of a technical problem was predictable with certainty. In order to render a solution obvious it is sufficient to establish that the skilled person would have followed the teaching of the prior art with a reasonable expectation of success (**T 249/88**, **T 1053/93**, **T 318/02**, **T 1877/08**, **T 2168/11**, **T 867/13**, **T 3103/19**), which is to be assessed on a case-by-case basis.

In some decisions, especially in the field of biotechnology, the boards have asked whether in the cases in point it was obvious for the skilled person to try a suggested approach, route or method with a **reasonable expectation of success** (**T 60/89**, OJ 1992, 268). For more about biotechnological inventions and the definition of the skilled person, see also chapter I.D.8.1.4 below.

In **T 2168/11** the board referred to the case law, according to which the expectation of success depended on the complexity of the technical problem to be solved. While for very ambitious problems requiring the consideration of all the features relied on by the respondent (patent proprietor) but not contained in claim 1, important difficulties might be expected a priori, **less ambitious problems** might normally be associated with higher expectation of success (see **T 192/06**, **T 782/07**, **T 688/14**, **T 967/16**). In **T 967/16** the board found that the expectations of a skilled person for the value of the claimed correlation between the HLA-B*1502 allele and the adverse drug reaction SJS/TEN developed in response to, or associated with, the OXC or LIC treatment could be as high as 100% but also as low as 47% or even lower than those reported in document (4) for other aromatic anticonvulsants less, or not at all, related to CBZ. In this sense, the board found that the formulated technical problem was not very ambitious and thus, the skilled person had a high expectation of success.

In line with **T 918/01**, the board in **T 1577/11** concluded that, given the superior efficacy of anastrozole, as compared with tamoxifen, in treating advanced breast cancer, there was a reasonable expectation it would also improve the treatment of early breast cancer, as compared with that achieved with tamoxifen.

In **T 1680/17** the board considered that the skilled person would not have turned to formulations used in basic research when aiming at providing a formulation for therapeutic treatment. The requirements of a formulation to be used in basic research were fundamentally different from the requirements of a formulation to be administered to a patient.

In **T 96/20** the board considered that the announcement of a detailed safety and efficacy clinical trial protocol for a particular therapeutic and disease provided the skilled person with a reasonable expectation of the success of this particular therapeutic, unless there was evidence to the contrary in the state of the art. The board failed to see how the mere fact that no myasthenia gravis therapy had been approved for a long time would have diminished the expectation of success for the specific clinical trial disclosed in the prior art.

In **T 1941/21** the board noted that clinical trials were usually initiated on the basis of encouraging results from preclinical experiments. Thus, the announcement of a phase II clinical trial protocol for a particular therapeutic agent and a disease might provide the skilled person with a reasonable expectation of success. The board held, however, that such reasonable expectation of success was to be denied in a situation where a skilled person would have been discouraged from carrying out the clinical trials, such as when the state of the art provides the skilled person with reasons for not pursuing the solution envisaged in the clinical trial or provides the skilled person with an expectation of failure.

7.2. Obvious to try

In **T 296/93** the board held that, in relation to inventive step, the fact that other persons or teams were working contemporaneously on the same project might suggest that it was "**obvious to try**" or that it was an interesting area to explore, but it did not necessarily imply that there was a "reasonable expectation of success" (see also **T 187/93**). A reasonable expectation of success should not be confused with the understandable "hope to succeed"; it implied the ability of the skilled person to predict rationally, on the basis of the knowledge existing before a research project was started, the successful conclusion of the said project within acceptable time limits. The more unexplored a technical field of research was, the more difficult it was to make predictions about its successful conclusion and, consequently, the lower the expectation of success (**T 694/92**, OJ 1997, 408). According to **T 207/94** (OJ 1999, 273), the "hope to succeed" was merely the expression of a wish, whereas a "reasonable expectation of success" presupposed scientific appraisal of available facts.

In **T 223/92** the board said that in 1981, given the state of the art at that time, the skilled person would have opted for DNA-recombination technology only if relying, e.g., on their own good luck and inventiveness to overcome the known (and as yet unknown) problems involved, which would have caused the average skilled person to expect to fail.

In **T 923/92** (OJ 1996, 564) the board had to decide whether the skilled person would have attempted, with reasonable expectation of success, to produce cDNA coding for human t-PA, or whether in this instance they would have known from their technical knowledge, before even embarking on the research, that they would be able to complete their project within an acceptable time. The board bore in mind that, as stated in **T 816/90**, even when it was possible to theoretically conceive a straightforward approach to solve a specific technical problem, the skilled person might be confronted with unexpected difficulties when trying to put the conceived strategy into practice. The board stated that, although hoping to succeed, the skilled person embarking on this project would have known that its successful conclusion depended not only on technical skill in putting into practice the

sequence of precise steps of the theoretical experimental protocol, but to a large extent also on the ability to take the right decisions along the way whenever a difficult experimental situation so required. Under these circumstances, it could not be said that the skilled person had a reasonable expectation of success.

In **T 386/94** (OJ 1996, 658), again citing **T 816/90**, the board ruled that, in gene technology, inventive step could not be acknowledged if, at the priority date, a skilled person could expect to perform the cloning and expression of a gene in a fairly straightforward manner, and the cloning, although requiring much work, did not pose such problems as to prove that the expectation of success was ill-founded.

In **T 207/94** (OJ 1999, 273) the board held that where the expression of a cloned DNA in a chosen foreign host constituted the subject-matter of the claimed invention, the question whether a reasonable expectation of success existed or not could be evaluated only by taking into account real difficulties relating to that step. Thus, in order to be considered, any allegation that features jeopardised a reasonable expectation of success had to be based on technical facts.

7.3. Random techniques and elements of surprise

In **T 737/96** the board was of the opinion that it was not appropriate to attempt to evaluate the expectation of success of a **random technique** such as mutagenesis where results depended on chance events. This was because the skilled person knew that, unless a specific selection method could be developed, which was not the case in the patent in suit, perseverance and chance played a key role in achieving success, as no form of control could be exerted over the mutation events. Under these circumstances, as in a lottery game, the expectation of success always ranged irrationally from nil to high, so it could not be evaluated in a rational manner based on technical facts (see also **T 645/02, T 694/92**, OJ 1997, 408).

In **T 1231/01** the board held that the isolation of a specific virus strain useful for a defined purpose was a **technique of random nature**. The skilled person trying to solve this problem, having from nil to high expectations, had to expect a large number of failed attempts. In such technical circumstances, it was the actual isolation of a virus indeed having the desired characteristics which was surprising. The board came to the decision that the isolation of the specific viruses of claim 1, which could efficaciously be used as vaccines against PRRS, contained elements of surprise which justified the recognition of an inventive step.

In **T 775/08** the board held that in line with the above case law concerning the use of random methods, the actual isolation in the case in hand of a glyphosate tolerant alfalfa plant having the desired properties and containing **elements of surprise might justify the recognition of an inventive step**. The question was whether the claimed glyphosate tolerant alfalfa event contained these elements of surprise or not. See also **T 2239/08** and **T 915/10**. In **T 3103/19** the board found that there were no elements of surprise in the sense outlined in the above case law and thus the relevant subject-matter did not involve an inventive step.

7.4. Try and see situation

When neither the implementation nor the testing of an approach suggested by the prior art involves any particular technical difficulties, the consideration that the skilled person would have at least adopted a "try and see" attitude is a reason for denying inventive step (see e.g. **T 333/97**, **T 377/95** of 24 April 2001, **T 1045/98**, **T 1396/06**, **T 2168/11**). In such situations the concept of "reasonable expectation of success" does not apply (**T 91/98**, **T 293/07**, **T 688/14**, **T 259/15**). The skilled person would prefer to verify whether the potential solution they had conceived worked, rather than abandon the project because success was not certain ("try and see" approach).

A "try and see" situation was considered to have occurred if the skilled person, in view of the teaching in the prior art, had already clearly envisaged a group of compounds or a compound and then determined by routine tests whether such compound/s had the desired effect (**T 889/02**, **T 542/03**, **T 1241/03**, **T 1599/06**, **T 1364/08**). See also in this chapter I.D.9.21.7. "Enhanced effect".

In **T 1396/06** the board held that, in spite of the understandable uncertainties which always characterise biological experiments, the skilled person would have had no reason to adopt a sceptical attitude in the case in hand. The skilled person would have had either some expectations of success or, at worst, no particular expectations of any sort, but only a "try and see" attitude, which does not equate with an absence of a reasonable expectation of success (see also **T 759/03**).

In **T 293/07** the board stated that the testing of humans could not be considered to represent known routine tests and accordingly the skilled person was not in a "try and see" situation. In **T 847/07** the board considered it questionable whether the skilled person would adopt a "try and see" attitude at all in cases where extensive in vivo animal and ultimately human testing would be necessary in order to determine whether or not a compound has a certain property. See also **T 1545/08**. In **T 1011/17** the board found that more extensive studies would have been required to confirm the efficacy of bosutinib in human leukemia patients with imatinib-resistant cancer cells carrying the F317L mutation. In this context, the person skilled in the art would no longer have been in a "try-and-see" situation but would have required a reasonable expectation of success as an incentive for moving to further much more extensive and larger studies in a clinical setting.

In **T 62/16** the board pointed out that the skilled person assessing the possibility of starting a clinical study with a product that had never been tested on humans would have a conservative attitude. During the development of a new pharmaceutical product for use in humans there would always be the necessity, at some point, to make the step from experimentation with animal models to experimentation with humans. This step would necessarily involve some degree of uncertainty. Whether or not the skilled person would decide to start a clinical study with the product in question was a matter that had to be decided in the circumstances of each case.

In **T 259/15** the board held that the case law did not support the conclusion that the skilled person would systematically avoid a "try-and-see" approach whenever testing on human

patients was involved, regardless of the circumstances of the case. In the circumstances of the case in hand, the board considered that the skilled person would test the device in question (a buprenorphine transdermal patch) on human subjects despite the uncertainties as to the maximum duration of application.

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

In **T 688/14** appellant I argued that the skilled person would have adopted a sceptical attitude and not a "try and see" attitude. The board disagreed. Document 8 not only informed the skilled person of the presence of several problems when trying the method in question but it also provided means and measures to overcome them. Indeed, these problems were already known in the art and means and measures to solve them were also provided there. There was no reason for a person skilled in the art to ignore all the information to hand and select the worst possible known system or method when facing a "try and see" situation. The board held that it was worth noting that, in the case in hand, the skilled person was not looking for an improvement or a surprisingly advantageous effect, but only for an alternative method.

In **T 1715/15** the board found that the person skilled in the art could be both regarded as being cautious and of a conservative attitude (see I.D.8.1.3) but also tasked with the furthering of the prior art by routine adaptations or trials (see also **T 688/14**, **T 2697/16** and **T 1289/22**).

In **T 2015/20** the board was of the opinion that the defined subject-matter of claim 1 was not the obvious result of routine experimentation, but rather represented the unexpected outcome of a study for finding an aclidinium dose for treatment of a chronic disease which combined optimised effectiveness with the absence of side-effects. The board thus concluded that the subject-matter of claim 1 involved an inventive step. See also chapter I.D.10.8 "Unexpected bonus effect".

In **T 3016/18** the board said that a skilled person could theoretically replace a given layer of a layered composite with any randomly chosen alternative layer. However, they would only consider this as a "try and see" option within the context of their usual routine approach if the possible alternative layers were known to provide the desired functionality of the layer to be replaced. This condition was however not met in the case in question.

In **T 2695/18** the board disagreed that the skilled person combining the teaching of document D1 with either D3 or D17 was at least in a "try-and-see" situation, such that the skilled person would inevitably have arrived at the claimed subject-matter. There was **no pointer** in any of the available documents; none of the prior art teachings clearly envisaged a way of proceeding in the light of the problem to be solved; the skilled person was not in the position to verify prior art teachings by routine methods because Mn**(2+)'s dose effect on increasing sialylation was not known and therefore this one way among the many possible ways of solving the problem was not foreshadowed.

In **T 2565/19** the board stated that in the case in hand the importance of research on humans in a medical context would have led the skilled person to repeat the experiments done in rats in document D2 in humans, even in the face of alternative explanations for the results and even in the face of the knowledge that only one type of TRH receptor had been found in humans. The board accepted it was common knowledge in the art that working with post-mortem human tissue and brain tissue in particular was associated with particular practical problems. However, given that the skilled person was seeking to replicate an animal model in humans, they had no choice but to turn to human tissue.

Decisions **T 455/91** (OJ 1995, 684), **T 412/93**, **T 915/93**, **T 63/94**, **T 856/94**, **T 91/98**, **T 111/00** and **T 948/01** also consider this topic.

8. Skilled person

8.1. Definition of the skilled person

8.1.1 Definition

According to the case law of the boards of appeal (see e.g. **T 1787/20**), the person skilled in the art should be presumed to be an **experienced practitioner who has average knowledge and abilities** and who is aware of what the common general knowledge was in the relevant art concerned at a particular time (average skilled person). The skilled person should also be **presumed to have had access to everything in the state of the art**, in particular the documents cited in the search report, and to have had at their disposal the normal means and capacity for routine work and experimentation (Guidelines G-VII, 3 – April 2025 version). The skilled person will be an **expert in a technical field** (**T 641/00**, OJ 2003, 352). The board in **T 39/93** (OJ 1997, 134) held that, whilst generally accepted definitions of the notional "person skilled in the art" did not always use identical language to define the qualities of such a person, they had one thing in common, namely that none of them suggested the skilled person was possessed of any inventive capability. It was the presence of such capability in the inventor which set them apart from the notional skilled person.

In **T 1462/14** the board noted that the skilled person was **a notional entity** that had been elaborated on by the case law of the boards of appeal in order to serve as an objective reference when deciding on various issues under the EPC. This notional person could not be equated with any real person in the technical field of the invention. Neither an inventor,

nor an opponent, nor an examiner, nor a member of a board of appeal, could be equated with the skilled person. This also applied to a representative.

With regard to the definition of the skilled person, the board in **T 26/98** summarised the following principles which are generally applied by the boards of appeal: if the problem prompts the skilled person to seek its solution in another technical field, the specialist in that field is the person qualified to solve the problem (confirmed in **T 1523/11**, see also **T 1787/20**). The assessment of whether the solution involves an inventive step must therefore be based on that specialist's knowledge and ability (see decision **T 32/81**, OJ 1982, 225; **T 141/87**; **T 604/89** of 15 November 1990; **T 321/92**; see also chapter I.D.8.3). The skilled person can also be expected to look for suggestions in neighbouring fields if the same or similar problems arise in such fields if they are aware of them (see chapter I.D.8.2). The skilled person can be expected to look for suggestions in a general technical field if he is aware of such fields. In advanced technical fields the competent "skilled person" could be taken to be a team of experts from the relevant technical branches (see chapter I.D.8.1.3). Solutions to general technical problems in non-specific (general) fields are considered to form part of the general technical knowledge (see chapters I.D.8.2 and I.D.8.3).

It is further established case law that it is the normal task of a skilled person working in a certain field not to remain inactive but to seek alternatives, to be constantly occupied with the elimination of deficiencies, with the overcoming of drawbacks and with the achievement of improvements of known devices and/or products (**T 867/11**; see also amongst others **T 455/91**, OJ 1995, 684; **T 1102/00**, **T 247/11**).

In **T 1030/06** the application related to a system and method for securely buffering content. The board considered that the skilled person was a person of ordinary skill in the art which meant not only having access to the state of the art and common general knowledge in the field, but also the capability to perform routine work and experimentation. Thus, the skilled person could be expected to seek out solutions and make choices to try to solve design problems that crop up.

According to the board in **T 1761/12**, the position that the problem-solution approach developed through the boards' case law did not allow for considering whether or not it was necessary to retain features not differing from the closest prior art was too formalistic. Over and above the lack of imagination widely attributed to the skilled person, this position also seemed to deny them the capacity to draw conclusions from information obtained direct from the prior art.

According to **T 422/93** (OJ 1997, 25), when examining for inventive step using the "problem and solution approach", the starting point for defining the appropriate skilled person was the technical problem to be solved on the basis of what the prior art disclosed, irrespective of any other definition of the skilled person suggested in the contested patent. Since the technical problem addressed by an invention had to be so formulated as not to anticipate the solution, the skilled person to be considered could not be the appropriate expert in the technical field to which the proposed solution belonged if this technical field was different to the one considered when formulating the technical problem. Nor did the

appropriate skilled person's basic knowledge include that of a specialist in the different technical field to which the proposed solution belonged, if the closest prior art gave no indication that the solution was to be sought in this other technical field.

In **T 25/13** the board stated that opponents were essentially free to choose the starting point for assessment (here D4), but their choice then had implications for the technical knowledge of the relevant skilled person. The board concluded that there were two options: either to take the skilled person in the field of the invention (motor vehicle) – who would never have consulted D4 (tumble dryers) because it was from a totally different field – or to take D4 as the starting point, in which case the skilled person's field would be domestic appliances and the solution would not be obvious to them.

In **T 1924/20** the board highlighted that the **description and drawings** were typically used by the deciding body to determine the "skilled reader" and, hence, the viewpoint from which the claims are interpreted. See also II.A.6. "Interpretation of claims".

8.1.2 Point at which the skilled person enters the stage

In **T 1450/16** the board's view, following the conclusions drawn in **T 422/93**, was that the person skilled in the art within the meaning of Art. 56 EPC entered the stage only when the objective technical problem had already been formulated. Thus, the skilled person under Art. 56 EPC was the person qualified to solve the established objective technical problem (see also e.g. **T 32/81**, OJ 1982, 225; **T 26/98**; **T 1523/11**, **T 154/17**) and not necessarily the person versed in the field of the underlying application or in the field of the selected closest prior art.

The board in **T 2759/17** stated however, that, in line with the established case law, the skilled person was the relevant point of reference right from the start of any inventive-step assessment.

See also the case law in chapter I.D.3.2.

8.1.3 Competent skilled person – group of people as "skilled person"

Sometimes the "skilled person" may be a group of people, such as a research or production team. For the purposes of Art. 56 EPC 1973, the person skilled in the art was normally not assumed to be aware of patent or technical literature in a remote technical field. In appropriate circumstances, however, the knowledge of a team consisting of persons having different areas of expertise could be taken into account (**T 141/87**, **T 99/89**, **T 26/98**). This would be the case in particular if an expert in one particular field was appropriate for solving one part of the problem, while for another part one would need to look to another expert in a different area (**T 986/96**).

In **T 15/15** the board held that where a new technology was about to spread into a traditional field, it was common practice to group people from both technical fields into a development team. The board was thus of the opinion that the skilled person in the case in hand consisted of a team of an orthodontist and an expert in CAD/CAM technology. This

conclusion was drawn from the situation in the field before the filing/priority date, without considering any specific invention.

In **T 164/92** (OJ 1995, 305, Corr. 387) it was observed that sometimes the average skilled person in electronics, particularly if they did not have an adequate knowledge of programming languages themselves, might be expected to consult a computer programmer if a publication contained sufficient indications that further details of the facts described therein were to be found in a program listing attached as an annex thereto.

In **T 147/02** the board observed that the skilled person in the field of drainage systems for tunnels, flood barriers, dams and hydro-electric installations, was typically an engineer or architect in the civil engineering sector who drew up plans and supervised the building work, frequently working in a team with other specialists (**T 460/87**, **T 99/89**).

Further comments on the concept of the "team of experts" are to be found in the following decisions: **T 57/86**, **T 222/86** (in advanced laser technology, the "skilled person" as a production team of three experts in physics, electronics and chemistry respectively), **T 141/87**, **T 295/88**, **T 424/90** (consideration that in real life the semiconductor expert would consult a plasma specialist), **T 825/93**, **T 2/94**, **T 402/95** and **T 986/96** (team consisting of a first expert in the field of mail processing and a second expert acquainted with information in the field of weighing) and **T 2192/10** (team comprising a machine designer and an actuator technician). In **T 2803/18** the board found the skilled person may also be considered as a team of skilled persons knowledgeable in the fields of absorbent articles and mathematics.

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

The person skilled in the art in the field of biotechnology is well defined by the case law of the boards of appeal. The skilled person's attitude is considered to be conservative. However, this must not be seen in the sense of being reluctant or opposed to modify or adjust a known product or process, but rather in the sense of being cautious. The skilled person would never go against an established prejudice, nor try to enter into "sacrosanct" or unpredictable areas nor take incalculable risks. However, they would readily seek appropriate, manifest changes, modifications or adjustments which involved little trouble or work and no risks or only calculable risks, especially for the sake of obtaining a more handy or convenient product or of simplifying a procedure. In particular the skilled person would perform a transfer of technology from a neighbouring field to their specific field of interest, if this transfer appeared to be easy and to involve no obvious risks, for example involving routine experimental work comprising only routine trials (**T 455/91**, OJ 1995, 684; see also **T 500/91**, **T 387/94**, **T 441/93**, **T 1102/00**, **T 867/13**). If, on the other hand, the skilled person would expect to have to perform scientific research rather than routine work in order to transfer a technology previously set up in one field of research to a neighbouring field, then inventive step could be acknowledged (**T 441/93**).

From the notional skilled person nothing more can be expected than the carrying out of experimental work by routine means within the framework of the normal practice of filling

gaps in knowledge by the application of existing knowledge (**T 886/91**, **T 223/92**, **T 530/95**, **T 791/96**).

In **T 60/89** (OJ 1992, 268) the board took the view that the skilled person in genetic engineering in 1978 could not be defined as a Nobel prize winner, even if a number of scientists working in this field at that time actually had been awarded that prize. Rather the skilled person should be assumed to be a scientist (or team of scientists) working as a teacher or researcher in the laboratories which made the transition from molecular genetics to genetic engineering at that time. See also **T 500/91**, in which the board ruled that the development of the art normally expected by the notionally skilled person – who may be represented by a team of appropriate specialists (**T 141/87**) – did not include solving technical problems by performing scientific research in areas not yet explored (see also **T 441/93**).

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

In **T 207/94** (OJ 1999, 273) the board stated that it had to be assumed that the average skilled person would not engage in creative thinking. Yet the average skilled person could be expected to react in a way common to all skilled persons at any time, namely that an assumption or hypothesis about a possible obstacle to the successful realisation of a project must always be based on facts. Thus, in the board's view, an absence of evidence that a given feature might be an obstacle to carrying out an invention would not be taken as an indication that this invention could not be achieved, nor that it could.

In **T 455/91** (OJ 1995, 684) the board held that the skilled person in this field was well aware that even a small structural change in a product (e.g. a vector, protein, or DNA sequence) or procedure (e.g. a purification process) could produce dramatic functional changes. Therefore, the skilled person would constantly be conditioned by the prior art and, before taking action, would carefully ponder any possible modification, change or adjustment against the background of the existing knowledge. See also **T 867/13**.

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

The board in **T 387/94** distinguished **T 455/91**, in which the modification necessary was small and the neighbouring fields were very close. In the case in hand the technical situation was much less well defined. Little information was available at the relevant priority date on the mechanisms of gene expression in plant and animal cells and the implications of this knowledge in the case where the genes to be expressed were not an intrinsic part of the genomes of said cells had not been researched. The reasoning used in decision **T 455/91** could not therefore be applied.

In **T 493/01** the invention related to a protective antigen potentially useful in a vaccine against whooping cough. The board noted that in **T 455/91** (OJ 1995, 684) the skilled person in the field of biotechnology had already been defined as being cautious and conservative. The board said this did not mean her skilled person would refrain from considering information because it did not concern the mainstream of research in their field of specialisation or because it applied only to some parts of the world. The skilled person's skill and knowledge were not geographically limited; in fact they would have a global point of view. Thus if, as in the case in point, a pathogen constituted a known threat in some restricted parts of the world, the skilled person would not refrain from taking prior knowledge about that pathogen into consideration or from using it as a basis for their activities.

In **T 867/13**, in the board's view, it was not conceivable that in the case of the treatment of a potentially lethal disease the motivation of the skilled person to search for further - or alternative - treatments stopped solely because one treatment existed, even if it was perceived as satisfactory at the time.

8.1.5 Identification of the skilled person in the case of computer-implemented inventions

In **T 641/00** (OJ 2003, 352) the board stated that the identification of the skilled person needed careful consideration. The skilled person would be an **expert in a technical field**. If the technical problem concerned a computer implementation of a business, actuarial or accountancy system, they would be someone skilled in data processing, and not merely a businessman, actuary or accountant (**T 172/03**).

In **T 531/03** the patentee submitted that the invention at issue required a combination of a technical and a non-technical inventive step, and that the skilled persons would therefore consist of a team of a "non-technical person" plus a technical person. The board rejected this approach and stated that an attempt to take into account the contribution of non-technical and technical aspects on an equal footing in the assessment of inventive step would be inconsistent with the EPC, since the presence of inventive step would, in such an approach, be attributed to features which were defined in the EPC as not being an invention.

The board in **T 407/11** held that the relevant skilled person in the context of providing computer-system users with operating assistance via a user interface (e.g. error messages or warnings) was an expert in software ergonomics concerned with the user-friendliness of human-machine interfaces rather than an expert in software programming or in computer technology in the strict sense.

8.2. Related technical fields (neighbouring fields)

Two landmark decisions, **T 176/84** (OJ 1986, 50) and **T 195/84** (OJ 1986, 121) addressed in detail the problem of the relevant technical field, i.e. the question of the extent to which neighbouring areas beyond the specific field of the application might be taken into consideration when assessing inventive step. According to **T 176/84** the state of the art to be considered when examining for inventive step includes, as well as that in the specific field of the application, the state of any relevant art in neighbouring fields and/or a broader general field of which the specific field is part, that is to say any field in which the same problem or one similar to it arises and of which the person skilled in the art of the specific field must be expected to be aware. The board in **T 195/84** added that the state of the art to be considered included that in a non-specific (general) field dealing with the solution of any general technical problem which the application sought to solve in its specific field. Such solutions of general technical problems in non-specific (general) fields had to be considered as forming part of the general technical knowledge which a priori was to be attributed to those skilled persons versed in any specific technical field. These principles have been applied in a large number of decisions.

In **T 560/89** (OJ 1992, 725) the board took the view that the skilled person would also draw on prior art in other fields which were neither neighbouring nor broader general fields, if prompted to do so because the materials used were related or because of public debate about a technical problem common to both fields. Expanding on this, **T 955/90** added that, in practice, the person skilled in a broader general field would also draw on the narrower, more specialised field of the known main application of the general technology in search of a solution to a problem lying outside the special application of that technology (**T 379/96**).

In **T 454/87** the board expressed the opinion that a skilled person specialising in a particular technical field (gas chromatography equipment) would, in the course of their normal professional activity, also observe developments in equipment used in a related technical field (absorption spectral analysis).

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

In **T 1910/11** the board stated that, whether the prior art and the claimed invention belonged to neighbouring technical fields within the meaning of **T 176/84** was less a question of whether the relevant implementation parameters were identical than a question of the degree of similarity between the respective problems, boundary conditions and functional concepts. Applying this to the case in hand, it observed that automotive electronics and avionics were traditionally considered to be neighbouring technical fields because they involved similar problems (e.g. interference resistance, robustness and reliability), boundary conditions (e.g. mobility) and functional concepts (e.g.

physical/logical separation of the communications systems for safety and maintenance data in the vehicle).

In **T 767/89**, regarding carpets, the board ruled that wigs were neither a neighbouring technical field nor a broader general one which included the former field. So wigs were not a related technical field in which the person skilled in carpets would have been prompted to seek solutions. The two inventions addressed different problems; the user requirements were not comparable.

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

Further comments on the concept of relevant field are to be found in several other decisions, including the following: **T 277/90** (in dentistry, moulding technology and prosthodontics are neighbouring technical fields), **T 358/90** (discharging the content of a portable toilet did not lead the skilled person to the field of filling a tank of a chain saw by means of a special kind of container), **T 1037/92** (a person skilled in the art of making fuse links for programmable ROMs would also have consulted the documentation in the field of ultraminiaturised integrated switches), **T 838/95** (the pharmaceutical and cosmetic fields were immediate neighbours), **T 26/98** (the board did not consider the field of electrochemical generators to be a neighbouring field of iontophoresis because, though both fields relied on electrochemical processes, such processes had substantially different purposes and applications and, consequently, had to satisfy different requirements), **T 1202/02** (the manufacture of mineral fibres and that of glass fibres were two closely related technical fields irrespective of differences between the raw materials respectively used), **T 47/91** (casting rolls and casting wheels when continuously casting molten metal represent neighbouring technical fields).

In **T 244/91** the board found the person skilled in the art of heat exchangers would take account of publication D3 on "gaskets of plate heat exchangers", or would at least consult a specialist in the non-specific field of gaskets who must be expected to be familiar with such standard literature.

In **T 1154/16** the board found that the disclosures of D9 and D19 in the case in hand could not be considered to be in a neighbouring field to that of shoe press belts for papermaking, but that they did form part of a broader, general field, relating to the general use of polyurethanes in dynamic mechanical applications solving similar problems to the current case. Therefore the skilled person would consider the disclosure of both documents.

In **T 1979/18** the board found that while it was true that agricultural engineering may combine (depending on the particular application) with a wide variety of other disciplines such as civil, chemical, mechanical, bio-systems, and environmental engineering, this did not mean that the skilled person was therefore also fully knowledgeable in those fields.

In **T 28/87** (OJ 1989, 383) the board held that if reference was made in the introduction to the description of an application or a patent to a state of the art which could not objectively

be classified as a relevant field, that state of the art could not in the course of examination for patentability be applied to the applicant's or patent proprietor's disadvantage as a neighbouring field merely on account of that reference.

In **T 1731/20** the board found that motor vehicle engines was not a neighbouring technical field of food processing machinery because the latter was undisputedly powered by electric or pneumatic motors while motor vehicles were powered by combustion engines. Further, a single technical book within the narrow technical area of vehicle electronics was not adequate proof that reducing the range of combustion motors to just one motor used with various data records was a general solution to a general technical problem. The board added that a skilled person who used a specific device such as a motor vehicle in an everyday way did not possess extensive knowledge in this area by virtue of such use. Their knowledge was that of an average user of motor vehicles, familiar with the general workings and structure of motor vehicles but unfamiliar with production or marketing aspects of the combustion engine variants used. The board therefore made a distinction between the case at hand and decisions **T 560/89**, **T 176/84** and **T 195/84**.

In **T 1787/20** the board was not convinced that the area in question was the area of cartridges. There was no distinct technical area covering every possible type of cartridge because cartridges were used for all kinds of applications. They were used, for example, for ammunition, toner and flammable gas, although the cartridge sizes, material and requirements differed for each of these examples. In the board's view, the skilled person was given no indication in the case at hand to look for the solution in a technical area other than the area of water-guiding household devices, making that the area in which the person was to be regarded as being skilled. See also parallel proceedings **T 1797/20**.

8.3. Skilled person – level of knowledge

8.3.1 In general

Inventive step has to be assessed on the basis of the skilled person's knowledge before the priority or filing date (see **T 268/89**, OJ 1994, 50; **T 365/89**). The same level of skill has to be applied when, for the same invention, the two questions of sufficient disclosure and inventive step have to be considered (**T 60/89**, OJ 1992, 268; **T 373/94**, **T 99/14**, **T 1861/16**, see also chapter II.C.4.1 "The disclosure is aimed at the skilled person"). In **T 694/92** (OJ 1997, 408) the board added that, although the same level of skill is applied for both Art. 56 and Art. 83 EPC 1973, the two starting points differ; for inventive step purposes, the skilled person knows only the prior art; for sufficiency of disclosure, they know the prior art **and** the disclosed invention.

In **T 2039/18** the board found that the skilled person's ability to reproduce an invention based on the information in the contested patent and common general knowledge was completely unrelated to whether its subject-matter was obvious to the skilled person in view of the state of the art. In an assessment of inventive step, the person needed not only to possess the appropriate ability: there also had to be a reason for the measure. This reason was one that should not be construed retrospectively (see chapter I.D.6. "Ex post

facto analysis"). It was not justified in the board's view to attach equal weight to the requirements of Art. 83 and 56 EPC in this context.

8.3.2 Awareness of the totality of the pertinent prior art

In **T 1464/05** the board stated that, according to established doctrine, the notional person skilled in the art referred to in Art. 56 EPC 1973 was assumed to be aware of the totality of the prior art pertinent to the relevant area of technology and in particular of everything made available to the public within the meaning of Art. 54(2) EPC 1973. The different means by which the state of the art was made available to the public ranked equally with each other. The notional skilled person was supposed to be aware of all the features of the prior use in suit that had been made available to the public. Thus, although it would be unrealistic to assume that all skilled members of the interested public would have been aware of the features made available to the public by the prior use, the notion of the skilled person under Art. 56 EPC 1973 ensured that any obvious development or application of the features of the public prior use by any particular skilled member of the interested public who had gained information on the features made available to the public by the prior use was treated under Art. 56 EPC 1973 as such, i.e. as obvious with regard to the state of the art, irrespective of whether or not other members of the interested public had actually become aware of the features of the prior use.

8.3.3 Textbooks, technical literature and common knowledge

In **T 426/88** (OJ 1992, 427) the board held that a book providing general teaching in a general technical field covering the invention's specific technical field was part of the general knowledge of a specialist in that specific technical field. When books, representing common general knowledge, described a basic general technical theory or methodology and exemplified the same with specific applications in certain technical fields only, these did not limit the general scope and relevance of such disclosures so as to exclude possible applications in other fields. The appellant had argued that the book, written in German, was not a general reference book consulted by experts in that field in Great Britain. The board, however, adhered to the definition of the state of the art given in Art. 54 EPC 1973, according to which no account was taken of the location at which the skilled person exercised their profession. It was also of the view that the language of publication alone could not be decisive for the admissibility of a technical book representing the common general knowledge of the skilled person (see also **T 1688/08**). In **T 2058/18** the board found that the (technically) skilled person might be considered a multilingual person but not normally a linguist (see also **T 532/20**).

In **T 766/91** the board pointed out that information did not usually become common knowledge through publication in a given handbook or textbook; rather it appeared in handbooks or textbooks because it was already common knowledge. For this reason, publication in an encyclopaedia, say, could normally be taken as proof that the information was not only known but was common general knowledge. In **T 378/93** the board added that the same applied to articles in scientific periodicals addressed primarily to qualified professionals and enjoying worldwide repute. In **T 537/90** the board held that numerous publications in the specialist press over a fairly short time, reporting on meetings and

research in a particularly active field of technology, could reflect common general knowledge in this field at that time. The board noted further in **T 890/02** (OJ 2005, 497), that the skills of the skilled person included not only basic general knowledge of a particular field of technology, but also the ability to look up such knowledge in encyclopaedias and handbooks as well as, in exceptional cases, in a series of relevant studies, or in a scientific publication or a patent specification.

The board in **T 1255/21** held that in a fast-moving field such as medical research, and in particular the field of oncology, review articles could be considered to reflect the skilled person's common general knowledge.

8.3.4 Common general knowledge in general

In **T 206/83** (OJ 1987, 5) the board pointed out that normally patent specifications were not part of common general knowledge. In **T 1540/14** the board held that the common general knowledge of the skilled person was not normally established on the basis of the content of patent documents (see also e.g. **T 671/94**).

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

In **T 939/92** (OJ 1996, 309) it was explained that the state of the art could also perfectly well reside solely in the relevant common general knowledge, which, in turn, need not necessarily be in writing, i.e. in textbooks or the like, but might simply be a part of the unwritten "mental furniture" of the average skilled person. In the case of any dispute, however, the extent of the relevant common general knowledge had to be proven, e.g. by documentary or oral evidence.

It has been emphasised in several decision that the assertion that something was part of the common general knowledge needed only to be substantiated if challenged by another party or the EPO (see e.g. **T 766/91**, **T 234/93**). Where an assertion that something was part of the common general knowledge is challenged, the person making the assertion must provide proof that the alleged subject-matter indeed forms part of the common general knowledge (**T 766/91**; **T 939/92**, OJ 1996, 309; **T 329/04**; **T 941/04**; **T 690/06**).

In **T 1601/15** the board held that the skilled person did not need prompting to apply their knowledge. It was not convinced by the argument that the skilled person would have had no reason to draw upon it. The skilled person did not need a reason to apply their knowledge. This knowledge formed, as it were, the technical background for any activities they performed and fed into all their decisions. In this regard, a distinction had to be made between the common general knowledge in the art and the teaching of specialist documents.

In **T 1520/19** the board held that it was appropriate, at least until the skilled person's qualifications were challenged, that in proceedings before the EPO the skilled person was

often left undefined as long as their skills and knowledge were implied by the circumstances or the reasoning provided. It was in most cases pointless to fix the academic degree of the skilled person, unless attributing any specifically relevant, and controversial skill or common general knowledge to the skilled person depended on such detail. What exactly it required to establish any controversial qualification of the skilled person would depend on the case at issue. In the case in hand the board doubted that the qualification "Ph.D." level provided a practicable definition of a skilled person, and considered that appreciation of the application was possible for a person with the relevant practical experience in the art as proposed by the appellant.

8.3.5 Technical field

In **T 422/93** (OJ 1997, 25), the board held that since the technical problem addressed by an invention had to be so formulated as not to anticipate the solution, the skilled person to be considered could not be the appropriate expert in the technical field to which the proposed solution belonged if this technical field was different to the one considered when formulating the technical problem. Nor did the appropriate skilled person's basic knowledge include that of a specialist in the different technical field to which the proposed solution belonged, if the closest prior art gave no indication that the solution was to be sought in this other technical field.

In **T 984/15** the board recalled that the technical field and general knowledge associated with the notional skilled person within the meaning of Art. 56 EPC should be defined on the basis of the objective technical problem to be solved by that skilled person in the framework of the problem-solution approach. This was because the skilled person under Art. 56 EPC is the person qualified to solve the established objective technical problem (see e.g. **T 32/81**, OJ 1982, 225; **T 422/93**, OJ 1997, 25; **T 1140/09**; **T 1523/11**; **T 1450/16**).

8.3.6 Other

In **T 632/10** the board pointed out that even if an invention happened to be obvious only for skilled persons of German nationality or residence, it would still lack an inventive step within the meaning of Art. 56 EPC 1973. The fact that the German Signature Law (SigV) was valid only within Germany thus had no bearing on its status as prior art or its relevance for the assessment of inventive step outside Germany.

8.4. Everyday items from a different technical field

In **T 1043/98** the patent concerned an inflatable gas-bag for a vehicle restraint system, one part being club-shaped and the other generally butterfly-shaped. According to the appellant, the skilled person would immediately arrive at the claimed gas-bag from their knowledge of tennis-ball or baseball construction. This raised the issue of the application of features or solutions drawn from another technical field but which could be considered "everyday items".

In **T 397/87** the board had already pointed out that there was no obvious reason why a skilled person trying to solve a non-trivial problem should have been led to the claimed process by simple examples from everyday life which were unrelated to the problem in question. In **T 349/96**, too, the board was unable to see why the fact that different transport containers were used for beer bottles in an everyday context should prompt a skilled person to invent a spinning/winding machine combination with an integrated transport system even if the many citations from the relevant technical field were unable to do this (see also **T 234/91**).

In **T 234/96**, however, the board concurred with the examining division's view that the skilled person dealing with the practicalities of motorising a dispenser drawer for washing powder had in mind as a model the disc tray of a CD player with push-button electromotor operation, which, at the time of filing the application, was familiar to anyone and which therefore suggested the subject-matter of claim 1. In the board's view, the fact that washing machines and CD players were intrinsically different items serving different purposes did not suffice to prevent the skilled person concerned with the construction of washing machines from taking into consideration the basic principle of automatic tray operation in CD players when designing a dispenser drawer for washing powder.

From a comparison of the above-mentioned decisions, the board in **T 1043/98** concluded that the relevance of such items for inventive step depended very much on the circumstances of the individual case. It agreed that persons skilled in developing the gas-bags in question would include tennis or baseball players. It could not, however, share the appellant's view that to solve the problem addressed by the invention the skilled person would draw on what they might know about tennis-ball or baseball construction. The main reason was that the gas-bag was not intended to be spherical in shape. It was therefore unlikely that the skilled person would take as their starting point an object which was the epitome of a sphere (see **T 477/96**, where the board also concluded that everyday experience was not relevant to the technical field of the invention).

9. Assessment of inventive step

9.1. Assessment of inventive step in the case of mixed-type inventions

The case law of the boards of appeal on the assessment of inventive step in cases where the invention consisted of a mix of technical and non-technical features is as follows: It is legitimate to have a mix of technical and "non-technical" features appearing in a claim, in which the non-technical features may even form a dominating part of the claimed subject-matter. Novelty and inventive step, however, can be based only on technical features, which therefore have to be clearly defined in the claim (**T 641/00**, OJ 2003, 352; **T 154/04**, OJ 2008, 46; **G 3/08**, OJ 2011, 10; **T 116/06**; **T 1769/10**; **T 209/91**; as similarly held in the earlier **T 26/86**).

Inventive step can therefore be based only on technical features. Non-technical features, to the extent that they do not interact with the technical subject-matter of the claim for solving a technical problem, i.e. non-technical features "as such", do not provide a technical contribution to the prior art and are thus ignored in assessing novelty and

inventive step (**T 641/00**, OJ 2003, 352; **T 154/04**, OJ 2008, 46). When assessing the inventive step of such a mixed-type invention, all those features which contribute to the technical character of the invention are taken into account. These also include the features which, when taken in isolation, are non-technical, but do, in the context of the invention, contribute to producing a technical effect serving a technical purpose, thereby contributing to the technical character of the invention. However, features which do not contribute to the technical character of the invention cannot support the presence of an inventive step (**T 641/00**, OJ 2003, 352).

9.2. Problem-solution approach when applied to mixed-type inventions

For the purpose of the problem-solution approach, the problem must be a technical problem which the skilled person in the particular technical field might be asked to solve at the relevant priority date. The technical problem may be formulated using an aim to be achieved in a non-technical field, and which is thus not part of the technical contribution provided by the invention to the prior art. This may be done in particular to define a constraint that has to be met (even if the aim stems from an a posteriori knowledge of the invention) (**T 641/00**; **T 172/03**; **T 154/04**, OJ 2008, 46; **T 116/06**; **G 3/08**, OJ 2011, 10; **T 1769/10**). In **T 1623/21**, the board held that if the problem-solution approach was not used, the examining division should have explained the reasons for not using it.

9.2.1 The Comvik approach

The Comvik approach was applied in **T 641/00** (OJ 2003, 352). The Comvik approach (**T 641/00**) is a conventional application of the problem-solution approach where the differences from the closest prior art are determined and only those that contribute to technical character are considered for inventive step. The previously customary contribution approach had been abandoned as early as **T 1173/97** (OJ 1999, 609, point 8 of the Reasons; see also **G 3/08**, OJ 2011, 10, point 10.6 of the Reasons), it being held that features already known from the prior art could form the basis for a finding that the requirements of Art. 52 (2) and (3) EPC were met.

In **T 641/00** the board specified that an inventive step can only be acknowledged for an invention which makes a technical contribution to the art (see, inter alia, **T 38/86**, OJ 1990, 384; **T 1173/97**; **T 1784/06**, **T 258/03** (OJ 2004, 575)), i.e. a contribution in a technical field. The case law of the boards of appeal has also developed the understanding that the examples of subject-matter excluded from patentability given in Art. 52(2) and (3) EPC 1973 concern fields considered to be non-technical.

In **T 258/03** (OJ 2004, 575) the board noted that one compelling reason for not refusing subject-matter consisting of technical and non-technical features under Art. 52(2) EPC 1973 is simply that the technical features may in themselves turn out to fulfil all the requirements of Art. 52(1) EPC 1973. It is often difficult to separate a claim into technical and non-technical features, and an invention may have technical aspects which are hidden in a largely non-technical context.

In **T 912/05**, although the board agreed with **T 641/00** (OJ 2003, 352) and **T 258/03** (OJ 2004, 575), it found that in the case at issue it was not necessary to seek to separate features that were essentially business-related, and thus not relevant for the solution of a technical problem, from those features that, as essentially technical, should be taken into account when assessing inventive step. It concluded that the assessment of the inventive step of a business-related method might be possible without a preliminary clear-cut separation between business-related features and technical features.

In **T 1462/11** the board held that, as has been the case since **T 641/00**, non-technical elements do not contribute to inventive step, and, to that end, may appear in the formulation of the objective technical problem. If the essential idea of the invention lies in a non-technical field (usually one excluded by Art. 52(2) EPC), the objective technical problem often amounts to a statement of requirements that any implementation must meet.

In **T 1784/06** the board noted that the established way of assessing inventive step under Art. 56 EPC made reference to Art. 52 EPC. However, this did not mean that the assessment of the two requirements was "mixed". In **T 1461/12** as well, the board observed that the Comvik approach did not involve an inadmissible mixing of the requirements of Art. 52 and 56 EPC, which were still to be examined separately. Inventive step, however, required a technical contribution to the prior art (see, in particular, **T 38/86**, OJ 1990, 384; **T 1173/97**; **T 1784/06**), i.e. a contribution in a technical field.

In **G 1/19**, the Enlarged Board examined the Comvik approach at length (see in this chapter I.D.9.2.4.

9.2.2 Excluded subject-matter

It is the established case law of the boards of appeal (see **G 3/08**, OJ 2011, 10; **T 258/03**, and **T 424/03**, **T 313/10**) that claimed subject-matter specifying at least one feature not falling within the ambit of Art. 52(2) EPC is not excluded from patentability by the provisions of Art. 52(2) and (3) EPC. Features which would, taken in isolation, belong to the matters excluded from patentability by Art. 52(2) EPC may nonetheless contribute to the technical character of a claimed invention, and therefore cannot be discarded in the consideration of the inventive step. This principle was already laid down, albeit in the context of the so-called "contribution approach", in one of the earliest decisions of the boards of appeal to deal with Art. 52(2) EPC, namely **T 208/84** (point 4 et seq. of the Reasons) (see also **T 1784/06**).

The presence of an inventive step can only be established on the basis of the technical aspects of both the distinguishing features of, and the effects achieved by the claimed invention over the closest state of the art (**T 641/00**, OJ 2003, 352) (see also **T 619/02**, OJ 2007, 63).

In **T 531/03** the board stated that an attempt to take into account the contribution of non-technical and technical aspects on an equal footing in the assessment of inventive step would not be in conformity with the EPC, since the presence of inventive step would in

such an approach be attributed to features which are defined in the EPC as not being an invention.

In **T 1543/06** the board stated that the principle as expressed in **T 641/00** (OJ 2003, 352) could be also reformulated as follows: an invention which **as a whole** falls outside the exclusion zone of Art. 52(2) EPC 1973 (i.e. is technical in character) cannot rely on excluded subject-matter alone, even if novel and non-obvious (in the colloquial sense of the word), for it to be considered to meet the requirement of inventive step (see also **T 336/07**).

The presence of an inventive step cannot rely on excluded (non-technical) subject-matter alone, however original it may be (see also **T 336/07**).

9.2.3 Technical implementation of excluded subject-matter

In **T 928/03** the board stated that in applying the Comvik approach **in a fair manner**, its purpose must be borne in mind: on the one hand, the approach is to make sure that non-technical aspects do not support a finding of inventiveness; on the other hand, actual contributions to the technical character by any feature of an invention must be taken into account when assessing inventive step. In this context, a game rule constraint has to be distinguished carefully from its technical implementation (**T 1461/12**).

In **T 1543/06** the board noted that a **mere technical implementation** of excluded subject-matter could not per se form the basis for inventive step (see also **T 1793/07**, **T 337/06**, **T 1225/10**). Inventive step can be based only on the particular manner of implementation (**T 859/07**, **T 414/12**). The mere implementation of effects that were inherent in the excluded matter or resulted from circumvention of the technical problem rather than contributing to a technical solution cannot qualify as technical effects (see also **T 258/03**).

In the context of the problem-solution approach this can be rephrased as a fictional technical problem in which the per se excluded subject-matter appears as an aim to be achieved, see **T 641/00** (Headnote II). Where such excluded subject-matter is novel such a formulation of the problem seemingly implies that such matter may be regarded as a given in the assessment of inventive step, which thus appears to depart from what is in fact a hidden starting point. The board viewed this fiction as an artefact of the systematic use of the problem-solution approach for assessing inventive step and the need to differentiate between excluded and non-excluded matter. This should not detract from the basic tenet that excluded subject-matter cannot form the sole basis for a patentable invention. A consideration of the particular manner of implementation must focus on **any further technical advantages** or effects associated with the specific features of implementation over and above the effects and advantages inherent in the excluded subject-matter (**T 336/07**). The latter are at best to be regarded as incidental to that implementation.

The board went on to state that the explicit requirement of a **"further" technical effect** was first formulated for computer-related inventions in decisions **T 1173/97** (OJ 1999, 609) (see also **T 935/97**), but the same principle holds also for other categories of excluded

subject-matter which may inherently possess some "technical" effect. In fact, inherent and arguably technical effects may be easily identified for practically all excluded subject-matter, for example such a simple one as reducing time when using or performing it. This is why it needs to be stressed that the **"further" technical effect** cannot be the same one which is **inherent** in the excluded subject-matter itself (**T 2449/10**, **T 1225/10**, **T 1547/09**, **T 1782/09**, **T 2127/09**, **T 1331/12**). This consideration of the specific implementation must, moreover, be from the point of view of the relevant skilled person under Art. 56 EPC, who may be identified on the basis of the invention's technical character. This was analogous to the approach of **T 928/03** (point 3.2 of the Reasons), which considered the actual contribution of each feature to the technical character by, for each feature, stripping away its non-technical content. Thus, "the extent to which the characterizing features contribute to the technical character ... in relation to the effects achieved by those features" had to be determined (**T 1023/06**, **T 336/07** and **T 859/07**).

In **T 1173/97** (OJ 1999, 609) the board held that a computer program product is not excluded from patentability under Art. 52(2) and (3) EPC 1973 if, when it is run on a computer, it produces **a further technical effect** which goes beyond the "normal" physical interactions between program (software) and computer (hardware)" (see point 9.4 of the Reasons). The board also held that, for the purpose of determining the extent of the exclusion under Art. 52(2) and (3) EPC 1973, the "further" technical effect could, in its opinion, be known in the prior art. Determining the technical contribution which an invention achieves with respect to the prior art is therefore more appropriate for the purpose of examining novelty and inventive step than for deciding on possible exclusion under Art. 52(2) and (3) EPC (see also **T 1461/12**, **T 556/14**).

In **T 1755/10** the board noted that in the light of Art. 52(1), (2) and (3) EPC, Art. 56 EPC 1973 requires a **non-obvious** technical contribution (see e.g. **T 641/00**, OJ 2003, 352; **T 1784/06**). However, non-technical aspects cannot meet that requirement. In the case at issue, as the overall goal of the claimed method (determining commissions) was not technical, the software concept could not derive any (further) technical character from that goal. In fact, the board judged that no "further" technical effect was present at all. The board made it clear that, in the absence of any other potential "further" technical effect, the mere use of a specific software solution did not amount to a technical implementation (which would have to be considered in the inventive step examination). It held that the frequent general argument that modified software causes a modified behaviour of the computer and should for that very reason (eo ipso) be considered as a technical implementation means was insufficient. The board in **T 1755/10** thus added a "**software implementation fallacy**" to the "fallacies" established in **T 1670/07** and **T 1741/08**. The board also held that even a more specific program structure within the data model did not constitute a technical implementation by itself as the alleged technical effect was limited to the general observation that modified software results in a modified operation of the computer. This was just another way of saying that software interacts with hardware and thus was not sufficient to establish a "further" technical effect. Consequently, even the more specific programming structure did not enter into the examination for an inventive step.

In **T 1834/10** the board held that the combination of two types of non-inventions (presentation of information, computer program) is not enough to define a technical contribution (**T 1755/10**, "software implementation fallacy").

9.2.4 G 1/19

In **G 1/19**, the Enlarged Board examined the Comvik approach at length. The invention in question related to a method of testing – by simulation – a modelled environment with respect to pedestrian crowd movement. However, the Enlarged Board made some findings that apply across the board. In **T 761/20**, the board held that though **G 1/19** was related to computer-implemented simulations, its reasons apply to computer-implemented methods other than simulations as well.

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

A computer-implemented simulation of a technical system or process that is claimed as such can, for the purpose of assessing inventive step, solve a technical problem by producing a technical effect going beyond the simulations implementation on a computer.

For that assessment it is not a sufficient condition that the simulation is based, in whole or in part, on technical principles underlying the simulated system or process.

The answers to the first and second questions are no different if the computer-implemented simulation is claimed as part of a design process, in particular for verifying a design.

When considering the existing case law on simulations, the Enlarged Board agreed with the findings of **T 1227/05** and **T 625/11** if they were understood as being that the claimed simulation processes in those particular cases possessed an intrinsically technical function. It also did not see a need to require a direct link with (external) physical reality in every case. However, it held that there were rather strict limits for the consideration of potential or merely calculated technical effects according to the COMVIK approach (**T 641/00**). The approach of **T 1227/05**, that the simulation constituted an adequately defined technical purpose for a numerical simulation method if it was functionally limited to that purpose should not be taken as a generally applicable criterion of the COMVIK approach for computer-implemented simulations, since the findings of **T 1227/05** were based on specific circumstances which did not apply in general. In the Enlarged Board's opinion, the COMVIK approach was suitable for the assessment of computer-implemented simulations. Like any other computer-implemented inventions, numerical simulations may be patentable if an inventive step can be based on features contributing to the technical character of the claimed simulation method. In the opinion of the Enlarged Board, when the COMVIK approach is applied to simulations, the underlying models form boundaries, which may be technical or non-technical. In terms of the simulation itself, these boundaries were not technical. However, they may contribute to technicality if, for example, they were a reason for adapting the computer or its functioning, or if they formed the basis for a further technical use of the outcomes of the simulation (e.g. a use having an impact on physical reality). In order to avoid patent protection being granted to non-patentable

subject-matter, such further use had to be at least implicitly specified in the claim. The same applied to any adaptations of the computer or its functioning. The same considerations applied to simulations claimed as part of a design process. A design process was normally a cognitive exercise. However, the Enlarged Board found that it certainly could not be ruled out that in future cases there may be steps within a design process involving simulations which did contribute to the technical character of the invention.

On question one, the Enlarged Board concluded that no group of computer-implemented inventions could be a priori excluded from patent protection. The COMVIK approach required an assessment of the technical contribution of the individual features of computer-implemented inventions. Like any other computer-implemented method, a simulation without an output having a direct link with physical reality could still solve a technical problem (see also **T 489/14** of 26 November 2021).

On question two the Enlarged Board concluded that it had been established in the COMVIK approach that, depending on the technical context, features that were non-technical per se could still contribute to the technical character of a claimed invention, just as features that were technical per se would not necessarily contribute to it. In view of this, the Enlarged Board was of the opinion that it was neither a sufficient nor a necessary condition that a numerical simulation was based, at least in part, on technical principles that underlay the simulated system or process.

On question three, the Enlarged Board did not see any need for the application of special rules if a simulation was claimed as part of a design process.

9.2.5 Features contributing to the technical character of the invention

The issue of technical character is analysed in detail in chapter I.A.3 "Technical character as a requirement for an invention".

According to the established case law, features of an invention that do not have a technical effect or do not interact with the remaining features of the invention so as to result in a technical functional contribution cannot be considered to contribute to an inventive step within the meaning of Art. 56 EPC. This is not only the case when the features themselves do not contribute to the technical character of the invention (**T 641/00**, OJ 2003, 352; **T 258/03**, OJ 2004, 575; **T 531/03**; see also **T 456/90**, **T 931/95**, **T 27/97**, **T 258/97**, **T 1121/02** and **T 1784/06**), but also when the features may in principle be qualified as being of a technical nature but do not have any technical function in the context of the claimed invention (**T 619/02**, OJ 2007, 63; **T 72/95**, **T 157/97**, **T 158/97**, **T 176/97**). In addition, this is so regardless of whether the features are themselves obvious or not (see **T 72/95**, **T 157/97**, **T 158/97** and **T 176/97**). In **T 1784/06**) the board held that it would appear paradoxical to recognise an inventive step on the basis of a non-technical innovation (such as an organisational, administrative, commercial or mathematical algorithm) having no technical implication other than the (obvious) desire for its implementation on a general-purpose computer (see also **T 279/21**).

Decisive for the presence of a (potentially patentable) invention is the inherent technical character of the claimed subject-matter (**T 931/95**, OJ 2001, 441; **T 935/97**; **T 1173/97**, OJ 1999, 609; **T 641/00**, OJ 2003, 352; **T 914/02**; **T 154/04**, OJ 2008, 46; **T 1227/05**, OJ 2007, 574). The subject-matter claimed must have a "technical character" or to be more precise – involve a "technical teaching", i.e. an instruction addressed to a skilled person as to how to solve a particular technical problem using particular technical means (**T 154/04**, OJ 2008, 46). Having technical character is an implicit requisite of an invention within the meaning of Art. 52(1) EPC 1973 (requirement of "technicality"). Art. 52(2) EPC 1973 does not exclude from patentability any subject-matter or activity having technical character, even if it is related to the items listed in this provision since these items are only excluded "as such" (Art. 52(3) EPC 1973) (**T 154/04**, OJ 2008, 46). Technical character results either from the physical features of an entity or (for a method) from the use of technical means (**T 641/00**, OJ 2003, 352, **T 1543/06**).

The case law identifies the requirement of technical character as **separate to and independent** of the remaining requirements of Art. 52(1) EPC 1973, in particular novelty and inventive step, compliance with which can therefore be assessed without having recourse to the prior art (**T 154/04**). The legal definition of Art. 56 EPC is to be put into context with the remaining patentability requirements of Art. 52 to 57 EPC these articles implying the general principles that patents shall be available for inventions in all fields of technology and that technical character is a sine qua non for an invention within the meaning of the EPC (**T 931/95**, OJ 2001, 441; **T 935/97**, **T 1173/97**, OJ 1999, 609; **T 641/00**, OJ 2003, 352; **T 914/02**, **T 154/04**, OJ 2008, 46, **T 1227/05**, OJ 2007, 574). According to **T 208/84** (OJ 1987, 14), one indication of technical character is that the method has an **overall technical effect**, such as controlling some physical process (see also **T 313/10**).

In **T 388/04** (OJ 2007, 016) the board took the view that subject-matter or activities that are excluded from patentability under Art. 52(2) and (3) EPC 1973 remain so even where they imply the possibility of making use of unspecified technical means.

In **T 1370/11** the board stated that the improved speed of a computer program is not by itself a technical contribution to the art (see also **T 42/10**). See in this chapter I.D.9.2.10 for further details.

In **T 2488/11** the board held that logging or documenting the execution details of tests carried out in a laboratory, irrespective of the technicality of the tests themselves was not technical. The board also held that the mere automation of a non-technical task by means of notorious technical means cannot involve an inventive step.

In **T 302/19** the examining division considered claim 1 as being a straightforward automation of a known manual practice of a laboratory assistant. The board held that for such an argument to succeed, it should be clear what is the alleged manual practice, it should be convincing that it was indeed an existing practice at the relevant date and that it would have been obvious to consider automating it.

The board in **T 1411/21** confirmed that stock management is not technical and held that this also applied to fleet management of hire cars, which in this case included a method for determining a technical stop of a vehicle at a maintenance centre.

In **T 1375/11** the problem was to improve ergonomic operability. The board was in no doubt that how to improve **ergonomics** was a technical problem, citing **T 1296/05**. It also referred to the approach taken in **T 862/10**, in which it had been held, that both the problem and its solution were technical because they depended not on psychological or subjective factors, but on technical parameters (based, among other things, on human physiology) that could be precisely defined.

In **T 2491/12** the board held that the claimed invention was not directed to a real-time problem in the sense of improving a technical process, but rather to automation in the sense of making (non-technical) financial information available quickly. This automation was achieved by mapping the financial concept of derivative transactions on a client-server computer system, which was deemed not sufficient for technical effect.

In **T 1148/18** the board's view was that predicting travel time based on historical data is conceptually similar to predicting arrival dates for delivery of mail based on previous delivery times (see **T 983/11**) or predicting future purchases based on previous ones (see **T 977/17**). These are all activities excluded per se from patentability under Art. 52(2)(a) and/or (c) and (3) EPC (see also **T 154/04**). In **T 2367/22**, the board cited **T 1148/18** and held that a system for more accurately predicting a travel time was not technical.

9.2.6 Assessment of non-technical features

When assessing the inventive step of a mixed-type invention, all those features which contribute to the technical character of the invention are taken into account (**T 641/00**, OJ 2003, 352). These also include the features which, when taken in isolation, are non-technical, but do, in the context of the invention, contribute to producing a technical effect serving a technical purpose, thereby contributing to the technical character of the invention (**T 641/00**, **T 154/04**, **T 1143/06**, **T 336/14**).

a) Technical contribution

In **T 1784/06** the board confirmed the Comvik approach and held that it would appear paradoxical to recognise an inventive step on the basis of a non-technical innovation (such as an organisational, administrative, commercial or mathematical algorithm) having no technical implication other than the (obvious) desire for its implementation on a general-purpose computer. Where an intrinsically non-technical solution (here: a mathematical algorithm) seeks to derive a technical character from the problem solved, the problem must be technical. Otherwise, the solution remains non-technical and does not enter into the examination for an inventive step (**T 566/11**). The board agreed with the statement that a non-technical problem can have a technical solution. However, where an intrinsically non-technical solution (mathematical algorithm) seeks to derive a technical character from the problem solved, the problem must be technical.

In **T 1145/10** the board stated that it may be acceptable to start the inventive-step assessment of a particular invention including a mix of technical and non-technical features from a "general-purpose computer system". However, the inventive-step reasoning should normally mention which features, especially which technical features of the invention, are anticipated by that well-known prior art. Where specific technical features or functionality of the standard computerised system are required to implement the non-technical features, those specific well-known technical features and functionality should be clearly identified (see also **T 1930/13**).

In **T 1379/11** the board held that the closest prior art is usually chosen on the basis of the technical problem to be solved and/or the technical features of the invention. The closest prior art does not normally have to include non-technical features of the claim. On the other hand, features which would, when taken in isolation, be considered non-technical may nonetheless impose technical requirements or contribute to the technical character of the invention. Such features should be taken into account when choosing a starting point for assessing inventive step.

In **T 483/11** the board held that a feature does not automatically inherit the technical character of the context in which it occurs. The feature must, itself, make a contribution to the technical context or the technical aspects of the invention (see also **T 1722/12**).

b) Interaction of non-technical features with technical subject-matter

In **T 603/89** (OJ 1992, 230) the board pointed out that the subject-matter of a "mix" claim is not excluded from patentability under Art. 52(2) and (3) EPC 1973 when, but only when, the **non-technical elements interacted** with the known technical elements in order to produce a technical effect (see **T 26/86**, OJ 1988, 19). In the absence of such an interaction – when the technical elements were only a support for the non-technical elements but did not otherwise co-operate therewith – the invention did not make use of technical means and could not therefore be granted (see **T 158/88**, OJ 1991, 566; **T 1670/07**).

In **T 154/04** (OJ 2008, 46) the board stated that a non-technical feature may interact with technical elements so as to produce a technical effect, e.g. by its application in the technical solution of a technical problem. Non-technical features, to the extent that they do not interact with the technical subject-matter of the claim for solving a technical problem, i.e. non-technical features "as such", do not provide a **technical contribution** to the prior art and are thus ignored in assessing novelty and inventive step (see also, for example, decisions **T 619/02** and **T 172/03**) (see also **T 641/00**, OJ 2003, 352; **T 1505/05**; **T 477/08**; **T 1358/09**).

9.2.7 Aim to be achieved in a non-technical field included in the formulation of the technical problem

In **T 641/00** (OJ 2003, 352) the board considered the formulation of the technical problem in the case of mixed-type inventions. Although the technical problem to be solved should not be formulated to contain pointers to the solution or partially anticipate it, merely

because some feature appeared in the claim did not mean it was automatically excluded from appearing in the formulation of the problem. In particular where the claim referred to an aim to be achieved in a non-technical field, this aim might legitimately appear in the formulation of the problem as part of the framework of the technical problem which was to be solved in order to avoid taking into account a non-technical contribution when assessing inventive step. The board referred to its decision **T 1053/98**, where it had considered it necessary to formulate the technical problem in such a way that "there was no possibility of an inventive step being involved by purely non-technical features". Such a formulation of the problem could refer to the non-technical aspect of the invention as a given framework within which the technical problem was posed. Thus, the board allowed an **aim to be achieved** in a non-technical field to appear in the formulation of the problem as part of the framework of the technical problem that is to be solved, in particular as a constraint that is to be met (see e.g. **T 2063/09**).

In **T 154/04** (OJ 2008, 46) the board noted as follows: For the purpose of the problem-solution approach, the problem must be a technical one which the skilled person in the particular technical field might be asked to solve at the priority date. (as similarly held in **T 641/00**). The technical problem may be formulated using an aim to be achieved in a non-technical field, and which is thus not part of the technical contribution provided by the invention to the prior art. This may be done in particular to define a constraint that has to be met (even if the aim to be achieved stems from an a posteriori knowledge of the invention (as similarly held in **T 641/00**)). The definition of the technical problem is difficult if the actual novel and creative concept making up the core of the claimed invention resides in the realm outside any technological field, as is frequently the case with computer-implemented inventions. Defining the problem without referring to this non-technical part of the invention, if at all possible, would generally result either in an unintelligible vestigial definition, or in a contrived statement that does not adequately reflect the real technical contribution provided to the prior art.

In **T 1284/04** the board held that the Comvik approach does not consider the non-technical constraints as belonging to the prior art, but rather as belonging to the conception or **motivation phase** normally preceding an invention, since they may lead to a technical problem without contributing to its solution. Such aspects have never been taken into account in assessing inventive step, irrespective of whether or not they were known from the prior art (see e.g. **T 958/03** and **T 506/06**).

In **T 144/11** the board stated that what the board had held in **T 1463/11** demonstrated that a careful analysis of which parts of a claimed feature involve a business requirement could help to resolve the grey area between technical and non-technical features. A corollary of this approach, and what is seen in practice, is that a problem of the type "implement the business requirement" will normally never lead to an allowable claim. Either the implementation will be obvious or have no technical effect, or if not, the implementation will have a technical effect that can be used to reformulate the problem essentially to "achieve the effect of the implementation". However, the implementation-type problem is just a starting point that might have to be modified when the implementation is considered. It helps when a technical problem is not apparent at the outset. Examining the business requirements like that and correctly establishing what is to be implemented ensures that

all technical matter arising from the idea of the invention and its implementation is taken into account for inventive step.

In **T 232/14** the board followed **T 144/11** and held that using ranges of unit identifiers to label a number of (consecutive) unit identifiers of manufactured items was, at the level of generality at which it was claimed, on the business side of the line between technical and non-technical subject-matter. The ranges of unit identifiers did have a meaning for the business person. They corresponded to batches of units produced on a production line. Even if the "determining of ranges of unit identifiers" achieved a technical effect, such as reducing data storage and data bandwidth requirements, it was a matter of routine design for the skilled person, a software programmer or a database expert, based on common general knowledge to store the first and the last element of a list of items, instead of the whole list.

In **T 2052/12** the invention dealt with parking meters that could credit money on smart cards, but also stored a repayment limit on the smart card to prevent theft. The board held that the claimed method involved technical features carried out by the data carrier, in particular the storing, setting and reducing of the repayment limit, the checking of the reimbursement value and its contingent addition to the memory value, and the checking of key information identifying the communication facility's credit authorization. It held that these technical features brought about technical effects beyond the mere implementation of the claimed method in such a way as to achieve the aims corresponding to the non-technical features.

In **T 581/14** the board took the view that a reduction in complexity of calculation could be a technical aim.

In **T 2314/16** the invention concerned the distribution of rewards to participants in an affiliate marketing scheme, by which an influencer (called user in claim 1) received a reward for advertising a product or service on a blog or on social media. Participating influencers were each allocated a portion of an advertisement banner displayed on a web site. The visitors to the website did not see the user areas, only an advertising banner. When the visitor clicked on the banner, the user whose portion was clicked on got a reward, distributed according to the sizes of the image portions. The partial areas were allocated such that the reward distribution rates matched the degree of contribution of each user to the advertising. The board held that the specification of the business method ended with how to determine the reward distribution ratio. The features of dividing the advertisement display area into partial areas and allocating each partial area to a user such that when the partial area was clicked on the user got a reward, were based on technical considerations of the web page system. It was not motivated by any business considerations. In order to come up with this idea, one needed to understand how a web site is built, and in particular how an image map works. Thus, this feature could not be part of the non-technical requirements. Instead it was part of the solution that had to be evaluated for obviousness.

In **T 550/14** the board declined to define criteria that the examining division should use to prove that a feature is not technical, in keeping with previous case law. However, as stated

in **T 2314/16**, over the years the case law has provided guidance on the issue of technicality, most recently the framework for discussion given in **T 1463/11** to help classify whether borderline features of a claim are on the technical or the non-technical side. The board gave one piece of advice for examining divisions: where possible to search for and start from a document that already discloses some of the alleged non-technical features, thus avoiding the discussion for these features (see e.g. **T 756/06** or **T 368/05**).

In **T 351/19**, the board held that according to the Comvik approach the non-technical features of a claim may be incorporated into a goal to be achieved in a non-technical field. Subsequently, the approach invokes what might be described as the legal fiction that this goal, including the claimed non-technical features, would be presented to the skilled person, who would be charged with the task of technically implementing a solution which would achieve the stated goal. The question whether the skilled person would "arrive" at the non-technical features does not therefore arise, as these features have been made known to the skilled person, as part of the goal to be achieved. The relevant question for the assessment of inventive step is whether it would be obvious for the skilled person to implement a technical solution corresponding to the claimed subject-matter.

In **T 1049/19**, the board held that if the claimed non-technical features do not interact with claimed technical features such that they produce a further technical effect, for the assessment of inventive step one may

- either include the corresponding aim to be achieved in a non-technical field in the formulation of the problem as part of the framework of the technical problem that is to be solved,

- or else take the corresponding business scenario as the starting point for the problem-solution approach.

In **T 1230/20**, the board stated that where an efficiency gain was an inherent consequence of a scheduling method, it strongly suggested that optimising task scheduling within the context of the invention was not of a technical nature.

9.2.8 Credible technical effects

In **T 258/97** the board held that an assessment of inventive step could only be based on those elements and aspects of the invention in respect of which a technical effect could be established (see also **T 1461/12**). Whether an invention caused a technical effect was essentially a question of fact. While the EPO has a duty to determine such facts in examination proceedings, the onus is upon the applicant to cooperate in said determination, in particular in the event of doubt (see also **T 953/04**, **T 1958/13**).

In **T 27/97** the board held that an abstract algorithm was relevant to inventive step only if a technical effect could be established which was causally linked to the algorithm, such that the technical effect provided a contribution to the solution of a technical problem and thereby conferred a "technical character" on the algorithm.

In **T 953/04** the board followed decision **T 258/97** in this respect and noted that if the doubts about the technical character of the invention could not be resolved, the features in question had to be ignored in assessing inventive step (see also **T 27/97**).

In **T 823/07** the board, following decision **T 1143/06**, stated that the manner how cognitive content is presented to the user may only contribute to the technical solution of a technical problem if the manner of presentation (exceptionally) shows a **credible technical effect** (see also **T 1575/07**, **T 1741/08**, **T 1562/11**). In **T 116/20**, a feature defining presentation of information was deemed to contribute to inventive step, since it enabled a practitioner X-raying an implanted port to unambiguously determine the orientation of the port, including whether the port was being viewed from above or below.

In **T 1958/13** the invention was concerned with copying and pasting on a touchscreen display by means of a "single-drag gesture". Although the board deemed those effects, in principle, to be technical effects, since in the end they **aim at providing tools** which serve or assist user activities (see e.g. **T 643/00**), the question whether they were actually achieved depended exclusively on **subjective user skills or preferences**. Therefore, the board was not satisfied that they could be regarded as objectively credible technical effects for the purpose of formulating the objective problem to be solved (see also **T 1567/05**, **T 1841/06** and **T 407/11**; see also **T 77/14** on gesture-based functions).

9.2.9 The notional business person

In **T 1463/11** the board introduced the notional business person. The formulation of the objective technical problem in terms of non-technical requirements raises the question of what requirements the business person (for example) can actually give to the technically skilled person. Naturally, any requirement that is purely a business matter can be included. However, in the assessment of inventive step, the business person is just as fictional as the skilled person of Art. 56 EPC. Thus, the notional business person might not do things an actual business person would. He would not require the use of the internet This approach ensures that, in line with the Comvik principle, all the technical matter, including known or even notorious matter, is considered for obviousness and can contribute to inventive step.

In **T 144/11** the board followed **T 1463/11** and held that the technical skilled person must receive a complete description of the business requirement, or else he would not be able to implement it and should not be providing any input in the non-technical domain.

In **T 1082/13** the board held that the notional business person, as interpreted within the framework of **T 641/00** knows all about the business related requirements specification and knows about the fact that such business related concepts can be implemented on a computer system. The choice of where to do a calculation in a distributed system is not necessarily technical, but can also be driven by administrative considerations. What the notional business person does not know, however, is how exactly it can be implemented on a computer system. This is in the sphere of the technical expert and subject to the assessment of inventive step. When referring to prejudices, it has to be carefully analysed, whether it is actually a technical prejudice or, in fact, a business prejudice.

In **T 1408/18** the board found that a business person who wanted to offer a product enabling users to make a transaction on a single terminal device would specify that the transaction could go ahead only after user authorisation and that, in keeping with the latest trends, it would be desirable for users to be able to make all necessary entries on their smartphone. By contrast, using a TAN-based process, including dealing with how the TAN could be transmitted securely, fell within the sphere of a technical expert. Building on traditional PIN-based password authentication, using a TAN, i.e. a one-time password, added a second layer of security. The associated interaction of two applications and communication channels for obtaining and providing a TAN led to two-factor authentication guaranteeing greater security. So, regardless of how a TAN-based process was used in practice, there were technical considerations behind it that went beyond the technical understanding that could be expected of a business person.

In **T 2455/13** the board endorsed the above reasoning in **T 1082/13** and added that, features were not technical where they were specified merely as modules on an abstract meta level and represented functions the "non-technical skilled person" would base their idea on; after all, in outlining these functions, that person would not be considered to have dictated any technical features either. It was only once actual implementation steps had been specified in the claim that such modules could be treated as technical features.

In **T 926/20**, the appellant sought to differentiate its invention, which concerned the use of location-based services for assigning tasks to users, such as cleaning workers, from the situation in **T 1082/13**, where the time was used as a non-technical "timeout" condition. In contrast, in the invention, time was not just an administrative parameter, but also provided a technical effect that was not found in the prior art documents, according to the appellant. The board held that the term "time" as used in the claim, refered to its ordinary meaning of organising tasks based on the availability of users. This could be accomplished through the use of a timetable, and therefore, was considered an administrative function.

In **T 737/14** the board held that the proper application of **T 641/00** required a thorough analysis of the business constraints when formulating the problem to be solved before investigating what the skilled person would have done to solve it.

In **T 817/16** the board considered that a useful test for determining whether such technical considerations were present was to ask whether the non-technical features would have been formulated by a technical person rather than by a non-technical person or persons (**T 1214/09**, **T 1321/11**, **T 1463/11**, **T 136/13**). This was not an enquiry into the actual state of technical or non-technical knowledge at the effective filing date; the question was rather whether the knowledge required for coming up with the non-technical features in the particular case was of a kind that only a technical person, i.e. a person not working exclusively in areas falling under Art. 52(2) EPC, could possess.

In **T 1902/13** the board held that a business consultant, who wanted to assess the competence of an organisation, would design a set of rules and questions which could be reused for another organisation. Automating parts of this process did not render it technical. The board did not agree that the business person and the skilled programmer would have to sit together in order to elaborate a workable solution. Rather, the underlying

administrative concept would be provided to the programmer as a requirements specification.

In **T 1749/14** the board held that the notional business person might come up with the abstract idea of avoiding the customer having to provide PIN and account information to the merchant. The invention however required a new infrastructure, new devices and a new protocol involving technical considerations linked to modified devices and their capabilities as well as security relevant modifications of the transfer of sensitive information using new possibilities achieved by the modifications to the previously known mobile POS infrastructure. This went beyond what the notional business person knew and concerned technical implementation details which were more than a straight-forward 1:1 programming of an abstract business idea. This was in the sphere of the technical expert and subject to the assessment of inventive step (see **T 1082/13**).

In **T 698/19** the invention proposed a system for automated pay-out of insurance premiums. The system comprised a network computer for calculating a likelihood of risk exposure, receiving and storing payments, dividing a risk into a parameterizable part and a non-parameterisable part and in case of a loss, transferring payments from both risk pools to the policy holders. The board held that the payment itself was undoubtedly a technical process, but it was motivated by a business plan or (in the image of "notional business person" versus "technically skilled person") commissioned by the notional business person and worked out by the technically skilled person in a straightforward manner. The notional business person - unlike the real business person - must not have any technical skills or knowledge about how to implement an algorithm in a computer system.

In **T 524/19** an object of the invention was to provide an automated system preventing imminent grounding of aircraft fleets due to missing financial resources after risk events and to provide a systematic and automated management of risk exposure. The invention proposed determining, based on given business rules, the automatic payment of financial compensation to the affected business units, i.e. airlines and their fleets. This object was solved by monitoring relevant airport data, defining critical thresholds, and automation of cover payments in case of airport closures. The board held that since the primary technical effect of feature (T) was that a natural disaster could be detected, it could not be argued that the technical effect was "diminished" by the fact that in the final effect it served exclusively to pay out an insurance premium. In general, the primary technical effect of a non-technical feature could not be diminished by the fact that in the final effect it serves exclusively a non-technical or business purpose. This would be tantamount to imputing technical knowledge to the notional business person. If non-technical features had both a technical and a non-technical effect, the technical effect had to be taken into account when assessing inventive step (**T 698/19**) See also **T 1439/21**.

In **T 2626/18** the appellant had argued that the claimed features relating to the abstract business concept could not have been provided by the business person to the technical expert for programming. The technical expert would also not have had corresponding knowledge starting from a networked standard computer system. The appellant thereby alleged that there was to be considered an imaginary third person who had come up with

the concept of the invention to be implemented on a computer system. The board noted that when assessing inventive step in the field of computer-implemented business-related inventions following the COMVIK approach and the corresponding case law, there was no room for such a third expert. When analysing the features of a claim and answering the question of whether they provide a technical contribution, each such feature had to be judged to be either a contribution of the technical expert or of the non-technical business person in order to conclude whether there was an inventive technical contribution.

In **T 1026/17** the board held that it was part of the non-technical requirement specification to keep keys (be it analog or electronic keys) away from people one did not trust. This did not require technical considerations of a technically skilled person. The board considered this to be an administrative consideration within the sphere of a business person when contemplating a secure tender process. It was not regarded as a technical innovation, but a natural choice for the bidders to use individual keys, hold back the keys for as long as possible and furnish them as late as possible.

In **T 909/14** the board stated that according to **T 1463/11** (CardinalCommerce), in the assessment of inventive step, the circumstances under which inventions are developed in the real world had to be ignored to a certain extent. The notional business person may formulate business requirements to be implemented but would not include in them any technical matter. The notional business person is a legal fiction representing a shorthand for a separation of business considerations from technical ones. The board in **T 1463/11** held that using this legal fiction was the price paid for an objective assessment; a real inventor does not hold such considerations separately from one another. Under the approach established in **T 1463/11**, the test used in deciding on technicality of a feature was whether the notional business person could have come up with it. This boiled down to determining whether there would have been at least one way to devise it without technical considerations. If so, it did not have technical character and may form part of the requirement specification regardless of what alternative ways of arriving at it were disclosed in the application or were conceivable. This result, although unfortunate for an applicant who did actually arrive at the feature via the technical path, was not unique to the business-related exclusion. As noted in **G 1/19**, another example would be methods for treatment of the human body which have both patentable non-therapeutic and therapeutic uses falling within the exception to patentability under Art. 53(c) EPC (see e.g. **T 1635/09**, OJ 2011, 542). In the present case, the board held that providing limited functionality for some users, such as not enabling the creation of documents, was a business decision which need not be based on technical considerations.

In **T 1117/19**, the board held that boosting user satisfaction, for example during a live TV transmission, was generally a non-technical, administrative task that was usually within the competence of a TV channel manager as the expert.

In **T 288/19** the board held that the business person sets the framework of the problem to be solved by their business model and thus reduces - by setting specific boundary conditions – the degrees of freedom of the skilled computer specialist. The technically skilled person, who has to solve the objective technical problem of implementation, therefore has no latitude in selecting the corresponding (physical) parameters.

9.2.10 Computer programs

For the technical character of computer programs, see also chapter I.A.6.5 "Computer-implemented inventions".

Purely conceptual aspects of software design and development will normally not contribute to an inventive step according to the jurisprudence of the boards of appeal (**T 983/10**; see e.g. **T 49/99**, **T 1171/06** and **T 354/07**).

In **T 1173/97** (OJ 1999, 609) the board held that a computer program product is not excluded from patentability under Art. 52(2) and (3) EPC 1973 if, when it is run on a computer, it produces **a further technical effect** which goes beyond the "normal" physical interactions between program (software) and computer (hardware)" (see point 9.4 of the Reasons).

In **T 2825/19** the board considered that opinion **G 3/08** of 12 May 2010, when compared to decision **T 1173/97**, reframed the interpretation of technicality with respect to computer programs. **G 3/08** (Reasons 13.5 and 13.5.1), explicitly rejected the position that any technical considerations are sufficient to confer technical character on claimed subject-matter. Such a narrower interpretation of the term "technical" with respect to computer programs is a normal development for the interpretation of a legal provision open to interpretation (see opinion **G 3/19**), and this is the case for programs for computers "as such" in Art. 52(2)(c) and (3) EPC. The board saw no support for the appellant's view that the concept "further technical considerations" should be interpreted with a broader meaning that would also cover considerations aiming to solve problems "merely" relating to programming such as maintainability, re-usability and understandability of program code, or, in this case, the use of a universal template for translating natural language into executable expressions in external operational environments. Such a broader view of the concept "further technical considerations" appeared problematic with regard to the imperative to ensure legal certainty and judicial predictability requiring a uniform application of the law (see opinion **G 3/08**, point 7.2.3 of the Reasons) since no criteria were apparent which could then be used to establish a clear boundary between "technical" and "non-technical" aspects of computer programs.

In **T 1370/11** the board stated that the improved speed of a computer program is not by itself a technical contribution to the art (see also **T 42/10**). In that respect, it must be established that a computer-implemented method or a computer program has a "further" technical effect and solves a technical problem independently of its absolute or relative computing time. Only then, and only if the alleged speed-up affects an established technical effect, can it be argued that the speed-up contributes to a technical effect and thus to inventive step (**T 641/00**).

In **T 354/07** the board stated that conceptual processes and meta methods for software production generally have no technical features relevant for patentability and thus cannot provide a basis for inventive step, unless, in an individual case, a direct causal connection can be proved with a technical effect which is relevant to the solution of a technical problem. Software development and manufacture takes place in several stages from

demand analysis through various design phases to production. All these stages essentially involve intellectual activity comparable to an engineer's design work, even if it is supported by programming tools and what is being designed is a technical system. While the design and programming of complex systems in particular require the active involvement of engineers and the application of technical knowledge, the eventual result to which each of these development phases is directly geared is not the technical solution of a technical problem but a requirements specification, a data, process and/or function model, or a program code. This assessment applies in particular to meta methods, which are concerned with the process of software production itself on an even more abstract level. For instance, they give the software developer instructions as to how the design process should be structured and organised or what modelling methods are to be used.

In **T 1539/09** the invention related to a graphic programming language and environment that was designed to allow a user to write code without much training or expertise. The board took the view that reducing a programmer's intellectual effort was not a technical effect. This applied all the more since the effect was likewise sought for all programs developed, regardless of their purpose (see **T 741/11**). The board stated that the activity of programming – in the sense of writing code – is a mental act, at least to the extent that it is not used in an actual application or environment to produce a technical effect. Therefore, the definition and provision of a programming language does not per se contribute to a technical solution, even if the selection of a programming language helps to reduce the programmer's intellectual effort (see also **T 2270/10**).

In **T 790/14** the board held that programming language constructs were even more abstract than programs which were as such excluded from patentability. Furthermore, programming is a mental act, and programming language constructs had the intrinsic aim of enabling and easing the work of a programmer, which itself lacked technical character (see **T 423/11** and **T 1539/09**). In **T 1105/17** the board stated that it had consistently been decided by the boards of appeal (see, e.g. **T 1539/09** and **T 790/14**) that the design or provision of programming language constructs per se did not contribute to the solution of a technical problem and could not therefore contribute to the presence of an inventive step. In **T 1105/17** the board held that while it was true that having to write "less verbose" source code may "spare" the programmer some "burden" or the "mechanical" effort of inputting that code into a computer, this did not amount to a technical problem. The invention had no effect on the compiled code eventually carried out.

In **T 42/10** and **T 1281/10** claim 1 defined a method which, based on outcomes of games, calculated indications of the skills of the players by passing messages between nodes of a factor graph. The board had to determine to what extent the features of the claim had a technical character and could contribute to inventive step. The board referred to the decision of the Court of Appeal of England and Wales in *Re Gale's Application* [1991] RPC 305. The board's approach to assessing questions of what is and what is not technical about a computer-implemented method was, in this case, to ask the same questions as Nicholls LJ in *Re Gale's Application*. The first was what does the method as a whole do, and does it produce an overall technical result? The second was; if there is no overall technical result, does the method at least have a technical effect within the computer? If both questions were answered in the negative, no technical problem had

been solved and there could be no inventive step. The board's view regarding technicality could be summarised as follows; the overall aim of keeping players interested is not technical. The intermediary aim of assessing and comparing playing performance is not technical. The representation of performance by probability distributions, and the updating of them, are mathematical methods. The use of factor graphs with message-passing is a matter of mathematics or abstract computer science. The board concluded that the only technical feature defined in this claim was the (computer) processor. The subject-matter of claim 1, therefore, did not involve an inventive step if it would have been obvious to the skilled person, who had the task of implementing the method, to use a computer processor.

In **T 1630/11** a method for simulating a multi-processor system in an electronic device was found to lack inventive step. The appellant had argued that the invention enabled users "to efficiently model and simulate a multi-processor system". The board noted that the major part of claim 1 was concerned with the expressions of a graphical programming environment which were found in **T 1539/09** (point 5 of the Reasons) not to contribute to inventive step (see also **T 2270/10**, point 7 of the Reasons). The board followed its earlier jurisprudence according to which modifications to a programming language or system that enable the programmer to develop a program with greater ease and thus, presumably, speed and accuracy, do not make a technical contribution to the art.

In **T 2147/16**, the board held that the mere assumption that an algorithm is optimised for the computer hardware and may have a technical contribution is not sufficient. The implementation of an algorithm in a method for filtering spam messages must have a proven further technical effect or specific technical considerations; such further technical effect must be specifically and sufficiently documented in the disclosure of the invention and be reflected in the claim wording; the algorithm must serve a technical purpose.

In **T 761/20**, the board held that though **G 1/19** was related to computer-implemented simulations, its reasons apply to computer-implemented methods other than simulations as well. While the Enlarged Board in **G 1/19** found that a direct link with physical reality may not be required for a technical effect to exist, it did, in this board's view, confirm that an at least indirect link to physical reality, internal or external to the computer, was indeed required. The link could be mediated by the intended use or purpose of the invention ("when executed" or when put to its "implied technical use").

In **T 1959/20** the board recognised that the implementation of non-technical requirements on a technical prior art system might require modifications which, at first glance, appeared non-obvious, as there was no technical reason for them in view of the prior art alone. However, since according to the principles of "Comvik" non-technical features cannot contribute to inventive step, the non-technical requirements had to be seen as a given, and the skilled person implementing them had to make the necessary modifications to the prior art.

9.2.11 Assessment of features relating to a presentation of information

When deciding if a feature relating to the presentation of information is technical or not, what has to be considered is whether or not it contributes to solving a technical problem. The fact that mental activities are involved does not on its own render the subject-matter non-technical (**T 643/00**, **T 336/14**). However, a feature that solely addresses a user's **subjective preferences** does not solve a technical problem (**T 1567/05**).

For further information on the technical character of features relating to the presentation of information and display of data, see also chapter I.A.6.4. "Aesthetic creations" and I.A.6.7.. "Presentation of information".

a) Data visualisation

The jurisprudence of the boards of appeal provides little support for the idea that screen representations inherently address technical problems (**T 1143/06**, **T 95/86**). A feature which relates to the manner in which cognitive content is conveyed to the user on a screen normally does not contribute to a technical solution to a technical problem. An exception would be if the manner of presentation can be shown to have **a credible technical effect** (**T 1143/06**, **T 1575/07**, **T 1741/08** and **T 1562/11**). Features aimed exclusively at i**mprovements** regarding **the way information is perceived or processed** by the human mind are regarded as non-technical (see e.g. **T 1567/05**, **T 125/04**, **T 579/11**).

In **T 543/14** the board held that providing a visual indication of technical conditions of a machine is a technical feature, according to the case law of the boards of appeal (see **T 528/07**, **T 781/10** and **T 887/12**).

In **T 1567/05** the board stated that the indication of "strength levels" in the form of predetermined display colours – which is a classification – has no technical effect. Although they refer here to technical phenomena, the stress values are mere pieces of information aimed exclusively at the human mind. As was noted in decision **T 154/04** (point 8 of the Reasons), this list covers subject-matters whose common feature is a substantial lack of technical character. That this is true for presentations of information was observed in decision **T 119/88** (OJ 1990, 395), which states in point 4.2 of the Reasons that the classification of objects by colour represents a non-technical effect.

In **T 726/07** the feature in question was the **use of a colour** to represent a state of the cache. The board stated that even assuming that this could be considered as representing "conditions prevailing in an apparatus" in the sense of **T 115/85** (OJ 1990, 30), the board considered that the **use of a colour** was a common and obvious implementation of a status indication.

In **T 1734/11** the board stated that a reduction of user interaction does not necessarily convey technical character to the means for achieving the reduction (following **T 1741/08**). Inputting information to a machine and **reducing the burden of doing so**, while these may be technical tasks a priori (at least in the sense that they are not listed in Art. 52(2) EPC), not everything that supports a technical task has itself a technical

character. However, in contrast to the presentation of the state of a technical machine, which may have technical character (**T 115/85**, OJ 1990, 30), the board considered that the presentation of pricing information, for example by **colour coding**, is a non-technical aspect even if it helps the user to conduct a price-sensitive travel query more efficiently.

b) Graphical user interfaces

A **GUI layout** (graphical user interface) as such is considered to be non-technical, being a "presentation of information" (Art. 52(2)(d) EPC; **T 1741/08** citing **T 1143/06**). See also **T 1214/09**, **T 1185/13**.

Features concerning the graphic design of user interfaces do not have a technical effect, because their design is not based on technical considerations, but on general intellectual considerations as to which design is particularly appealing to a user (Guidelines G-II, 3.7.1 – April2025 version). For example, the colour (see **T 1567/05**, **T 726/07**, **T 1734/11**), shape (**T 677/09**), size (**T 823/07**, **T 1237/07**), layout (**T 756/06**, **T 1741/08**, **T 1214/09**), arrangement of items on the screen (**T 643/00**, **T 1237/10**) or the information content of a message displayed is usually not a technical aspect of a graphical user interface. An exception would be if these features contribute to achieving a particular technical effect (**T 1741/08**, **T 1143/06**).

A feature defining a presentation of information produces a technical effect if it credibly assists the user in performing a technical task by means of a continued and/or guided human-machine interaction process (**T 336/14**, **T 1802/13** and **T 1185/13**). Such a technical effect is considered credibly achieved if the assistance to the user in performing the technical task is objectively, reliably and causally linked to the feature. This would not be the case if the alleged effect depends on subjective interests or preferences of the user (Guidelines G-II, 3.7 – April 2025 version).

In **T 1235/07** the board took a wider view of "presentation of information" than just the actual information that is displayed, the so-called cognitive content, to include also structural aspects of how the information is displayed. This broader meaning was supported by almost the only reference to the presentation of information in the travaux préparatoires. In the board's view, such additional aspects can only contribute to inventive step if they have technical character. The board considered the circumstances of the case in hand to be similar to those in **T 1143/06**, but they were even less convincing because the invention was merely a visual display of a known analysis technique using known means, whereas in **T 1143/06** the idea of varying the speed of the element was at least not known.

In **T 211/21** the board held that to complement automatisation with human intervention, providing means enabling a skilled artisan to actively intervene in an automated process for producing foods and to provide a backup to pre-programmed procedures was an obvious measure. Including a user interface having two separate push-buttons to enable the skilled artisan to send a request for assistance and for triggering data transmission was also considered to be obvious by the board. User interfaces having touch buttons are commonly used in the field.

In **T 1245/20** the application related to methods of identifying an application type of unknown data that may be encountered during a data recovery process. The board held that the construction of the mapping according to the claimed invention was performed based on non-technical rather than technical considerations. The mapping itself was also considered to be non-technical. The board was also not convinced that there was a credible increase in the speed of the mapping of the retrieved data to a particular application type over the whole scope of the claim. One question that arose was whether the method of claim 1 had the potential to cause technical effects. But the mapping and display of the data record in a respective column of the user interface resulting from the claimed method was not specifically adapted for any technical use (**G 1/19**).

In **T 2760/18** the appellant argued that it was not necessary to describe in the application how a user should use the claimed GUI for navigation as this was intuitive. The board did not find this argument convincing because intuition is subjective. It depends on personal factors, such as experience, preferences and cognitive abilities (**T 407/11**). A credibly achieved technical effect, however, requires an objective and reliable link between the feature and the effect. Since the effect of improved navigation depended on the user's intuition, i.e. on the user's subjective evaluation, it was not credibly achieved.

In **T 415/21**, the board held that the distinguishing features concerned a graphical user interface (GUI) and presentation of information. While the layout of a GUI was usually not considered to be technical, a user-interface element that the user could activate to trigger an associated action was a technical part of the user interface (**T 2028/11**).

i) Broken technical chain

In **T 1741/08** the board made clear that "lowering the cognitive burden of the user" is not of itself a technical effect (**T 1143/06** followed, **T 49/04** not followed). It found that the reduction in use of resources would be caused by the way the brain of the user perceives and processes the visual information given by a particular way of presenting information. The appellant also argued that there was a chain of effects. But in terms of technical effects this was a broken chain. The board did not accept that such a broken chain could be used as evidence of the required technical effect overall ("broken-technical-chain fallacy"; see also **T 158/88**, **T 603/89** and **T 1670/07**). Following **T 1143/06**, the board considered a **GUI layout as such to be non-technical**, being a "presentation of information" (Art. 52(2)(d) EPC).

In **T 1670/07** the board confirmed the "broken-technical-chain fallacy" (**T 1741/08**) and cited **T 603/89** and **T 1670/07** as examples. The board held that the possible final technical effect brought about by the action of a user could not be used to establish an overall technical effect because it was conditional on the mental activities of the user.

In **T 1214/09** turned on whether **improving a human's cognitive evaluation** of certain information by changing the manner in which the information is presented was non-technical. The board considered the alleged effect not to be a technical effect since in the context of this invention any **improvement** in the efficiency of image retrieval can only

be the result of the non-technical improvement in the user's evaluation of the displayed thumbnail file images.

In **T 306/10** the board cited **T 1741/08** and decided that the selection of an item for recommendation to a user did not qualify as a technical purpose (see also **T 1869/08**). From a technical point of view the recommendations were irrelevant, because while making "good" or "bad" recommendations might lead to different user reactions and thereby, in the end, to different technical results, such results did not qualify as a technical effect of the recommendations, as they depended on subjective choices made by the user. The board in **T 183/21** held that while recommending products was not generally recognised as having technical character, the technical effect of the distinguishing features was that the use of network bandwidth required to provide the training data to the recommender system was minimised, as was the amount of storage necessary for storing said training data in the communications system. The amount of training data was indirectly limited via the tendency/convergence of the measured performance metric towards, or oscillation around, the predetermined level of recommendation performance, which was not necessarily the maximum achievable level of recommendation performance. The board came to the conclusion that this technical effect was achieved.

In **T 1834/10** a web page is made more attractive to potential customers by presenting images in a lively manner, and the images to be presented are selected and displayed automatically so that the presentation can be changed rapidly. The board noted that however innovative an attractive content selection may be, it related to a presentation of information which was a priori non-technical (Art. 52(2)(d) EPC), even if it **lowers a user's cognitive burden** (**T 1741/08**) or prompts the user to start some technical action (**broken technical chain**, **T 1741/08**, **T 1670/07**).

The board in **T 49/04** decided otherwise, finding that technical aspects could not be ruled out in the design and use of a graphic interface. Furthermore, the presentation of natural language text on a display in a manner which improved readability, enabling users to perform their task more efficiently, related to how, i.e. by what physical **arrangement of the text**, cognitive content was conveyed to the reader and could thus be considered as contributing a technical solution to a technical problem.

In **T 619/98** it was held that an action performed by a user in response to a message in the form of questions or suggestions concerning the technical functioning of an apparatus did not render the form of the information technical. The board in **T 1143/06** came to the same conclusion, holding that an action (possibly) performed by a user in response to a message concerning the technical functioning of an apparatus did not necessarily render technical the information conveyed. The board came to the conclusion that the information provided according to the relevant features could not credibly support a **continued and guided human-machine interaction** process. Thus, it could not assist the user in performing the technical task. It only addressed the human mental process of an "average user", however the latter was supposed to be defined based on **personal skills and preferences** (see e.g. **T 407/11**).

In **T 752/19** the board held that improved patient compliance to a pharmaceutical formulation could not be used to establish an overall technical effect if it was the result of a "broken technical chain", namely an alleged chain of technical effects starting with information provided to a patient, which was then broken by the patient's mental activities.

ii) Features of the graphic design

In **T 244/00** the board stated that the **graphic design of menus** was, as a rule, not a technical aspect of a menu-driven control system (see **T 154/04**, OJ 2008, 46; **T 125/04**, **T 1143/06**).

T 333/95 concerned using a computer to produce animations. However, the board in that case clearly considered the feature of "making said graphics object the current cursor" as a technical feature per se. This "graphics object cursor" replaced the normal cursor (also technical) and its movements were recorded and translated into a kind of programming language. There was at least a technical effect in allowing the user to move the selected object around under control of the mouse.

In **T 125/04** the board stated that, in general, the task of **designing diagrams** is non-technical. This is so even if the diagrams arguably convey information in way which a viewer may intuitively regard as particularly appealing, lucid or logical. In **T 125/04** the invention, like **T 643/00**, also concerned an **arrangement of images** but was different in that only the information conveyed by the images, i.e. their "cognitive content" (see **T 1194/97**, OJ 2000, 525), was relevant. The new features had to do with how this content was represented. Unlike **T 643/00**, the invention provided no information about the computer system itself, such as the location where the data are stored.

In **T 1073/06**, the underlying GUI was configured, upon user input, to display objects of a **simulation model**, including graphical link representations to improve the ease of a user's comprehension of the model. The deciding board held that an improvement in the comprehension of a model is a purely mental effect, so that the problem solved was not seen as being technical.

iii) Support in performing a technical task

In **T 1741/08** the board held that not everything that supports a technical task has itself a technical character.

In **T 1802/13** the issue was "how" specific cognitive data was actually presented rather than "what" was presented. The crucial consideration was therefore that the feature involved presenting cognitive content which addressed solely the user's mental process. It was established case law of the boards of appeal that, as a general rule, "lowering the cognitive burden of a user" could not, per se, be considered to be a technical effect (see e.g. **T 1741/08**, **T 1539/09**, **T 1237/10** and **T 1105/17**).

In **T 336/14** the board held that in the assessment of inventive step of a claim, in which the non-technical features relate to cognitive content presented to the user of a graphical user

interface, i.e. relate to "what" is presented rather than "how" something is presented, it has to be analysed whether the GUI together with the content presented credibly assists the user in performing a technical task (related to "why" that content is presented) by means of a continued and/or guided human-machine interaction process. It has to be established whether the information supplied based on the relevant features credibly enable the user to properly operate the technical system in question, or whether it only addresses the human mental process of an "average user" (on this point, see also **T 1895/17** and **T 772/18**).

In **T 374/21** the boad negated any parallels with **T 336/14** as drawn by the appellant. It explained that in **T 336/14**, a distinction had been made between information indicating an operation state, a condition, or an event internal to the underlying technical system, prompting the system user to interact with it in a continued and/or guided way for enabling its proper functioning on the one hand, and information representing a state of a non-technical application run on that technical system on the other hand. The former was considered to be technical whereas the latter was not. In the context of the present invention, which concerned a computer-implemented trading tool for generating and displaying trading information and trading strategies for an option, the underlying technical system would be the computer system. However, the user rather interacted with data relating to the price of an asset i.e. cognitive data which lacked technical function and character. Thus, the boad held that the present invention fell into the second, non-technical category of information mentioned in **T 336/14**.

In **T 690/11** the invention concerned a dialysis system which comprised a display device, a web server and web browser operating with the display device to display information that could guide an operator through the set-up procedure for performing a dialysis treatment and then illustrate the progress of that treatment. In the board's opinion, the claimed features possessed more than mere information content directed exclusively to the human mind. The claimed display related to the interaction between the system and the operator and hence, implied technical means for the transmission and handling of respective signals contributing to the correct operation of the system. This conferred a technical character on the claimed features.

In **T 297/20** the board held that the mere change, by an operator, of the degree of abstraction of a graphical view ("condensation") of a power grid did not credibly assist a user in performing a technical task by means of a continued and/or guided human-machine interaction process within the meaning of **T 336/14** and **T 1802/13** and thus could not bring about a technical effect.

c) Functional and cognitive data

In **T 1194/97** (OJ 2000, 525) the board held that functional data were to be distinguished from coded cognitive content. A record carrier characterised by having functional data recorded on it was not a presentation of information as such. In this context the term "functional data" included a data structure defined in terms which inherently comprised the technical features of the system in which the record carrier was used.

In **T 2049/12** the board held that a common misconception regarding decision **T 1194/97** was that there were only two kinds of data – cognitive and functional – and that functional (i.e. non-cognitive) data was always technical. The relevant question for assessing whether a data structure had technical character was rather whether it produces a technical effect.

In **T 643/00** the board noted that it was true that non-technical aspects may be found in the design and the use of an interface through which the user interacts with a system (see **T 244/00**). Indeed, presenting information through a user interface, if the only relevant effect of the presentation relates to the visually attractive nature of the graphic design or artwork, does not have technical character. However, in its decision the board had not excluded the possibility that an arrangement of menu items (or images) on a screen might be determined by technical considerations. Such considerations might be intended to enable the user to manage a technical task, such as **searching and retrieving images** stored in an image processing apparatus, in a more efficient or faster manner, even if an evaluation by the user on a mental level was involved. Although such evaluation per se did not fall within the meaning of "invention" pursuant to Art. 52 EPC 1973, the **mere fact that mental activities were involved** did not necessarily qualify subject-matter as non-technical. The board referred to **T 1177/97** where it was stated that the use of a piece of information in a technical system, or its usability for this purpose, may confer a technical character on the information itself in that it reflects the properties of the technical system, for instance by being specifically formatted or processed.

T 677/09 was concerned with information about differences between different vehicles which was provided to the user of a vehicle information system on actuating a component. The board considered that such an effect would depend on the content of the information and the user's reaction to it. This effect was thus not the **direct effect of the feature** and could not be used to formulate the technical problem. The board noted that the appellant invoked non-technical aspects as a reason for not modifying the prior art and that in **T 1670/07**, this kind of argument was referred to as a **"non-technical prejudice fallacy"** (point 16 of the Reasons). The fact that this was not possible followed from the fact that the non-technical features relating to the information content could not contribute towards an inventive step at all. The question was not whether the skilled person would consider providing these features because that had already been decided in formulating the technical problem, but whether it would be obvious to implement the features in the claimed manner.

In **T 1806/20** the board was not convinced by the argument that information about a parcel's water-sensitivity was functional technical data in the sense of decisions **T 1194/97** and **T 424/03**, because its loss would impair the technical operation of the system (**T 1194/97**). It was self-evident that if a piece, either technical or non-technical, of any invention was taken out, it would not work as designed. In the board's view, what **T 1194/97** was saying was rather that the loss of functional data would make the system inoperable at the technical level. In contrast, if cognitive data was lost, the system would still work but possibly produce results that would be unintended for non-technical reasons.

In **T 2594/17** and **T 2607/17** the invention at issue was a virtual weldment system for training purposes. In the board's opinion, the claimed system carried out image processing. Images of weldments were rendered, manipulated and displayed. That the images represented weldments or that the manipulations represented testing and/or inspection of those weldments was, in the general manner claimed and described in the application, the result of the cognitive content (information) of the displayed images. It is the user who perceives the images as weldments and the manipulation of those images as testing and/or inspection. Such cognitive information ("what" is displayed) is not related to any technical problem or technical constraints. This applies also to the type of tests (e.g. destructive or non-destructive) the system is able to simulate. The board relied on established case law that the cognitive content of a displayed image ("what" is displayed) is in principle not a technical feature and considered that the display of 3D virtual weldments and the fact that the image processing carried out represents weldment testing and/or inspection could not be seen as technical features of the claimed system which provided any technical effect.

d) User preferences for displaying data

In **T 756/06** the board noted that the indication of internal states of a technical system, in the form of visual feedback for human interaction with the system, has been acknowledged to be technical by the boards in the past (see e.g. **T 115/85** (OJ 1990, 30; **T 362/90**). This finding has been confirmed by more recent cases, in particular in **T 643/00**, where the design of a GUI (Graphical user interface) was seen in the context of the technical process of fast and efficient image retrieval in an image processing apparatus. On the other hand, in cases where the GUI design aimed exclusively at the mental activities of a viewer, in particular at preparing the relevant data for a non-technical decision-making process by the user as the final addressee, no technical contribution has been acknowledged beyond its mere implementation. In the case before it, the board considered that the **layout** of the schedule was for the user's mental use, i.e. according to the **user's requirements and preferences**, rather than for a technical purpose in a technical process.

In **T 1841/06** the board stated that the aim and object of the invention was at best the result of balancing various **mental preferences of the user** but it was per se not a technical problem. Having the option of choosing between an original language and the preferred language might be felt as an inconvenience by one user but as an advantage by another. The invention brought about a mental simplification and subjective advantage for some users but it did not provide any objective advantage nor any technical advance in any field of technology.

In **T 478/06** the claimed invention was a method of providing access to geographic information in a computer system. The board noted that, generally, any aspects that are based on the subjective interests, personal preferences and (business/commercial) activities or circumstances of the user are non-technical in nature. Similarly, managing, i.e. using depending on wishes, personal and geographical information was non-technical. Also, the choice of where to provide a control button was a matter of user preference, and/or the commercial circumstances such as which program was available to be modified. The same goes for the second aspect of prompting the user, when the map

information was displayed, to indicate if directions were required, neither being a technical consideration.

In **T 1000/09** the board held that effects resulting from a user-defined data presentation depended on the user's perception and/or constituted **indirect technical effects** and/or related to organisational and economic aspects. Regarding the technical, inputting side of the man-machine interface, the desire to provide it with inputting means for controlling the data output was driven by the obvious needs of users.

In **T 862/10** held that choosing the location of the display object in function of the urgency of the message was non-technical. The board judged that determining (or attempting to determine) a user's visual focus of attention as a point on a screen and displaying objects in positions relative to that point could be considered to have a technical effect, but that the particular choice of where to display an object dependent on a value assigned to that object (its "urgency") could not be.

In **T 1472/14** the board found that what the claimed subject-matter did was merely to organise anthropometric data in a database so that they were provided in standardised form or in the form of statistical characteristic values for querying by way of a communication device. The subject-matter of the claim was concerned with evaluation results only, even if those results were transmitted for a stated purpose of producing products. There was no monitoring of the operation of a production plant; instead, only product data were provided. The board did not consider this to be a technical effect going beyond the mere and obvious automation of an abstract idea for standardisation.

e) Data structures

Data structures which are used to store cognitive data are not considered to contribute to the technical character beyond the mere storage of data, but data structures used for functional purposes are considered to contribute to producing a technical effect (e.g., **T 1194/97**, OJ 2000, 525; **T 424/03**; **T 697/17**).

In **T 49/99** the board ruled that information modelling was a non-technical intellectual activity, but that the purposive use of information modelling in the context of a solution to a technical problem could contribute to the technical character of an invention.

In **T 858/02** the board held that an electronic message was not automatically excluded from patentability as a presentation of information. It depended on whether the message was defined by its structure or its content. A computer data structure was not under all circumstances excluded from patentability; the fact that in the present case the instructions defined a structure of the message did not automatically lead to the conclusion that a "format (i.e. data structure)" was unpatentable.

In **T 1351/04** an index file used for the purpose of controlling the computer "along the path leading to the desired data" was considered to contribute to the solution of a technical problem. See also **T 1902/10**, **T 2539/12**, **T 2330/13**.

In **T 1867/18** the board held that using a significance value to identify false positives in potential approximate matches was not by itself a technical use given the abstract nature of approximate string matching. Hence, even if this potential use were considered to be implied by claim 1 (which it was not), it would not be an implied technical use in the sense of **G 1/19**.

In **T 1199/20** the invention concerned storing and retrieving biomedical information. The board held that the data structure was not technical. It described the organisation of biological data at an abstract logical level, which was in the realm of information modelling, which is an intellectual activity and cannot contribute to the technical character of the invention unless it serves a technical purpose (see above **T 49/99**), which the claimed data structure did not.

9.2.12 Assessment of features relating to mathematical algorithms

As mathematical methods as such are deemed to be non-inventions, mathematical algorithms may contribute to the technical character of an invention only in so far as they serve a technical purpose (Art. 52(2) and (3) EPC), (**T 1784/06**; **T 208/84**; **T 1227/05**, OJ 2007, 574; **T 1358/09**; **T 306/10**; **T 566/11**; **T 2035/11**; **T 2249/13**; **T 2330/13**). This is a very topical issue as it also has a bearing on the rapidly expanding field of artificial intelligence.

It was in **T 208/84** that a distinction began to be made between abstract concepts on the one hand and technical processes involving and modifying a "physical entity", such as an electrical signal, on the other hand. It was held that a basic difference between a mathematical method and a technical process could be seen in the fact that a mathematical method or a mathematical algorithm was carried out on numbers (whatever these numbers may represent) and provided a result also in numerical form, the mathematical method or algorithm being only an abstract concept prescribing how to operate on the numbers. No direct technical result was produced by the method as such. In contrast thereto, if a mathematical method was used in a technical process, that process was carried out on a physical entity (which could be a material object but equally an image stored as an electric signal) by some technical means implementing the method and provided as its result a certain change in that entity.

In **T 1161/04** the invention related to an apparatus for rebalancing a stock index. The board held that the data represented nothing but numbers, arguably describing "physical entities", which necessarily require interpretation by a human being without any further interaction with, or modification of, the technical system.

On the other hand, the board in **T 1814/07** held that an automated collection and analysis patient care system and method for ordering and prioritising multiple health disorders to identify an index disorder was a mathematical method but was used in a technical process. This process was carried out on a physical entity by some technical means implementing the method and provided as its result a change in that entity, and so it contributed to the technical character.

In **T 2418/12** an algorithm suggested related terms. This was considered not to be a technical problem; whether terms were "related" to each other was a cognitive or linguistic matter and not a technical issue (**T 1358/09**, **T 2230/10**, **T 2439/11**). This was in line with the case law of the boards of appeal, which generally holds that **algorithmic efficiency** is not a technical effect (see e.g. **T 1784/06**, **T 42/10**, **T 1370/11**).

More recently, there is a line of case law, which takes a critical view of the Guidelines for Examination in respect of mathematical methods.

In **T 1910/20**, the appellants had argued that the pattern enhancement algorithm as indicated in the distinguishing features was above all a mathematical method which contributed to the technical character of the invention, not only by virtue of the resultant presentation of information but also on account of the derivation of a patient's physiological state. They referred to the Guidelines for Examination in the EPO, G-II, 3.3 (essentially unchanged in the April 2025 version), which stated the following: "If steps of a mathematical method are used to derive or predict the physical state of an existing real object from measurements of physical properties, as in the case of indirect measurements, those steps make a technical contribution regardless of what use is made of the results." The appellants had argued that a patient was also an existing real object and their physiological state, in terms of patterns in their blood glucose data, was a physical state. They further referred to **T 1785/14** as support for their argument.

The board stated that the appellants' argument seemed to build on a misleading blanket statement they had cited from the Guidelines. In the preceding sentence of the Guidelines, referring to relevant case law, it was correctly stated that "[d]efining the nature of the data input to a mathematical method does not necessarily imply that the mathematical method contributes to the technical character of the invention". In particular, to contribute to technical character, it was not sufficient that the quantities processed by a mathematical method represented physical parameters. As arguably all physical parameters represent a physical state of an existing real object, it followed that the subsequent sentence in the Guidelines, at least at its level of generality ("those steps make a technical contribution regardless of what use is made of the results"), was wrong.

Moreover, the board held that it could not be derived from **T 1785/14** that defining the input to a mathematical method as physiological parameters would suffice to contribute to the technical character of the invention. The board in that case had found that the distinguishing features solved the technical problem of allowing for better accuracy when determining the sampling time for an individual animal (**T 1785/14**). That was not comparable with the case in hand, in which the appellants had been unable to demonstrate any technical effect of the presentation of cluster centres produced by the mathematical steps of claim 1 of any of the requests.

As already set out above, according to the board in **T 761/20**, although **G 1/19** was related to computer-implemented simulations, its reasons apply to computer-implemented methods other than simulations as well. Although a direct link with physical reality may not be required for a technical effect to exist, an at least indirect link to physical reality, internal or external to the computer, is indeed required. The link can be mediated by the intended

use or purpose of the invention ("when executed" or when put to its "implied technical use").

In **T 1741/22** the invention involved receiving measurements of glucose levels in a patient's blood and generating from them maximum and minimum measured glucose values, for the purpose of identifying potential medical outlier values. While in **T 2681/16**, the board had acknowledged that, "providing an overall measure of the glucose variability… and a prediction of glycemic events", was technical, the board in the case at hand took a different view. The board held that, In the present case as well as in **T 2681/16**, the interaction with the physical reality ended once blood glucose measurements were carried out. The provision of overall glucose variability and a prediction of glycemic events were held to be mathematical steps or intellectual activities which took place in the absence of this interaction with the physical reality and were therefore held not to be measurements in this sense.

In relation to the example in Guideline G-II, 3.3 (unchanged in the version of April 2025), which states that "providing a medical diagnosis by an automated system processing physiological measurements" is an example where a mathematical method can make a technical contribution quoted, the board stated that, "As providing a "medical diagnosis" - whether done by a physician or by an automated system - is devoid of any technical character (see e.g. decision **G 1/04**, points 5.3 and 6.3 of the Reasons), this example is clearly erroneous. As there is no further explanation, let alone a reference to any case law, the board sees no reason to speculate on how the Guidelines came up with this example"

a) Designs

In **T 471/05** the main request was directed to a method of designing an optical system, the method consisting essentially of designing the optical system so that substantially all light rays imaged by the optical system between two predetermined points on the optical axis of the system satisfied the algebraic condition specified in the claim. The board found that the claim merely formulated a series of mathematical and optical abstract concepts without properly requiring a physical, technical implementation. It followed that the subject-matter was the "mere design" of an optical system and encompassed purely abstract and conceptual implementations.

In **T 835/10** the board held that "de-automating" or undoing (in a computer-implemented method) the automation performed by a prior art software – could not in general be considered to be inventive. In particular, the board could not see an inventive activity in leaving the optimisation task mainly to the designer and providing him with the necessary aid to perform that task (reporting the evaluation parameters for the current design and providing him with a GUI for modifying the design).

b) Simulations/modelling

As already set out in this chapter I.D.9.2.4, in **G 1/19** the Enlarged Board expressed a clear opinion on the patentability of simulations. The Enlarged Board held that a computer-implemented simulation of a technical system or process that is claimed as such can, for

the purpose of assessing inventive step, solve a technical problem by producing a technical effect going beyond the simulation's implementation on a computer. For that assessment it is not a sufficient condition that the simulation is based, in whole or in part, on technical principles underlying the simulated system or process. Since that decision, the case law of the boards of appeal has dealt with the implementation of **G 1/19**. The relevant decisions are summarised below.

(i) Case law after **G 1/19**: technical effect denied

In **T 1371/16** the board applied **G 1/19**. The claim concerned an apparatus for computer aided design of a wire harness wiring path which outputs "data on corrected wiring path" as a final result. The claimed subject-matter was thus analogous to a computer-implemented simulation of a technical system. The board referred to the criteria established in **G 1/19**, according to which, if a claimed process results in a set of numerical values, it depends on the further use of such data whether a resulting technical effect can be considered in the inventive-step assessment. If such further use is not, at least implicitly, specified in the claim, it will be disregarded for this purpose. Calculated numerical data reflecting the physical behaviour of a system modelled in a computer usually cannot establish the technical character of an invention even if the calculated behaviour adequately reflects the behaviour of a real system underlying the simulation. Only in exceptional cases may such calculated effects be considered implied technical effects. Citing decision **G 1/19** the appellant had argued that the claim specified at least implicitly a further use of the designed wire harness which had an impact on physical reality, and therefore fulfilled the requirements expressed in **G 1/19**, point 137 of the Reasons. The board was not convinced. It concluded that the data produced by the apparatus of claim 1 was not limited to a further technical purpose and did not contribute to an "implied" technical effect.

In **T 3226/19**, the claim specified a calculation of numerical data concerning the opportunity in a reservoir system for an objective variable over different time horizons, but did not specify any further use of the calculated data. The board stated that the claim did not limit its subject-matter, either implicitly or explicitly, to a further technical use of the calculated numerical data. Other uses, for instance in management, were also within the scope of the claim. The appellant's argument that the claimed method had a technical purpose because it determined a technical variable from a technical system could only hold if the method were considered a measurement method, which the board found it was not.

In **T 2660/18** the appellant cited decision **T 625/11**, in which the board concluded that the determination, as a limit value, of the value of a first operating parameter conferred a technical character to the claim which went beyond the mere interaction between the numerical simulation algorithm and the computer system. The nature of the parameter thus identified was, in fact, "intimately linked to" the operation of a nuclear reactor, independently of whether the parameter was actually used in a nuclear reactor (**T 625/11**, Reasons 8.4). The board in **T 2660/18** was of the opinion that, in the case at hand, no technical effect was achieved by the method's functionality as the method merely produced a test rod pattern (i.e. a fuel bundle configuration) design and data "indicative of

limits that were violated by the proposed test rod pattern design during the simulation". Contrary to case **T 625/11**, here no parameter was identified that was "intimately linked to" the operation of a nuclear reactor. A rod pattern design appeared to have non-technical uses such as for study purposes. These were "relevant uses other than the use with a technical device", and therefore a technical effect was not achieved over substantially the whole scope of the claimed invention (**G 1/19**).The data "indicative of limits that were violated by the proposed test rod pattern design during the simulation" did not, or at least did not entirely, reflect the physical behaviour of a real system underlying the simulation (**G 1/19**).The board noted that, due to the breadth of the wording of claim 1 of the main request, the obtained rod pattern design might violate any number of limits by an almost unlimited amount. Hence, this was not an "exceptional case" in which calculated effects could be considered implied technical effects.

In **T 2014/21** the board pointed out that establishing a model was a purely mental act (see **G 1/19**). Consequently, improving such a model, e.g. in terms of accuracy, also represented a purely mental act and thus corresponded to a non-technical problem.

T 2594/17 and **T 2607/17** concerned the simulation and design of a virtual weldment method for training purposes. The appellant had argued that the claimed system processed virtual weldments and was thus part of a virtual reality system (VRAW system), which is a technical system. It constituted a "feedback component" of the VRAW system, resulting in generating virtual weldments of a better quality, which could be tested. They could for example be integrated in a simulated bridge and the testing could involve simulations of the bridge over time in order to estimate whether the quality of the weldment would influence the life time of the bridge. The board held that the claims did not define or suggest any connection or relation of the claimed system with the VRAW system and that there was no feedback loop. There was thus no direct causal link between the simulation results and the test system. According to **G 1/19** it is not a sufficient condition that the simulation is based, in whole or in part, on technical principles underlying the simulated system or process. Thus, even if the computer-simulated testing of the virtual weldment were to be carried out within a computer-simulated simulation of a bridge (the bridge having incontestably sufficient technical character), this would not have had any influence on the assessment of inventive step of the features of the claimed invention. Summarising, the board held that the claimed system differed from a notoriously well-known general purpose computer in that it was configured to display images of virtual weldments, of virtual testing of those virtual weldments, and of the results of the virtual testing on those virtual weldments. It could also determine a pass/fail condition based on those results.

Those differences related only to the cognitive content of the images and the board did not consider them to be technical features.

T 1892/17 concerned the simulation of an electric power system for optimising electric-power consumption. Claim 1 differed from the closest prior art in that characteristic time curves of the consumption of electric power by the individual consumers were determined and a plan was made for apportioning electric power to the concsumers on the basis of those curves. The board held that claim 1 did not refer to a simulation as such. The claimed data processing or simulation was rather based on (real) measurements of consumed

electric power in a technical system, resulting in a plan and a prognosis, which did not produce a purely virtual effect. Therefore, claim 1 was limited to a technical teaching, involving the specific technical use of the calculated characteristic time curves, plan and prognosis. In the assessment of inventive step – which was acknowledged by the board - all claimed method steps were taken into account.

In **T 1035/18**, the invention concerned a simulation for estimating net solar energy production for airborne photovoltaic systems. Fuel savings were estimated on the basis of different determined amounts of solar irradiance. The board considered that the question of whether or not the present case resembled that of **T 1227/05** was moot in view of **G 1/19**, which superseded **T 1227/05**. According to **G 1/19**, whether a simulation contributes to the technical character of the claimed subject-matter does not depend on the degree to which the simulation represents reality; nor does it depend on the technicality of the simulated system. What counts is whether the simulation contributes to the solution of a technical problem. The board held that estimating the fuel savings for a flight was a non-technical administrative activity which could e.g. be used for business decisions. Therefore, estimations do not have an "implied technical use".

In **T 2220/22**, the application related to optimising the shape of a three-dimensional model, for automotive steel-sheet structures. The board held that a potential technical effect as the result of a specific "implied" use of the output data can be taken into account in the assessment of inventive step only if the output data has no non-technical other relevant uses (**G 1/19**). Here, however, the output data was displayed to the user and could be used, for example, in an iterative design process, which is a non-technical, cognitive activity (**G 1/19**). Moreover, the output data was not directly usable for building an automotive steel-sheet vehicle structure, as building the structure would normally require further steps, including cognitive steps.

In **T 279/21** the invention related to a central control system for providing automated real-time interaction and state-transition-controlled processing of (data) objects. The invention was said, rather generally, to provide a system which was capable of flexibly capturing the external and/or internal factors that may affect the processing of an object within a workflow and that was more capable of being operated by externally or internally occurring boundary conditions or constraints. Furthermore, it was able to react dynamically to changing environmental or internal conditions or measuring parameters that were possibly not known or predictable at the beginning of the workflow process, in particular without human interaction. The examining division had argued, that the claimed subject-matter related to abstract information modelling concepts at meta-language level in the context of workflows. They had pointed out that the design and modelling of workflows for business processes represented activities in the sphere of methods for doing business.

The appellant had argued that when **G 1/19** (e.g. at point 51 of the Reasons) stated that any technical effect going beyond the implementation of the process on a computer may be considered for inventive step, it meant anything beyond a 1:1 mapping between the implementation and a step of the business method being implemented. In other words, any subject-matter that does not "map" to a step in the business method is technical. The board agreed that the "implementation" of a business method implies some sort of

mapping between non-technical steps of the business method and their technical realisation. Decision **G 1/19** had something to say about this mapping, at least in the forward direction, at point 51, when it rephrased the requirement for technical effect as "technical effect going beyond the simulation's straightforward or unspecified implementation on a standard computer system". Thus, even a 1:1 mapping might be inventive if it is not "straight-forward" (e.g. not standard programming or routine modification of the technical means used), or "unspecified" (e.g. not simply as "means for [carrying out the step]"). But, according to the board, looking for a mapping from "implementation" to the step of a business method in the reverse direction did not make sense as the steps of the non-technical activity do not have to be specified explicitly. They would include any steps that the business person would come up with in a non-technical workflow. The way this was handled was by considering the mapping of the implementation to the effect of the step and to examine whether the effect had any technical character, or whether it would be covered by what the business person would consider as part of the non-technical process. This was, in other words, the standard COMVIK approach where one looks at the effect of a feature in order to pose a technical problem, which might simply be the implementation of the feature, for which the above-mentioned mapping in the forward direction meant in **G 1/19** applied. Looking at the feature of the "operating tags" in the present case, the effect was to define business conditions determining whether a certain task shall be executed or not. This, of course, corresponded to a non-technical step of the workflow system, namely keeping track of the state of a process. Going forward again with the mapping in order to judge inventive step, the implementation was seen to be the use of "operating tags", which even if escaping the "unspecified" classification must surely be "straight-forward".

In **T 687/22** the board held that a modification introduced solely for the sake of differentiation from the prior art simply means that, at most, the novelty requirement of Art. 54 EPC is met. This does however not guarantee compliance with Art. 56 EPC. To be considered "not obvious to a person skilled in the art", such a modification must, as a prerequisite, yield a discernible technical effect that credibly solves a technical problem. This is at least the case for electronic circuits, as in the case in hand, where a change in the processing chain might simply alter the way in which information is physically manipulated, without necessarily affecting a tangible, technical outcome.

(ii) Case law after **G 1/19**: technical effect acknowledged

In **T 1618/19** the claimed subject-matter related to a concrete apparatus, namely a blending control system in a refinery, and a corresponding method. The claimed blending control apparatus/method comprised a computer modelling apparatus/method. The modelling was performed for an active refinery process in an actual refinery. The feeding of the model with the input parameters (flow and product parameters of the "rundown components supplied from the splitter" and refinery product commitments) as well as the direct conversion of the simulation results ("blend recipes", "blend events", "blend timing", "split ratio") into output signals for the control of the blender and splitter in the refinery process could be considered technical inputs / outputs according to **G 1/19**, point 85 of the Reasons, and were therefore technical or had a technical effect.

The feeding of process parameters of a running process, i.e. the refinery process, into the simulation and the conversion of calculated process parameters into control signals were thus indications of a "direct link with physical reality" (**G 1/19**) and of a "further technical effect" that went beyond the mere technical implementation of the algorithm in a computer (**G 1/19**). Consequently, it was irrelevant whether the final step of implementing the optimisation results by means of control signals, i.e. to the splitter and blender, was explicitly claimed (as would be recommended in principle according to **G 1/19**), if the skilled person understood from the wording of the claim, that the simulation results were directly converted into control signals of the splitter and blender, as was the case here.

In **T 1422/19** the claimed method measured "raw" information about a running web browser and processed this information to produce an estimate of a technically meaningful parameter. The board held that such an indirect measurement was normally of a technical nature and that finding a way to "circumvent a technical problem" may well form the basis for a patentable invention.

In **T 182/20** and **T 1557/20** the invention concerned predicting future malfunctions of mechanical or electrical components based on the current values of one or more parameters.

Beyond the server-based processing, the method in claim 1 comprised a number of technical features. Firstly, the method involved measuring specific parameters (e.g. temperature and lubricant condition in the bearings of a gas turbine), which the board considered to be inherently technical (**G 1/19**, points 85, 99 of the Reasons). Furthermore, these measurements were used to predict specific malfunctions in particular components (e.g. a bearing defect in a gas turbine or an insulation defect in a transformer). The board considered that the choice of parameters for predicting the specified malfunctions reflected technical considerations about the functioning of the claimed mechanical or electrical components.

On the other hand, the mathematical calculations in steps 3) and 4), when considered in isolation, were non-technical. These computations generated numerical data, i.e. the conditional probability of a future malfunction in an electrical or mechanical component and the question remained, whether these calculations contributed to the technical character of the invention. With reference to **G 1/19** the board saw the conditional probability obtained by the method of claim 1 as an indirect measurement of the physical state (i.e. a particular failure) of a specific physical entity (i.e. a specific mechanical or electrical component). The mathematical framework in the claim is rooted in stochastic modelling and simulation, specifically Markov chains, which are recognised for credibly capturing and predicting the transition dynamics of systems based on empirical data.

In **T 1304/22**, although the examining division had not questioned that pain reduction was in principle a technical therapeutic effect, it was not convinced that such an effect was credibly achieved in the case at hand. The major point of disagreement between the appellant and the examining division in the case at hand was whether "pain reduction" could be recognised as the technical effect of a virtual reality system, i.e. a system providing "presentation of information", and the level of proof required to credibly

demonstrate "pain reduction" as a technical effect. It essentially considered any effect achieved by displaying a virtual reality scene to a patient to be psychological, subjective and speculative, as opposed to the effect of analgesics. It questioned the causal relationship between virtual reality and pain reduction, in particular noting that some patients in the study group did not report any alleviation of their symptoms.

However, the board held that it is not surprising that not all patients respond in the same way to a therapy. Nor was there any objective reason to question whether virtual reality could lead to a therapeutic effect, especially in view of the fact that already the prior art documents cited by the examining division, disclosed the use of virtual or augmented reality systems for therapeutic purposes. Therefore, although claim 1 was silent as to the details of the respective "digital models", the board, in the appellant's favour, accepted the technical effect and the objective technical problem as submitted by the appellant.

c) Database management systems and information retrieval systems

In **T 107/87** the board held that a data coding rule for identifying and eliminating statistical redundancy contributed to the solution of a technical problem where it was used to reduce the amount of data to be stored or transmitted. This meant that if a computer-implemented method included steps of losslessly compressing and decompressing intermediate results to reduce the amount of memory space required for storing those results, at least those steps would make a technical contribution. The implementation of the coding rule would normally still be algorithmic in nature (see also **T 650/13**).

In **T 1242/04** (OJ 2007, 421) the invention related to a system for providing product-specific data in a service station. Since the claims featured a central database for recording the required status and an archive store for recording the actual status which communicated with each other by computing means, the board found that they had technical character.

In **T 1924/17** the board saw no reason why relational database management systems should be non-technical, if it was accepted that database management systems in general were technical. The board noted that its position was not that all features implemented in (relational) database management systems contributed by virtue of this fact alone and independent of their nature to the technical character of an invention. The board reviewed decisions relating to accessing data base management systems (**T 1242/04** (OJ 2007, 421), **T 279/05**, **T 862/05**, **T 658/06**, **T 1500/08**, **T 963/09**, **T 104/12**, **T 1965/11**) and information retrieval (**T 1569/05**, **T 1316/09**, **T 309/10**, **T 2230/10**, **T 598/14**). In the light of these decisions, the board in **T 1924/17** summarised that structured declarative queries, which are used for retrieving data managed in a relational database management system, normally have precise, formally defined semantics and the database management system then retrieves the specified data set as a result. It explained that relational database management systems typically executed such queries by determining an efficient query execution plan based on cost estimates for the necessary internal operations of the computer system. Such database management systems were software platforms for the centralised control of data. Features of these platforms often had a technical character, as they had been designed based on engineering

considerations concerning the efficient exploitation of the computer system as a technical system. Information retrieval systems typically had to formally calculate a semantic similarity of documents, which is typically regarded as involving non-technical considerations and being based on subjective criteria and the content (semantics) of the documents to be retrieved (see also **T 598/14**, **T 2401/22**).

In **T 279/05** the invention related to determining airline seat availability. The invention involved a mixture of technical aspects, e.g. servers, and non-technical aspects, e.g. airline seat availability and yield management. Database querying was considered be a technical field by the board.

In **T 2852/19** the invention related to optimising the occupancy of an event. The aim was to avoid seats remaining empty if visitors could not reach the event location in time. The invention proposed to automatically determine whether visitors to an event were in a defined area at a certain distance from the venue. GPS data from visitors' cell phones was used for this purpose. If ticket buyers were not in said area shortly before the start of the event, an alert was sent to them, and their ticket was resold in case of cancellation.

The board held that there were two effects: (i) was optimising the seat occupancy, which was held to be technical; and (ii) was to increase the profit by reselling seats shortly prior to the event in case a visitor had cancelled its venue, which was held to be non-technical. The board found that **T 279/05** did not apply since the dynamic adjustment of the monitored area had already been disclosed in the prior art. See also **T 2879/18**.

In **T 697/17** the board stated that in decision **T 388/04** (OJ 2007, 16), subject-matter or activities that are excluded from patentability under Art. 52(2) EPC and Art. 52(3) EPC were considered "to remain so even where they impl[ied] the possibility of making use of unspecified technical means" (point 3 of the Reasons). But that was not the case where the claimed subject-matter does not only merely "imply the possibility of making use of unspecified technical means" but in fact clearly implied the use of concrete technical means. For example, in decision **T 650/13** the board considered that the method of claim 1 was not excluded because "transmitting the symbol in a code word to a decoder" implied the use of technical means (point 6.1 of the Reasons). In **T 697/17**, the board held that carrying out a method performed in a relational database system involved the use of a computer system. Therefore, the claimed method could not be seen as a purely abstract method, but as a method which used technical means. The board furthermore noted that there were several examples in the case law in which features of a database system had been considered as technical aspects when assessing inventive step (**T 1242/04**, **T 1025/08**, **T 1500/08**, **T 1414/10**, **T 1924/17**). In this context, the board noted that describing a technical feature at a high level of abstraction did not necessarily take away the feature's technical character.

In **T 1272/20** the board agreed with the appellant that **T 598/14** did not express that any manner in which a computer performs a search was non-technical for the sole reason that the result was a "better search". The board did not agree with the examining division that only the "physical features" of the claim, or that only the features "computer-implemented", "database" and "links", made a technical contribution within the context of claim 1. The

claim specified a computer-implemented method for searching personal information when a user performs an internet search. The claimed method involved retrieving data from the internet and from a separate database, the "personal database", and presenting to the user search results and links to access some of those search results. It also included steps describing a user interaction with the computer system: receiving a user selection of one of the links and retrieving the respective data. These features contributed to the technical effect of retrieving data in a computer system. One technical constraint was that the notes were stored in a personal database which could not be searched by the search engine. Even though, the decision to present only previews of the notes, instead of the full notes, was not technical, technical considerations were involved Links were considered technical in the decision under appeal. The mere fact that at least some of these technical features might have been notoriously known or generically specified, or that some technical aspects might have been implicit from the claim, did not mean that the corresponding subject-matter cannot make any technical contribution. Relevant was whether the criteria developed by the case law were fulfilled.

In **T 873/19** the board was of the opinion that reducing the number of multiple tables needed to be processed when retrieving the attributes for a given BOI is a technical effect.

In **T 366/20** the application related to devices and methods for managing the identity of media content data. The appellant had argued that the objective technical problem to be solved was "how to provide, at a client node, a more efficient non-duplicate downloading and file identity reconciliation". The board stated that claim 1 did not define how the "first master identifier" received from a server node corresponded to the "first set of metadata" provided by the client to this server node. Since the first master identifier seemed to be determined based only on the metadata, and since the metadata may be incomplete or incorrect or otherwise not identifying for the media content or may not capture differences in actual content of the media content data files (for example due to different versions of the same song, movie etc.) the result of the claimed method seemed to be essentially unpredictable with respect to the detection of duplicate media content files over the whole scope of the claim. Moreover, the claim did not define what "processing" was performed on the first master identifier to identify whether a second master identifier was stored in the database of local identification data and metadata that matched the first master identifier. Since there was no technical effect over the whole scope of the claim, no technical problem was solved over the whole scope of the claim and the claimed method therefore lacked an inventive step.

d) Navigation systems

In **T 2035/11** the application mainly related to navigation systems that could be tailored to a user's particular wishes. The board held that optimisation algorithms are mathematical methods. It noted that **mathematical algorithms may contribute to the technical character** of an invention only in so far as they serve a **technical purpose** (see e.g. decision **T 1784/06**). The purpose of the algorithm was the mere display of an optimal path to the user for cognitive processing. The user could act on the information, but did not need to. The board held that providing real-time route-guidance information is a technical task solely if the navigation system encompasses route-planning functionality as well as a

position-determining device which is configured to provide route-guidance information in dependence on the actual real-world position of the system. This involves an interaction between the user and the navigation system, wherein the navigation system continuously measures the user's position using technical means and, on the basis of these measurements, provides the user with information aimed at enabling the user to manage the technical task of moving a vehicle to a desired destination.

As stated in decision **T 1670/07**, a technical effect may arise from either the provision of data about a technical process, regardless of the presence of the user or its subsequent use, or from the provision of data (including data that on its own is excluded, e.g. produced by means of an algorithm) that is applied directly in a technical process. In the case at issue, the data was produced by means of an algorithm and was not applied directly in a technical process, so that neither possibility applied. The German Federal Supreme Court had come to a similar conclusion in respect of a navigation system offering the user the possibility to exclude road segments based on a user-selectable property such as the road segment being a toll road (see BGH, 18 December 2012, X ZR 3/12 – Routenplanung).

In **T 1986/20** the board made reference to **T 2025/11** and distinguished the claimed invention from a real-time navigation system. The claimed invention concerned a system for supporting an operator in the tasks of shipping or warehousing articles, specifically by offering guidance to the designated articles. The board found that the claimed system, measured the operator's actual position only once, specifically at the outset of the shipping/warehousing procedure. All subsequent positions were either predetermined or at the very least derived from locations stored in a database. In the event that the operator diverged from the provided guidance, the system's ability to provide accurate real-time route guidance was compromised, given that the positional information of the preceding article became erroneous. In the board's assessment, the fundamental disparity lay in the fact that the system outlined in claim 1 of the invention did not constitute a closed loop wherein, irrespective of the user's actions, a position measurement is automatically fed back to the system for the purpose of updating route guidance information.

In **T 651/12** the board stated that what were meant in Art. 52(2)(a) EPC were merely abstract mathematical methods, i.e. calculations for the sake of the calculation. However, in the case at issue, which was essentially the technical implementation in a map display apparatus of the method for displaying a bird's eye view map, the outcome of the calculation was used for a technical purpose, namely to **display information in an ergonomically improved manner**. The board further stated that also the calculation as such in that case had in the board's judgment clear technical aspects: the technical effect of reducing the need for data storage and enhancing the calculation speed, which were considered to provide a technical solution to a technical problem. In **T 505/18** the board decided, in line with **T 651/12**, to recognise improved safety in the technical context of the invention, that of real-time route guidance of a driver of a vehicle, as being a technical effect, and the considerations regarding improved safety in a vehicle navigation system as being technical considerations made by the technical expert in navigation systems.

e) Artificial intelligence and machine learning

In **T 1903/20** the invention related to neural network based machine translation. The board held that the translation of text from a source language to a target language was a matter of linguistics and not a technical effect. This was so even if the computer program included algorithmic aspects which were not directly based on linguistic concepts. It stated that merely finding a computer algorithm to implement an automated translation process did not render the resulting computer program technical (see also decisions **T 598/14**, **T 2825/19** and **T 2401/22**).

In **T 183/21** the board came to the conclusion that a technical effect was achieved by the subject-matter of a claim defining a method of automatically controlling the performance of a recommender system in a communications system, the communications system including a client device associated with a user to which the recommendations were provided, on average, over substantially the whole scope of the claim.

In **T 702/20**, the object of the invention was to reduce the number of connections between the nodes of a neural network ("loose coupling"). Claim 1 differed from the closest prior art in that the different layers of the neural network were connected in accordance with an error-code check matrix. The proposed network structure only defined a class of mathematical functions, which, as such, was excluded matter. Other "non-technical" matter, could only be considered for the assessment of inventive step when used to solve a technical problem. The appellant had argued that the claimed neural network solved a technical problem by providing effects within the computer related to the implementation of neural networks (storage requirements), and that neural networks generally solved technical problems by automating human tasks. The board remarked that a technical problem may also be solved if the outputs of the system have an implied further technical use (**G 1/19**), but held that the outputs of the neural network did not have any implied "further technical use"; they may e.g. be related to forecasting stock market evolution.

The appellant had argued that the proposed modification in the neural network structure, in comparison with standard fully-connected networks, would reduce the amount of resources required, in particular storage, and that this should be recognized as a technical effect, following **G 1/19**. The board however held that, while the storage and computational requirements were indeed reduced, in comparison with the fully-connected network, this meant that the modified network was different and would not learn in the same way. So it required less storage, but did not do the same thing.

The appellant had also argued that the neural networks were an automation tool, mimicking the human brain and that their behaviour could not be predicted or understood by their programmer. However, the board saw no evidence that neural networks functioned like a human brain. Neural networks are a mathematical approximation function, which can be simple and understandable if the network is small. It is only the sheer complexity of a larger neural network that makes it appear unpredictable. That a learning system is complex is not sufficient to conclude that it replicates the functioning of a brain.

The board stressed that there could be no reasonable doubt that neural networks could provide technical tools useful for automating human tasks or solving technical problems. In most cases, however, this required them to be sufficiently specified, in particular as regards the training data and the technical task addressed. What specificity was required would regularly depend on the problem being considered, as it had to be established that the trained neural network solved a technical problem in the claimed generality (see also **T 2246/18** and **T 161/18** where the boards found the use of neural networks obvious and **T 748/19**, as well as **T 1191/19**, where the claims were also too generalised). The board in **T 1952/21** referred to **T 702/20** and stated that it was in many ways similar. It reiterated that a trained machine learning model, namely a neural network, can only be considered for the assessment of inventive step when used to solve a technical problem, e.g. when trained with specific data for a specific technical task.

In **T 1191/19** a so-called meta-learning scheme was the subject of the invention. The board held that this constituted the application of known techniques - such as meta-learning - to other areas, which was a general technological trend and could not be inventive as such. The board could not see in the method of claim 1 any non-obvious detail of the application of the meta-learning scheme known in the prior art to the problem at hand beyond a mere reiteration at an abstract level of the scheme disclosed in the prior art.

The board decided in a similar vein in **T 1425/21**, where approximating "cumbersome" machine learning models with "distilled" machine learning models which require less computation and/or memory was claimed. The board held that while the distilled model reduced the storage or computational requirements of a machine learning model, that was insufficient, by itself, to establish a technical effect, as one also had to consider the performance of the "reduced" learning model. The board found that it was not credible in general that any model with fewer parameters could be as accurate as the more complex one it is meant to replace.

In **T 598/07** the invention concerned a heartbeat monitoring method, which was based on a neural network for the purpose of identifying irregular heartbeats. The board held that this made a technical contribution. The board also held, that since none of the method claims in question included the step relating to the diagnosis for curative purposes stricto sensu representing the deductive medical or veterinary decision phase, the method claims did not fall under the exclusion provisions of Art. 53(c) EPC.

In **T 1286/09** the invention related generally to the field of digital image processing and, in particular, to a method for improving image classification by training a semantic classifier with a set of exemplar colour images, which represented "recomposed versions" of an exemplar image, in order to increase the diversity of training exemplars. The board found that it involved an inventive step.

In **T 1510/10** the board decided that 'no inventive step can derive just from the use of machine learning. The Appeal was dismissed.

In **T 1784/06** the automatic classifying of abstract data records was held to be non-technical since the data records were classified for the non-technical purpose of billing. A

valuable mathematical property of the algorithm could imply technical benefits but only when used for a technical purpose.

In **T 755/18** the board held that if neither the output of a machine-learning computer program nor the output's accuracy contributed to a technical effect, an improvement of the machine achieved automatically through supervised learning to generate a more accurate output was not in itself a technical effect.

In **T 761/20**, the claim defined a method of automated script grading using machine learning, which was effectively a computer-implemented process. Such processes may have technical effects - and thus be deemed to solve a technical problem - at their input or output, but also by way of their execution (see **G 1/19**, point 85 of the Reasons). A technical effect may also be acknowledged in view of their purpose, i.e. an (implied) technical use of their output (see **G 1/19**, point 137 of the Reasons). The claimed method contained steps for extracting numerical "linguistic" vectors from scripts (for all con-sidered samples, training scripts and scripts to be graded), a step of training a perceptron, and a step of using the perceptron to grade the scripts. In principle, the claimed training procedure might constitute a technical contribution to the state of the art (see e.g. **G 1/19**, point 33 of the Reasons). Taken alone, however, this was a mathematical method, so this contribution was in the excluded field of mathematical methods (see **T 702/20** and **T 755/18**, Catchwords) and was therefore not a patentable contribution. Assuming that the claimed invention served the purpose of supporting its users in evaluating linguistic competences, as the appellant had argued, the board could not see any other implied purposes. The board also did not agree with the appellant that the field of "educational technology" was a technical field.

In **T 874/19** the application related to classifying search engine resources as a spam resource (or as belonging to the "spam" category) or not a spam resource (or as belonging to the "not spam" category) based on a "deep network". This involved different layers of a neural network for automatically classifying search input data. The claimed classifier was capable of processing an alternative mathematical representation of input data to then calculate a so-called "category metric" for each category in a given set of categories. Each category metric also provided a probability value that the particular resource actually belonged to the corresponding category. The board could not see what a further technical effect of the distinguishing features could be, nor what objective technical problem the subject-matter of claim 1 would solve.

f) Linguistics and classification of texts

In **T 1177/97** the board held that the use of a piece of information in a technical system, or its usability for this purpose, may convey a technical character to the information itself in that it reflects the properties of the technical system, for instance by being specifically formatted and/or processed. Such information when used in or processed by the technical system may be part of a technical solution to a technical problem and form the basis for a technical contribution of the invention to the prior art. Information and methods related to linguistics may thus in principle assume technical character if they are used in a computer system and form part of a technical problem-solution.

Methods of text classification per se did not produce a relevant technical effect or provide a technical solution to any technical problem (**T 233/09**, **T 1316/09**, and **T 1358/09**).

In **T 1358/09** claim 1 defined a method for classifying text documents essentially in terms of an abstract mathematical algorithm. The board noted that whether two text documents in respect of their textual content belong to the same "class" of documents was not a technical issue (see also **T 1316/09**, **T 233/09**). In **T 1358/09** the board pointed out that not all efficiency aspects of an algorithm are by definition without relevance for the question of whether the algorithm provides a technical contribution. However, such technical considerations must go beyond merely finding a computer algorithm to carry out some procedure (see **G 3/08**, OJ 2011, 10; see also **T 2418/12**, **T 22/12**). In **T 22/12** too, the board thus decided that the classification of emails as spam was not technical. In **T 2363/16** the board cited **T 22/12** and held that the classification criteria regarding which emails should be blocked were determined by the user of the system based on non-technical considerations regarding which emails the user did not want to receive.

In **T 817/16** the board held that merely assigning a score to a document for a search engine in a memory-efficient manner was not a technical effect even if the score is somehow based on the frequency and the amount of changes made to the document.

Similarly in **T 306/10** the board considered that a reduction in the number of search queries and the corresponding saving of resources did not qualify as a technical effect of the (improved) recommendations, as they depended on subjective choices made by the user. It referred to decision **T 1741/08**, where the argument was made that a chain of effects could not be used as evidence of a technical effect if one of the links between the effects was not of a technical nature (but, for example, of a psychological nature).

g) Image processing

In decision **T 208/84** (OJ 1987, 14), which was concerned with a method of digitally filtering a two-dimensional data array (representing a stored image), the board provided a fundamental clarification. It noted that a basic difference between a mathematical method and a technical process could be seen in the fact that a mathematical method or a mathematical algorithm was carried out on numbers (whatever those numbers represented) and provided a result also in numerical form, the mathematical method or algorithm being only an abstract concept prescribing how to operate on the numbers. No direct technical result was produced by the method as such. In contrast, if a mathematical method were used in a technical process, that process would be carried out by a technical means on a physical entity (which could be a material object but equally – as here – an image stored as an electrical signal) and would result in a certain change in that entity. The technical means might include computers comprising suitable hardware or appropriately programmed general-purpose computers (as similarly found in **T 935/97**).

In **T 1286/09** a method for improving image classification was also found to be inventive.

Similarly, a method of encrypting/decrypting or signing electronic communications may be regarded as a technical method, even if it is essentially based on a mathematical method (**T 1326/06**).

In **T 1455/16** the application related to retrieving images according to user specified arrangement information. The image data memory means was arranged to store position information of the image data, indicating the shooting spot of the image and recommending a shooting spot at which such an image could be captured. The board held that the text of the application did not reflect the application of the position information in a technical task of guiding the user to a point in space. Therefore, it could not be said that in the present case providing position information to a user was based on technical considerations. The mere fact that the position information concerned physical elements in the real world was not sufficient for establishing a technical contribution of providing the position information (**T 154/04**, OJ 2008, 46; **T 2035/11**; **T 670/16**; different in **T 572/15**).

In **T 1370/18** the invention concerned audio and video coding in a telecommunication environment. The idea of the invention was to use multi-dimensional codewords to take advantage of the statistical dependencies between neighbouring symbols and to adapt the codeword length to symbol probabilities. The board held that an encoding or compression algorithm contributed to the technical character of the claimed compression method if it was used for the purpose of reducing the amount of data to be stored or transmitted.

h) Security

In **T 1326/06** the board held that methods of encrypting/decrypting or signing electronic communications had to be regarded as technical methods, even if they were essentially based on mathematical methods. It referred to **T 953/04**, where the board had stated that the use of cryptographic methods in the technical context of electronic data processing and communication certainly had technical character. The board in **T 1326/06** also referred to **T 27/97**, where the board had stated that a method of encrypting or decrypting a message represented in the form of a digital word using RSA-type public-key algorithms was not excluded from patentability under Art. 52(2) and (3) EPC, even if based on an abstract algorithm or mathematical method.

In **T 2101/12** the application related to a computer implemented invention concerning a method and system for providing an electronic signature and authentication. The board considered this to be a straightforward automation of a known process (e.g. a contract agreement executed before a notary) devoid of any inventive activity.

In **T 1158/17**, however, the board came to a different conclusion. The board here was not convinced by the contested decision's finding that the claimed components were not technical because they modelled the roles of humans interacting within the framework of the administrative postal scheme. The board considered that a similarity to a business or administrative solution was not a sufficient reason for denying a technical contribution of a claim feature applied in a technical context and involving technical considerations. Put another way, technical considerations in the technical context cannot be negated merely

on the basis of a non-technical analogy. The board held the invention to be no mere automation of an administrative scheme.

In **T 1461/12** the application related to a system and method for auditing software usage with the aid of the acquired licences using an unlock key. In the board's view, it was up to the rights owners whether they wanted to limit the number of "copies" made of a given piece of software and to grant one set of rights for the first number of copies and a different, limited set of rights subsequently for a second number of copies. Moreover, the board took the view that the rights owner would make that choice according to legal, economic and administrative considerations rather than technical ones. The board therefore considered that the content of the license did not contribute to the technical character of the invention.

The board in **T 548/13** held that the only distinguishing feature, requiring the security features to show different views of the same image on the front and back of a value document, was non-technical. It conceded that it made the document more difficult to counterfeit, but two different motifs could just as easily be used.

In **T 1749/14** the invention was in the field of mobile point-of-sale (POS) terminals for carrying out transactions, e.g. involving a credit card. The invention tried to avoid the customer's sensitive information becoming known if a merchant's device was tampered with by allowing a transaction to be carried out without the customer having to present account information and the PIN to the merchant. The board held that the invention required a new infrastructure, new devices and a new protocol involving technical considerations linked to modified devices and their capabilities as well as security relevant modifications of the transfer of sensitive information using new possibilities achieved by the modifications to the previously known mobile POS infrastructure. The board considered the security relevance of the modifications to contribute to the technical character of the present invention.

9.2.13 Discoveries

In **T 1538/05** the applicant claimed to have discovered a magnetic force that was hitherto unknown, and as a consequence thereof, established a number of theories. The board held that the discovery of a new magnetic force was not patentable.

In **T 2677/16** the board held that identifying a drug discovery target was not technical. It held that a drug target was not a therapy, but merely a promising direction for future research. The discovery of a drug target may well turn out to be a valuable scientific discovery, but neither discoveries nor science have technical character as such, as is explicitly enshrined in Art. 52(2)(a) EPC. This should not be confused with the invention of a drug, which would represent a technical purpose.

In **T 1789/13** the board held that the "weather" was not a technical system that the skilled person could improve, or even simulate with the purpose of trying to improve it. It was a physical system that could be modelled in the sense of showing how it worked. This kind of modelling was held to be rather a discovery or a scientific theory, which are excluded

under Art. 52(2)(a) EPC and thus do not contribute to the technical character of the invention.

9.2.14 Human Perception

In **T 619/12** the board held that the perceptual processes taking place in the mind of a test person presented with odours in an odour selection test did not constitute mental acts within the meaning of Art. 52(2)(c) EPC. Nonetheless, human perception phenomena could not be qualified as being of a technical nature.

In **T 339/13** the application was concerned with a virtual pet that was capable of giving "haptic feedback". Noting that the owner of a toy had to be willing to accept the toy's behaviour as real, the board accepted that achieving a reliable and reproducible perception of a physical interaction was a technical problem and found that the invention solved this problem by technical means, namely a reciprocating cursor movement and haptic feedback.

9.2.15 Games

In **T 1023/06** the invention related to a method of operating an electronic video poker machine. Following the approach of **T 49/04** the board held that an improvement in readability, which related to how "cognitive content" was presented, constituted a technical contribution.

In **T 717/05**, **T 42/10** and **T 1281/10** the boards had to examine whether the amusement of the player could be a technical problem. In **T 717/05** the board held that amusement was the psychological purpose of a gaming apparatus and thus was the relevant objective technical problem to the extent that the enhanced amusement was achieved by technical features of the claim. In **T 42/10** and **T 1281/10** the boards denied this.

In **T 1543/06** the board applied **T 641/00** and furthermore held that a consideration of the particular manner of implementation had to focus on any further technical advantages or effects associated with the specific features of implementation over and above the effects and advantages inherent in the excluded subject-matter. The latter were at best to be regarded as incidental to that implementation. It also held that non-technical effects inherent in non-technical game rules could not be taken into account in assessing inventive step.

In **T 336/07** the board followed the same approach. It held that the mere fact that subject-matter (here rules for playing games), which is excluded per se under Art. 52(2)(c) EPC 1973, is technically implemented could not form the basis for inventive step. Inventive step can be based only on the particular manner of implementation of such subject-matter. A consideration of the particular manner of implementation has to focus on **any further technical advantages** or effects associated with the specific features of implementation over and above the effects and advantages inherent in the excluded subject-matter (see also **T 1543/06**). In **T 336/07** the board concluded that the subject-matter of the claims did not involve an inventive step. In **T 1782/09** where the application

concerned a game apparatus the board stated that "game rules" form part of "the regulatory framework agreed between [or with] players concerning conduct, conventions and conditions that are meaningful only in a gaming context. The board was unable to identify any further technical effects in the particular manner of technical implementation that might have rendered it non-obvious to the skilled person.

In **T 1225/10** the board also adopted the approach set out in **T 1543/06** and held that it was decisive how excluded subject-matter was technically implemented, and whether that implementation was obvious. Such a consideration focused on any further technical effects of the implementation of the excluded subject-matter over and above those inherent in the excluded subject-matter itself (**T 1543/06**, **T 1782/09**). In the case at issue the board came to the conclusion that using points on the player character that overlapped with a target object was a computationally effective and efficient approach to determine the collision side on a target object for a variety of such objects. That effect was not the inevitable result of programming the game rules per se. It was rather the direct technical consequence of the particular technical way selected data was used to determine a display state. Therefore the technical effect was affirmed.

In **T 1467/21**, the board held that under the Comvik approach administrative settings related primarily to customer or player satisfaction could be taken into account in the formulation of the objective problem as non-technical constraints.

In **T 686/22**, the board adopted the approach as set out in **T 1543/06** (above). Thus, only those features that contributed to technical character were to be taken into account when assessing inventive step. That requirement cannot rely on excluded (non-technical) subject-matter alone, however original it may be. The mere technical implementation of something excluded cannot therefore form the basis for inventive step. Rather, it is necessary to consider in detail how that matter has been technically implemented. The case concerned a game console. The board found a game rule underpinned the feature distinguishing the application from the prior art, which was considered not inventive.

9.2.16 Mental acts – technical embodiments

In **T 914/02** the board held that the involvement of technical considerations is not sufficient for a method which may exclusively be carried out mentally to have technical character. Technical character may be provided through the technical implementation of the method, resulting in the method providing a tangible, technical effect, such as the provision of a physical entity as the resulting product or a non-abstract activity, such as through the use of technical means. The board rejected a claim directed to an invention involving technical considerations and encompassing technical embodiments on the grounds that the invention as claimed could also be exclusively performed by purely mental acts excluded from patentability under Art. 52(2)(c) EPC (see **T 619/02**, OJ 2007, 63; **T 388/04**, OJ 2007, 16, **T 1073/06**).

In **T 930/05** the application was concerned with a method for modelling a process network. The board held that the method lacked technical character because though the claimed subject-matter comprised technical embodiments, implementations that could be deemed

non-technical were also conceivable. The board in **T 647/20** came to the same conclusion, with reference to **T 930/05**.

In **T 1171/06** the application related to object-oriented modelling, namely a method and a device for modelling a mechatronic system in a motor vehicle. The board held that a model used in software development was not imparted a technical effect because it served documentation or communication, even if its subject-matter was a technical system. The board continued this approach in **T 354/07**, which concerned the automatic generation of program code from a model, the board had noted that conceptual processes and meta methods for software production generally had no technical features relevant for patentability and thus could not provide a basis for inventive step unless it could be demonstrated, in a given case, that there was a direct causal connection with a technical effect relevant for solving a technical problem.

9.2.17 Logistics

In **T 696/06** the application concerned a data processing system intended to facilitate confronting an offer and a demand in the field of transporting travellers or goods. Essentially the system executed business processes and transactions, like mediating offers and demands, which were typical for a transportation broker or freight exchange service and which the board held not to be technical.

In **T 912/05** the application related to a mail delivery system that could deliver by physical and/or electronic means. The board held that methods of mail delivery can qualify as inventions if they involve "technical means", with mail delivery by e-mail qualifying as such.

In **T 1806/20** the application concerned a parcel delivery system that sought to prevent damage to water-sensitive parcels by avoiding delivery to rainy destinations. The board found that the requirement to ensure that parcels do not get damaged by water formed part of the non-technical logistics scheme.

In **T 1594/20**, the board held that an arithmetic optimisation for efficiently dividing up a picking order did not necessarily bring about a simulation of the underlying physical operation (the transport of goods in this case) but also included purely deterministic mathematical optimisations.

Asserted energy savings were purely speculative and could not readily lead to a technical effect being acknowledged. For this, any such effect would have to be achieved using technical means. In the claimed subject-matter, however, energy savings (if any) would be the result of a purely organisational or algorithmic optimisation based essentially on a mental act. No technical effect can be derived from this to acknowledge inventive step.

T 1960/20 related to an invention tracking how quickly a warehouse employee enters and exits the proximity of a warehouse robot waiting for them. The board considered that understanding and analysing spatial and temporal conditions under which the steps of the established business workflows are carried out is per se a non-technical exercise.

9.2.18 Weather-related algorithms

In **T 1798/13** the invention concerned forecasting the value of a weather-based structured financial product. The values of these products were based on specific weather measures, such as temperature, precipitation, hours of sunshine, heating degree days, cooling degree days or wind speed. The board agreed with the appellant that a system for weather forecasting, for example, comprising sensors for measuring specific weather data, had technical character. The invention, however, relied on the use of already measured weather data. It could be argued that this (raw) weather data represented measurements about the physical world and was therefore also technical. The situation would thus be similar to that in **T 2079/10**, which considered that physical parameters represented technical data and that the choice of which physical parameters were to be measured fell within the competence of the technical skilled person.

In **T 2079/10**, however, the invention was seen to lie in the improvement of the measurement technique itself, which involved technical considerations about the sensors and their positions. In the case in hand, the measurements themselves did not play a role, the improvement was in the processing of data to provide a better weather forecast. The applicant's second argument was essentially that an improvement in the weather data by calculating and further processing it was also technical. In the board's view this led to the key issue in this case, namely whether improving the accuracy of given data of a weather forecast was technical. If it was not, then the details of the algorithm, the "mathematics" as the division put it, did not help. The board held that it was not. The "weather" was not a technical system that the skilled person could improve, or even simulate with the purpose of trying to improve it. It was a physical system that could be modelled in the sense of showing how it works. This kind of modelling was rather a discovery or a scientific theory, both of which were excluded under Art. 52(2)(a) EPC and thus did not contribute to the technical character of the invention (see also **T 2331/10**). In **T 2079/10** the board held that a purely non-technical interpretation of the claim's subject-matter was not possible and that it therefore had technical character.

In **T 1234/17** the board essentially held that it was not enough that an algorithm makes use of a technical quantity in the form of a measured physical parameter (weather data). What matters is whether the algorithm reflects any additional technical considerations about the parameter, such as its measurement. In that case there were none, which contrasted with the matter in **T 2079/10**.

9.3. Combination invention

9.3.1 Existence of a combination invention

In assessing the inventive step involved in an invention based on a combination of features, consideration must be given to whether or not the state of the art suggested to a skilled person precisely the combination of features claimed. The fact that an individual feature or a number of features were known individually does not conclusively show the obviousness of a combination (**T 37/85**, OJ 1988, 86; **T 656/93**; **T 666/93**; **T 1018/96**). The question is not whether the skilled person, with access to the entire prior art, **could** have

made the combination according to the invention, but whether they actually **would** have done so in expectation of an improvement (**T 2/83**, OJ 1984, 265; **T 713/93**; **T 223/94**; **T 406/98**). When assessing inventive step in a combination invention, the decisive criterion is not whether individual elements of the combination were known and obvious from prior art, but whether the state of the art would lead a skilled person to this particular overall combination of (possibly already known) features. Were this not so, it would be impossible for a combination consisting exclusively of known individual features to involve an inventive step (**T 37/85**, OJ 1988, 86; **T 388/89**; **T 717/90**; **T 869/96**).

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

The existence of a combination invention requires that the relationship between the features or groups of features be one of **functional reciprocity** or that they show a combinative effect beyond the sum of their individual effects. In **T 1054/05** the board stated that two features interacted **synergistically** if their functions were interrelated and lead to an additional effect that went beyond the sum of the effects of each feature taken in isolation. It was not enough that the features solved the same technical problem or that their effects were of the same kind and added up to an increased but otherwise unchanged effect (see also **T 926/11**, and **T 708/21**, in which the respective boards found there was a lack of synergistic effect – the differentiating features did not produce a combined effect greater than the sum of their individual contributions).

In **T 406/98** the board found that as a rule, particularly when large numbers of citations were involved, it was necessary to ask **why** the skilled person would consider documents in that specific combination, and whether, **not knowing the invention**, they had reason to do so. In this case, a complete solution to the problem required deliberate selection from a large number of citations.

In **T 55/93** the appellant's argument that the alleged invention should have been regarded as a mere aggregation of solutions of two independent partial problems which were not interrelated, was not accepted by the board. This reasoning could only stand if the primary and more general problem were already known and solved by the prior art. In the case in point, not only could the primary problem underlying the contested patent neither be found nor be derived from the prior art documents, but also the claimed features complemented each other. The board stated that the features were functionally linked together, which was the very characteristic of a combination invention. The board stated it was no consequence whether, in a combination invention, possibly all features were already known per se, separately (**T 37/85**, OJ 1988, 86). It was wrong to select on the basis of a plurality of partial problems to be solved, the respective constructional means used in the apparatus combination, or the steps of the method worded in terms of functional features, which by working together provided a solution to the problem taken as a whole. The non-obviousness of a combination claim turned on the simultaneous application of all its features (**T 175/84**, OJ 1989, 71). A combination effect was also acknowledged in **T 120/88**, **T 731/94**, **T 434/95**, **T 897/95**, **T 1201/13**.

In **T 2585/18** the board was of the opinion that starting from the disclosure of D2, the skilled person could have changed the composition of Batch 4 of Example 9 in several ways

which could not be considered as isolated changes. These changes could have resulted in undesired effects; the features exendin-4 concentration, sucrose concentration, TPV, and the absence of a buffer and salting-out salts mutually influenced each other, i.e. there was functional reciprocity. Consequently, the combination of features could not be considered obvious in view of the teachings in D2, D8 or D9, alone or taken in combination.

In **T 1050/22** the respondent argued that any technical effect associated with individual distinguishing features over D1 could not be split up and that the nature and concentration of all the components had a combined effect. It claimed that neither D1, nor any other cited prior art document provided any hints towards the claimed combination of ingredients, let alone their concentrations. The board disagreed and considered that the subject-matter of claim 1 was a simple aggregation of known features and that the implementation of each feature was obvious in view of the cited prior art. There was no evidence of a general relationship between the effects from the distinguishing features; the individual differentiating features were mostly the result of specific individual technical effects, and not of a combined technical effect different from the sum of the technical effects of the individual features.

9.3.2 Partial problems

In patent law terms, the existence of a combination of features, i.e. of a combination invention, is to be viewed differently from the mere existence of partial problems, i.e. of an aggregation of features. According to current case law, partial problems exist if the features or sets of features of a claim are a mere aggregation of these features or sets of features (juxtaposition or collocation) which are not **functionally interdependent**, i.e. do not mutually influence each other to achieve a technical success over and above the sum of their respective individual effects, in contrast to what is assumed in the case of a combination of features. What must be established is whether each set of features is separately obvious in the light of the prior art (**T 389/86**, OJ 1988, 87; **T 387/87**; **T 294/90**; **T 363/94**; **T 926/11**; **T 1587/14**). It should also be borne in mind that solutions to partial problems in differing technical fields must be assessed on the basis of the knowledge and expertise of the person skilled in the art where the solution is found (**T 32/81**, OJ 1982, 225; **T 324/94**).

In **T 389/86** (OJ 1988, 87) the relationship between the two groups of features was not one of functional reciprocity. The board ruled that in such circumstances no combinative effect could be advanced in support of inventive step; rather the question was whether each group, taken singly, was obviously derivable from the prior art. For the subject-matter of the claim to be inventive, it sufficed if one of these groups was (see also **T 345/90**, **T 701/91**, **T 94/05**, **T 450/06**, **T 102/08**, **T 619/08**, **T 2097/10**, **T 1012/19**).

In **T 1836/11**, the patent concerned a two stage turbocharger for an internal combustion engine. The respondent (patent proprietor) argued that the backsweep and dual feed worm features could not be considered separately since they synergistically contributed to the stated aim of increasing efficiency. The board did not see any synergy between the two features. That the features both served the same overall purpose did not establish, in the board's view, a functional reciprocity between the two.

In **T 130/89** (OJ 1991, 514) the technical problem intended to be solved by the claimed invention consisted of two technically independent partial problems, each solved independently by one of the claimed subject-matter's features. The board held that the independence of the claimed subject-matter's features (each producing a different effect) meant that in assessing inventive step, in addition to the closest prior art D1, two further prior art documents (D2 and D3) had to be considered to enable each of the two partial problems to be defined. It concluded that since each of the partial problems was solved by means which merely performed their known functions, each partial solution was obvious and the invention thus lacked inventiveness. In **T 597/93** the board again saw no inventive step in combining the claim's two features – both known per se – since they related to the solving of two entirely separate partial problems. It cited **T 687/94** which held that in such cases the solutions could be assessed separately against the prior art (see also **T 315/88**, **T 65/90**, **T 2110/08**).

In **T 711/96** the board found that characterising features (a) and (b) functioned completely independently of each other; there was no functional interplay (combination) between them. Although the setting for one value (e.g. spread) could indirectly affect that for the other (e.g. quantity), in that spread and quantity could both be adjusted upwards to maintain constant distribution, the two features were not directly related. In other words, the characterising features did not necessarily influence each other, although they could do. The board therefore assessed the inventive step of the two features separately, and concluded that both partial problems were obvious (see also **T 1585/07**).

In **T 410/91** the board of appeal stated that no inventive step was involved since, although all the measures in claim 1 contributed to an increase in the efficiency of the plant, that contribution was based on known, different individual effects which resulted in these measures being executed in a manner expected by the skilled person. The subject-matter of claim 1 therefore involved the stringing-together of known measures which displayed their characteristic effects; no **synergistic** effect based on a combination of the individual measures was discernible in the sense of a mutual influence on their respective operation (see also **T 144/85**, **T 141/87**, **T 407/91**, **T 1277/01**).

In **T 204/06** the board recalled that the "could-would approach" involved asking whether the skilled person would have – as opposed to could have – taken a certain step towards the invention in expectation of some improvement or advantage (**T 2/83**, OJ 1984, 265). This approach should not be taken to mean that inventions involving known design choices were non-obvious if only the number of choices was sufficiently great. It did imply, however, that if the skilled person expects some advantage of each feature in a claim and obtains no more than this advantage, then the claimed feature combination is obvious. It follows that any combination of features having known advantages (and disadvantages) is obvious unless it provides an unexpected effect (see also **T 2044/09**).

In **T 547/17** the board agreed that the two distinguishing features of the claim at issue contributed to maximising the output current, however, this did not mean that the resulting output current was more than the sum of the individual contributions of the two ratios. The mere fact that both features contributed to maximising the same physical quantity (here the output current) was not sufficient to conclude that there was synergy between them.

The board further agreed with the respondent that the two ratios according to the distinguishing features were interrelated. However, whether there was synergy between two features was a matter of whether their technical effects produced a combined technical effect which was greater than the sum of their individual technical effects, and not simply a matter of geometrical interrelation.

In **T 2622/19** the board held that even if the technical effect were credibly attributable to features (h) and (i) in combination, it was not convinced that the skilled person would have arrived at the subject-matter of granted claim 1 without the benefit of hindsight. While it could have made technical sense for the skilled person, based on their common general knowledge, to consider the respondent's objective technical problem (a combination of features), the board did not agree that the skilled person would have readily combined E2 with E5 as suggested by the respondent.

In **T 277/23** the board was of the view that the subject-matter of claim 1 was the result of a multiple selection from the wider disclosure of D1. But there being no technical effect associated with the selection steps, the steps were random. The board said that the skilled person was driven by routine to take such random selection steps in relation to the wider disclosure in the technical field in question, thus enabling them to arrive at the claimed subject-matter. The claimed subject-matter was therefore obvious to the skilled person. The question of how often the skilled person needed to make a selection to arrive at the disputed subject-matter of the claim while going about matters in their routine way was, contrary to the view of the appellant (who was of the opinion that four selections would be indicative of inventive step or of a sufficient inventive gaps), irrelevant (see also **T 204/06**).

9.4. Combination of teachings

In **T 1014/07** the examining division considered the subject-matter of claim 1 as obvious for the reason that each of the claimed features had been disclosed in the prior art. However, the board stated that the mere existence of teachings in the prior art was not a conclusive reason for explaining that the skilled person would have combined these teachings in order to solve the problem that they were confronted with. For the determination of the obviousness or non-obviousness of claimed subject-matter, it is not decisive that teachings are known – it must be decided whether or not the skilled person would have combined the known teachings such as to arrive at the claimed subject-matter when attempting to solve the underlying technical problem. Thus, the combination of known teachings may result in non-obvious subject-matter, namely when the skilled person is not motivated, for example by promptings in the prior art, to make such a combination. Under these circumstances the presence of any special effect arising from the combination is not necessary to establish an inventive step (see also **T 1861/16**).

In **T 2695/18** the appellant submitted that the claimed method lacked an inventive step in light of the combined teaching of document D1 (closest prior art) and D17. The appellant submitted that the disclosure in D17 of using Mn**(2+) in the preferred range of "10 nm to 100 µM" motivated the skilled person to use Mn**(2+) across this entire range. The board agreed that normally the mentioning of a feature in a document as being preferred motivated the skilled person to apply this teaching for an intended purpose. However the

skilled person seeking to increase sialylation of EPO/DPO would not ignore the experimental data and the explicit teaching in D17 that Mn**(2+) concentrations above 0.1 µM did not achieve this effect.

In **T 2197/19** the board found that D2 was in line with the **very essence** of the teaching in the closest prior art, D3, which disclosed "a method for moulding hollow articles of thermoplastic material". The skilled person would thus have combined the teachings of documents D3 and D2 to solve the first partial objective technical problem.

In **T 1246/21** the board noted that since Art. 56 EPC and the final stage of the problem-solution approach both considered what was obvious to a person skilled in the art, an inventive step could not be acknowledged solely on the finding that the claimed subject-matter was not directly and unambiguously disclosed from the combination of two documents. The skilled person's common general knowledge and skills also had to be taken into account when combining the two documents.

See also chapter I.D.5 "Could-would approach".

9.5. Technical disclosure in a prior art document

In line with the established case law of the boards of appeal, when investigating inventive step it should be borne in mind that the technical disclosure in a prior art document should be considered in its entirety, as it would be done by a person skilled in the art and that it is not justified arbitrarily to isolate parts of such document from their context in order to derive from them technical information which would be distinct from the integral teaching of the document (**T 56/87**, OJ 1990, 188; **T 768/90**; **T 223/94**; **T 115/96**; **T 717/96**;**T 776/96**, **T 414/98**, **T 501/04**, **T 212/22**, **T 702/22**, **T 2163/22**). According to **T 95/90**, **different parts of text in a document** can be combined if there is nothing to stop the skilled person from doing so. Any ex post facto analysis of a document, i.e. any attempt to misinterpret the disclosure of the prior art so as to distort the proper technical teaching of the disclosure in order to arrive at the claimed subject-matter, should be avoided since this would conceal the real technical contribution of the invention (**T 1967/08**).

9.6. Features not contributing to the solution of the problem

According to the established case law of the boards of appeal, features which do not contribute to the solution of the problem set in the description are not to be considered in assessing the inventive step of a combination of features (**T 574/92**). In **T 37/82** (OJ 1984, 71) The board held that in assessing the inventive step of a combination of features, consideration had to be given to a feature only if the applicant had provided evidence that it contributed, either independently or in conjunction with one or more of the other features, to the solution of the problem set in the description (see also **T 65/87**, **T 144/90**, **T 206/91**, **T 226/94**, **T 912/94**, **T 15/97**, **T 471/98**, **T 442/02**). Therefore, only those claimed features are to be considered which contribute causally to the solution of the problem (**T 285/91**). In **T 294/89** the board stated that the additional feature provided no surprising advantage and did not make any contribution to solving the problem

indicated. Hence, the said additional feature was not relevant for assessing the inventive step of the combination of features claimed.

In **T 589/95** the terms of the solution of the technical problem extended into an area of use where it had been admitted that the relevant problem was known not to arise in practice. The board stated that, for such an area, the features of the solution did not contribute to the solution of the technical problem and could not be taken into account in the assessment of inventive step.

With reference to **T 119/82**, Board 3.3.05 held in **T 72/95**, **T 157/97**, **T 176/97** and **T 158/97** that similar considerations applied to technically non-functional modifications. An inventive step could not be claimed on the basis of a non-functional modification of a known device. If a known device was modified by adding a feature which had no technical function, this modification could not be inventive (see also in this chapter I.D.9.1. "Assessment of inventive step in the case of mixed-type inventions").

In **T 1009/12** the board took the view referring to **T 206/91** that an ineffective concentration of a compound was considered as an arbitrary feature not contributing to the solution of the underlying problem and therefore not further considered. Since there were no further distinguishing features it was not feasible to identify the technical problem to be solved and the claim lacked inventive step.

In **T 2044/09** the board held that even if there was no pointer or suggestion in the prior art towards the addition of a distinguishing feature, if said modification was not linked to a particular functionality, then it could not per se constitute the basis for acknowledging an inventive step (see also **T 1289/22**).

In **T 2287/16** the board had no objection to the examining division ignoring, in an inventive-step assessment, a feature that it found to contravene Art. 123(2) EPC. The board considered that the examining division was not obliged to anticipate the replacement of such a feature with a similar one that might have been originally disclosed and to provide a speculative inventive-step assessment of a so-amended claim.

In **T 2623/17** the board held that a skilled person would retain those features of a prior art document which would also serve a technical purpose in the context of the claimed subject-matter, i.e. after the starting point of the prior art had undergone the proposed inventive development. The board illustrated this concept by way of analogy. If a skilled person wanted to improve a car with a diesel engine so as to be less harmful to the environment, and the solution to this problem was to provide the car with an electrical motor, a skilled person would have a good reason to retain the rear view mirror of the diesel car, because it was still necessary to supervise the rear of the car even when it was modified to have an electrical drive. However, the urea injection and catalyst of the diesel engine ceased to be useful when the latter was replaced by an electrical drive. A skilled person would therefore not have any motivation to retain it, even though it was mentioned in the prior art as an improvement over a diesel engine without NOx particle reduction.

In T **885/20** the board found the distinguishing feature did not credibly lead to any technical effect over essentially the **whole scope of the claimed subject-matter**. Hence, the distinguishing feature amounted to an arbitrary, non-functional modification of the prior art, and according to the established case law, any such arbitrary modification was to be disregarded in the assessment of inventive step

9.7. Substitution of materials – analogous use

In **T 21/81** (OJ 1983, 15) the board held that it had to be considered as forming part of their normal activities for a skilled person to select, from the materials known to them as suitable for a certain purpose, the one which was the most appropriate. In **T 324/94** the board held that the skilled person should therefore be at liberty, within the constraints of standard technical progress, to use alternative means known by them to have the same effect. In **T 410/92** the board concluded that the skilled person who encountered known problems when using newly developed materials would not be deterred from using them in order to achieve specific, desired improvements, particularly since the means of overcoming such problems could be derived from the prior art.

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

In this regard the board in **T 130/89** (OJ 1991, 514) held that the use of a known material in a combination on the basis of its known properties and in a known manner to obtain a known effect was not normally inventive ("similar use"). Exceptions to this principle might be allowed in special cases, e.g. where a selection brought unexpected advantages, a known prejudice was overcome or unforeseen difficulties were encountered, such as the need to alter another component (see also **T 1216/05**, **T 330/07**, **T 422/09**).

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

9.8. Combination of documents

In **T 552/89** the board confirmed that, when assessing inventive step, it was not permissible to combine the teachings of different documents within the state of the art in order to establish the obviousness of a claimed invention, unless it would have been obvious for the skilled person to do so at the time of filing. When a problem defined by reference to the closest prior art as disclosed in a primary document consisted of individual problems, the case law of the boards of appeal stated that the skilled person could be expected to take account of solutions to the individual problems proposed in different secondary documents in the same or neighbouring technical fields. Thus, the teachings of

secondary documents might be combined with the disclosure of the closest prior art if such secondary documents provided solutions to specific individual problems forming part of the objective problem in progressing from the closest prior art, in particular when such individual solutions were merely aggregated together in the claimed invention (see also **T 302/02**, **T 881/09**).

It would not be obvious to a skilled person to combine an isolated, **very old document**, which had not given rise to a trend in the art and whose teaching ran counter to the present trend, with the document reflecting the closest state of the art. See for example **T 261/87** (literature from 1907), **T 366/89** (a document filed in 1927), **T 404/90** (a "relatively old" document published in 1949).

In **T 745/92** the board pointed out that the disclosure of two prior documents – even if they were classified under the same IPC classification – could only be combined so as to result in a finding of lack of inventive step if such combination would have been obvious to a skilled person seeking to solve the problem underlying the claimed invention (see also **T 104/95**, **T 395/00**).

In **T 715/09** the board stated that IPC classification alone was no reason for determining whether or not two pieces of prior art could be combined. The mere fact that two documents had the same classification was no reason for saying the combination of the teachings was obvious (**T 745/92**). Likewise, the mere fact that the technologies had been given different IPC classes did not necessarily mean that they could not be combined.

In **T 302/02** the board added that, if an invention consisted of a new combination of features taken from different technical areas, a discussion whether or not it was obvious would normally involve at least as many documents as technical areas combined in it. The board adopted the approach taken in **T 552/89**, according to which a technical problem might be formed of "individual problems". The number of individual problems obviously depended on the degree of detail of the claim under consideration and the cited decision did not suggest that beyond a certain number the presence of an inventive step might be taken for granted. On the contrary, it was said to be obvious to try to solve the individual problems as long as the corresponding solutions were "merely aggregated together" in the claim.

In **T 278/14** the board rejected the argument that the need to combine three pieces of prior art in order to arrive at the claimed process confirmed the presence of an inventive step. The board held that there was no general principle which determines that in order for a lack of inventive step to be established only two documents may be combined.

In **T 881/09** the board stated that since the teachings of both documents stood in heavy discrepancy to each other, in view of their incompatibilities a combination of these documents was not obvious (**T 552/89**) but rather artificial and could only be the result of an ex post facto analysis.

In **T 1641/18** the board held that a combination of prior art documents was taken into consideration based on the prospect of actual success in solving the technical problem

underlying the application, and not on the skilled person's risk tolerance level in a particular area. It was normal for a skilled person (striving to improve the state of the art) to replace a feature regarded as essential in the narrow context of the closest prior art with other features which, in view of the teachings in the cited documents, offered a better or alternative means of fulfilling the same function.

In **T 1190/17**, the board was not convinced by the argument that because the board had to cite more than two documents to prove the lack of inventive step, this paradoxically showed that the claimed subject-matter could not be clearly derived from the state of the art. In the present case, distinctive characteristics (a), (b) and (c) identified on the basis of D2 gave rise to the definition of three different, independent problems. The board said that this gave grounds for analysing the question of inventive step separately for each individual characteristic and that multiple documents could be cited to show the lack of inventive step of the claimed subject-matter.

9.9. Chemical inventions

9.9.1 Problem-solution approach in chemical inventions

In a number of chemistry decisions the problem-solution approach – based on landmark decisions **T 1/80** (OJ 1981, 206), **T 24/81** (OJ 1983, 133) and **T 248/85** (OJ 1986, 261) – involves the following steps:

a) establishing the closest prior art;

b) defining the problem in the light of that prior art;

c) identifying the solution;

d) demonstrating the success of the solution;

e) optionally reformulating the problem;

f) examining the obviousness of the solution in view of the state of the art.

Demonstrating the success of the solution and reformulating the problem are particularly important steps (see **T 231/97**, **T 355/97**).

9.9.2 Structural similarity

In **T 852/91** the board held that to deny inventive step for novel chemical compounds because of their structural similarity to known chemical compounds amounted to an allegation that a skilled person would have reasonably expected the same or similar usefulness of both the known and the novel compounds as the means for solving the technical problem underlying the application in question. Such an expectation would be justified, if the skilled person knew, be it from common general knowledge or from some specific disclosure, that the existing structural differences of the chemical compounds

concerned were so small that they would have no essential bearing on those properties, which were important for solving the said technical problem and could be disregarded (see also **T 358/04**).

In **T 643/96** the board held that the concept of bioisosterism did form part of the common general knowledge of those skilled in the art, but that it had to be applied with caution when deciding upon inventive step. In the field of drug design, any structural modification of a pharmacologically active compound was, in the absence of an established correlation between structural features and activity, expected a priori to disturb the pharmacological activity profile of the initial structure. This also held true for an alleged case of bioisosterism, which was one option of a structure-activity relationship, as long as it was not an established case of bioisosterism (see also **T 548/91**). The board further held that, when deciding upon inventive step in relation to pharmacologically active compounds, what was essential was not whether a particular substructure of a chemical compound was replaced by another known isosteric one, but whether information was available on the impact of such a replacement on the pharmacological activity profile of the specific (group of) compound(s) concerned (see also **T 467/94**, **T 156/95**).

In **T 2402/10** the board stated that in the field of drug design, any structural modification of a pharmacologically active compound was, in the absence of an established correlation between structural features and activity, a priori expected to disturb the pharmacological activity profile of the initial structure (see **T 643/96**, **T 548/91**).

In **T 930/94** the board held that knowledge of the fact that one specific member of a class of chemical compounds did not lead to the effect achieved by several other members of this class, did not, without additional indications, mean that such an effect could be attributed to all the compounds in this group. In such circumstances, the effect in point did not lead to a recognition of the existence of a technical concept that could be generalised (see also **T 641/97**, **T 209/98**, **T 853/03**).

In **T 989/93** the board stated that, in the absence of the appropriate common general knowledge, no conclusions were possible on the basis of the known properties of one group of chemical compounds (here: benzene derivatives) regarding the properties of a different group of chemical compounds (here: naphthalene derivatives).

9.9.3 Broad claims

In **T 694/92** (OJ 1997, 408) the board, with reference to **T 939/92** (OJ 1996, 309), explained that Art. 56 EPC 1973 required the claimed invention, i.e. the proposed technical solution for a given technical problem, not to be obvious to a skilled person from the state of the art. If the inventive step of a claimed invention was based on a given technical effect, the latter should, in principle, be achievable over the whole area claimed (see also **T 583/93**, OJ 1996, 496).

T 939/92 (OJ 1996, 309) contained fundamental rulings on broad claims in the field of chemistry. The board held that in view of the state of the art the technical problem which the patent in suit addressed was the provision of further chemical compounds with

herbicidal activity. It was necessary for all the claimed compounds to possess this activity. Moreover, the question as to whether or not such a technical effect was achieved by all the chemical compounds covered by such a claim, might properly arise under Art. 56 EPC 1973, if this technical effect turned out to be the sole reason for the alleged inventiveness of these compounds. The appellants' submission that the test results contained in the description showed that **some** of the claimed compounds were indeed herbicidally active could not be regarded as sufficient evidence to lead to the inference that **substantially all** the claimed compounds possessed this activity. In such a case the burden of proof rested with the appellants. The requirements of Art. 56 EPC 1973 had not therefore been met (**T 268/00**, **T 1188/00**, **T 320/01**, **T 1064/01**, **T 924/02**, **T 488/16**).

Following **T 939/92** (OJ 1996, 309), the board stated in **T 668/94** that the technical problem could only be taken into account in the assessment of inventive step if it could be accepted as having been successfully solved, i.e. if it were credible that substantially all the claimed compounds possessed the plant growth regulating activity. When only some and not substantially all claimed compounds exhibited a particular technical effect, the conclusion had to be that the invention as broadly defined in the independent claim was not a solution to the technical problem of achieving the given technical effect, with the consequence that the alleged technical effect of some of the claimed compounds was to be disregarded when determining the objective problem underlying the invention and thus when assessing inventive step.

In **T 942/98** the problem as per the application was the preparation of improved selective herbicides. With reference to **T 939/92** (OJ 1996, 309), the board did not agree with the applicant that, in the case in hand, he merely had to show an improved effect at the direct interface between prior art and the application in order to demonstrate, without providing further details, that such an improvement applied without qualification for the entire breadth of the claim. The appellant's position, in the board's view, amounted to allowing the applicant to decide how broad a claim could be, whether or not an improvement in the effect of all the compounds claimed was actually credible.

In **T 415/11** the board stated when the credibility that a technical effect is achieved by substantially all claimed compounds is at issue and in a situation where, it is prima facie unlikely that this is credible, it is not the opponent, but the patentee who has the burden of proving that the effect is achieved (referring to **T 939/92**, OJ 1996, 309; **T 97/00**).

In **T 41/16** the board observed that it was the boards' established case law that a technical effect on which inventive step was based had to be achieved over substantially the whole of the claimed range (see e.g. **T 939/92**, OJ 1996, 309). However, that did not mean that every composition encompassed by a claim had to show an improvement over any composition comprised in the prior art, or even just over the one closest to the claim. What was required instead was that each composition according to the invention that differed from an equivalent composition in the closest prior art only in that it had the feature distinguishing the claim from the prior art showed the alleged improvement.

In **T 1296/13** the board stated that Art. 69 EPC and its Protocol did not provide a basis for excluding from a claim embodiments that fell within the wording of the claim (referring to **T 223/05**).

In **T 1265/17** the board held that if a claim was unduly broadened with respect to the scope of the examples used to illustrate a technical effect, particularly when this broadening concerned the feature/s allegedly providing that effect, the burden of proof might shift back to the proprietor to prove that the effect observed in the examples would also be obtained throughout the entire scope of the claims. If no evidence was provided in this respect, a conclusion may have to be drawn on the basis of plausibility arguments, in particular by assessing whether the effects in the examples could be plausibly extrapolated to other technically reasonable embodiments covered by the claims.

In **T 814/19** the appellant (opponent) contested that the problem was solved across the whole breadth of claim 1 because the claim was drafted too broadly; the claim would encompass formulations with high drug loadings that would not exhibit the required stability and bioavailability for administration to patients. The board disagreed. It was not disputed that the higher the drug loading, the more likely crystallisation was to occur. Crystallisation would reduce bioavailability to some extent, but some degree of crystallisation did not make the formulation necessarily unsuitable for administration to patients. Furthermore, the skilled person could not be expected to work within unreasonable ranges of drug loadings that would result in a massively oversaturated product that would no longer qualify as a solid dispersion.

9.9.4 Intermediate products

In decision **T 22/82** (OJ 1982, 341) the board ruled that the preparation of new intermediates for a surprisingly advantageous complete process for the preparation of known and desired end products was inventive.

Again in **T 163/84** (OJ 1987, 301) intermediate chemical products were held to be patentable on the grounds that their further processing to the known end products involved an inventive step. The board however held that a new chemical intermediate did not become inventive merely because it was prepared in the course of an inventive multi-stage process and was further processed to a known end-product; there had to be other factors as well, such as that the process for preparing the new intermediate had enabled it to be prepared for the first time and had done so inventively and other methods of preparing it had appeared to be ruled out.

In **T 648/88** (OJ 1991, 292) the board disagreed with the view expressed in **T 163/84**, pursuing instead the line taken in **T 22/82**. An intermediate intended for the preparation of a known end-product was deemed to be inventive if its preparation took place in connection with inventive preparation or inventive further processing or in the course of an inventive complete process (confirmed in **T 1239/01**).

In **T 65/82** (OJ 1983, 327) it was explained that new intermediates which take part in (non-inventive) analogy processes for sequent products (i.e. end products or intermediates of various kinds), must – in order to qualify as intermediates – provide a structural contribution to the subsequent products. Even where this condition was met, such intermediates were not thereby unconditionally inventive, i.e. not without taking the state of the art into consideration. As state of the art in relation to intermediates there are two different areas to be taken into account. One is the "close-to-the-intermediate" state of the art. These are all compounds identified from their chemical composition as lying close to the intermediates. On the other hand the "close-to-the-product" state of the art must also be taken into account, i.e. those compounds identified from their chemical composition as lying close to the subsequent products. With respect to the **"close-to-the intermediate" state of the art**, the question was whether or not the skilled person could have deduced from it the need to carry out certain purposive modifications to known compounds in order to obtain that intermediate which alone could enable them to solve the problem of making the subsequent products by means of a specific analogy process. With respect to the **"close-to-the product" state of the art**, a further question then was whether or not the skilled person could have derived from it the claimed intermediate in an obvious fashion.

In **T 18/88** (OJ 1992, 107) the applicants had argued that the insecticidal activity of the known end products was significantly superior to that of another known insecticide with a similar structure; this was sufficient to establish an inventive step for the intermediate products, even if the end products were not novel and/or inventive. The board, referring to **T 65/82** (OJ 1983, 327), rejected the applicants' argument on the following grounds: claimed intermediates must themselves be based on an inventive step to be patentable. Whether, under certain circumstances, new and inventive subsequent products might support an inventive step of intermediates was not the question here, because the subsequent products in this case were either not novel or not inventive. The superior effect of subsequent products which were neither novel nor inventive was not sufficient to render the intermediates inventive (**T 697/96**, **T 51/98**).

In **T 1798/22** the technical problem addressed by the patent in suit, was to provide an ethylene polymer composition to be used as an impact modifier. The board, referring to **T 65/82**, considered that the closest prior art D3 did not constitute a relevant "close-to-the-product" state of the art (since it did not address at all the use as an impact modifier and impact modified compositions) but rather that it could at most constitute a "close-to-the-intermediate" state of the art. However, since the problem of providing an impact modifier was not derivable from D3 itself, the answer to the question whether or not the skilled person could have deduced from it the need to carry out certain purposive modifications to known compounds in order to obtain that intermediate which alone could enable them to solve the problem of making the subsequent products could only be in the negative.

9.9.5 Predictable improvements resulting from to crystalline forms

It has been held in numerous decisions that an inventive step could be acknowledged if the claimed polymorph had an unexpected property meaning that its selection was non-arbitrary (**T 1994/22**, see also e.g. **T 777/08**, **T 1684/16**, **T 2086/21**). However, the mere presence of a further polymorph does not involve an inventive step, since screening for

polymorphs is a routine activity in the context of pharmaceutical development (see e.g. **T 2157/21**).

In **T 777/08** (OJ 2011, 633) the claims in question related to a particular polymorph (form IV) of crystalline atorvastatin hydrate. The board found that the skilled person in the field of pharmaceutical drug development would have been aware of the fact that instances of polymorphism were commonplace in molecules of interest to the pharmaceutical industry, and would have known it to be advisable to screen for polymorphs early on in the drug development process. Moreover, the skilled person would be familiar with routine methods of screening. Consequently, in the absence of any technical prejudice and in the absence of any unexpected property, the mere provision of a crystalline form of a known pharmaceutically active compound could not be regarded as involving an inventive step (see also **T 41/17**, **T 1831/18**). Further, when starting from the amorphous form of a pharmaceutically active compound as closest prior art, the skilled person would have a clear expectation that a crystalline form thereof would provide a solution to the problem of providing a product having improved filterability and drying characteristics. The arbitrary selection of a specific polymorph from a group of equally suitable candidates cannot be viewed as involving an inventive step.

In **T 478/17** the board distinguished the case in hand from **T 777/08** and **T 41/07**. The case in hand was not about the selection of any crystalline form but about the selection of one specific salt, namely eliglustat hemitartrate, in which at least 70% by weight of the salt was crystalline. The selection of this specific salt was not arbitrary. Rather, this salt had unexpected properties, namely an improved (reduced) hygroscopicity and an improved chemical stability. The board could not see any "one-way street situation" in view of D1, as claimed by the appellant. The skilled person starting from D1 would have had various choices in terms of stoichiometry and degree of crystallinity. It concluded that, having regard to the cited prior art, it would not have been obvious to the skilled person to isolate eliglustat hemitartrate in which at least 70% by weight of the salt was crystalline and arrive at the compound as defined in claim 19 of the main request.

In **T 1684/16** the board distinguished the case in hand from **T 777/08**, in the light of which the appellant submitted that the solution in the case in hand was obvious since screening of polymorphs was a routine task as demonstrated in the prior art. Unlike **T 777/08** the case in hand was not about the selection of any crystalline form but about the selection of one specific crystalline form (Form I of bosutinib monohydrate). The board found that the selection of this specific crystalline form was not arbitrary, but rather this form had unexpected properties, namely an improved stability when compared with the other crystalline forms in D1, D2 and D3. The fact that the skilled person was taught in the prior art to investigate polymorphs in order to isolate the crystalline form having the most desirable properties was in itself not necessarily sufficient to consider a specific polymorphic form having a certain desired property obvious (see also **T 1326/18**).

In **T 1079/18** the board found that the skilled person, faced with the problem of providing a crystalline form of febuxostat that has a higher solubility than form A, would clearly be inclined to check whether form A underwent an endothermic phase transition into a new higher-melting form at higher temperatures. Such a form existed or it did not. It found that

the skilled person would have been in a "try and see" situation. By performing a DSC analysis of form A, the skilled person aiming at higher solubility would have identified form I as being the desired form. The fact that form I merely retained the non-hygroscopicity of form A could be considered merely as a bonus effect that the skilled person inevitably achieved because they were primarily looking for a crystalline form of febuxostat with higher solubility.

In **T 215/20** the board distinguished the case in hand from **T 777/08**. First, the effect relied on for inventive step was different (filterability and drying characteristics in **T 777/08** vs hygroscopicity in the case at hand) and, second, although a solution to the objective technical problem of providing a pharmaceutical composition comprising a crystalline form of dapagliflozin which is more stable (i.e. less hygroscopic) may have been suggested by D4, the skilled person would not have had a reasonable expectation that the solution offered by D4 would have solved this problem. The skilled person would have considered the effect suggested by D4, namely the universal decrease in hygroscopicity, to be a mere allegation. Given the generally recognised high unpredictability of properties of crystalline forms, the skilled person would not have had a reasonable expectation of obtaining a less hygroscopic form of dapagliflozin.

In **T 672/21** the objective technical problem as defined by the board was the provision of a crystalline form of selexipag with a balance of beneficial properties. There was no absence of unexpected properties and the selection was not arbitrary, since the selected Form I had a balance of beneficial properties in terms of stability, industrial processability and purity in comparison with Form II and Form III. There was nothing in the prior art which pointed to the fact that the claimed Form I would have this balance of beneficial properties and they were thus not expected. The present case thus differed from the situation at issue in decision **T 777/08**. The board also distinguished **T 41/17** in which it was concluded that the skilled person would have performed screening of the different polymorphs disclosed in the closest prior art, to identify the most stable form. In the present case, stability was not the only property, but rather part of a balance of beneficial properties. Hence, even if the stability of Form I had been expected, the same would not have applied to the balance of various beneficial properties (see also **T 2086/21**).

The board in **T 1994/22** distinguished the case in hand from **T 672/21**, finding that there was no balance of beneficial properties. In the present case, the board saw nothing unexpected in finding a polymorph that was optimum for one property but only intermediate for several other properties. If this were unexpected and thus gave rise to an inventive step being acknowledged, an applicant or proprietor having identified a new polymorph would simply need to carry out tests for long enough to find one single property for which the identified polymorph performed best. This might result in a situation in which almost any polymorph in the world becomes inventive, which would render Art. 56 EPC meaningless.

In **T 2086/21** the board confirmed the objective technical problem underlying claim 1 was the provision of a form of apalutamide with a beneficial combination of properties: improved hygroscopicity, high thermodynamic stability and high polymorphic stability. The appellants (opponents) submitted that apalutamide was the subject of an Investigational New Drug filing before the filing date of the patent and argued the skilled person would

thus have been motivated to perform routine screening, polymorphic screening and stability testing being part of common general knowledge. The board found these submissions failed to take into account the formulation of the objective technical problem in accordance with the problem-solution approach, that Form B displayed a beneficial combination of properties which could not have been expected by the mere provision of a crystalline form per se. The board held there was no absence of unexpected properties. The board distinguished **T 41/17**; in the present case even if the effect of thermodynamic stability were to have been considered obvious, the same did not apply to the beneficial combination.

For more on "Try and see situation" see this chapter I.D.7.4. For more on "Unexpected bonus effect" see chapter I.D.10.8.

9.9.6 Synergistic effects

The concept of synergism is normally used to indicate an interaction of two or more technical measures that produces an effect which is greater than the sum of the separate effects provided by each of these measures (**T 2773/17**; see also e.g. **T 141/87**, **T 650/10**, **T 601/22**). It is not enough that the features solve the same technical problem or that their effects are of the same kind and add up to an increased but otherwise unchanged effect (**T 1054/05**).

In **T 1814/11** the problem to be solved was to provide an alternative synergistically active fungicidal composition based on prothioconazole. The board concluded that synergistic effects were not foreseeable, i.e. even if a combination of two specific compositions had a synergistic effect as in document 1, such synergy could not necessarily be expected if the structure of one of the two compositions were modified. **Synergy** was not in principle foreseeable and therefore could not be attributed to a specific mechanism of action and/or structure. The board dismissed the respondent's suggestion of **trial-and-error** experimentation as inappropriate in this case.

The board in **T 116/18** of 28 July 2023 noted that an inventive step was often acknowledged with reference to the common general knowledge that synergism was rare and unpredictable (see also **T 1336/19**). It explained that a synergistic effect did not deserve a special position compared with other effects on which patent applicants or proprietors regularly relied for inventive step. To successfully question whether a patent applicant or proprietor could rely on a specific purported technical effect required a legitimate reason to doubt said effect, and that must be more than the mere argument that the effect is surprising. The board in **T 1639/21** agreed, stating further that as for any other effect, it had to be established whether, having regard to the state of the art, obtaining a synergistic effect was obvious. The answer depended on the details of the case and the state of the art.

In **T 696/19** the board held that for a synergistic effect to be present, it was necessary to show that the sum of the separate effects was inferior to the effect of the two measures combined. This was not proven in the case in hand.

T 1639/21, the board held that in the case in hand the finding that the synergistic effect could be reasonably expected to occur depended on the skilled person's fundamental understanding of the mechanistic relationship between the mRNA vaccine and the antibody targeting an immune checkpoint and not on any structural elements of the compounds under consideration.

9.10. Equivalents

According to established case law of the boards of appeal, equivalents which are not disclosed in a published document must not be considered in assessing novelty, as this properly belongs to the examination for inventive step (see **T 167/84**, OJ 1987, 369; **T 446/88**; **T 517/90**; see also Guidelines G-VI, 2 – April 2025 version). In **T 697/92** the board dealt with the concept of "equivalent means", according to which two means were equivalent if, despite having different embodiments, they fulfilled the same function with regard to the same result. Both means performed the same function if they shared the same basic idea, i.e. if they applied the same principle in the same way. The result was the totality of the technical effects produced by the means. In order to be considered as equivalents, the means had to achieve the same kind and quality of result. A means was thus not equivalent if, because of its different embodiment, it led to a result of the same kind but of a different quality or degree of effectiveness. The result did not necessarily even have to be better; it was sufficient for it to be different, since it was not the result itself which was patentable but the means by which it was achieved (see also **T 818/93**, **T 929/02**).

9.11. Selection inventions

In **T 2623/11** the board stated that for selection inventions, only if the selection was connected to a particular technical effect, and if no hints existed which lead the skilled person to the selection, may an inventive step be accepted. In the case in hand, there was no support in the application for the claimed selection being connected to any particular technical effect. Moreover, hints existed in the state of the art which led the skilled person to the selection.

9.12. Problem inventions

The discovery of an unrecognised problem may in certain circumstances give rise to patentable subject-matter in spite of the fact that the claimed solution was retrospectively trivial and in itself obvious (see **T 2/83**, OJ 1984, 265; **T 225/84**). The posing of a new problem did not represent a contribution to the inventive merits of the solution if it could have been posed by the average person skilled in the art (**T 109/82**, OJ 1984, 473). It also had to be taken into consideration that it was the normal task of the skilled person to be constantly occupied with the elimination of deficiencies, the overcoming of drawbacks and the achievement of improvements of known devices and/or products (see **T 15/81**, OJ 1982, 2; **T 195/84**, OJ 1986, 121; **T 455/91**, OJ 1995, 684, **T 867/13**).

In **T 532/88** the board confirmed the established principle that to address a problem simply by looking for ways of overcoming difficulties arising in the course of routine work did not

constitute inventiveness. Following this case law, the boards held in **T 630/92**, **T 798/92**, **T 578/92**, **T 610/95**, **T 805/97**, **T 1417/05**, **T 2303/11** and **T 437/21** that the posing of the problem could not confer any inventive merit on the claimed subject-matter. Inventive step was however acknowledged in **T 135/94**, **T 540/93**, **T 1236/03**, **T 764/12**, **T 1201/13** and **T 2321/15** on the ground (also) that the posing of the problem was not obvious.

In **T 252/10** the board noted that the absence of a hint in the prior art that there might still be a desire for further improvement did not mean that an unrecognised problem had been discovered (see also **T 437/21**).

In **T 971/92** the board emphasised that the appreciation of conventional technical problems which formed the basis of the normal activities of the notional person skilled in the art, such as the removal of shortcomings, the optimisation of parameters or the saving of energy or time, could not involve an inventive step. The appreciation of a technical problem could thus only contribute to the inventive step in very exceptional circumstances. However, if an applicant nevertheless wished to rely on an assertion that the inventive activity resided in the recognition of a technical problem to which the solution was admittedly obvious, then the minimum requirement to be met was that this technical problem be clearly and unambiguously disclosed in the application as filed (see also **T 43/97**, **T 1417/05**).

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

In **T 764/12** the technical contribution of the patent in suit resided in identifying a problem which was hitherto not recognised in the prior art, namely the need for protection during storage at ambient environmental conditions of a chewing gum base comprising environmentally degradable polymers. The arguments of the opponent that the claimed invention lacked inventive step because the coating was well-known to reduce degradation over time were not relevant. Referring to **T 2/83** (OJ 1984, 265) the board acknowledged an inventive step because the perception of the problem had to be considered as being the main contribution to the inventive merits of the solution claimed.

In **T 703/18** the board noted that one reason why "problem inventions" were rare might be that they were somewhat at odds with the problem-solution approach. It was generally accepted that the formulation of the technical problem should not contain pointers to the solution or partially anticipate the solution. In contrast to this, "problem inventions" tend to do both. A situation might arise in which, if a subject-matter claimed was assessed as a "problem invention", an attack based on lack of inventive step could be successfully

directed only against the recognition of the problem, not against the claimed solution. At the same time, **T 2/83** made it clear on "problem inventions" that in the context of a clearly desired improvement, side-effects which might be interpreted as a solution of a yet unknown problem should not be decisive for patentability.

9.13. New use of a known measure

When determining inventive step in the case of a new use of a known measure, the boards of appeal examine whether or not the problem which has been solved with a known measure in a known case differs from the problem posed in the case to be decided. If this examination reveals that there is no fundamental difference between the two problems, it can in principle be concluded that there is no inventive step if the known measure is adopted (see in particular **T 39/82**, OJ 1982, 419; **T 142/84**, OJ 1987, 112; **T 332/90**; **T 485/91**; **T 25/97**). In **T 39/82** (OJ 1982, 419) the board stated that it could not be considered obvious for the skilled person to use a known measure in a different context since the problems differed fundamentally from one another.

Referring to **T 39/82** (OJ 1982, 419) the board confirmed in **T 818/93** that in a **combination invention** all the features might be known per se – the invention resided in the way the features were interrelated, both structurally and functionally. In assessing the inventive step of the combination in question it was therefore of no consequence that a suitable structure was already known, provided its use and application in the conditions, and circumstances disclosed in the patent were not suggested by the cited prior art. For more on combination inventions see in this chapter I.D.9.3.

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

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

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

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

In **T 940/21** the board found that feature 5 (pipeline segments maintained under a constant pressure) was not for solving the objective technical problem of simplifying and shortening the time for a method for laying a pipeline on a seabed as disclosed in D1, but for solving the technical problem of neutralising or minimising the effect of the external pressure head and to prevent wall collapse. In the board's view, the skilled person would thus not have arrived at the subject-matter of claim 1 in an obvious manner in view of the combination of disclosures argued by the appellant.

9.14. Obvious new use

Although **T 59/87** had found that a claim to an inherent but hidden later use of a known substance could be novel, the subject-matter of such a claim would still lack inventive step if the prior art indicated a well-established link between the earlier and later uses (see also **T 544/94**).

In **T 112/92** (OJ 1994, 192) document (1), as the closest prior art, referred to the use of glucomannan as a thickener for an ungelled processed food product, but did not mention its function as a stabiliser. The board applied the principles set out in **T 59/87** (OJ 1991, 561) to the case in hand and stated that even if glucomannan did act as an emulsion stabiliser in preparing the product in accordance with document (1), this use would have been a hidden use. It came to the conclusion that the use of a substance as a stabiliser for emulsions, if not inextricably linked with its use as a thickening agent, was at least very closely related. The board held that it would have been obvious for the skilled person, knowing that glucomannan was effective as a thickening agent for emulsions, at least to try to find out if it was also effective as a stabiliser. Although **T 59/87** had found that a claim to an inherent but hidden later use of a known substance could be novel, the subject-matter of such a claim would still lack inventive step if the prior art indicated a well-established link between the earlier and later uses (see also **T 544/94**).

9.15. Need to improve properties

In its Headnote to **T 57/84** (OJ 1987, 53) the board stated: if a product is required to manifest a particular property (in this case a highly fungicidal effect) under various conditions, the superiority of the invention will depend on whether or not that property is **improved under all conditions** liable to be encountered in practice and particularly under the various conditions evolved in order to test it (in this case exposure to water and wind). If comparative tests are cited in support of that superiority, it is their combined results that have to be considered. The decisive factor is whether the invention outperforms the substance used for comparison in the tests **as a whole** (in this case, results in the need to use a significantly lower concentration of the pollutant substance), even if the substance used for comparison proves better in one of the tests.

Following **T 57/84**, it was stated in **T 254/86** (OJ 1989, 115) that an invention which relied on a substantial and surprising improvement of a particular property did not also need to

show advantages over the prior art with regard to other properties relevant to its use, provided the latter were maintained at a reasonable level so that the improvement was not completely offset by disadvantages in other respects to an unacceptable degree or in a manner which contradicted the disclosure of the invention fundamentally (see also **T 155/85**, OJ 1988, 87). It was thus not necessary for there to be an improvement in every respect (**T 302/87**, **T 470/90**).

In **T 155/85** (OJ 1988, 87) it was further pointed out that subject-matter falling structurally between two particular embodiments of cited disclosure and displaying, in all relevant respects, effects substantially between those known for the same embodiments, lacked inventive step in the absence of other considerations.

9.16. Disclaimer

For information on disclaimers, see in particular chapter II.E.1.7. "Disclaimers".

9.17. Optimisation of parameters

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

In a number of other decisions, all of which referred to **T 36/82** (OJ 1983, 269) the subject-matter was found not to involve an inventive step, particularly when the problem addressed was to find a suitable compromise between different parameters (**T 263/86**, **T 38/87**, **T 54/87**, **T 655/93**, **T 118/94**, **T 1861/17**). In **T 410/87** the board stated that it was part of the activities deemed normal for the skilled person to optimise a physical dimension in such a way as to reach an acceptable compromise, serving the intended purpose, between two effects which were contingent in opposing ways on this dimension (see also **T 409/90**, OJ 1993, 40; **T 660/91**; **T 218/96**; **T 395/96**; **T 660/00**, **T 1861/17**, **T 1386/22**).

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

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

9.18. Small improvement in commercially used process

In **T 38/84** (OJ 1984, 368) the board of appeal pointed out that the achievement of a numerically small improvement in a process commercially used on a large scale (here enhanced yield of 0.5%) represented a worthwhile technical problem which should not be disregarded in assessing the inventive step of its solution as claimed (see also **T 466/88**, **T 332/90**). In **T 155/85** (OJ 1988, 87) the board added that it was correct to say that even small improvements in yield or other industrial characteristics could mean a very relevant improvement in large-scale production, but the improvement had to be significant and therefore above margins of error and normal fluctuations in the field in consequence of other parameters. In **T 286/93** the invention related to a process for manufacturing wrapping paper and board. The results for the process had shown that the machine speed and the mechanical quality of the paper obtained had improved by some 3 % vis-à-vis a process in which the order in which aluminium polychloride and cationic starch were added had been reversed. Since a process of this kind was obviously intended for the production of paper on an industrial scale, even a small improvement had to be regarded as significant.

9.19. Analogy processes

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

According to **T 2/83** (OJ 1984, 265), so-called analogy processes in chemistry are only claimable if the problem, i.e. the need to produce certain patentable products as their effect, is not yet within the state of the art.

In **T 1131/05** the board found that the conditions for granting a claim to an analogous process defined in **T 119/82** and **T 2/83** applied to the subject-matter of claim 10. It thus deemed a process claim directed to an analogy process to be new and inventive.

9.20. Envisageable products

In **T 595/90** (OJ 1994, 695) at issue was the inventiveness of a product which could be envisaged as such but for which no known method of manufacture existed. In its Headnote, the board noted that a product which could be envisaged as such with all characteristics determining its identity including its properties in use, i.e. an otherwise obvious entity, might nevertheless become non-obvious and claimable as such, if there was no known way or applicable (analogous) method in the art for making it and the claimed methods for its preparation were therefore the first to achieve this and do so in an inventive manner (see also **T 268/98**, **T 803/01**, **T 441/02**, **T 1175/14**).

In **T 268/98** the board found that the prior art did not comprise any technical information as to how to obtain the "pinning centers" according to claim 1. Therefore, even if the claimed product were to be considered highly desirable, there was no obvious method in the art to make it. Thus the average skilled person not even could, let alone would, have been able to arrive at the claimed product. The board, therefore, held that the product according to claim 1 involved an inventive step.

In **T 233/93** the combination of properties defining the claimed products had been a desideratum which the skilled community had striven to achieve. These properties, however had been considered to be irreconcilable. The board stated that such a desired product, which may appear obvious per se, may be considered non-obvious and be claimable as such, if there is no known method in the art to make it and the claimed methods for its preparation are the first to produce it and do so in an inventive manner (**T 1195/00**).

In **T 661/09** the board found the remaining features of claim 1 expressed no more than a set of desiderata, without any indication of a causal link between the desired properties and the constitution of the claimed device. Insofar as the claim did not define any concrete measures on how to ensure that the claimed properties were effectively obtained, the claimed properties remained at an abstract or conceptual level. The issue of inventive step boiled down to the question of whether or not the skilled person, in view of the available prior art and his/her common general knowledge, would in an obvious way have envisaged the claimed set of desiderata. The board found this question must be answered in the affirmative, concluding that claim 1 lacked an inventive step.

In **T 1079/18** the board distinguished the case before it from **T 595/90**, upon which decision the patent proprietor sought to rely. The board did not agree that form I was inventive simply because no way of making it had been found by the effective date of the patent. The skilled person would have obtained form I in an obvious manner, i.e. the process carried out until form I was obtained was not based on an inventive step. See also **T 1065/18**, **T 546/21**.

9.21. Examples of lack of inventive step

9.21.1 Foreseeable disadvantageous or technically non-functional modifications

In some decisions the subject-matter was found not to involve an inventive step, when the invention was the result of a foreseeable disadvantageous modification of the closest prior art (**T 119/82**, OJ 1984, 217; **T 155/85**, OJ 1988, 87; **T 939/92**, OJ 1996, 309; **T 72/95**; **T 694/13**, **T 2313/22**).

The board in **T 119/82** (OJ 1984, 217) had already found that disadvantageous modifications did not involve an inventive step if the skilled person could clearly predict these disadvantages, if their assessment was correct and if these predictable disadvantages were not compensated by any unexpected technical advantage. More recently, the board in **T 2197/09** confirmed that inventive step cannot be acknowledged on the basis of a purely disadvantageous modification of the closest prior art.

In **T 2465/19** the board found that distinguishing feature i) did not represent an arbitrary modification of the device of D1 having only foreseeable disadvantages, but rather represented an alternative solution to a known problem. The board accepted that the application did not explicitly mention any particular additional advantage or surprising beneficial effect. However, it could not be said to have only disadvantages with respect to D1. Nor could this feature be said to be arbitrary. The board noted with reference to Headnote II of **G 2/21** (OJ 2023, A85) that the technical effect of an invention over the closest prior art need not be explicitly stated in the application, as long as it was derivable from the original application, in particular since the closest prior art may not have been known to the applicant when drafting it. (see also chapter I.D.4.1).

9.21.2 Modifications to the closest prior art obvious to the skilled person

In **T 1862/15** the board accepted that an alternative means for achieving a known technical effect could, in some cases, be considered to involve an inventive step. However, achieving a known technical effect by means of modifications of the closest prior art which would be obvious to the skilled person could not be considered inventive.

In **T 3016/18** the board found that common technical questions and constraints taken into consideration as a matter of course by a skilled person were to be taken into consideration to prove the obviousness of a change to an embodiment in the state of the art.

In **T 814/22** the board found it was an obvious strategy to the skilled person to combine everolimus as a promising agent against HR+ breast tumours with one of the established therapies for treating HR+ breast tumours. Therefore, in the light of the common general knowledge, the combination of documents D9 and D10 would have led the skilled person to combine everolimus with an aromatase inhibitor as an obvious strategy for treating HR+ breast tumours.

9.21.3 Technical standards

In **T 519/12** the board held that it had to be expected of the skilled person that they would exercise their skills in the framework of technical standards in force in their field of activity. No inventive activity could be derived from a feature that simply reflected the contents of such a technical prescription.

9.21.4 Reversal of procedural steps

In **T 1/81** (OJ 1981, 439) the board held that in the absence of other features that from a technical point of view would contribute to patentability, the sequence in which the socket and pipe connection in the case in hand was made did not suffice to impart inventive step to the method claimed. The mere reversal of procedural steps in the production of component parts could not provide justification for inventive step.

9.21.5 Purposive selection

In **T 513/90** (OJ 1994, 154) the board held that if, for a particular application of a known process, the skilled person could obviously use a material generally available on the market and suitable for the purpose, and was also highly likely to use it for reasons irrespective of its characteristics, such use should not be considered as inventive on account of those characteristics alone. It stood to reason that if carrying out such a step was itself already obvious for other reasons, the natural choice of the particular means on the market-place was devoid of mental or practical effort, or of "purposive selection", in the absence of anything to the contrary (see also **T 659/00**, **T 1861/16**).

In **T 636/09** the board held that no inventive step was entailed in accepting a lower yield likely when using a more readily available raw material (e.g. where industrial hemp is substituted for marijuana (cannabis), the latter being more readily available for legal reasons).

9.21.6 Automation

According to the established case law of the boards, the mere automation of functions previously performed by human operators is in line with the general trend in technology and thus could not be considered inventive (**T 775/90**, **T 1175/02**, **T 438/06**, **T 734/13**, **T 711/14**, **T 2315/16**).

The mere idea of executing process steps automatically, e.g. replacing manual operation by automatic operation, was a normal aim of the skilled person (**T 234/96**).

In developing an automated process from a known manual process, apart from simply automating the individual steps of the manual process, the skilled person will also incorporate the facilities that automation typically offers for the monitoring, control and regulation of the individual process steps, provided they fall within the definition of technical skill (**T 850/06**). See also **T 2315/16**.

9.21.7 Enhanced effect

According to the case law of the boards of appeal enhanced effects could not be adduced as evidence of inventive step if they emerged from obvious tests (**T 296/87**, OJ 1990, 195; **T 432/98**; **T 926/00**; **T 393/01**).

In **T 308/99** the claimed use was based on a thoroughly obvious property of known substances. The slightly enhanced effects associated with the claimed use in comparison with substances used in prior art emerged from obvious tests.

In **T 104/92** the board held that work involving mere routine experiments, such as merely conventional **trial-and-error** experimentation without employing skills beyond common general knowledge, lacked inventive step. It would be obvious for a skilled person to use varying proportions of known polymers for outer layers with a reasonable expectation of obtaining better shrink or shrink and heat-seal characteristics for the laminate of the invention. See also in this chapter I.D.7.4 "Try and see situation".

In **T 253/92** the subject-matter of claim 1 related to a process for the manufacture of a permanent-magnet alloy. In the board's view, a skilled person would have regarded it as obvious to try out a variety of alloys known from the prior art to be of similar composition to those of the better examples and to measure their magnetic properties.

In **T 423/09** the board stated that the enhanced effect did not emerge from routine tests but from the practice to be followed according to the rules and recommendations of the handbook. The skilled person following the recommended practice prescribed in this handbook, and thus acting only routinely would inevitably obtain this enhanced effect, which therefore could not be taken as an indication of inventive step.

In **T 237/15** the technical problem was the provision of a treatment regimen for human patients based on oral administration of suberoylanilide hydroxamic acid. The board found that the determination of the optimum dosage regimen required to achieve the therapeutic effect in the (human) patient was a matter of routine experimentation for the skilled person. It held that such routine tests did not require inventive skill and could consequently not establish an inventive step. See also in this chapter I.D.9.21.12 "Animal testing and human clinical trials".

9.21.8 Simplification of complicated technology

In **T 61/88** the board indicated that, in the face of an optimal but sophisticated solution to a technical problem, the skilled person could not be denied the capacity to recognise that less complicated alternatives generally achieved less perfect results and consequently to envisage such alternatives, at least in situations in which the advantages of decreased complexity could reasonably be expected to outweigh the resulting loss of performance (**T 817/94**).

In **T 505/96** the board concluded that the simplification of complicated technology in situations in which the advantages of decreased complexity could reasonably be expected

to outweigh the resulting loss of performance must be considered to be part of the normal work of the person skilled in the art.

9.21.9 Choice of one of several obvious solutions

a) Arbitrary choice from a host of possible solutions

A merely arbitrary choice from a host of possible solutions cannot be considered inventive if not justified by a hitherto unknown technical effect that distinguishes the claimed solution from the other solutions (**T 939/92**, OJ 1996, 309; **T 739/08**; **T 1175/14**; **T 2554/16**; **T 1148/15**; **T 115/18**; **T 1984/15**; **T 1862/15**, **T 1445/21**). In **T 400/98** the board stated that applying one of the possible solutions which were available to the skilled person required no particular skills and hence did not involve an inventive step (see also **T 107/02**). In **T 1984/15** the board held that both single and repeated arbitrary choices were part of the skilled person's routine approach to providing an alternative solution.

In **T 1862/15** the board held that in a case involving an arbitrary selection, the prior art did not need to contain an incentive for the skilled person to select the particular solution claimed. Instead, all possible solutions had to be regarded as being equally suitable and obvious candidates for solving the objective technical problem; therefore, they all had to be considered to be suggested to the skilled person. See also **T 2029/21** in which decision the board held that where the problem to be solved resided in the provision of a mere alternative, no suggestion in the prior art was needed in order to render the subject-matter claimed obvious. Rather, it was sufficient to show that said missing features constituted an arbitrary selection within a host of available alternatives.

In **T 588/99** the board stated that in the particular situation where a document explicitly defined any compound having a certain activity as a suitable component of a detergent composition, and urged the skilled person to look for such compounds in publications of other technical fields such as biochemistry and medicine, it required no inventive activity to solve the technical problem of providing an alternative to the compositions disclosed in such prior art by replacing the explicitly specified compounds having the given activity with any other such compounds which may be found by exploring the other technical fields.

In **T 1941/12** the board stated inter alia that an arbitrary selection of strains, **by the very fact of it being arbitrary**, did not involve any inventive step. This was even more so since the two specific strains chosen were known from the prior art as commercially available.

In **T 892/08** the board referred to the established case law whereby, when the technical problem is simply that of providing a further composition of matter or a further method, i.e. an alternative to the prior art, any feature or combination of features already conventional for that sort of composition of matter or method represented an equally suggested or obvious solution to the posed problem. The boards have repeatedly established that the simple act of arbitrarily selecting one among equally obvious alternative variations is devoid of any inventive character. See also **T 311/95**, **T 89/16**.

In **T 816/16** the board held that the further addition of components well-known for their activity in the technical field concerned was considered an arbitrary choice among components which the skilled person would have had at their disposal.

In **T 1779/19** the proposed solution did not successfully solve the problem presented in the patent. However, the board considered that the experiments in the patent at least demonstrated that the claimed method performed significantly better than other known alternatives. This implied that the claimed additives had been identified as particularly effective for the purpose of preventing chlorine deposition, so they could not be considered to be arbitrarily selected. The board concluded that the claimed subject-matter did not simply provide a (general or arbitrary) alternative, but rather an alternative which was highly effective when compared to other commonly used additives. The problem to be solved was therefore reformulated as the provision of an alternative method which ensured a high effectiveness in the prevention of chlorine deposition.

b) Selection from obvious alternatives

In **T 190/03** of 29 March 2006 the board stated that in connection with the obviousness of a solution chosen from various possibilities, it was sufficient that the one chosen was obvious and not necessarily relevant that there were several other possible solutions (see also **T 214/01**, **T 688/14**).

In **T 357/02** the board found it followed from the minimalist character of the technical problem objectively arising from the closest prior art, which could only be formulated as a modification of that state of the art, that regardless of a success or failure of the measures applied, almost any modification of the latter process might be regarded as a feasible alternative by the person skilled in the relevant art, and therefore obvious, since each corresponding solution would be equally useful (or useless).

In **T 1072/07** the board concluded that to solve the problem (how to select a suitable type of burner), the person skilled in the art had to make a choice between two well-known possibilities. Either choice, which in a particular situation would be based on balancing the advantages of the specific type of burner being selected, such as efficiency in its operation, with its disadvantages, such as technical adaptations required and costs involved, was therefore obvious and did not involve an inventive step.

In **T 1045/12** the appellant (applicant) argued that the solution to the objective technical problem taught by D3 was one of several, equally likely options and that the board had to provide a reason why the skilled person would have selected the claimed option. The board disagreed. The fact that there were other options had no bearing on the obviousness of one specific option. Furthermore, if all options were equally likely, then the invention merely resulted in an obvious and consequently non-inventive selection among a number of known possibilities. See also **T 288/15**.

9.21.10 Several obvious steps

If the technical problem that the skilled person has set themselves to solve brings them to the solution step by step, with each individual step being obvious to them in terms of what they have achieved so far and what remains to be done, the solution is obvious to the skilled person on the basis of the prior art, even if two or more such steps are required, and it does not involve an inventive step (**T 623/97**, **T 911/98**, **T 558/00**, **T 1514/05**).

9.21.11 Putting the closest prior art device into practice

In **T 405/13** the invention was a meter with rapid response glucose sensor further adapted to cause the measurement of current to occur at a time 5 seconds or less after the detection of sample application. The objective technical problem to be solved was to implement a timing circuit having a concrete point in time at which the timing circuit causes the measurement of current to occur. Deciding whether the claimed solution to this problem was obvious or not boiled down to the question of whether or not the skilled person, while putting the meter of D10 (biosensing meter) into practice, would arrive at a value falling within the claimed range (for a similar approach see **T 408/12** and **T 315/97** of 21 June 2002). In the board's view, no inventive step could be seen in including in the reasonably broad time range as required by the timing circuit of the meter of D10 the claimed value of 5 seconds, the less so since reducing measurement time had to be considered as an obvious desire of the user.

9.21.12 Animal testing and human clinical trials

In **T 1493/09** the board found that the skilled person seeking to solve the problem formulated (provision of a broadly effective vaccine against HPV, especially providing broad protection against cervical cancer) would have considered not only formulations for immediate use in human clinical trials but also additional animal testing. It took the view that its assessment according to the problem-solution approach applied for the same reasons to claim 1 of auxiliary request 1 (directed to the second medical use of the vaccine composition and including the therapeutic effect "prevention or treatment of a disorder related to HPV infection" as an explicit feature), and concluded accordingly that it too lacked inventive step. See also **T 237/15**.

In **T 237/15** the invention aimed to provide suitable dosages and dosing schedules of histone deacetylase inhibitors, especially suberoylanilide hydroxamic acid (SAHA), and to develop preferably oral formulations. The technical problem was the provision of a treatment regimen for human patients based on oral administration of SAHA. The board found the skilled person, in the knowledge (disclosed in D2) that SAHA was bioavailable when given orally in animal studies and having been given the information that SAHA achieved effective treatment in humans when introduced directly into the blood stream, would expect an effective treatment also for oral administration in human patients. The determination of the optimum dosage regimen required to achieve the therapeutic effect in the (human) patient was a matter of routine experimentation for the skilled person. The board held such routine tests did not require inventive skill and could consequently not establish an inventive step. See also in this chapter I.D.9.21.7 "Enhanced effect".

10. Secondary indicia in the assessment of inventive step

10.1. General issues

According to established case law of the boards of appeal, a mere investigation for indications of the presence of inventive step is no substitute for the technically skilled assessment of the invention vis-à-vis the state of the art pursuant to Art. 56 EPC. Where such indications are present, the overall picture of the state of the art and consideration of all significant factors may show that inventive step is involved but this need not necessarily always be the case (see **T 24/81**, OJ 1983, 133 and **T 55/86**). Secondary indicia of this kind are only of importance in cases of doubt, i.e. when objective evaluation of the prior art teachings has yet to provide a clear picture (**T 645/94**, **T 284/96**, **T 71/98**, **T 323/99**, **T 877/99**, **T 56/22**). Indicia are merely **auxiliary considerations** in the assessment of inventive step (**T 1072/92**, **T 351/93**, **T 179/18**, **T 3016/18**).

In **T 754/89** – "EPILADY" the board detailed its reasons for ruling that an inventive step was involved. Although factors such as commercial success, the overcoming of prejudice, the age of the documents cited, the cost of advertising and the creation of a new market segment, the satisfaction of a long-standing need, the existence of imitations and forms of infringement had received considerable attention, particularly in the parties' written submissions, the technical facts of the case were such that secondary indications of inventive step had lost any relevance.

In **T 915/00** the board held that commercial implementation, licensing and the recognition of the inventor's merits by the scientific community constituted further convincing secondary indicia for the presence of inventive step.

In **T 1892/12** the board observed that the boards had in some cases taken account of "secondary indicia" that an inventive step was involved but had not so far done so for the purposes of establishing that it was lacking. According to Art. 56 EPC, an invention shall be considered as involving an inventive step if, having regard to the state of the art, it is not obvious to a person skilled in the art. In view of the negative definition in Art. 56 EPC, the board considered that inventive step could never in fact be proven but that secondary indicia might sometimes show it was plausible. A lack of inventive step by contrast could actually be proven by conclusively showing that a solution was obvious. So proving a lack of inventive step was possible, in principle, and indeed necessary where such a lack was alleged; it was then not enough to point to secondary indicia.

In **T 179/18** the board was not persuaded that any of the secondary indicia claimed by the appellant conferred inventiveness on the subject-matter of claim 1. It held that secondary indicia such as the satisfaction of a long-felt need, the overcoming of a prejudice in the professional world, or economic success, were auxiliary considerations in assessing inventive step. However, in the case in hand, application of the problem-solution approach led to the clear result that the subject-matter of claim 1 did not involve an inventive step.

10.2. Technical prejudice

According to the case law of the boards of appeal (see **T 119/82**, OJ 1984, 217; **T 48/86**), inventiveness can sometimes be established by demonstrating that a known prejudice, i.e. a **widely held but incorrect opinion** of a technical fact, needs to be overcome. In such cases, the burden is on the patentee (or patent applicant) to demonstrate, for example by reference to suitable technical literature, that the alleged prejudice really existed (**T 60/82**, **T 631/89**, **T 695/90**, **T 1212/01**, **T 1989/08**, **T 3016/18**).

A prejudice in any particular field relates to an opinion or preconceived idea widely or universally held by experts in that field. The existence of such prejudice is normally demonstrated by reference to the literature or to encyclopaedias published before the priority date. The prejudice must have existed at the priority date, any prejudice which might have developed later is of no concern in the assessment of inventive step (**T 341/94**; see also **T 531/95**, **T 452/96**, **T 1212/01**, **T 25/09**, **T 99/19**, **T 1328/20**).

In **T 3016/18** the board confirmed that the existence of a technical prejudice could, in case of doubt, be an auxiliary consideration in assessing whether there was inventive step, but was no substitute for a technical expert assessment of the invention vis-à-vis the state of the art.

10.2.1 Demonstrating prejudice

Generally speaking, established board of appeal case law is **very strict** when it comes to recognising the existence of a prejudice. For a prejudice to be considered actually to exist, there must be a **prevailing but incorrect school of thought widespread throughout the entire technical field**. A solution put forward as overcoming a prejudice must clash with the prevailing teaching of experts in the field, i.e. their unanimous experience and notions, rather than merely cite its rejection by individual specialists or firms (**T 531/95**; see also **T 62/82**, **T 410/87**, **T 500/88**, **T 74/90**, **T 793/97**, **T 2453/09**). A high standard of proof to demonstrate prejudice is required; that the expression of the prejudice in standard works or a textbook is normally required, raises the **level of proof** close to that needed for proving common general knowledge (**T 1989/08**).

A typical way of proving a prejudice is the citation of common technical knowledge published before the priority date, although other ways cannot be excluded. However, statements in the patent that are not accompanied by the citation of specific evidence of the alleged prejudice are not a suitable way of demonstrating a prejudice. Similarly, a mere statement in a patent application, cannot prove the presence of a prejudice, either (**T 2173/22**).

In **T 69/83** (OJ 1984, 357) the board held that the mere fact that the disadvantage resulting from the omission of a component of a mixture recognised in the art as advantageous was accepted suggested conscious acceptance of a disadvantage, not the overcoming of a prejudice. The fact that a disadvantage is accepted or the prejudice simply ignored does not mean that a prejudice has been overcome (see also **T 262/87**; **T 862/91**).

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

In **T 550/97** the board did not consider the fact that arguably less advanced solutions had been developed later, to be evidence of inventive step, as there was no reason to assume that later development was attributable to a technical prejudice which the invention had needed to overcome.

In **T 1212/01** the patentee referred to some thirty scientific articles in order to demonstrate the existence of a technical prejudice that drugs lowering blood pressure were a cause of impotence rather than a form of treatment for that condition. The board, however, stated that the contents of such a selection from the prior art could not be considered per se as creating a technical prejudice against oral treatment of male erectile dysfunction. Such a prejudice could only be established by proving that, in relation to the technical solution, a relatively widespread error or misapprehension about the technical invention existed among skilled workers in the relevant field before the priority date of the patent in suit. This was not the situation in the case in hand.

In **T 984/15** the board found that the fact that something was not explicitly disclosed, or even that it was explicitly prohibited, in a technical specification must not be necessarily interpreted as a prejudice of technical nature. There might be other non-technical reasons, such as circumventing a patented technology or simply lack of time in the meetings for further discussions that led the drafting group to dismiss or ignore an otherwise valid technical option.

In **T 179/18** the board considered that the three years separating the filing date of the patent and the filing date of the disclosed prior art was not a long period indicative of a technical prejudice.

10.2.2 Isolated examples of prejudice

Generally speaking, prejudice **cannot** be demonstrated by a statement in a single patent specification (**T 19/81**, OJ 1982, 51; **T 392/88**, **T 900/95**, **T 1212/01**), since the technical information in a patent specification or a scientific article might be based on special premises or on the personal view of the author. However, this principle does not apply to explanations in a standard work or textbook representing common expert knowledge in the field concerned (**T 321/87**; **T 392/88**; **T 515/91**; **T 453/92**; **T 1212/01**).

In **T 943/92** the existence of a prejudice was supported by a specialist book which reflected the technical knowledge in the special field of the contested patent. This book did not contain the opinion of just one specialist author, but that of experts in the field, as it had resulted from the collaboration of "numerous recognised scientists, technicians and practicians as well as associations and institutes". General critical remarks in one textbook were not sufficient to substantiate an alleged prejudice, if a plurality of prior art documents pointed to the opposite (**T 134/93**).

In **T 1989/08** the board noted it was not enough that the opinion or idea was held by a limited number of individuals or that it was a prevalent view within a given firm, however large. In the case in hand all the evidence offered in support of the alleged prejudice amounted to no more than ten documents, all of which were either specialist papers or patents. This small number of publications intended for a select readership in the field was in itself a tenuous basis for asserting prejudice (see also **T 25/09**).

In **T 2044/09** the board did not interpret a declaration by a technical expert in the field as evidence that there was a prejudice in the prior art at the priority date; rather, this declaration was taken as the opinion of one expert, issued almost ten years after the priority date.

In **T 638/19** the board found that regarding the alleged prejudice in the prior art, D4 and D1 were isolated publications which neither constituted common general knowledge nor presented conclusions that could be understood by the skilled person as being generally applicable. Therefore, they could not set a prejudice for the skilled person.

10.2.3 Development of the art in a different direction

One form of secondary indicia in the nature of a "technical prejudice" is a **development of the art in a different direction** (**T 24/81**, OJ 1983, 133; **T 650/90**; **T 330/92**).

In **T 883/03** the board found that the teaching that could have led to the characterising feature of claim 1 had long formed part of the state of the art; yet for all that time experts had been **"blind"** to that knowledge. In the case in point that was a further indication of the inventiveness of the solution proposed in claim 1.

In **T 872/98** the board pointed out that the presence of secondary indicia might also be attested by the fact that a competitor had, shortly after the priority date, filed a patent application with the German Patent Office in which the invention took an entirely different direction to the European application.

In **T 779/02** the board indicated that a prejudice could be proved by the fact that the closest prior art and the invention were separated by a long period of time (over 16 years in the case in hand), during which time the only solutions pursued led away from the invention, and the solution provided by the invention only becoming acceptable to experts in the field after this time.

10.3. Age of documents – time factor

The age of documents known long before the filing date might only be an indication of an inventive step if a need for the solution of an unsolved problem had existed for the entire period between the date of the documents and that of the invention (**T 79/82**, **T 295/94**). Nevertheless, the long period of time to be considered was not the period that had elapsed between the publication of a document and the filing of the European patent application disclosing the teaching of that document, but that between the time the problem became

apparent and the date of filing of the European patent application providing a solution (**T 478/91**).

In **T 273/92** the board held that a period of 23 years between the publication date of the document deemed to be the closest prior art and the priority date of the contested patent in an economically significant and frequently studied field could normally be viewed as an indication of the presence of inventive step. In **T 203/93** and **T 795/93** a period of 11 years was considered to be an indication in support of inventive step, in **T 986/92** a period of 70 years, in **T 478/91** 80 years and in **T 626/96** 60 years. See also **T 774/89**, **T 540/92**, **T 957/92**, **T 697/94**, **T 322/95**, **T 255/97**, **T 970/97**, **T 6/02**, **T 2271/08**.

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

In **T 1077/92** the board faced the unusual situation of a problem and its ready solution having co-existed for 100 years in general, and more recently in a field of intensive research, and still the seemingly obvious step had not been taken. The board concluded that, as no other explanation could be found, this must have been because inventive insight was needed. In **T 617/91** the board compared the 100 year interval in **T 1077/92** to the seven year interval between D1 and the priority date of the alleged invention in the case in hand. The board noted that despite there being a strong incentive amongst SG iron makers throughout that time interval to look for better methods which would be safer, and more economical, throughout that interval the teaching of D1 was ignored. Consequently, although D1 seen in hindsight seemed to suggest a solution, the board drew the inference that the generality of its teaching was such that it remained unnoticed, and would have remained so but for the inventive insight of the appellant.

In **T 123/97** the board found the failure to adopt an obvious solution to the technical problem underlying the patent in suit may have resulted from a variety of causes; for example, there may have been a commercial reason for not adopting this new technique, because the old technique was found satisfactory by the clients and could also be improved, thus avoiding considerable investment costs involved in the adoption of a new technique on an industrial scale. Therefore in the board's judgement, the claimed use according to claim 1 did not involve an inventive step.

The board in **T 833/99** found that, in addition to the other factors it had mentioned in examining whether a method of producing a grooved-rail frog for tramlines was inventive, it also had to be taken into account that citation D1 dated from 1930 and that, in the 60 years between it and the invention at issue, no skilled person had had the idea of taking up what it suggested and applying the method described to a single-piece frog. That was a serious indication of non-obviousness which could not be ignored.

The board in **T 1192/09**, having found that there was an inventive step, added that the actual developments in the relevant technical field, as evidenced by the documents on file, provided additional support in favour of an inventive step. The board noted in this respect that D8 (closest prior art) had been published about 12 years before the filing date of the patent in suit. The fact that the very inventors of D8 had not proposed the claimed structure, with its uncontested advantages, until 12 years after the publication of D8, and that this structure had later been praised in D10 (European patent, same inventors as D8, underlying application filed two months after the patent in suit) and made the subject of a granted European patent was considered by the board to be an additional indication of the non-obviousness of the concept which formed the basis of the claimed invention.

10.4. Satisfaction of a long-felt need

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

In **T 605/91** the board stated that it was not sufficient if only one individual skilled person discovered a "long-felt need". Only if various and repeated attempts to deal with the relevant disadvantages could be identified would such a long-felt need appear to have persisted.

In **T 1014/92** the board did not accept the appellant's further argument that the long period of time (about 35 years) during which documents (1) and (2) had been available to the public without having been combined, was in itself cogent evidence that there was no obvious connection between them. The board held that this conclusion might only be drawn if evidence relating to time were corroborated by other evidence, such as long-felt want (see also **T 1183/06**).

In **T 271/84** (OJ 1987, 405) the board found that where a process had been performed successfully on a commercial scale for more than 20 years in spite of economic disadvantages associated with it, and the claimed invention provided a solution to the technical problem of avoiding such economic disadvantages, this supported a finding of inventive step.

In **T 1599/21** the board did not consider the period of one year to be long enough to establish a "long felt need".

10.5. Commercial success

In principle, commercial success alone is not to be regarded as indicative of inventive step, but evidence of immediate commercial success when coupled with evidence of a long-felt want is of relevance provided the commercial success derives from the technical features of the invention and not from other influences (e.g. selling techniques or advertising). See Guidelines G-VII, 10.3 – April 2025 version.

In **T 106/84** (OJ 1985, 132) the board found that the appellant's assertion that the commercial success his device enjoyed was merely based on the superior performance of the product related to the features claimed, rather than extraordinary sales promotion efforts, must be considered in the light of the fact that the appellant's company was rather small and conceivably could not afford to indulge in major sales campaigns and sophisticated marketing techniques. The board was thus prepared to accept that the commercial success of the invention stemmed from the technical advantages related to the features claimed.

In **T 110/92** the board did not dispute that the heating assembly according to claim 1 might have been a commercial success. However, such a commercial success alone, with the technically relevant examination of the claimed subject-matter leading to a negative result, could not be regarded as forming the basis for an indication of inventive step even if the board were convinced that the success derived from technical features of the heating assembly and not from other causes such as those of a commercial nature (see also **T 5/91**, **T 219/90**, **T 373/94**, **T 109/15**).

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

In **T 1212/01** the patent related to pyrazolopyrimidinones for the treatment of impotence (Viagra). The board stated that in order to establish commercial success as an indicia of inventive step, two evidentiary steps were required. Firstly, commercial success must be demonstrated and, secondly, it had to be shown that such success resulted from the claimed invention and not from one or more other causes. Viagra had been the subject of various awards and praise in various journals. The board stated that the prizes would have been significant if awarded by persons who understood patent law. If however the prizes were awarded for the product's life-enhancing nature, or for the appellants' high standard of research, or for a high level of sales, then, for all that any of those reasons might well be prize-worthy, the prizes could have no significance in the context of inventive step. The board arrived at the conclusion that the evidence did not establish that the "prizes and praises" had resulted from the claimed inventive step.

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

In **T 626/96** the invention had likewise achieved great commercial success and gained widespread recognition in a number of countries. Furthermore, the success was achieved

in a very short space of time, so that there seemed to be a pressing commercial need for this simple solution. Furthermore, the success was directly attributable to the structure of the product claimed and was not due to marketing techniques or advertising skills.

10.6. Market competitors

Market competitors' efforts to obtain rights of joint use constitute further secondary indicia closely related to commercial success. They may result in a positive decision on inventive step, but need not necessarily do so. In **T 351/93** the board stated that the latter applied particularly where a technical and expert assessment of the invention in the light of the prior art led, according to the problem-solution approach, to the conclusion that the existence of inventive step had to be denied.

In **T 812/92** – the board found inventive step was also supported by the fact that shortly before the filing date of the contested patent, one of the patent proprietor's competitors offered a customer a technical apparatus without implementing the advantageous technical solution according to the invention.

In **T 252/06** the board confirmed the presence of inventive step inter alia on the grounds that the patent proprietor's competitors had used the patent's teaching and had filed applications relating to it.

10.7. Simple solution

In a technical field of commercial importance to which considerable attention is directed the simplicity of a proposed solution may indicate inventive step. The difficulty of developing a simple solution without sacrificing quality may therefore indicate inventive step (**T 106/84**, OJ 1985, 132; **T 9/86**, OJ 1988, 12; see also **T 229/85**, OJ 1987, 237; **T 44/87**; **T 528/89**; **T 73/95**). This did however presuppose the absence in the prior art of anything that hinted at the proposed solution (**T 712/92**).

In **T 29/87** the board expressed the opinion that a "simple" solution may be an indication for the presence of an inventive step if in the prior art the only processes disclosed were cumbersome, expensive, time-consuming, etc., i.e. which bore certain disadvantages and, although the problem to be solved apparently was not new and actually solved in more complex ways, the state of the art was nevertheless provided with a surprisingly "simple" solution.

In **T 234/91** it was pointed out that experience in structural engineering showed that with the same or even an improved effect – in the case in point an increase in reliability – it was often much more difficult to identify and achieve a simple solution than complicated embodiments. In view of the large number of solutions suggested in the technical literature, the board came to the conclusion that the improvement achieved by the simple structural measure suggested in the contested patent had not been obvious (see also **T 330/87**).

In **T 349/95** the subject-matter at issue related to a simple form of a simple device, a device which, however, had brought about a surprising major functional improvement. In the

board's view, this surprising improvement and the fact that the prior art gave no clear hint of the solution constituted evidence of the inventiveness of the claimed solution.

A different aspect was dealt with in **T 113/82** (OJ 1984, 10). In order to proceed from the known art to the invention, a series of steps needed to be taken. The board stated that this could be considered as an indicator of the presence of inventiveness, particularly in a case where the last decisive step had neither been proved to be known from the prior art nor was derivable therefrom, although this last step might at first sight seem to be a very simple one (see also **T 315/87** of 13 September 1989; **T 508/88**; **T 424/89**; **T 394/90**).

10.8. Unexpected bonus effect

10.8.1 General

An effect which may be said to be unexpected can be regarded as an indication of inventive step (**T 181/82**, OJ 1984, 401). However, certain preconditions have to be met.

If, having regard to the state of the art, it would already have been obvious for a skilled person to arrive at something falling within the terms of a claim, because an advantageous effect could be expected to result from the combination of the teachings of the prior art documents, such claim lacked inventive step, irrespective of the circumstance that an extra effect (possibly unforeseen) was obtained (**T 21/81**, OJ 1983, 15; see also **T 365/86**, **T 350/87**, **T 226/88**, **T 1317/13**, **T 696/19**, **T 1491/20**). Similarly, where, because of an essential part of the technical problem being addressed, the state of the art obliged a skilled person to adopt a certain solution, that solution was not automatically rendered inventive by the fact that it also unexpectedly solved part of the problem (**T 69/83**, OJ 1984, 357; see also **T 231/97**).

According to the case law of the boards of appeal, an improvement is not a prerequisite for inventive step (see also in this chapter I.D.4.5 "Alternative solution to a known problem"). Likewise, the achievement of a surprising effect is no precondition for the existence of inventive step. All that is necessary is to ascertain that the respective subject-matter could not be derived by the skilled person in an obvious manner from the available prior art (**T 154/87**; see also **T 426/92**, **T 164/94**, **T 960/95**, **T 524/97**, **T 888/08**).

For an additional, unexpected effect to be disqualified as a mere bonus effect, it has to be shown either that the situation was characterised by a lack of alternatives as regards the means for achieving the first, expected improvement (the "**one-way-street**" situation explained in **T 192/82**), or that, considering the relative technical and practical importance of the effects in the circumstances of the case, the additional unexpected effect was **merely accidental** (following **T 227/89**). See also **T 1356/21.**

10.8.2 One-way-street situation (inevitable effect)

The skilled person has to be free to employ the best means already available for their purposes, although the use of means leading to some expected improvements might well be patentable in relying on an additional effect, provided this involved a choice from a

multiplicity of possibilities. The **lack of alternatives** in this respect might therefore create a **"one-way-street"** situation leading to predictable advantages which remained obvious in spite of the existence of some unexpected **"bonus" effect** (**T 192/82**, OJ 1984, 415; see also **T 766/92**, **T 1936/13**, **T 1491/20**). An additional effect achieved inevitably by the skilled person on the basis of an obvious measure without any effort on their part simply represented a bonus under EPO case law which could not substantiate inventive step, even as a surprising effect (**T 506/92**; see also **T 431/93**, **T 681/94**, **T 985/98**, **T 794/01**, **T 688/13**, **T 179/18**).

In **T 551/89** the board stated that an effect which was to be expected as the result of an obvious measure could not contribute to recognition of the required inventive step, even if the scale of this effect was surprising to the skilled person. In this case an effect whose scale surpassed the skilled person's hopes merely represented a bonus effect following inevitably from the use of an obvious measure and obtained by the skilled person without any inventive effort on their part (see also **T 506/92**, **T 882/94**, **T 696/19**, **T 524/18**).

In **T 848/94** the solution of the existing technical problem required a combination of measures (synergistic effect) that was not suggested by the prior art in such a manner that it would have been adopted by the person skilled in the art (see also **T 716/07**). Therefore, the person skilled in the art was not in a "one-way-situation".

In **T 1713/13** the board held that a "one-way-street" situation could not be inferred as a mandatory prerequisite for the principle established in **T 21/81** (see chapter I.D.10.8.1).

The board in **T 1356/21** was of the view that the case law on bonus effects could not be applied to all situations where a given differentiating feature lead to (or inevitably achieved) **two separable technical effects**, one of which may be expected. In situations which did not qualify as a "one-way street", the board did not consider it appropriate that a crucial and unexpected technical advantage be disregarded in the assessment of inventive step as soon as any additional obvious effect was mentioned in the patent. It stated that neither **T 1317/13** nor **T 21/81** (see chapter I.D.10.8.1) offered a basis for an unqualified application of the bonus effect case law to any situation of plurality of technical effects without regard to their respective technical and practical importance. The board's view in this regard was in agreement with the statement in **T 192/82** that the use of means leading to some expected improvements might well be patentable if relying on an additional effect, provided this involved a choice from a multiplicity of possibilities. See also **T 1357/21**.

In **T 53/22** the board found that any additional effect stemming from the obvious combination in the case in hand (D2 in combination with common general knowledge) was a supplementary or bonus effect that could not establish an inventive step. The skilled person had very few realistic options, each of which would have occurred to them as a matter of course when they considered how to realise D2's teaching to realise a wastegate in a real turbocharger. The weighing of the pros and cons of each option depending on the circumstances and specifications was routine, here arising from straightforward practical constraints. The board distinguished the case in hand from those where there were a "multiplicity" (as in "a large number") of options (e.g. **T 192/82**), and also from **T 848/94**

because it was not argued there was a synergistic effect arising from a combination of measures.

10.8.3 Determining effects that are crucial from those that are merely accidental?

In **T 227/89** the board stated that in determining which effect was crucial and which was merely accidental (the so-called "bonus effect"), a realistic approach had to be taken, considering the relative technical and practical importance of those effects in the circumstances of a given case (see also **T 732/89**, **T 729/90**, **T 1147/16**). When assessing chemical substances for inventive step, it is often their surprising properties that are considered (see in this connection **T 20/83**, OJ 1983, 419).

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

In **T 2015/20** the application stated that it had been surprisingly found that for treatment of respiratory disorders, aclidinium was most effective upon administration by inhalation in a dosage of about 400 µg metered nominal dose. D1 described 1-2 formulations comprising 100 µg aclidinium bromide; it did not provide any suggestion towards an optimized dose of 400 µg. D2 presented a short summary of a trial in which patients suffering from COPD were administered a single dose of 100, 300 or 900 µg of aclidinium bromide, but which the board concluded seemed to teach away from an optimised dose of 400 µg for treatment of a chronic disease such as asthma. The board found that the defined subject-matter of claim 1 was not the obvious result of routine experimentation, but rather represented the unexpected outcome of a study and concluded that the subject-matter of claim 1 involved an inventive step.

10.8.4 Assessment of inventive step where unexpected effect solves a further technical problem

The board in **T 936/96** held that, once a realistic technical problem had been defined and once it had been established that a particular solution to such a problem would have been envisaged by a skilled person in the light of the relevant state of the art, that solution could not be said to involve an inventive step, and this assessment was not altered by the fact that the claimed invention inherently also solved further technical problems. In the case in point the claimed surprising effect could not be regarded as an indication of the presence of an inventive step. See also **T 1491/20**, in which the board held that if an alternative was obvious when addressing the problem to be solved, it was immaterial that the obvious alternative also had other beneficial effects, even if these were not immediately apparent.

In **T 170/06** the board held that if it was obvious for the skilled person to combine prior art teachings in order to solve an essential part of the problem, the presence of even an unexpected extra effect allowing another part of the problem to be solved at the same time did not in principle imply the presence of inventive step.

E. The requirement of industrial application under Article 57 EPC

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1. Notion of "industrial application"

Article 57 EPC provides that: "An invention shall be considered as susceptible of industrial application if it can be made or used in any kind of industry, including agriculture". It thus defines the third criterion for patent grant referred to in Art. 52(1) EPC, namely "industrial application", making it clear that the possibility of making or using the invention in any kind of industry is sufficient (**T 144/83**) and that agriculture too is a kind of industry for the purposes of the EPC (**T 116/85**, OJ 1989, 13). Both products and processes (**T 208/84**) are susceptible of industrial application. Claims directed to substances or compositions for use in methods for treatment of the human or animal body by therapy are directed to inventions which are susceptible of industrial application (**G 5/83**, OJ 1985, 64).
In **T 80/96** (OJ 2000, 50) the board found that the use of a substance to make a new pharmaceutical product without delimitation to an indication did not contravene the requirements of Art. 57 EPC 1973 in conjunction with Art. 52(1) EPC 1973.

Regarding the amendments to Art. 52(1) EPC in the course of the revision of the EPC, see chapter I.A.1. "Patent protection for technical inventions".

1.1. Invention and industrial application

The requirement of industrial application must be satisfied in addition to the other patentability criteria. Article 57 EPC excludes only a few inventions from patentability that are not already excluded by Art. 52(2) or 53 EPC. In particular the work of medical practitioners, previously excluded from patentability under Art. 52(4) EPC 1973 as lacking industrial application, is now covered in Art. 53(c) EPC. Industrial application is also lacking if the product or process is contrary to the laws of physics (**T 541/96**), such as for example a perpetual motion machine (Guidelines G-III, 3 – April 2025 version).

While the technical character of an invention and its susceptibility of industrial application are two different patentability requirements under the EPC, they are often discussed together.

In **T 953/94** the board stated that, as the EPC showed (Art. 52(1) EPC 1973), the requirement (defined in Art. 52(2) and (3) EPC 1973) of claimed subject-matter being an "invention" was distinct from the requirement (defined in Art. 57 EPC 1973) of the claimed

invention being "susceptible of industrial application". Even though the former requirement might, cum grano salis, be equated with a requirement for a "technical" contribution, this was not the same as a requirement for "industrial" applicability; at least in this context, the terms "technical" and "industrial" were not synonyms. In Art. 57 EPC 1973, the meaning of "industrial" was evidently intended to cover commercial applications; this was made clear, for instance, by the German version ("gewerblich"). In the context of Art. 52(2) EPC 1973, this was clearly not the case for the meaning of "technical". This was because, in the context of "controlling a [...] process", the adjective "industrial" should, other than in the context of Art. 57 EPC 1973, be understood to relate only to technical processes usually occurring in "industry" (this latter term in its present context being understood in the narrower sense of what in German would be called "Industrie") and thus not as including "commercial", or even "financial", applications (see also **T 208/84**, OJ 1987, 14 and **T 854/90**, OJ 1993, 669).

In **T 533/09** the board found that the claimed pulse train was of a tangible nature in that it was the result of modulating an electrical signal (derived from a capacitor discharge for defibrillation purposes) and its intensity was measurable at any time. Such a signal thus clearly came under the definition of "physical entity" within the meaning of **G 2/88** (OJ 1990, 93), in its original version. The board concluded that the nature of the subject-matter of claim 1 of the main request was no obstacle to its patentability; moreover, as there could be no doubt that such a signal could be produced and used for defibrillation purposes, that subject-matter clearly was susceptible of industrial application and thus met the conditions of Art. 57 EPC 1973. The board concluded that the wording chosen by the legislator for Art. 52 to 57 EPC on patentability does not in any way link the notion of patentable invention with any condition requiring such an invention to be of a tangible, viz. material, nature (see point 7.2 of the Reasons).

In **T 204/93** the board held that commercial use excluded from patentability under Art. 52(2)(c) and (3) EPC 1973 (in so far as it was not construed as a method for doing business) was a feature which might be understood to fall within the requirement that an invention had to be susceptible of industrial application (Art. 52(1) EPC 1973), i.e. that it could be made or used in any kind of industry (Art. 57 EPC 1973); reference was made in particular to the German word "gewerblich" in that provision of the EPC. The board noted that it was not disputed that computer programs could be exploited commercially. The exclusions from patentability defined in Art. 52(2) and (3) EPC 1973 did not in any way refer to the requirement in Art. 52(1) EPC 1973 of "industrial application" but to the requirement in that article that the subject-matter claimed had to be an "invention". The exclusions in Art. 52(2) and (3) EPC 1973 were generally understood to share the common feature that the excluded matters lacked technicality but not that they could not be made or used, e.g. traded. In this case the board denied patentability for lack of technical effect.

1.2. Any kind of industry

Industry is subject to broad interpretation in this context (**T 74/93**) and extends to any activity that is carried out continuously, independently and for financial gain (**T 144/83**) or that can be offered commercially by a company (**T 1165/97**). The case law refers to the

concepts of "financial (commercial) gain" (**T 144/83**) and of "profitable use" (**T 870/04**) in relation to industrial applicability (**T 898/05**). The need to show a "profitable use" is not to be understood in the narrow sense of an actual or potential economic profit (i.e. generating more income than expenditure) or of a commercial interest (i.e. creating a new or increased business opportunity). Rather, it must be understood in the wider sense that the invention claimed must have such a sound and concrete technical basis that the skilled person can recognise that its contribution to the art could lead to practical exploitation in industry (**T 898/05**). This interpretation therefore does not extend for example to inventions that merely amount to a research finding (**T 870/04**, **T 338/00**) or that are applied for exclusively private and personal purposes.

1.2.1 Methods applied in the private and personal sphere

In **T 74/93** (OJ 1995, 712) the application was refused by the examining division because claim 5, which was directed to the use of a contraceptive composition (e.g. a cream) for applying to the cervix of a female capable of conception, was not susceptible of industrial application as required by Art. 57 EPC 1973 in so far as the compound was to be applied to the cervix of a human female.

The board stated that in determining the borderline between industrial activities – in which the effects of patents had to be respected – and private and personal activities, which should not be adversely affected by the exercise of these rights, the board took into consideration the fact that Art. 57 EPC 1973 might be regarded as an expression of the general idea that any natural person had the right to have his or her privacy respected. The core of this right was not to be taken away from anybody. Therefore, the fact that for some women contraception was connected with professional activities did not give an act, which was in essence private and personal, an industrial character. The board noted that this did not apply to contraception in general, but to the specific type of application of a composition as claimed in claim 5.

The board was unable to ascertain any field of industrial application for the direct use defined in claim 5, for which the requirement of Art. 57 EPC 1973 had to be met. The question as to whether it would be sufficient for an industrial application to be expected in future could be left unanswered as this assertion had not been further substantiated.

In **T 1165/97** the board held that a method of using a vaginal discharge collector and disposing of the collector after a single use could be considered susceptible of industrial application if it was conceivable that these steps were carried out as a paid service and were not exclusively dependent for their execution on the instructions of the woman in question. The board noted that, for the purposes of Art. 57 EPC 1973, what was relevant was the possibility that such a service might be offered by an enterprise. In that case, the board decided in the affirmative, pointing out that – in contrast to the case in **T 74/93** – the service was not one satisfying only the strictly personal needs of the woman in question. Collecting a sample could be caused by external reasons, e.g. on the advice of a medical practitioner to have such a sample taken for further diagnosis.

1.2.2 Cosmetic and beauty salons

In **T 144/83** (OJ 1986, 301) the board stated that under Art. 57 EPC 1973 an invention was to be considered as susceptible of industrial application if it could be made or used in any kind of industry. Enterprises in the cosmetic field - such as cosmetic salons and beauty parlours - were part of industry within the meaning of Art. 57 EPC 1973, since the notion of "industry" implied that an activity was carried out continuously, independently and for financial gain. One board had already decided in **T 36/83** (OJ 1986, 295) that the professional use of such inventions in a cosmetic salon was an industrial application within the meaning of Art. 57 EPC 1973.

2. Reproducibility and sufficiency of disclosure

Another requirement for an invention to be considered susceptible of industrial application within the meaning of Art. 57 EPC is that the technical teaching disclosed in the application under Art. 83 EPC is reproducible.

In **T 718/96** the board held that reproducibility was to be assessed in the first instance with reference to Art. 83 and 100(b) EPC 1973, which lay down that the invention must be disclosed in such a way that it can be carried out by a skilled person. Article 57 EPC 1973 could also serve as a basis for objecting to a lack of reproducibility, because an invention that could not be carried out was also not susceptible of industrial application, but such an objection was always to be based on the most specific applicable provision. Nevertheless, given the link between the two notions, any findings as to reproducibility would apply in equal measure to industrial application under Art. 57 EPC.

In **T 1450/07** the board noted that the information in the application as filed should make plausible the identity of the claimed compound. Thus, the compound could be attributed to a known family of molecules on the basis of a comparison between its primary structure and that of molecules known in the art. Then, its putative functions could be disclosed. Experimental evidence was not necessarily needed. A number of reasonable assumptions could be made by taking into account the known functions of other family members as well as, for example and not exclusively, by taking into account the distribution of the claimed compound in the body. The treatments therein mentioned were in relation to the function plausibly attributed to the molecule. Post-published evidence backing up these assumptions was always welcome and the quality of the information was also fundamental. The board pointed out that each case had to be evaluated on its own merits. The board decided in the case at issue that the requirement of industrial applicability was fulfilled.

In **T 18/09** the board noted that the close inter-relationship between Art. 83 and 57 EPC was already addressed in previous decisions (see inter alia **T 898/05**). In respect of Art. 83 EPC, established case law of the boards of appeal stated that a patent could only be objected to for lack of sufficiency of disclosure if there were serious doubts, substantiated by verifiable facts (see **T 19/90**, OJ 1990, 476). For the board, it would not be justified and unfair to set a different standard of proof in respect of Art. 57 EPC.

In **T 541/96** the gist of the invention consisted in inducing nuclear fusion between light nuclei and heavy unstable nuclei at low temperature by means of an electric field. The board held that an invention or an application for a patent on an alleged invention which was incompatible with the generally accepted laws of physics did not meet the requirements of Art. 57 and 83 EPC 1973, because it could not be used and therefore lacked industrial application.

The EPC did not exclude "revolutionary" inventions from being patented. However, Art. 83 EPC 1973 made the amount of information required for a sufficient disclosure of an invention somewhat dependent on the actual "nature" of the invention. However, if the invention seemed, at least at first, to offend against the generally accepted laws of physics and established theories, the disclosure should be detailed enough to prove to a skilled person conversant with mainstream science and technology that the invention was indeed feasible (i.e. susceptible of industrial application). This implied, inter alia, the provision of all the data which the skilled person would need to carry out the claimed invention, since such a person, not being able to derive such data from any generally accepted theory, could not be expected to implement the teaching of the invention just by trial and error.

The appellant had provided neither experimental evidence nor any firm theoretical basis which would enable the skilled person to assess the viability of the invention; the description was essentially based on general statements and speculations which were not apt to provide a clear and exhaustive technical teaching, Thus, it was irrelevant to consider whether the fusion reactions referred to in the description might be theoretically possible, or whether they might indeed occur under certain conditions.

3. Indication of a profitable use of the invention in industry

Rule 42(1)(f) EPC (former R. 27(1)(f) EPC 1973) prescribes that the description should "indicate explicitly, when it is not obvious from the description or nature of the invention, the way in which the invention is industrially applicable".

In **T 1452/06** the board stated that a basic principle of the patent system was that exclusive rights could only be granted in exchange for a full disclosure of the invention, which included the need to indicate how to exploit the invention (Art. 57 EPC 1973). This indication must have "a sound and concrete technical basis", as a "speculative indication of possible objectives that might or might not be achievable by carrying out further research with the tool as described was not sufficient to fulfil of the requirement of industrial applicability" (see **T 898/05**, **T 870/04** and **T 1109/10**).

In **T 898/05** the board found that for the purposes of Art. 57 EPC 1973, a claimed invention had to have such a sound and concrete technical basis that the skilled person could recognise that its contribution to the art could lead to practical exploitation in industry. The board explained that while industrial applicability should be construed broadly, to include any "immediate concrete benefit", this also entailed the need to disclose in definite technical terms the purpose of the invention and how it could be used in industrial practice to solve a given technical problem, this being the actual benefit or advantage of exploiting the invention. There had to be at least a prospect of a real as opposed to a purely

theoretical possibility of exploitation, if it was not already obvious from the nature of the invention or from the background art. It should not be left to the skilled reader to find out how to exploit the invention by carrying out a research programme.

Accordingly, a product whose structure was given (e.g. a nucleic acid sequence) but whose function was undetermined or obscure or only vaguely indicated might not fulfil the above criteria, in spite of the fact that the structure of the product per se could be reproduced (made) (see **T 870/04**). If a patent was granted, it might prevent further research in that area. On the other hand, a product which was definitely described and plausibly shown to be usable, e.g. to cure a rare or orphan disease, might be considered to have a **profitable** use or concrete benefit, irrespective of whether it was actually intended for the pursuit of any trade at all.

In **T 1450/07** the board referred to the principles established in **T 898/05** that industrial applicability is acceptable if the disclosure in the application as filed on the function of a claimed compound (i) is plausible to the skilled person, (ii) is later confirmed by post-published evidence, and (iii) provides a clear basis for an industrial application.

In **T 870/04** the board stated that a "practical" application of the invention had to be disclosed. Merely because a substance could be produced in some ways did not necessarily mean that this requirement was fulfilled, unless there was also some profitable use for which the substance could be employed.

The board noted that biotechnological inventions were quite often concerned with substances found in nature (e.g. a protein, a DNA sequence, etc.). If a function was well known to be essential for human health, then the identification of the substance having this function would immediately suggest a practical application in the case of a disease or condition caused by a deficiency, as was the case, for example, for insulin, human growth hormone or erythropoietin. In such cases, an adequate description would ensure that "the invention can be made or used in industry". In cases where a substance, naturally occurring in the human body, was identified, and possibly also structurally characterised and made available through some method, but either its function was not known or it was complex and incompletely understood; no disease or condition had yet been identified as being attributable to an excess or deficiency of the substance; and no other practical use was suggested for the substance, then industrial applicability could not be acknowledged. Even though research results may be a scientific achievement of considerable merit, they are not necessarily an invention which can be applied industrially.

In cases **T 338/00** and **T 604/04** the boards found the inventions industrially applicable despite the absence of actual experimental data, because a profitable use could readily be identified on the basis of the description, taking into account common general knowledge. Thus, each case is decided on its own merits according to the particular technical circumstances, including extent of disclosure, background art and post-published evidence.

In **T 641/05** the board considered that no actual information regarding the function of the CEGPCR1a clone at any of the three particular levels of function referred to in decision

T 898/05, i.e. molecular, cellular and biological function in a broad sense (binding of a ligand, propagation of a transmembrane signal, role in a transduction signal pathway and/or in a network of interconnected pathways of a multicellular organism), could be directly derived from the application itself or from the prior art on file. Although, under certain conditions, the board was well prepared – following the case-by-case approach adopted in decision **T 898/05** – to acknowledge a possible function based on computer-assisted methods, in the case before it the probative value of these (sequence homology) methods was completely lacking. In the absence of this functional information, no "immediate concrete benefit" in the sense defined in decision **T 898/05** could be recognised for the CEGPCR1a clone disclosed in the application.

In **T 1452/06** the board commented that the basis for all the therapeutic indications of the claimed subject-matter was the predicted role of the purported serine protease activity of the polypeptide of sequence SEQ ID NO: 24 in the degradation of the extracellular matrix. No experimental evidence whatsoever was present in the application in support of a serine protease activity for a polypeptide comprising the amino acid sequence of SEQ ID NO: 24. There was no example disclosing this serine protease activity, nor any evidence showing that the screening methods and the therapeutic indications based on this serine protease activity could actually be achieved with a polypeptide of sequence SEQ ID NO: 24. The only use of a polypeptide of sequence SEQ ID NO: 24 was to find out more about the polypeptide itself and its natural function(s); this was a speculative outcome and therefore provided no "immediate concrete benefit" (**T 898/05**, **T 870/04**).

II. PATENT APPLICATION AND AMENDMENTS

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1. Basic principles

1.1. Purpose of claims

Article 84 EPC provides that claims must define the matter for which protection is sought. It lays down the relevant principles governing the content and wording of the claims, providing that claims should be clear and concise and be supported by the description. It is supplemented by R. 43 EPC.

In **G 2/88** (OJ 1990, 93, Corr. 469) the Enlarged Board stated that the primary aim of the wording used in a claim must be to satisfy the requirements under Art. 84 EPC 1973 and R. 29(1) EPC 1973 (R. 43(1) EPC), having regard to the particular nature of the invention and the purpose of the claims. The purpose of the claims under the EPC is to enable the protection conferred by the patent or patent application to be determined (Art. 69 EPC), and thus the rights of the patent owner within the designated contracting states (Art. 64 EPC), having regard to the patentability requirements of Art. 52 to 57 EPC.

The boards have repeatedly confirmed that claims must be clear for the sake of legal certainty, as their purpose is to enable the protection conferred by the patent to be determined (see e.g. **T 337/95**, OJ 1996, 628; **T 586/97**; **T 437/98**; **T 728/98**, OJ 2001, 319; **T 1074/00**; **T 560/09**; **T 754/13**: "constant jurisprudence"; **T 129/13**). Legal certainty is of paramount importance in any system where the rights of the public are affected by the grant of a monopoly (**T 81/14**). The public should not be left in any doubt as to which subject-matter is covered and which is not (**T 2086/11**, **T 2321/13**, **T 2186/14**). The skilled person should be able to establish the demarcation of the scope of the claim (i.e. its extent of protection) without undue burden (**T 754/13**).

1.2. Types of claim

The Enlarged Board set out in **G 2/88** that there are basically two different types of claim, namely a claim to a physical entity (e.g. product, apparatus) and a claim to a physical activity (e.g. method, process, use). These two basic types of claim are sometimes referred to as the two possible "categories" of claim. Within the above two basic types of claim various sub-classes are possible (e.g. a compound, a composition, a machine; or a manufacturing method, a process of producing a compound, a method of testing, etc.). Furthermore, claims including both features relating to physical activities and features relating to physical entities are also possible. There are no rigid lines of demarcation between the various possible forms of claim.

1.3. Technical features

Under the EPC the claims must define the matter for which protection is sought "in terms of the technical features of the invention" (R. 43(1) EPC). In **G 2/88** the Enlarged Board described the technical features of the invention as being the physical features which are essential to it. The technical features of a claim to a physical entity are the physical parameters of the entity, and the technical features of a claim to an activity are the physical steps which define such activity. The Enlarged Board also pointed out, however, that the boards had in a number of cases allowed the technical features to be defined functionally in certain instances. See in this chapter II.A.3.5.

1.4. Examination of the requirements under Article 84 EPC in opposition and opposition appeal proceedings

Article 84 EPC is not a ground for opposition. However, when substantive amendments are made to a patent during an opposition, consideration has to be given to whether the amendments introduce any contravention of any requirement of the EPC, including Art. 84 EPC (**T 301/87**, OJ 1990, 335). In **G 3/14** the Enlarged Board analysed whether, and if so to what extent, the requirements of Art. 84 EPC may be examined in opposition and opposition appeal proceedings, in particular if the amended claim is a mere combination of a granted independent claim and granted dependent claims or elements thereof. The Enlarged Board approved **T 301/87** and held that, for the purposes of Art. 101(3) EPC, the claims may be examined for compliance with Art. 84 EPC only when, and then only to the extent that the amendment introduces non-compliance with Art. 84 EPC. **G 3/14** has been applied in e.g. **T 1977/13**, **T 1905/13**, **T 565/11**, **T 248/13**, **T 1287/14**, **T 2311/15**, **T 2321/15** and **T 1221/19** (clarity of adapted description). In **G 2/19** (OJ 2020, A87), the Enlarged Board agreed with the findings in **G 3/14** and stated that it would run counter to them if an extraordinary right to appeal were to be conferred with a view to having a board review whether granted claims were unclear. See also chapter IV.C.5.2.2 "Extent of power to examine amended claims for compliance with Article 84 EPC".

1.5. Requirements under Article 84 and Article 83 EPC

Article 83 EPC requires that the European patent application discloses the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art. In certain circumstances, for example when undefined parameters are used in the claims and no details of the measuring methods are supplied, the question arises whether there is a problem with respect to Art. 83 or Art. 84 EPC. The answer is important, because Art. 83 EPC is a ground for opposition, whereas Art. 84 EPC is not. See chapter II.C.8. "The relationship between Article 83 and Article 84 EPC".

2. Form, content and conciseness of claims

Rule 43 EPC concerns the form and content of claims. Apart from the requirement that the claims define the matter for which protection is sought in terms of the technical features of the invention, it concerns the following issues which are the subject of this sub-chapter: the two-part form of claims (II.A.2.1.), the exceptions to the general rule that the application may contain no more than one independent claim in the same category (II.A.2.2.), the reasonable number of claims (II.A.2.3) and the provision that claims should normally not rely on references to the description and drawings in specifying the technical features of the invention (II.A.2.4.). R. 43 EPC has also been discussed in the context of clarity of claims (see in this chapter II.A.3.10. "Principles in connection with categories of claim").

2.1. Form of claims: Rule 43(1) EPC

Rule 43(1)(a) and (b) EPC (like R. 29(1)(a) and (b) EPC 1973) define the two-part form which a claim must contain where appropriate: (a) a statement indicating the designation of the subject-matter of the invention and those technical features which are necessary for the definition of the claimed subject-matter but which, in combination, form part of the prior art ("preamble"), and (b) a characterising portion specifying the technical features for which, in combination with the features stated in the first part, protection is sought. See also Guidelines F-IV, 2 – April 2025 version.

2.1.1 One-part or two-part claim

In **T 13/84** (OJ 1986, 253), the board ruled that a claim in two-part form had to be regarded as appropriate if a clearly defined state of the art existed from which the claimed subject-matter distinguished itself by further technical features (likewise **T 181/95**). This was confirmed by **T 162/82** (OJ 1987, 533), where the board added that the extent to which prior art was cited in the description could not determine whether the one-part or the two-part form of a claim was appropriate in a given case.

In **T 170/84** (OJ 1986, 400) it was pointed out that where a two-part claim would lead to a complex formulation it was no longer appropriate. In a one-part claim, the features required for the definition which belonged to the state of the art had to be sufficiently clear from the description. This principle has been upheld inter alia in **T 269/84**, **T 120/86**, **T 137/86** and **T 278/86**. The latter two decisions stipulated that a two-part claim was not justified if it gave an incorrect picture of the state of the art (likewise **T 181/95**). In **T 735/89** the board

did not accept a one-part claim because it gave the impression that there was no closer state of the art.

In **T 99/85** (OJ 1987, 413) the board held that in opposition proceedings there was no reason officially to insist on a change in the wording of the claim simply because one feature in the preamble to a two-part claim did not belong to the state of the art. Furthermore, the board saw R. 29(1) EPC 1973 (R. 43(1) EPC) as an implementing regulation which did not constitute a ground for opposition. A similar view was held in **T 168/85**, **T 4/87**, **T 429/88**, **T 65/89**.

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

In **T 121/06** the board found that the combination of features in claim 1 was not known from the prior art. It would thus be detrimental to the logic of the claim to split up its features (i) to (iii) into their basic building blocks merely to indicate which blocks happen to be known from the prior art, without having regard to their inter-relationships. Thus, the two-part form of the claim was found to be inappropriate.

For further instances in which a claim in two-part form was not regarded as appropriate, see inter alia **T 345/89**, **T 378/92** and **T 723/93**.

2.1.2 Two-part claims: preamble and characterising portion

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

In **T 13/84** (OJ 1986, 253) the board considered it could not be accepted as a general rule that the piece of prior art used for the preamble of the claim should be concerned with the same problem as the invention (likewise **T 287/02**). Generally, the apparatus or process constituting the prior art which was nearest to the invention would have to figure in the preamble of the claim, stating such features of it as were necessary for the definition of the claimed subject-matter and which were in combination already part of this prior art (see also **T 897/90**). R. 29 EPC 1973 (like R. 43 EPC) made no reference to the necessity or desirability that the characterising portion of the claim should fairly set out the inventive step. It was the subject-matter of the claim as a whole which embodied the invention and the inventive step involved. See also **T 886/91**, **T 157/93**.

T 850/90 confirmed that examination for inventive step should also take account of the features in the preamble, since the invention was defined by the claims as a whole. Likewise, in **T 980/95** it was held that there was no explicit requirement in R. 29(1)(a) EPC 1973 (R. 43(1) EPC) that a claim in two-part form be set up on the basis of the "closest" prior art, since the rule made no reference to the necessity or desirability for the characterising portion of the claim to set out the inventive step. Basing the two-part

form on a particular state of the art which later turned out not to be the "closest" state of the art for the assessment of inventive step did not in itself contravene R. 29(1)(a) EPC 1973.

In decision **T 688/91** the board took the view that there was a breach of R. 29 and Art. 84 EPC 1973 (R. 43(1) and Art. 84 EPC) where an incorrect distinction was made between the preamble and the characterising portion (likewise **T 181/95**).

2.2. More than one independent claim per category: Rule 43(2) EPC

Rule 43(2) EPC specifies that an application may contain more than one independent claim in the same category (product, process, apparatus or use) only if the subject-matter involves (a) a plurality of interrelated products, (b) different uses of a product or apparatus or (c) alternative solutions to a particular problem, where it is inappropriate to cover these alternatives by a single claim.

The case law below mostly relates to R. 29(2) EPC 1973 as amended with effect from 2 January 2002 (OJ 2002, 2), which corresponds to R. 43(2) EPC.

2.2.1 Conditions

In **T 56/01** each of the appellant's requests in the appeal stage contained three independent claims of the same category: one claim to a broadband communications module and two claims to a signal transport system. Hence, the board had to discuss compliance with R. 29(2) EPC 1973. The board concluded from the preparatory documents that condition (a), in spite of the distinction made between products and apparatus in the opening part of the rule, also applied to apparatus claims. Nevertheless, the board did not consider that condition (a) was met by the two claims for the signal transport system because they were not interrelated. The board inferred from the examples in an early proposal to the Administrative Council for the amendment of R. 29(2) EPC 1973 that interrelated products were meant to be different objects that complement each other, or somehow work together. Moreover, the board defined the "alternative solutions" under R. 29(2)(c) EPC 1973 as different or even mutually exclusive possibilities. Furthermore, even alternative solutions were only allowed under the condition that "it is not appropriate to cover these alternatives by a single claim". The board concluded from the preparatory documents that "not appropriate" meant "not possible or not practical". The intention was that, if it was possible to cover alternative solutions by a single claim, then the applicant should do so.

In **T 659/03** the board had to decide whether the two contentious independent claims in the same category were covered by the exception in R. 29(2)(c) EPC 1973. The board held, first of all, that the appellant's wish to protect the two alternative processes by two independent process claims was justified. It then confirmed that they were alternative solutions to a particular problem, since the independent claims each contained all the features required to solve the problem addressed.

In **T 525/03** the board also found that claims 1 and 13 defined alternative solutions to the particular problem and held that it would not appear appropriate to cover those alternative solutions in a single independent claim. Rather, attempting to redefine the subject-matter of these claims in a more generalising way in one independent claim might lead to an objection under Art. 123(2) EPC 1973. Such generalisation could furthermore be problematic under Art. 87 EPC 1973. In **T 895/05** too the board found that the requirements of R. 29(2)(c) EPC 1973 were satisfied.

According to the board in **T 2355/11**, it was appropriate for the application to have three independent process claims because a single claim bringing together all the process steps could entail a breach of Art. 83 EPC 1973. Besides, a single claim of this kind could give rise to objections under Art. 84 EPC 1973 because the essential features defining the sequencing of the steps in the process would be lost. The board concluded that it was possible but not practical to replace the three independent claims with a single claim.

In **T 671/06** the board found that a claim to a system comprising a power source (specified in broad functional terms) and claims to power sources (specified in structural terms) for that system did not fall under the exception in R. 29(2)(a) EPC 1973. It could be deduced from the examples provided in the Guidelines that interrelated products were, on the one hand, products which, although existing independently from each other as stand-alone products, only performed the invention when interacting with each other (e.g. plug and socket, transmitter – receiver), and, on the other hand, chemical products which were derived from their predecessors (i.e. intermediate(s) and final chemical product, gene – gene construct – host – protein – medicament). In contrast, the claimed system and the claimed power sources did not interact with each other, as the claimed system was completely self-contained in performing the invention. The board concluded that the term "inter-related products" in R. 29(2) EPC 1973 did not extend to a system which is self-contained in performing the invention and a product which is a constitutive substituent part for that system. The board did not follow **T 133/02**, which had held that a system claim and a means claim relating to a component of the system were directed to inter-related products, similar to a plug and a connection system combining the plug with an adapted socket. In **T 671/06** the board argued that a claim directed to a connection system comprising the plug would be dependent on the claim to the plug, as it necessarily comprised all the features of the plug. However, R. 29(2) EPC 1973 was not intended to permit or prohibit claims which were permitted under R. 29(4) EPC 1973. The scope of application of these rules should be kept separate.

Likewise in **T 1232/07** the board, discussing the exceptions laid down in R. 29(2) EPC 1973, highlighted that exception (a) referred only to interrelated products and not to some kind of interrelationship between the subject-matter of independent claims. Such products were, on the one hand, objects which although existing independently of each other as stand-alone products only performed the distributed invention when interacting with each other (e.g. lock and key) and, on the other hand, chemical compounds derived from their precursors. Moreover, the board pointed out that exception (b) referred to different uses of a product or apparatus and not to different uses of a concept as argued by the appellant (applicant).

In **T 978/10** the board held that, since claims 1 and 2 overlapped considerably and were essentially directed to the same object, claim 2 could appropriately be drafted as dependent on claim 1. Hence there was no need within the meaning of R. 43(2)(c) EPC to have two independent claims. See also **T 1770/11**,

In **T 2151/22** (and **T 2159/22**) claim 1 directed to glazing included all the features of claim 12 directed to a glazing element. The board considered that two independently worded claims were more appropriate for claiming all of the invention's embodiments. Moreover, in the patent application at issue, the glazing element complemented the glazing and so the two could be regarded as interrelated. The board therefore found that the conditions under R. 43(2)(a) EPC were met in the case in hand. It also observed that, contrary to the appellant's view, claims beginning with different terms could be dependent if one of them contained all the features of the other. The mere fact that a claim began with a different term than another claim did not confer a right to two independent claims.

2.2.2 Burden of proof

In **T 56/01** the board emphasised that, when an objection under R. 29(2) EPC 1973 arose, the burden of proof was shifted onto the applicant, i.e. it was up to the applicant to argue convincingly why additional independent claims could be maintained. Likewise, the board in **T 1388/10** stressed that the onus of setting out and proving the case for the application of an exception (in this case, an exception under R. 43(2) EPC) lay with the party seeking to rely on that exception. Thus, an applicant wanting more than one independent claim in the same category must, if the examining division objects, convincingly demonstrate that all the additional independent claims fall under one of the exceptions provided for in R. 43(2) EPC. See also **T 592/15**.

2.2.3 No applicability in opposition proceedings

In **T 263/05** (OJ 2008, 329) the board considered whether R. 29(2) EPC 1973 (R. 43(2) EPC) applied in opposition proceedings by virtue of the reference in R. 61a EPC 1973 (R. 86 EPC). The board reviewed decision **G 1/91** (OJ 1992, 253), which had considered the effect of R. 61a EPC 1973 in the context of the requirement of unity. The Enlarged Board had taken the view that the reference to Chapter II was only a general one and that R. 61a EPC 1973 could only be taken to refer "to those requirements which would still be reasonable to demand of the new documents relating to the amended patent". The board in **T 263/05** concluded that R. 29(2) EPC 1973 did not apply in opposition proceedings to prohibit an amendment to a granted patent if it would be unreasonable to demand that the amended claims comply with this rule. This condition was satisfied in a case where otherwise R. 29(2) EPC 1973 would force the patent proprietor to abandon potentially valid subject-matter already contained in the granted claims. Once an amendment to the claims had been established to be necessary and appropriate having regard to the grounds of opposition, it would be unreasonable to impose the additional requirement that the amendment complied with the purely administrative provisions of R. 29(2) EPC 1973 (see also **T 987/05**; **T 1242/06**, OJ 2013, 42; **T 85/08**). For example it is, in principle, possible in opposition proceedings to replace an independent claim as granted by two independent claims directed to specific

embodiments covered by the independent claim as granted (see **T 223/97**, **T 428/12** and chapter IV.C.5.1.2d) "Filing of new dependent or independent claims").

2.3. Conciseness and number of claims

Pursuant to Art. 84 EPC claims must not only be clear, but also concise. In a number of cases this has been interpreted as requiring claims to be concise both individually and in their entirety (see e.g. **T 79/91** and **T 246/91**). The examination of these requirements depends on the specific facts of the case (see also **T 596/97**, **T 993/07**). In **T 1296/19** the board considered that using two groups, both denoting the same substituent (3-methylbutyl), in the same list resulted in a lack of conciseness as regards the definition of R^1. The fact that the definition of R^1 was clear did not necessarily mean that the claim containing this definition was concise. In **T 1152/21** the board found that, if the term "about" associated with a specific temperature or a specific time was intended to cover measurement errors, it was superfluous and the claim was not concise.

A Markush formula is the most concise means of defining a class of chemical compounds in a claim (**T 1020/98**). The examining division had held that "formulating claims in a style that makes routine tasks in substantive examination unnecessarily difficult" was a contravention of Art. 84 EPC 1973. However, there is no legal basis in the EPC for a request to restrict the content of an independent claim so that substantive examination can be carried out with greater ease and less effort.

Regarding lack of conciseness because of a superfluous claim, see e.g. **T 988/02**.

In **T 1882/12** the board pointed out that R. 43(3) EPC neither prohibited including optional features in a claim nor made it mandatory to draft a separate dependent claim for each particular embodiment to be cited in the claims.

Whilst R. 43(2) EPC provides for a restriction in the number of independent claims per category, there is no equivalent limit on the number of dependent claims or claims concerning a particular embodiment of an invention (R. 43(3) and (4) EPC). R. 43(5) EPC provides that the number of claims shall be reasonable with regard to the nature of the invention claimed.

2.4. Reference to the description or drawings: Rule 43(6) EPC

Pursuant to R. 43(6) EPC claims shall not rely, "except where absolutely necessary", on references to the description or drawings in specifying the technical features of the invention. Expressions such as "as described in part...of the description", or "as illustrated in figure...of the drawings" are to be avoided.

In **T 150/82** (OJ 1984, 309) the board ruled that claims relying on references to the description in the specification in respect of all their technical features (so-called "omnibus claims") were unallowable as contrary to R. 29(4) and (6) EPC 1973 (R. 43(4) and (6) EPC), unless absolutely necessary, e.g. when a plurality of conditions would not lend themselves to verbal expression without such a reference. Examples of such exceptions

included inventions containing features or limitations which could only be expressed by means of drawings or graphs defining a particular shape or a plurality of conditions. In **T 271/88** the board upheld **T 150/82** and decided that it was not possible to base claims on an appendix showing structural chemical formulae designated as "chemical formulae incorporated within claims". The board held that it was quite evident that the terms "description" and "drawing" in R. 29(6) EPC 1973 were meant to cover structural chemical formulae. See also **T 752/94**.

In **T 1156/01** the board considered that, if the invention was characterised by parameters, the method of and means for measurement should appear completely in the claim itself, whenever this was reasonable, or by reference to the description in accordance with R. 29(6) EPC 1973 (R. 43(6) EPC), if the method was so long that it would impair the conciseness of the claim (confirmed in **T 796/01**).

In **T 237/84** (OJ 1987, 309) the board stated that the purpose of reference signs in a claim (R. 29(7) EPC 1973, now R. 43(7) EPC) was to make the claims easier to understand. They did not limit the scope of the claim but did affect its clarity and might enable it to be expressed more concisely than would otherwise be possible (confirmed e.g. in **T 572/90**). In **T 986/97** the board allowed a reference to the drawings.

In **T 816/90** plasmids were defined by use of a designation which had no technical meaning per se. Moreover, their structure was defined by reference to a figure. The board was of the opinion that such a definition of a plasmid was contrary to the requirements of Art. 84 EPC 1973 and therefore could not be accepted.

3. Clarity of claims

3.1. General principles

Claims lack clarity if the exact distinctions which delimit the scope of protection cannot be learnt from them (**T 165/84**, **T 6/01**). The claims per se must be free of contradiction (see **T 2/80**, OJ 1981, 431). They must be clear in themselves when read by the person skilled in the art, without any reference to the content of the description (**T 2/80**; **T 1129/97**, OJ 2001, 273; **T 2006/09**; **T 1253/11**; **T 355/14**, **T 1089/19**, **T 1152/21**). The Enlarged Board held in **G 1/04** (OJ 2006, 334) that the meaning of the essential features should be clear for the person skilled in the art from the wording of the claim alone (see also **T 342/03**, **T 2091/11**, **T 630/14**, **T 1140/14**, **T 1957/14**, **T 2968/19**). The description is taken into account for the purposes of interpreting the claims and has in some cases also been considered when determining clarity and conciseness (see in this chapter II.A.6.3.5).

In **T 1661/16** the board found that independent claim 7 lacked clarity: the last feature, added during the opposition procedure and objected to by the appellant (opponent), left it unclear to the skilled person what further structural or functional limitation to the claimed arrangement could be implied by this feature. Rejecting different arguments from the patent proprietor, the board emphasised that the clarity requirement of Art. 84 EPC for an amendment was a substantive one, and that the subjective component in the task of interpretation was eliminated by taking the position of the skilled person. Thus it could

objectively be concluded that the claim as amended was not clear. For the claim as a whole to be clear, the meaning, in terms of the limiting effect, of features introduced into a claim must be clear.

The preamble of claim 2 of the application in **T 363/99** contained a reference to a German patent specification. The board considered this to be a violation of Art. 84, second sentence. EPC 1973, since it was impossible to establish the scope of the matter for which protection was sought without consulting the reference document mentioned. The fact that the indication of the publication number of the reference document provided the most concise definition of the matter for which protection was sought (Art. 84 EPC 1973) was irrelevant by comparison. When formulating a patent claim, the form that was objectively more precise always had to be chosen (**T 68/85**, OJ 1987, 228). In **T 2968/19** the board made it clear that the requirement under Art. 84 EPC that the claims be concise was an independent condition designed to prevent the clear interpretability of a claim from being compromised, for instance by redundant features. However, it was not to be applied in a way that would restrict the clarity requirements under Art. 84 EPC.

Complexity as such is not equivalent to a lack of clarity. Clarity under Art. 84 EPC is not at stake in a case of mere complexity of a claim provided the subject-matter for which the protection is sought and the scope thereof are clear and unambiguous for a person skilled in the art, either per se or in the light of the description (see **T 574/96** re Art. 84 EPC 1973). In **T 1020/98** (OJ 2003, 533) the board confirmed that compliance with the clarity requirement of Art. 84 EPC 1973 was not dependent on the time required to establish whether a given compound was covered by the product claim. The clarity requirement was not a basis for objecting to the complexity of a claim. Clarity within the meaning of that article merely required the claims to define the subject-matter for which protection was sought clearly and unambiguously for the skilled person, if necessary in the light of the description.

In **T 75/09** the board held that where higher ranking requests are refused because a feature common to all requests does not meet the requirements of Art. 84 EPC, all lower ranking requests retaining this feature have to be refused for the same reason. The fact that in a lower ranking request the offending feature no longer has to be relied upon to establish a distinction over the prior art does not overcome the defect pursuant to Art. 84 EPC. Nor does it give the deciding body the discretion to disregard the deficiency. In particular, it has to be borne in mind that the significance of a feature may become apparent only at a later stage in the life of a patent, e.g. in opposition or revocation proceedings. Moreover, the board noted that a deficiency concerning the requirements of Art. 84 EPC was neither a ground for opposition before the EPO under Art. 100 EPC nor a ground for revocation under Art. 138(1) EPC. Consequently, such a deficiency cannot be dealt with, let alone remedied in either proceedings.

A prerequisite for arriving at a technically sensible claim interpretation is that the claim is technically consistent: if two features are separately clear, but inconsistent with each other from a technical point of view, then their combination, and the claimed subject-matter, cannot be clear (**T 935/14**). In **T 765/15** the board pointed out that claims 1 and 2

contradicted each other, although claim 2 depended on claim 1. As a consequence, the claim set was unclear according to Art. 84 EPC 1973.

In **T 2574/16** the examining division had found the method of claim 1 to be unclear in view of an example disclosed in the description. The board noted that the claim did encompass elaborate simulations going beyond any of the examples disclosed in the application as filed. But this in itself was not a problem of lack of clarity (or insufficiency of disclosure). In fact, it was normal for a claim to define the scope of protection in terms that positively define the essential features of the invention. Any particular embodiment falling within the scope of the claim could have further characteristics not mentioned in the claim or disclosed in the application (and could even constitute a patentable further development).

3.2. Relative qualities and vaguely formulated claims

In the key decision **T 728/98** (OJ 2001, 319) the board held that it followed from the requirement of legal certainty that a claim could not be considered clear within the meaning of Art. 84 EPC 1973 if it comprised an unclear technical feature (here "substantially pure") for which no unequivocal generally accepted meaning existed in the relevant art. This applied all the more if the unclear feature was essential for delimiting the subject-matter claimed from the prior art (see also **T 1399/11**, **T 1702/15**). According to the board in **T 869/20**, **T 728/98** did not conclude that clarity should only be examined when the unclear feature is the sole differentiating feature, but simply stressed that in such case the requirement of clarity is particular important to ensure legal certainty.

Likewise in **T 226/98** (OJ 2002, 498) the board held that the feature "as a pharmaceutical product" for defining a pharmaceutical standard of purity in a claim related to a product as such (here, famotidine form "B"), rendered said claim unclear in the absence of a generally accepted quantitative definition for the purported standard of purity. Also in **T 174/02** ("[in] quick [succession]"), **T 1640/11** ("value"), **T 842/14** ("accurate"), **T 1963/17** ("substantially simultaneously"), **T 362/17** ("brief [history of spoken words]"), **T 1903/19** ("low intensity"), **T 1152/21** ("appropriate temperature", "about 70°C", "about 3 hours") the boards ruled that the relative terms at issue were unclear.

In **T 1469/20** the board held that the terms "inexpensive", "swift", "wide variety" and "pleasant association" in claim 1 were not clear. The fact that the claim could be interpreted, essentially by disregarding the relative and subjective terms which were not clearly limiting, did not mean that the claim could be allowed as it stood. The board pointed out that clarity is a requirement separate from novelty and inventive step, and allowing unclear terms to remain in the claim places an undue burden on the reader seeking to determine the scope of protection. The fact that "inexpensive" and "pleasant association" were non-technical concepts which as such did not count for inventive step, did not matter for the question of clarity.

In **T 586/97** the main claim was directed to an aerosol composition comprising a propellant and an active ingredient which was not defined. The board held that, when an essential ingredient comprised in a chemical composition is open to be labelled arbitrarily "active ingredient" or not, the meaning of that feature would be variable. Leaving the public in

doubt as to which compositions are covered by the claim would be at variance with the principle of legal certainty. Therefore, the claim at issue failed to meet the requirement of clarity imposed by Art. 84 EPC 1973. See also **T 642/05**, **T 134/10**.

In decisions **T 1129/97** (OJ 2001, 273) and **T 274/98** the board emphasised that, to satisfy the clarity requirement, the group of compounds/ingredients according to the claim had to be defined in such a way that the skilled person could clearly distinguish compounds/ingredients that belonged to the claimed group from those that did not (see also **T 425/98** regarding the expression "consisting of a major amount of").

In **T 268/13** the board concluded that a claim to a "method for producing a [...] decorative strip having a [...] structure consisting of a text or graphic symbol [...]" satisfied the requirements of Art. 84 EPC 1973. Although it was impossible to give an entirely general, universally applicable definition of what constituted a symbol, in the case in hand it would be clear whether or not a particular character was a symbol in the given cultural, linguistic or technical context. The claim therefore presented neither somebody wanting to avoid infringing the patent nor a court deciding on infringement with an impossible task.

In **T 1845/11** the board concluded that the term "Asian race" was not clear. Clearly defined objective criteria for patient assignment into racial groups were not available to the skilled person.

In **T 860/93** (OJ 1995, 47) the board decided as follows: where a quality is expressed in a claim as being within a given numerical range, the method for measuring that quality must be general technical knowledge, so that no explicit description is needed, or a method of measuring that quality needs to be identified (decision **T 124/85** followed). In contrast, where a claim specifies a relative quality, in this case that the products should be "water-soluble", it is not normally necessary to identify any method for its determination (for the term "soluble" see also **T 785/92**, **T 939/98**, **T 125/15**). In the following cases the boards confirmed that the use of a relative term in a claim may be accepted where the skilled person is able to understand the meaning of this term in a given context: **T 860/95** ("for a long period of time"), **T 649/97** ("transparent"), **T 1041/98** ("thin plate"), **T 193/01** ("thin film"), **T 545/01** ("flat"), **T 378/02** ("smooth"), **T 2367/16** ("overnight") and **T 2402/17** (relationship between the terms "higher" and "lower oscillation susceptibility" and "smaller values"). In **T 1045/92** the claims concerned "a two-pack type curable composition comprising [...]". In the board's view "a two-pack curable composition" was an item of commerce as familiar to readers skilled in the polymer art as everyday articles were to the public at large. The claim was therefore clear.

In **T 1170/16** it was held that "useful for" in the expression "a liquid absorbent structure useful for absorbent articles" of claim 1 resulted in a lack of clarity. "Useful for" included an element of value with respect to the features it linked. In claim 1 this benefit was not defined and so the reader was left in the dark as to how the structure was useful for the absorbent articles. The board did not accept that "useful for" was synonymous with "for", meaning "suitable for". It had an effect going beyond mere suitability. In **T 1526/22** the examining division had objected to the wording [apparatus] "for a motor vehicle driver assistance for an ego vehicle" in the claim because this suggested that an effect

supporting motor vehicle assistance was to be produced, which was however not apparent from the wording of the claim. The board interpreted the wording of claim 1 as meaning an apparatus suitable for a motor vehicle driver assistance system for an ego vehicle, as is usual for a purpose feature in an apparatus claim in the form "apparatus for ...". Claim 1 did not require the claimed apparatus to be configured to provide the output of the state estimator as input to a driver assistance system. The board did not see a lack of clarity in that respect.

In **T 651/05** the board found that the introduction of vague terms created a lack of clarity due to different but equally valid interpretations (see also **T 621/03**, **T 127/04**). In **T 1534/10** a claim contained the feature "that the data carrier (1) is constructed in a multi-layered manner as a laminate and contains at least two films (4, 5) which are integrated as a cover film (4) or as a core film (5) into the layer construction of the laminated data carrier". The board considered this wording ambiguous because it combined a plural form ("at least two films (4, 5)") with a singular form ("as a cover film (4) or as a core film (5)"), making it unclear whether the "at least two films" were each either a cover film or a core film, or whether together they formed a new film that was then either a cover film or a core film.

Where, on one of several possible constructions of a vaguely formulated claim, part of the subject-matter claimed is not sufficiently described to be carried out, the claim is open to objection under Art. 100(b) EPC 1973 (**T 1404/05**, see also chapter II.C.8.1. "Article 83 EPC and support from the description").

In **T 1065/18** the board held that due to its wording ("Pharmaceutical composition ... packed or filled into a container"), the claim put the emphasis on a pharmaceutical composition rather than a container comprising said composition. This made it unclear whether the protection sought was limited to the pharmaceutical composition per se, or whether a container comprising a pharmaceutical composition was to be protected (see **T 352/04** for a similar case). Thus, the claim lacked clarity.

3.3. Indication of all essential features

According to the established case law of the boards of appeal, Art. 84 EPC has to be interpreted as meaning not only that a claim must be comprehensible from a technical point of view, but also that it must define the object of the invention clearly, that is to say indicate all the essential features thereof. An independent claim should explicitly specify all essential features needed to define the invention (**G 1/04**, OJ 2006, 334). All features which are necessary for solving the technical problem with which the application is concerned have to be regarded as essential features; see on this issue **T 32/82**, OJ 1984, 354 and **T 115/83**, confirmed inter alia in **T 269/87**; **T 622/90**; **T 409/91**, OJ 1994, 653; **T 694/92**, OJ 1997, 408; **T 1055/92**, OJ 1995, 214; **T 61/94**; **T 488/96**; **T 203/98**; **T 260/01**; **T 813/03**; **T 1540/12**; **T 2427/13**; **T 1180/14**; **T 30/16**; **T 2291/15**; **T 874/16** and **T 110/21**. The indication of all essential features is seen as necessary to meet the clarity requirement.

In **T 1957/14** the board was not persuaded by the appellant's argument that deposited material serves as a surrogate for the description of a sequence, i.e. as an alternative to structural information. In the board's opinion, relying on deposited inbred line material for the definition of the essential features of the invention and requiring it to be analysed in order to identify the relevant alleles was at odds with the principle that, generally, the meaning of a claim, including its essential features, should be clear for the person skilled in the art from the wording of the claim alone.

The essential features should in particular comprise those which distinguish the invention from the prior art (**T 1055/92**, **T 813/03**). Regarding the delimitation of essential from non-essential features, see also **T 61/94**, **T 203/98**, **T 141/00**, **T 260/01**, **T 1573/12**, **T 2131/12** and **T 21/16**.

Whether a feature following the expression "in particular" has to be regarded as optional depends on the specific context (**T 260/10**). In **T 2035/16** the board noted that "in particular" can be interpreted in two different ways, as meaning an option as in **T 1882/12** or as meaning "essential" or "above all" as in **T 260/10**. This ambiguity of "in particular" was considered a lack of clarity by the opponent. The board, however, took the description into account and concluded that it was clear that the term "in particular near infrared radiation" in claim 1 was an optional feature, not an essential feature, and the claim was, therefore, clear.

According to the board in **T 888/07**, if from the wording of an independent claim it must be concluded that a solution of the problem of the invention is achieved by not needing a step, whereas this very feature according to the description cannot be abolished, but is necessary for a workable solution, then such a feature is to be considered an essential feature of the invention. An independent claim missing this feature is therefore neither clear, nor supported by the description. See also in this chapter II.A.5.

In **T 809/12** the board stated that, if an independent claim contained a feature defined by a result to be achieved which essentially corresponded to the problem underlying the application, to comply with Art. 84 EPC 1973 the remaining features of the claim had to comprise all essential features necessary for achieving that result. See also **T 2427/13** and **T 1034/20**.

According to the board in **T 818/03** a method claim which does not state sufficiently clearly the steps by which a particular result was achieved might still be considered clear provided the result to be achieved was clearly defined. A claim which defines a method of achieving some less than clearly defined result might also still be considered clear provided the steps that need to be taken to achieve that result are sufficiently clearly defined. However, a claim must be considered to lack clarity if, as here, it sets out insufficiently clearly both the necessary parameters of the method and the relevant characteristic features of the result.

In **T 2001/12** the board held that, if doubt that the invention as claimed is capable of solving the problem defined in the application arises because the claim fails to specify those features which are disclosed in the application as providing the solution to the problem, then the description and claims are inconsistent in relation to the definition of the invention,

and an objection under Art. 84 EPC 1973 may properly arise that the claims do not contain all the essential features necessary to specify the invention (see also chapter II.C.6. "Reproducibility"). See also **T 1180/14**.

In **T 1055/92** the board stated that since the primary function of a claim was to set out the scope of protection sought for an invention, it was not always necessary for a claim to identify technical features or steps in detail. This primary function of the claims should be clearly distinguished from the requirement that the European patent application had to disclose the invention in such a way that it enabled a person skilled in the art to carry out that same invention. Under Art. 83 EPC 1973 sufficient disclosure was required of a European patent application but not of an individual claim as such. A claim had to comprise the essential features of the invention; the essential features should in particular comprise those features which distinguished the invention from the closest prior art. See also **T 61/94**.

G 1/04 (OJ 2006, 334) concerned **diagnostic methods**. The Enlarged Board held that a diagnostic method within the meaning of Art. 52(4) EPC 1973 had an inherent and inescapable multi-step nature. If diagnosis as the deductive medical or veterinary decision phase was a purely intellectual exercise, the feature pertaining to the diagnosis for curative purposes and the features relating to the preceding steps which were constitutive for making the diagnosis represented the essential features of a diagnostic method within the meaning of Art. 52(4) EPC 1973. Thus, in order to satisfy the requirements of Art. 84 EPC 1973, an independent claim relating to such a method must include these features. The Enlarged Board further held that, while essential features were for the most part of a technical nature, a non-technical feature constitutive for defining the invention must likewise be included as an essential feature in the independent claim. Thus, although diagnosis stricto sensu was a purely intellectual exercise unless it was carried out by a device, the feature pertaining to it was such an essential feature as to be included in the independent claim. See also chapter I.B.4.6.1c) "Clarity of a claim relating to diagnostic methods".

G 1/07 (OJ 2011, 134) concerned **surgical methods**. The Enlarged Board referred to **G 1/04** and stated that a claim should explicitly specify all essential features and must be clear. Under Art. 84 EPC, whether or not a step being or encompassing a surgical step excluded from patentability can be omitted either by using positive wording for such omission like "pre-delivered" or by simply leaving it out from the claim depends on whether the claimed invention is fully and completely defined by the features of the claim without that step. See also chapter I.B.4.4.4c) "Surgical step part of claimed method or simply a preparatory measure?".

In **T 2102/12** the application related to medical robotic systems which allow to robotically move a tool on an articulated arm in response to the surgeon's manipulation of an input device. The board referred to **G 1/07** and held that claiming the measurement of the movement of the tool while "unclaiming" the movement itself rendered the claim unclear under Art. 84 EPC. The claimed method of intertwined non-surgical ("claimed") and surgical ("unclaimed") steps was not comparable to that underlying **T 836/08**.

In decision **T 923/08** the board decided as follows: if a method for recording measurements on the human or animal body necessarily entails a surgical step in order to fix to the human or animal body a measuring device which is indispensable for performing the method, this step has to be deemed an essential feature of the method and is comprised in such a method, even if the claim contains no method feature explicitly directed to it. Such a method is excluded from patentability under Art. 53(c) EPC. The exclusion of such a surgical step, whether by stating that the surgically attached measuring device was already fixed to the body before the start of the method or whether by use of a disclaimer, breaches Art. 84 EPC 1973 because such a process claim does not then include all the essential features of the claimed invention.

3.4. Clarity of broad claims

It was established in **T 238/88** (OJ 1992, 709) that the clarity of a claim is not diminished by the mere breadth of a term of art (e.g. "alkyl") contained in it, if the meaning of such term – either per se or in the light of the description – is unambiguous for a person skilled in the art (see also in this chapter II.A.6. "Interpretation of claims").

However, in **T 935/14** the board also pointed out that broad features could only be considered clear under the proviso that the borders of the – broad – scope of protection could be clearly inferred by the skilled person. This made the distinction between broad but clear and broad and vague.

In **T 523/91** the board held that the wording "plastics in combination with inserts" and "this insert is combined with the plastics granules in a wound or folded manner" did not cause the subject-matter of the claim to be unclear within the meaning of Art. 84 EPC 1973. Although the nature of the combination covered many possibilities, the resulting subject-matter of the claim was broad rather than unclear. The broadness of a claim could not be contested on its own but only in conjunction with other criteria such as novelty, inventive step or reproducibility.

Likewise in **T 688/91** the board stated that a broad claim was not to be equated with one lacking clarity. The claim was worded as follows: "Integrated microprogrammed apparatus [...] with apparatus to generate [...] T-states [...] characterised in that [...] the generation [...] of the [...] T-states [...] is in each case effected as a function of preceding T-states and of state parameters such as the instantaneous values of state and/or mode signals [...]". The board held that, even if the words "such as" were understood to mean "for example", with the result that the subsequent information was not to be interpreted in a restrictive sense, the words "state parameters" were clear in as much as they conveyed the fact that T-state generation was to be effected as a function of any parameters representing one of the states of the apparatus. Although the claim was to be regarded as broad, since the terms used were open to general interpretation, breadth was not to be equated with an absence of clarity.

In **T 630/93** the board noted that Art. 84, first sentence, EPC 1973 implied that it was not always necessary for a claim to identify technical features or steps in full detail. The function of the essential features, although normally expressed in technical terms, was

often to define the borders of an invention rather than details of the invention within those borders. Thus, essential features could often be of a very general character and in extreme cases indicate only principles or a new idea (see also chapter II.C. "Sufficiency of disclosure").

In **T 29/05** it was held that the existence of unrelated subject-matter in the claims at issue was merely hypothetical, and no evidence had been provided by the examining division to support its possible presence in the prior art. In the absence of such evidence, each and every nucleic acid molecule (as specified) had to be assumed to be related to the subject-matter disclosed in the application. The fact that a large number of possible nucleic acid sequences might fall within the scope of the claim was not a reason for raising a lack of clarity objection.

In **T 2154/11** the board held that the objections of the examining division that the expressions "metadata describing an event", "taking", "connecting" were broad and embraced well-known activities were not considered per se a valid reason for a lack of clarity. The fact that some of these method steps might be understood to refer to "mental acts" or "normal human actions" was also no valid reason for a finding of lack of clarity as long as these steps did not give rise to ambiguity, as in the case in hand. If a method step could be interpreted to refer to a normal human activity, then this assessment should be taken into account for novelty and inventive step.

According to the board in **T 712/21**. the terms hydrodeoxygenation ("HDO") and hydrodewaxing ("HDW") had a generally accepted meaning in the underlying technical field. Therefore, although the scope of these features could overlap with that of similar processes (e.g. whether a hydrotreating process or a hydroisomerisation step would fall within or outside the scope of HDO or HDW, respectively), such challenges did not arise due to a faulty or incomplete definition, but because language cannot comprehensively capture every detail of real-life objects or processes, an issue which becomes more pronounced when features are broadly defined. The board concluded that the features HDO and HDW were clear to a person skilled in the art and that any ambiguity in distinguishing them from other similar processes should be attributed to the inherent limitations of technical language.

The principle whereby a broad claim is not unclear per se has also been applied in e.g. **T 393/91**, **T 456/91**, **T 530/94**, **T 950/97**, **T 103/00**, **T 1173/03**, **T 1345/08**, **T 2220/09**, **T 2068/10**, **T 745/11**, **T 125/15**, **T 901/16**, **T 1821/16** and **T 2676/16**.

3.5. Functional features

In **T 68/85** (OJ 1987, 228) the board found that functional features defining a technical result were permissible in a claim (i) if, from an objective viewpoint, such features could not otherwise be defined more precisely without restricting the scope of the invention, and (ii) if these features provided instructions which were sufficiently clear for the skilled person to reduce them to practice without undue burden, if necessary with reasonable experiments. The board further pointed out that the effort to define a feature in functional terms had to stop short where it jeopardised the clarity of a claim as required by

Art. 84 EPC 1973. The following decisions agreed with these findings: **T 139/85**, **T 292/85** (OJ 1989, 275), **T 293/85**, **T 299/86** (OJ 1988, 88), **T 322/87**, **T 418/89** (OJ 1993, 20), **T 707/89**, **T 204/90**, **T 752/90**, **T 388/91**, **T 391/91**, **T 810/91**, **T 822/91**, **T 894/91**, **T 281/92**, **T 490/94**, **T 181/96**, **T 750/96**, **T 265/97**, **T 568/97**, **T 484/98**, **T 1186/01**, **T 295/02**, **T 499/02**, **T 1173/03**, **T 404/06**, **T 959/08**, **T 560/09**, **T 556/11**, **T 2067/12**, **T 754/13**, **T 2427/13**, **T 2114/14** and **T 1605/20**. Some of these decisions (see e.g. **T 204/90**, **T 181/96**, **T 265/97**) examine a third criterion, which is not strictly speaking a requirement under Art. 84 EPC 1973 and requires that (iii) the state of the art does not stand in the way of using such functional and therefore general and broad terminology.

In **T 361/88** the board distinguished between two types of functional feature: the first type of functional feature is related to process steps which are known to the person skilled in the art and may easily be performed in order to obtain the desired result; the second type of functional feature consists of process steps defined by the result which is aimed at. This is also allowable as long as the person skilled in the art knows, without exceeding their normal skills and knowledge, what they have to do in order to obtain said result.

In case **T 720/92** the board noted that the term "clarity" in Art. 84 EPC 1973 referred to the practical meaning of the language of the patent claims. Claims with functional features which do not enable the skilled person to carry out the invention in the light of the disclosure and on the basis of common general knowledge do not meet the requirement of clarity. A claim combining functional definitions limited to features, which a skilled person would have no difficulty in determining on the basis of common general knowledge, and a structural definition of the essential contribution of the applicant is not objectionable under Art. 84 EPC 1973.

In **T 560/09** the board emphasised with regard to technical features expressed in general functional terms that the function must be able to be verified by tests or procedures adequately specified in the description or known to the skilled person. That meant not only that a feature in the claim must be comprehensible, but also non-ambiguous in that it could be determined without any ambiguity whether the claimed functional requirement was satisfied (see **T 2427/13**). Hence, means of distinction were mandatory in order to allow a definition by a function instead of by a structure in a claim.

In **T 243/91** it was stated that a functional feature was allowable if that feature provided a clear instruction to a skilled person to reduce it to practice without undue burden. In **T 893/90** the feature "being present in amounts and proportions just sufficient to arrest bleeding" was held to be a functional feature which defined a technical result which also constituted a testable criterion to be satisfied by the claimed pharmaceutical composition. Because such testing involved only routine trials, the adopted functional language was allowable. The introduction of a reference to specific amounts and/or proportions of the components would limit the claim and was not necessary. The situation in **T 893/90** was distinguished from the one before the board in **T 181/96**. Although in the former case the testing might appear prima facie bothersome, it was nothing out of the ordinary for the field of medicine, involving only routine trials. In **T 181/96**, however, which concerned an apparatus for hydrostatically testing a sealing element of a threaded connection between two connected sections of pipe, there was no general type of pipe connections with

generally well-defined ranges of dimensions which were thus generally available for verification of the functional features as such. In **T 1802/12** the board stated that the description did not contain any test to verify whether the functional features were present after having applied the claimed method. The board concluded that – contrary to the situation in **T 893/90**, where a test was available – the requirements of Art. 84 EPC were not met.

In **T 391/91** claim 1 set out in general terms the sequence of steps to be followed in order to put the invention into practice, i.e. in order to produce unicellular micro-organism host cells having INA (ice nucleation activity) or enhanced INA. The claim was in fact a generalisation from the particular examples. The board stated that as there was no reason to doubt that it was possible to generalise the specific teaching of the examples given, it would be unfair to the appellant to require a restriction of the claim by incorporation therein of the specific features of the examples. The skilled person could use any suitable variant capable of providing the same effect of the invention. This might be tedious, but it was nothing out of the ordinary in this field and involved only routine trials. The claim was thus allowable under Art. 84 EPC 1973.

In **T 241/95** (OJ 2001, 103) the Swiss-type second medical use claim defined the disease or disorder to be treated with substance X as "condition which is capable of being improved or prevented by selective occupation of the serotonin receptor". The board held that this functional definition was unclear because no test was at hand to determine whether the therapeutic effects were a result of the newly discovered property of X of occupying the serotonin receptor or any other known or unknown property of that substance. See also **T 2321/13**.

The board in **T 830/08** was concerned with the clarity of a claim directed to a second medical use. Such claims are considered clear only if the disease to be treated is clearly defined in it (e.g. **T 1048/98**). In the case in hand the disease to be treated was defined in functional terms as "the preferential induction of apoptosis in a first population of cells compared to a second population of cells wherein the cells of the first population are tumour cells". The question was whether the skilled person could clearly attribute a disease or group of diseases to this functional definition. In the board's view, this was not the case. The skilled person reading this definition in claim 3 would be struck, on the one hand, by the explicit mention and the specific definition of the first population of cells and by the explicit mention, but absence of specific definition of the second population of cells, on the other hand.

In **T 1074/00** the board considered that the term "capable of hybridising under stringent conditions" was sufficiently clear for the purposes of Art. 84 EPC 1973, having regard to the particular nature of the subject-matter (see also **T 29/05**). The board found that, although different experimental protocols might be applied for assessing hybridization under stringent conditions, this did not mean that these protocols would lead to different results as far as the detected nucleotide sequence was concerned. Moreover, it had to be taken into account that the present claim defined its subject-matter also by a further functional feature relating to the biological activity.

In **T 151/01** the product claim at issue was intended to be restricted vis-à-vis the prior art embodiments by a functional feature, namely that the amount of the ingredient present in the composition must be a "therapeutic amount". The board had no doubt that the skilled person was perfectly able in most cases to decide whether a certain amount of a given non-steroidal anti-inflammatory agent had a therapeutic effect or not. However, it pointed out that, in order to establish the lower limit of the therapeutic amount for a given non-steroidal anti-inflammatory agent, in other words, in order to clearly establish the scope of protection of the claims, a standard test was required, since the result would strongly depend on the experimental method used. As there was no such test in the description or known to the skilled person, the board concluded that the claim did not fulfil the requirement of Art. 84 EPC 1973.

In **T 143/06** the density of the product which was "close to the theoretical maximum" was identified by the board as a functional feature of the product inextricably linked to the process conditions for obtaining the product. There was thus no objection of lack of clarity under Art. 84 EPC.

In **T 2565/19** the claimed subject-matter was an isolated TRH receptor, which was defined only by locational and functional features, i.e. the tissue from which it can be isolated and its ability to bind the compounds defined in the claim. Neither of these features conveyed any structural information about the claimed product, for instance whether it was a protein or not, or if it were a protein, what its sequence might be. The board held that in the absence of any structural features, the claim could not be considered as clear because it failed to enable the protection conferred by the patent (or patent application) to be determined and it did not define the claimed subject-matter in a manner which allowed a meaningful comparison with the state of the art to be made. Indeed, in the absence of any structural information about the claimed subject-matter, it was not possible to determine if the claimed product was novel. For instance, there was no way of ruling out that the functional and locational features defined in the claim did not simply re-characterise a known molecule.

In **T 147/22** the respondent raised a clarity objection on the basis that there were compounds cited in claim 1 that could have more than one function (excipient, binder, lubricant, flavouring agent…) and, depending on their function, the amount allowed in the composition could be different. For instance, polyvinyl alcohol could be a binder or a lubricant. In the first case it could be present in an amount of 0.001 to 5% by mass, in the second case it could not be present because it was not listed among the lubricants in component (d). The board disagreed. The fact that polyvinyl alcohol was known to be a binder and a lubricant did not render the claim unclear. If polyvinyl alcohol was present in the composition, it necessarily played the role of a binder, even if it also fulfilled the function of a lubricant. Therefore, it should be counted as a binder that may be present in an amount of 0.001 to 5% by mass in the composition.

3.6. Characterisation of an invention by a parameter

In decision **T 94/82** (OJ 1984, 75) the board ruled that the requirement of clarity could be fulfilled in a claim to a product if the characteristics of the product were specified by

parameters related to the physical structure of the product, provided that those parameters could be clearly and reliably determined by objective procedures which were usual in the art (see also **T 452/91**, **T 541/97**, **T 437/98**, **T 193/01**). It is not mandatory to give instructions in the claim itself as to how the product is to be obtained (**T 94/82**).

In **T 849/11** the board summarised case law on the requirements of Art. 84 EPC with regard to the characterisation of an invention by parameters. The board stated that: (i) the claims must be clear in themselves when read by the skilled person, (ii) the method for measuring a parameter (or at least a reference thereto) must appear completely in the claim itself (see **T 1156/01**, **T 412/02**, **T 908/04**, **T 555/05**, **T 1497/08**), and (iii) the applicant who chooses to define the scope of the claim by parameters should ensure that a skilled person can easily and unambiguously verify whether they are working inside or outside the scope of the claim. The board further stated that the requirements of Art. 84 EPC can still be met if it can be convincingly shown that: (i) the method to be employed belongs to the skilled person's common general knowledge, or (ii) all the methodologies known in the relevant technical field for determining this parameter yield the same result within the appropriate limit of measurement accuracy (see **T 1156/01**).

In **T 412/02** the board held that the unambiguous characterisation in a claim of a product by parameters or by a mathematical relation between parameters necessarily required that each parameter could be clearly and reliably determined. In the board's view, it followed that the knowledge of the method and conditions of determination of the parameter was necessary for the unambiguous definition of the parameters and, as a consequence, for the unambiguous definition of a mathematical relation between them. Thus, in order to allow the matter for which protection was sought to be defined, it had to be clear from the claim itself when being read by the person skilled in the art exactly how the parameters should be determined. This would, as a rule, imply that the method of determination and the conditions of measurement which might have an influence on the value of the parameter should be indicated in the claim, either expressly or, if appropriate, by way of reference to the description according to R. 29(6) EPC 1973. Such indication would only become superfluous provided it could be shown that the skilled person would know from the outset which method and conditions to employ.

In **T 992/02** the board took the view that whilst noting the general principle that the claims must be clear per se, the non-inclusion in the claim of the method whereby one of the parameters characterising the composition claimed (level of formation of volatiles) could be measured was justified by the requirement that the claims be concise. It considered that such a conclusion could be reached in the case in hand because the method was clearly identified in the description and did not give rise to any ambiguity.

In **T 29/05** it was found that although different experimental protocols might be applied in the case in point for assessing hybridisation under stringent conditions, they were usual in the art (following **T 1084/00**).

In **T 307/06** the claims contained the added feature "and a T_g of less than 25°C". The board noted that there were different methods for determining T_g (glass transition temperature). However, the mere fact that several methods existed did not render the claims unclear if

at least one of the following conditions was met: (a) the different methods yield essentially the same T_g values for the same material, or (b) the person skilled in the art had associated the range of T_g values mentioned in claim 1 at issue with only one standard method of measurement. Neither condition (a) nor (b) was fulfilled. The board concluded that this left doubt as to which subject-matter was covered by claim 1, and thus rendered said claim unclear (see **T 728/98**, OJ 2001, 319; **T 306/13**).

In **T 1819/07** the board held that the parameter "average particle size" rendered the claim unclear as neither the type of average (volume, surface, number) nor a method for determining it was indicated in the claims. See also **T 967/08** and **T 45/10**.

In **T 2086/11** the parameter "mean aspect ratio" represented the mean of the individual aspect ratios, defined as the ratio of the major axis to thickness, of 50 aluminium flake particles having major axes of not more than 10 µm. The board held that this parameter did not enable to distinguish which subject-matter was covered by the claims and which was not. According to the method of measuring explained in the description, the investigated sample contained thousands of particles having a major axis of not more than 10 µm and the method described in the application did not give any precise indication of how to select such 50 particles. One operator, by selecting at random one group of 50 particles, could measure a mean aspect ratio within the claim whilst another operator, by selecting a different group of 50 particles, could find a value of mean aspect ratio outside the claim. The parameter "mean aspect ratio" was thus by itself insufficient to characterise the claimed product in a reliable way and did not comply with Art. 84 EPC 1973.

In **T 2676/16** the board disagreed with the examining division that the parameter "an outcome of a pseudo-random hopping" of the method of claim 1 was not clear because it could have many interpretations to a skilled person in the field of telecommunications. In context, the term "outcome" had the same meaning as "result". It was clear that by means of the "pseudo-random hopping" operation a scalar number was to be produced. The meaning of "pseudo-random" was also clear for the skilled reader. The fact that a feature could be implemented in various ways did not necessarily render this feature unclear.

In **T 999/20** the application as filed contained no information regarding how the parameter "number average molecular weight" (Mn) specified in the claim was to be determined. However, the board was satisfied that the information provided in the affidavits A1 and A2 showed that the skilled person would know how to determine Mn unambiguously using the standard method (size exclusion chromatography) commonly used in the art. Hence, the Mn feature did not lead to a lack of clarity pursuant to Art. 84 EPC.

In **T 1420/21** the board held that the characterising feature "the density of the structures formed on the structured surface ranging between 15% and 80% of the surface" was ambiguous because it did not indicate which of the three surfaces in the claim "the surface" that served as the denominator of the "density" parameter referred to. The claim cited three surfaces: the surfaces of the first or second functional area, the exposed surface and the structured surface.

In **T 1726/22** the claimed subject-matter related to an acetylated wood as such; however, it was defined by shrinkage ratios specified in relation to the wood before acetylation. The application did not mention anything regarding how the shrinkage ratios before acetylation could be determined on the basis of the acetylated wood. The board found that it was not enough for the requirement of clarity to be fulfilled that the parameter could be measured when manufacturing the wood, as the manufacturing method was not specified in the claim. It was impossible for the skilled person faced with the acetylated wood to revert to the manufacturing process during which the shrinkage before acetylation could have been measured, or to the unacetylated wood. Even if it was assumed that, as argued by the appellant, the skilled person had the idea to using a reference wood, they would not find any instructions on how to select a suitable reference wood. Considering that the choice of the reference wood, and indeed the choice of the measuring method in general, was in no way limited, it could not be concluded that repeatable and reliable results for the shrinkage ratios would be obtained on this basis, irrespective of the question of whether such a reference wood could be reliably identified, and whether such a reference wood was at all representative of the (acetylated) wood under consideration. The requirements of Art. 84 EPC were therefore not met.

3.7. Unspecified features

In **T 88/87** the disputed feature was an applicator member which was capable of springing back to its original shape upon release of the pressure applying it against the surface to be coated. The spring back capability depended on several parameters such as, for example, the strength and resiliency of the material of the cap and the thickness of the central portion of the cap. The board found that to avoid an undue limitation of the scope of the claim a functional characterisation relying on the resulting effect was allowable. The extent to which the applicator member should be capable of springing back could be specified by the indication of the effect to be produced (i.e. the freeing of the orifice) because the person skilled in the art could verify the result directly by tests involving nothing more than trial and error.

The objection in **T 487/89** (raised in relation to sufficiency of disclosure) was based on the fact that the claim had indicated both tenacity and toughness with a lower but no upper limit. The opposition division took the view that such "open-ended" parameters were always objectionable if they related to an inherently desirable characteristic. The board, however, held that whether the absence of an upper or lower limit was acceptable in a claim in any individual case depended on all the surrounding circumstances. Where, as in the case in question, the claim sought to embrace values as high as could be attained above a specified minimum level, given the other parameters of the claim, then such open-ended parameters could not normally be objected to. This decision was confirmed by **T 129/88** (OJ 1993, 598) for the question of clarity, **T 297/90** and **T 1018/05** for the question of sufficient disclosure (see also **T 989/95**, in which **T 487/89** was agreed with but not applied). In **T 586/97**, on the other hand, the board found that the absence from any independent claim of any upper limit on the amount of a particular detrimental but necessary component in the chemical composition claimed was at variance with the aim of the invention as set out in the description, namely, to decrease the percentage of the undesirable ingredient in the claimed composition. An essential feature was missing, so

that the claim was so broad it went beyond the scope of the invention as disclosed in the description. Therefore, the requirement of Art. 84, second sentence, EPC 1973 that the claims must be supported by the description was not met.

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

In **T 455/92** independent claim 2 was worded as follows: "Covering [...] for a pressing [...], characterised by: (a) a length which corresponds at least to the circumference of the shell face of the pressing to be covered, (b) an overall breadth sufficient to cover the shell face and both end faces of the pressing, and (c) a fold such that [...] the breadth [...] corresponds to the breadth of the shell face of the pressing [...]". The board did not see this as a breach of Art. 84 EPC 1973, since reference had been made to a physical entity which was known; hence the range of sizes was definable in so far as it excluded packaging materials for other physical entities. Furthermore, it was self-evident to a skilled person in this field that the size of the packaging material (the covering) was dependent on the physical entity to be packed. In **T 1020/13**, however, the definition of a claimed entity by reference to a second entity that was not part of the claim was deemed a breach of Art. 84 EPC.

3.8. Standards

In the application at issue in **T 1888/12**, claim 1 referred to undated ISO standards. The board pointed out that such standards were typically revised over time, and the possibility of substantial changes could not be ruled out (see **T 783/05**). The appellant's argument that the date to be taken into account was the application's priority date did not convince the board because there was no such indication in the description. In the board's view, the definition of technical features by general reference to ISO standards was not sufficiently clear. However, in **T 2187/09**, the board decided that the UNISIG standard mentioned in the claim merely provided context for the invention. Details of the standard were not needed to define the scope of the invention and to enable the skilled person to know if they were working within or outside the claimed scope.

According to **T 3003/18**, the clarity of a claim specifying a norm or standard depended on the case, and in particular the claimed subject-matter. The MTRJ connector specified in claim 1 designated a well-known standardised family of connectors having, on the one hand, specific features that could differ among the connectors of the family and could change over time according to different specific versions of the corresponding standard or norm and, on the other hand, a series of common features that ensured a predetermined degree of compatibility and interchangeability between the different connectors of the same family. These connectors were commonly and generally designated

"MTRJ connectors" in textbooks, reference books and the like, without reference to any particular version of the corresponding standard or norm. The features of the MTRJ connector relevant in the technical context of claim 1 were the common features, and so the skilled person would understand what was meant in the claimed context by the optic connector being an "MTRJ connector".

3.9. Trade marks

In **T 762/90** a lack of clarity was found in the use of a trade mark designating a whole series of products which differed from one another depending on phases in their industrial development. Moreover, the board expressed doubts about the use of such a designation, since it was uncertain whether the meaning of the trade mark would remain unaltered up to the end of the patent term (see also **T 939/92**, **T 409/10**, **T 270/11**, **T 872/20**; see also chapter II.E.1.7.3e) "Drafting of disclaimers – clarity"). Similarly, in **T 480/98** the board considered that a trade mark product referred to in the characterising portion of claim 1 did not have a clear technical meaning, in that it could refer to a plurality of products having different compositions and properties. In consequence there was a lack of clarity, and the claim was not allowable. According to the board in **T 623/91** the exclusion of a composition by reference to the trade mark or trade designation would not introduce uncertainty and therefore not offend against Art. 84 EPC 1973, as changes in the range of chemical composition would not be likely without a corresponding change in the trade name or trade mark.

3.10. Principles in connection with categories of claim

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

In case **T 410/96** concerning a data processing system the question arose whether it was permissible for a claim to a system to refer back to a claim to a method. The board held that, although R. 29(4) EPC 1973 mentioned a reference only in the context of a claim including all the features of the claim it referred to, this did not imply a contrario that a reference which did not fulfil this condition was necessarily impermissible. The board found that there was no a priori objection under Art. 84 EPC 1973 to an independent claim which partially drew its features from preceding claims of a different category. The essential features were thus incorporated in the disputed claim by reference, the claim thus complying with R. 29(3) EPC 1973 (R. 43(3) EPC).

In **T 1722/11** a claim related to a computer program resident on computer-readable media was defined by reference to a method claim. The execution of the method required co-ordinated interaction between various resources in a communication network. As these resources were at different, mutually remote locations, the board considered it unclear how the method referred to could be executed solely by a (single) computer program when run on a computer. The claim thus lacked clarity.

In decisions **T 418/92** and **T 453/90** the boards confirmed that it was possible for claims to relate to both physical activities and physical entities, in particular where the inventions concerned were fully disclosed as processes to the skilled person only if apparatus features were also included in the definition. In **T 1046/05** too the board confirmed the clarity of an apparatus feature in a process claim.

In **T 426/89** (OJ 1992, 172) the board decided that a claim relating to a "method for operating" a device was not "clear" (Art. 84 EPC 1973) if the claimed features only described how the device worked.

In **T 841/95** the board found that where a claim for an apparatus sought to define the invention by reference to features of the use to which the apparatus was to be put, a lack of clarity could result. However, if the subject-matter of the application was an apparatus and it was not viable to define the apparatus other than by reference to the said use, an apparatus claim directed to a combination of apparatus and use and defining the apparatus unambiguously could be clear.

Including in a device claim "for carrying out a process" a reference back to an earlier claim did not alter the fact that it was an independent (non-process) claim; rather, it limited the claimed device to being suitable to carry out the process referred to (**T 1017/98**).

A claim in **T 952/99** contained two different aspects of a use claim: on the one hand it defined the use of a particular physical entity to achieve an "effect", and on the other it defined its use to produce a product. Although a use claim normally falls into either one category or the other, the board found that such a clear distinction was not possible in this case. The claim contained both application and process features and there was a technical affinity between the additional process step and the "core" of the invention. Both the application and process features were thus technical features of the invention, so that their combination did not contravene R. 29(1) EPC 1973, the relevant criterion for assessing the extent to which the combination of a "use" claim and technical process features was allowable from the point of view of clarity. The board drew a distinction with **T 796/91**, in which it had been held that the heterogeneous combination of process features and application features rendered the claim fundamentally unclear. That case had concerned the combination of a process claim and a use claim with no process claim at all. In contrast to the case before the board, the process features had apparently had no affinity to the application features, which had made it impossible to subsume the two different types of technical feature under one claim.

In **T 921/11** the board considered that the claims as a whole, construed in the light of the description, were so unclear as to the meaning of the term "system" that the skilled reader was neither in a position to recognise the nature of the claimed subject-matter nor the category to which claim 1 belonged.

For the particularities of product-by-process claims, see in this chapter II.A.7.

4. Disclaimers

Disclaimers play an important role in the drafting of claims and amendments. The principles concerning the allowability of disclaimers are set out in chapter II.E.1.7.3e) "Drafting of disclaimers – clarity".

5. Claims supported by the description

5.1. General principles

Article 84 EPC stipulates that the claims must be supported by the description. This requirement means that the subject-matter of the claim must be taken from the description and it is not admissible to claim something which is not described (see e.g. **T 906/10**, **T 684/12**, **T 1694/12**, **T 758/13** and **T 56/21**).

In decision **T 133/85** (OJ 1988, 441) the board took the view that a claim which did not include a feature described in the application (on the proper interpretation of the description) as an essential feature of the invention, and which was therefore inconsistent with the description, was not supported by the description for the purpose of Art. 84 EPC 1973. The boards apply this principle as part of their established jurisprudence, see e.g. **T 409/91** (OJ 1994, 653), **T 939/92**, **T 322/93**, **T 556/93**, **T 583/93**, **T 659/93**, **T 482/95**, **T 616/95**, **T 586/97**, **T 687/98**, **T 1076/00**, **T 637/03** and **T 1399/17**. The requirement for all essential features to be indicated is inferred to some extent from different provisions of Art. 84 EPC (see in this chapter II.A.3.3. in relation to clarity). In **T 2049/10** the board considered the topic "essential feature missing" to not primarily be a question of clarity but of support by the description (both subsumed under Art. 84 EPC).

In **T 409/91** the invention related to fuel oils. In the description the use of certain additives was presented as an essential constituent of the fuel oil composition. As this feature was missing in the claims, the board found that they defined some other invention which was not sufficiently disclosed. Although the requirements of sufficient disclosure of the invention (Art. 83 EPC 1973) and support by the description (Art. 84 EPC 1973) were related to different parts of the patent application, they gave effect to the same legal principle that the extent of a patent monopoly, as defined by the claims, should correspond to the technical contribution to the art (see also chapter II.C.8. "The relationship between Article 83 and Article 84 EPC").

Many boards further stress that the requirement for the claims to be supported by the description was intended to ensure that the extent of protection as defined by the patent claims corresponds to the technical contribution of the disclosed invention to the art (see **T 409/91**; **T 435/91**, OJ 1995, 188; **T 1055/92**, OJ 1995, 214; **T 659/93**; **T 825/94**; **T 586/97**; **T 94/05**; **T 1217/05**; **T 1694/12** and **T 809/12**). Therefore the claims must reflect the actual contribution to the art in such a way that the skilled person is able to perform the invention in the entire range claimed (**T 659/93**, **T 94/05**). A purely formal support by the description, i.e. a verbatim repetition of the mention of a claimed feature, cannot meet these requirements (**T 94/05**, summarised in the next section; see also **T 127/02**, **T 1048/05**, **T 758/13** and **T 2483/16**). However, according to a different view, a review of

the discussions in the various drafts to be found in the preparatory material suggests that the requirement for support of the claims was viewed rather as a formal matter to ensure that the description and claims had the same extent (**T 1020/03**, OJ 2007, 204). In **T 1020/03** the board concluded that in the case in point Art. 84 EPC 1973 could not be used to force an applicant to cut down the scope of first or second medical use claims considered too broad compared to any use disclosed in the description. Other decisions in turn consider both aspects (see e.g. **T 297/05**).

In **T 695/16** the board noted that characterising features a and b in claim 1 were clear to the skilled person, i.e. their structural form, function and interrelation were clear. In the description there was at least a verbatim repetition of the characterising features of claim 1. Thus said features were also disclosed in a clear manner in the description, thereby supporting the wording of claim 1, and the scope of the claims was not broader than justified by the extent of the description. Since features a and b were per se clear, a specific denomination of these in the part of the description directed to the specific embodiment depicted in the figures was not mandatory. Any reading of the description and viewing of the figures had to be done with the knowledge that features a and b were present and interacted.

For case law on the use of description and drawings to interpret the claims see in this chapter II.A.6.3.

In **T 223/23** claim 1 of the main request was directed at a product as such, namely a trace element solution, which was defined by the types and amounts of the trace elements (zinc, manganese, selenium and copper) dissolved therein. The board found that even if, according to the description, the invention aimed at providing a highly concentrated trace element solution, and provided for the first time a process allowing the preparation of such a highly concentrated solution, this did not mean that the claims should be limited to that particular process or to a solution defined in terms of that particular process for them to comply with Art. 84 EPC. A lack of support would only arise if there were well-founded reasons for believing that the skilled person would be unable to extend the particular teaching of the description to the whole of the field claimed by using routine methods.

5.2. Restrictions on generalising the technical information and examples adduced in the description

The question of the extent to which the technical information and examples adduced in the description may be generalised in the formulation of the claims is usually examined in the context of the requirements of Art. 83 EPC (see in particular chapter II.C.5. "Clarity and completeness of disclosure"). Sometimes though it is also considered in the context of the requirement for support by the description. See also chapter II.C.8. "The relationship between Article 83 and Article 84 EPC".

In **T 2231/09** the patent concerned a method of representing and analysing images. Claim 1 of the main request set out that "... at least one said descriptor element is derived using only a subset of pixels in said image." The appellant had put forward an interpretation according to which a "subset" could correspond to all pixels in the image, which the board

considered inconsistent with essential parts of the described embodiments. The board stressed that, while a certain degree of generalisation may be permitted, features as claimed should make it possible to clearly identify features of embodiments that are covered by the terms of a claim. Moreover, the generalised subject-matter as claimed should make it possible to understand the technical problem to be solved. The terms of a claim should be commensurate with the invention's technical contribution to the art. The board regarded the division of the image into regions and subsets as essential for achieving the technical effect underlying the invention. Therefore, claim 1 was not supported by the description and did not comply with Art. 84 EPC 1973.

In **T 659/93** the board held that the requirement that the claims should be supported by the description meant that they had not only to contain all the features presented as essential in the description, but had also to reflect the applicants' effective contribution by enabling the skilled person to carry out their teaching throughout the field to which they applied (similarly **T 332/94** with reference to **T 409/91**, OJ 1994, 653).

In **T 939/92** (OJ 1996, 309) the examining division had raised the objection that the disputed claim was an unreasonable generalisation of the examples contained in the description. However, the board held that it did not follow from Art. 84 EPC 1973 that a claim was objectionable just because it was "unreasonably broad". The expression "supported by the description" meant that the technical features stated in the description as being essential features of the described invention must be the same as those used to define the invention in the claims, otherwise the claims would not be true definitions but mere descriptions. If a claim concerned a group of chemical compounds per se, an objection of lack of support by the description could not properly be raised for the sole reason that the description did not contain sufficient information in order to make it credible that an alleged technical effect (which was not, however, a part of the definition of the claimed compounds) was obtained by all the compounds claimed (see, with regard to Art. 83 EPC, also **T 2001/12**). The facts of the case in question differed from those underlying **T 409/91**.

In **T 94/05** the board pointed out that the requirement for the claims to be supported by the description was intended to ensure that the extent of protection as defined by the patent claims corresponds to the technical contribution of the disclosed invention to the art (see also **T 409/91**, **T 435/91**). Therefore the claims must reflect the actual contribution to the art in such a way that the skilled person is able to perform the invention in the entire range claimed (**T 659/93**). In the board's view, a purely formal support by the description, i.e. a verbatim repetition of the mention of a claimed feature, could not meet these requirements. To be allowable, functional features must disclose a clear teaching which the skilled person can carry out without undue burden (see **T 68/85**, OJ 1987, 228). From this, it followed that the skilled person, at least after reading the patent specification, taking account of their common general knowledge, and possibly also after carrying out normal experiments, must actually be provided with at least a plurality of different embodiment variants. The reproducibility from the patent specification of the above-mentioned functionally defined feature was confined to the sole embodiment described. The board concluded that the functional definition in claim 1 did not adequately reflect the technical contribution described in the patent specification. Moreover, claim 1 and the description

were contradictory, so that the claim was not supported by the description and the requirements under Art. 84 EPC were not met.

In **T 568/97** the claims defined the physiological effect to be achieved by a sufficiently high concentration of vasoactive intestinal polypeptide and/or prostaglandins as active agents in a pharmaceutical composition for transurethral administration. Neither individual values nor ranges of the amounts of vasoactive intestinal polypeptide and/or prostaglandins were disclosed in the patent. Furthermore, it was impossible to find out without undue burden the physiologically effective amounts as claimed merely on the basis of common general knowledge. The board held that the description of the patent lacked support within the meaning of Art. 84 EPC 1973 as to the amount of vasoactive intestinal polypeptide and/or prostaglandins required to achieve a physiologically effective dose. The functional feature not only had to be such that the skilled person could understand it; they also had to be able to implement it.

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

5.3. Bringing the description into line with amended claims

In **T 977/94** the board decided that if the patentee amended the claims, it was essential that the description be adapted to them, because of its fundamental importance. An invention was only claimable to the extent that it was supported by the description (Art. 84, second sentence, EPC 1973), and the claims were interpreted in the light of the description (Art. 69 EPC 1973). It was thus necessary to check that the essential elements of the invention claimed were also described as such in the description. See also **T 300/04**, **T 1399/17**.

In **T 295/02** the board found that an inconsistency between a claim and the provisional description was not a valid reason to refuse the application. The inconsistency arose from an amendment in the claims and the appellant was prepared to adapt the description to conform to a definite allowable set of claims.

In **T 1808/06** the board recalled that, in order to meet the requirement of Art. 84 EPC that the claims have to be supported by the description, any disclosure in the description and/or drawings inconsistent with the amended subject-matter should normally be excised (see also **T 1883/11**, **T 1252/11**, **T 237/16**). Reference to embodiments no longer covered by amended claims must be deleted, unless these embodiments can reasonably be considered useful for highlighting specific aspects of the amended subject-matter. In such a case, the fact that an embodiment is not covered by the claims must be prominently stated (see also **T 978/16**). Reference to Art. 69(1) EPC was not an appropriate justification for a less stringent adaptation of the description and in so far misleading as it

could be understood to suggest a direct applicability of its contents at the examination or opposition stage. This was clearly not the case as Art. 69(1) EPC related to the scope of protection (see in this chapter II.A.6.3.2 "Legal basis for using the description and drawings to interpret the claims"). It was only in situations where the removal of inconsistencies was not possible for procedural reasons (e.g. no amendment possible of the granted version) that – purely as an auxiliary construction – Art. 69(1) EPC could be invoked for an interpretation of the claimed subject-matter.

In **T 1989/18** the board held that the description could not be relied upon to resolve a clarity issue in a claim, nor could it give rise to any such issue if the definition of the subject-matter in a claim was clear per se. In particular, if the claims were clear in themselves and supported by the description, their clarity was not affected if the description contained subject-matter which was not claimed. Art. 84 EPC could not serve as a legal basis for a refusal in such circumstances. When assessing clarity, Art. 69 EPC was of no relevance since it was only concerned with the extent of protection conferred. In the absence of an objection of lack of unity under Art. 82 EPC, the board failed to see how R. 42(1)(c) EPC could be the legal basis for requiring the applicant, as a general rule, to bring the description in line with claims intended for grant, and to remove passages of the description that disclosed embodiments which were not claimed. A number of decisions have relied on R. 48(1)(c) EPC as a potential legal basis for requiring the description to be adapted to the subject-matter as claimed. However, the board, taking into account the wording and history of R. 48(1)(c) EPC, considered that this provision could not serve as a legal basis for the refusal of an application if the description was not adapted to the claimed subject-matter.

In **T 1024/18** the board disagreed with decision **T 1989/18**. The board recalled that the established case law of the boards of appeal had interpreted the requirement of support by the description as requiring the entirety of the description to be consistent with any claims found to meet the requirements of the EPC. That this was the established case law of the boards could also be gleaned from the explanatory remarks to Art. 11 RPBA which deal with the case where remittal to the department of first instance is still provided for the purpose of adaptation of the description. The board found that the requirement in Art. 84 EPC that the claims be supported by the description included the requirement that the description be consistent with the claims not only in part but throughout. The board confirmed that when amendments were made to the claims, the description had to be made consistent therewith in the sense that a reader was not presented with any information conflicting with the wording of the claims. It stated that embodiments of the invention which were not consistent with the claims therefore had to be deleted or had to be clearly identifiable to the reader, for example by rewording of relevant passages to indicate that such passages were not, or were no longer, part of the invention. **T 1024/18** was followed in **T 2378/13**, **T 2766/17**, **T 1968/18**, **T 2293/18**, **T 2685/19**, **T 3097/19**, **T 121/20**, **T 1516/20**, **T 438/22**, **T 673/22**.

In **T 1444/20** the board observed that nothing suggested that the claims of the main request were not clear in themselves to a person skilled in the art. Moreover, it considered that the claim-like clauses included in the description under the heading "Specific embodiments of the invention" could not be mistaken for claims, since it was evident that

they were a part of the description text, and they were not denoted as "claims", either. Thus, there was no reason why the presence of those clauses in the description should affect the clarity of the claims. The board pointed out that if claim-like clauses in the description did not result in a lack of clarity of the actual claims, Art. 84 EPC could not provide the justification for removing them. The board further noted that the entire section "Specific embodiments of the invention" related to the same subject-matter as the claims. Thus, this section provided additional support for the claims in the description, as also required in Art. 84 EPC. Regarding the removal of the "Specific embodiments of the invention" from the description as "redundant" subject-matter, the board followed **T 1989/18**. It rejected that R. 42(1)(c) and 48(1)(c) EPC provided a legal basis for the obligation to bring the description in line with the claims of the main request, and to remove passages of the description that disclosed embodiments which were not claimed.

In **T 2194/19** the board was of the view that the requirement that the claims are to be supported by the description under Art. 84, second sentence, EPC does not necessarily mean that all the "embodiments" of the description of a patent application have to be covered by the (independent) claims. The board further rejected that R. 42(1)(c) EPC could be the legal basis for establishing such a broad requirement for an adaptation of the description to the claims. In **T 3097/19** the board disagreed with the conclusions of **T 2194/19** and it considered necessary that embodiments said to be "of the invention" fall within the scope of the claims.

According to the board in **T 438/22,** there is no provision stipulating that examples within the meaning of R. 42(1)(e) EPC should not be in the form of claim-like clauses at the end of or in another part of the description. There is no justification for deleting such examples just because they are drafted as claim-like clauses. They are to be treated like any other part of the description and thus, inter alia, must support the claims (Art. 84 EPC). It is a general and overarching objective, and as such also a "requirement" of the EPC, that authorities, courts and the public interpreting the claims at a later stage should, as far as possible, arrive at the same understanding of the claimed subject-matter as the EPO bodies deciding on its patentability. The only tool for achieving this objective is the patent specification as the expression of a unitary legal title. The description, as an integral part of the patent specification, should therefore also serve this overriding objective, i.e. it should provide a common understanding and interpretation of the claims. If the description contains subject-matter which manifestly impedes a common understanding, it is legitimate to insist on its removal under Art. 84 and 94(3) EPC and R. 42, 48 and 71(1) EPC. The board approved the practice where instead of a direct removal, i.e. the deletion of the subject-matter not covered by the claims, a "removal" by way of an appropriate statement is made, leaving the technical disclosure unaffected. See also **T 1426/21**, where the board held that there was no reason to require the deletion of claim-like clauses which were consistent with the claims.

In **T 56/21** the board analysed the function and relationship of the claims and the description, the relationship between the assessment of patentability and the determination of the extent of protection as well as the requirements of support by the description and clarity in Art. 84 EPC. Regarding the adaptation of the description the board revised the early and recent decisions of the boards of appeal, and concluded that

in examination of a patent application, neither Art. 84 EPC nor R. 42, 43 and 48 EPC provide a legal basis for requiring that the description be adapted to match allowable claims of more limited subject-matter. In the case at hand the description included a passage entitled "specific embodiments", which contained claim-like clauses. Those clauses included subject-matter which was not claimed. The board set aside the refusal decision and remitted the case to the examining division with the order to grant a patent.

In **T 2391/18** the board dealt with an alleged inconsistency between the claims and the description, which was already present in the granted version. Since Art. 84 EPC is not a ground for opposition, the board held that the requested amendment to the description was not "occasioned by a ground for opposition" within the meaning of R. 80 EPC. Moreover, applying the considerations of the Enlarged Board in **G 3/14**, the board concluded that the claims of the patent could be examined for compliance with the requirements of Art. 84 EPC only when, and then only to the extent that the amendment introduced non-compliance with Art. 84 EPC. See also **T 1477/15**, **T 454/20**, **T 447/22**, **T 736/22**.

According to the board in **T 2178/17**, the filing of a description adapted to a set of claims found by a board of appeal to meet the requirements of the EPC does not generally constitute an amendment to a party's appeal case, even less so when, as in the case at hand, the amended description consisted solely of the deletion of the references to no longer existing claims. Therefore, its admittance into the proceedings was not subject to the board's discretion under Art. 13(2) RPBA. In **T 1968/18** however the board held that the filing of an adapted description during the oral proceedings before the board resulted in an amendment of the patent proprietor's appeal case, but at the same time it considered that adapting the description to the claims which were found to be allowable constituted exceptional circumstances within the meaning of Art. 13(2) RPBA. Thus, the board decided to admit the amended description.

6. Interpretation of claims

6.1. General principles

According to the established case law, the skilled person should try, with synthetical propensity, i.e. building up rather than tearing down, to arrive at an interpretation of the claim which is technically sensible and takes into account the whole disclosure of the patent. The patent must be construed by a mind willing to understand, not a mind desirous of misunderstanding (see inter alia **T 190/99**, **T 920/00**, **T 500/01**, **T 1023/02**, **T 749/03**, **T 405/06**, **T 2480/11**, **T 2456/12**, **T 383/14**, **T 1477/15**, **T 448/16**, **T 111/22**).

As stated in **T 10/22**, when it comes to claim construction the often-used reference to "a mind willing to understand" is about relying on "a mind willing to objectively construe a claim", rather than "a mind willing to understand the applicant's or patent proprietor's alleged intention". This is mainly so because it would be to the detriment of third parties and the public if claim construction depended on the alleged intention of the applicant or proprietor.A considerable number of decisions have held that the skilled person, when considering a claim, should rule out interpretations which are illogical or which do not make

technical sense (see inter alia **T 190/99**, **T 552/00**, **T 920/00**, **T 1023/02**, **T 749/03**, **T 859/03**, **T 1537/05**, **T 1204/06**, **T 383/14**, **T 681/15**). Some decisions (**T 1408/04**, **T 1582/08**, **T 493/09**, **T 5/14**) have emphasised that this is understood to mean only that technically illogical interpretations should be excluded. A mind willing to understand does not require that a broad term need be interpreted more narrowly (even if, as in the case underlying **T 1408/04**, the narrower interpretation would refer to a structure which is very common, but not exclusive, in the technical field concerned). In **T 1514/14** the board noted that when a claim requires interpretation, the skilled person will endeavour to interpret it in a technically sensible manner and in the overall context. However, this of course did not mean that only those interpretations which fulfil the requirements of the EPC can be considered technically sensible. See also **T 566/20**.

It is a well-established principle laid down in the boards' case law that a non-specific definition in a claim should be given its broadest technically sensible meaning in the context of that claim (see e.g. **T 79/96**, **T 596/96**, **T 1266/19**). **T 1553/19** applied this rule of claim construction to a feature defined in a negative manner ("in absence of […] metal organic catalyst"). The board explained that the broadest scope of the claim corresponded to the narrowest (i.e. most limited) technically sensible definition of the element to be excluded.

In **T 1354/18** the board pointed out that patent claims conveyed a technical teaching and were directed at a reader with technical knowledge in the field of the application. The correct interpretation of claim features must therefore always be based on their technical literal meaning in the overall technical context of all features from the perspective of a person skilled in the art and not on a purely linguistic analysis of the wording of individual terms. The terms used in patent documents should therefore primarily be given the meaning they usually conveyed in the relevant state of the art. This could easily lead to a situation where the skilled person in the relevant technical field understood certain terms differently on the basis of her/his general technical knowledge than on the basis of a purely linguistic analysis. Moreover, the patent specification itself could attribute a specific meaning to individual features that deviated from a purely linguistic understanding; in this respect, a patent document could be its own dictionary. The interpretation must lead to a technically sensible result, whereby the claims should normally be attributed the broadest technically sensible meaning. The linguistic analysis of a feature could at best complement or confirm the analysis of the technical meaning, but could not replace it. See also **T 2007/19**, **T 1382/20**.

In **T 1886/22** and **T 1345/23** the board held that, in order to determine whether the term "extends through" should be interpreted as "from one end to the other" or as "along within", the disputed feature had to be interpreted in the technical context of the claim. The skilled person reading the claim as a whole would understand that for the catheter tip portion to be coupled to the distal end of the catheter shaft it was sufficient that the proximal portion of each of the arms extended partially through the proximal bushing, in other words, that it extended into the bushing. It was irrelevant whether the proximal portion extended through the entire bushing or whether it terminated somewhere within the bushing.

In **T 42/22** the board considered whether an independent product claim 1 was to be interpreted in the context of method claim 6. In the board's view, the interpretation of product claim 1 could not be dependent on whether or not method claim 6 was present in the claim set. Instead, each claim should be interpreted independently. The board did not find in Art. 84 EPC support for the contention that all claims needed to be interpreted together. In addition, there was a technically sensible interpretation of claim 6 which was also compatible with the selected interpretation of claim 1. The board pointed out that in line with the case law, a technically sensible interpretation could not be disregarded even if additional interpretations were possible.

On the consultation of the description and drawings to interpret the claims, see in this chapter II.A.6.3.

In **T 1513/12** the board noted that an interpretation of a claim agreed by the parties to the proceedings was not to be regarded as binding on the board: the "principle of party disposition" was not to be understood as meaning that the parties to the proceedings could choose an interpretation of the patent which, although it might be satisfactory for them, might have implications for others not party to the proceedings. Confirmed in **T 2319/18** and **T 1024/19**.

In **T 1473/19** the board pointed out that claim interpretation is overall a question of law which must as such ultimately be answered by the deciding body, and not by linguistic or technical experts. It does, however, involve the appraisal of linguistic and technical facts which may be supported by evidence submitted by the parties. In **T 450/20** and **T 1494/21** the board concurred with this statement and it stressed that a board of appeal is not limited to the claim interpretations advanced by the parties but may also adopt a claim interpretation of its own. Relying on documentary evidence is not a precondition for the adoption of a certain claim interpretation by a board of appeal. In this context evidence can only be relied upon to prove facts, such as how the person skilled in the art understood a certain technical term in a certain prior art document at a certain point in time, but not to ultimately ascertain whether a certain claim interpretation is correct or not.

See also chapter I.C.8.1.3c) "Interpretation of process claims".

6.2. Meaning of "comprising (substantially)", "consisting (essentially) of", "containing"

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

of". However, in view of the unequivocal character of the words "consisting of" as compared to "comprising", the expression "consisting essentially of" was to be given preference. See also **T 1730/09**, **T 274/16**.

In **T 405/00** the board considered that, according to the language conventional for patent claims in the field of chemistry, the wording "composition comprising a persalt" defined exclusively the mandatory presence of at least one of the specific chemical compounds belonging to the group of persalts.

In **T 1023/02** the board stated that a claim using "comprising" language should generally not be construed as covering subject-matter which included further steps of a nature that would manifestly counteract the specified technical purpose of the step(s) recited in the claim.

In **T 1599/06** the board likewise had to interpret the term "comprising". It emphasised that the meaning of terms in a patent claim has to be determined from the point of view of the skilled person, who reads the claim in the context of the application and against the background of their common general knowledge. The claim was directed to a vaccinating agent comprising at least one specific purified and isolated protein of Mycobacterium tuberculosis. The examining division had interpreted the term "comprising" broadly and held that the claimed subject-matter lacked novelty in relation to a partially purified protein fraction which, in their view, contained inter alia the specified proteins. In the board's view, however, the skilled person would derive from the application as a whole the information that the specific characteristic of the vaccinating agents according to the invention was their generation from isolated and purified Mycobacterium tuberculosis proteins. Therefore, the skilled person would have considered that the definition in claim 1 covered vaccinating agents that, firstly, were constituted from isolated and purified proteins as mentioned in the claims and, secondly, contained those proteins as their main constituents.

In **T 1771/06** a claim specifically referred with closed language to the characterising part (GBSS gene fragment in the antisense direction) of the gene construct and, in an attempt to generalise, left open other structural elements necessary to operate the system ("comprising a fragment ... which codes for ...., said fragment consisting of a nucleotide sequence selected from ... SEQ ID No: ..."). According to the board this was not an unusual claim formulation. The board did not accept the appellant's argument that the scope of the claim extended to gene constructs which comprised any DNA in addition to the GBSS gene fragments. The skilled person would certainly take into account the fact that the gene construct was made for the purpose of introducing the GBSS DNA fragment into the potato cells and integrating it into the genome. Accordingly, the gene construct would be thought to contain all necessary DNA elements for these steps to take place.

In **T 390/08** the board held that the definition of a composition as "consisting of" compulsory and optional components met the requirements of Art. 84 EPC, as such a composition defined a "closed" composition from which elements other than those mentioned were excluded. See also **T 1190/01**, **T 1998/07.**

In **T 2027/13** the claimed composition was defined by an open formulation (in view of the word "comprising"), which already implied the presence not only of the optional excipients, but also of any additional pharmaceutically acceptable components (including impurities) and even of further release controlling agents, and the expression "consisting essentially of", which referred to a single ingredient of the composition. As the usual reading of this expression did not make sense in the case in hand, the skilled person reading the claim was at a loss as to the possible limitation introduced by the expression.

In **T 2103/22** the claim was directed to "[…] a layer of a polyester resin which comprises an ethylene terephthalate unit […], characterised in that said polyester resin is a blended polyester resin which is a blend of a lowly crystalline polyester resin and a highly crystalline polyester resin at a weight ratio of 90:10 to 10:90 […]".The board stated that, although it was correct that the normal rule of claim construction was that the terms used in a claim should be given their broadest technically sensible meaning, the literal reading of this passage defined that "said polyester resin" consisted of the lowly crystalline and highly crystalline polyester resins further defined in the claim, in the given weight ratio, i.e. it excluded the presence of any other components other than the ones specifically defined. As the polyester resin specified in the term "a layer of a polyester resin" was identical to the "said polyester resin", the board concluded that it consisted of a blend of only the lowly and highly crystalline polyester resins.

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

Regarding Art. 123(2) EPC, see chapter II.E.1.15. "Comprises", "consists of", "consists essentially of", "contains".

6.3. Using description and drawings to interpret the claims

6.3.1 General principles

The subject-matter of claims is governed by Art. 84 EPC and their function by Art. 69 EPC. According to Art. 84 EPC the claims define the invention for which protection is sought. According to Art. 69 EPC the claims determine the extent of the protection which will be conferred by the patent, through their definition of the invention. Under Art. 69 EPC the description and drawings are used to interpret the claims. The question arises whether it is possible to interpret the claims in the light of the description and drawings as provided in Art. 69 EPC merely in order to determine the extent of protection or whether it is also possible to do so in order to establish whether the conditions governing patentability and clarity have been satisfied.

In a number of decisions, such as **T 23/86** (OJ 1987, 316), **T 16/87** (OJ 1992, 212), **T 327/87**, **T 89/89**, **T 121/89**, **T 430/89**, **T 476/89**, **T 544/89**, **T 565/89**, **T 952/90**, **T 439/92**,

T 458/96, **T 717/98**, **T 1321/04**, **T 1433/05** and **T 2145/13**, the boards of appeal have laid down and applied the principle whereby the description and drawings are used to interpret the claims and identify their subject-matter, in particular in order to judge whether it is novel and not obvious. Likewise, in a large number of decisions (e.g. **T 238/88**, OJ 1992, 709; **T 416/88**; **T 194/89**; **T 264/89**; **T 472/89**; **T 456/91**; **T 606/91**; **T 860/93**; **T 287/97**; **T 250/00**; **T 505/04**), the boards interpreted the claims in the light of the description and drawings in order to establish whether they were clear and concise within the meaning of Art. 84 EPC 1973.

Occasionally, however, the limits to interpretation in the light of the description and drawings are emphasised (see in this chapter II.A.6.3.4). A discrepancy between the claims and the description is not a valid reason to ignore the clear linguistic structure of a claim and to interpret it differently (**T 431/03**) or to give a different meaning to a claim feature which in itself imparts a clear credible technical teaching to the skilled reader (**T 1018/02**, **T 1395/07**, **T 711/14**, **T 1456/14**, **T 2769/17**, **T 169/20**, **T 821/20**, **T 42/22**, **T 447/22**). In **T 1023/02**, though, "unfortunate" claim language ("transcription" instead of "translation") in contradiction with the description of the invention was interpreted differently.

In **T 197/10** the board explained that if the claims are worded so clearly and unambiguously as to be understood without difficulty by the person skilled in the art, there is no need to use the description to interpret the claims. In the event of a discrepancy between the claims and the description, the unambiguous claim wording must be interpreted as it would be understood by the person skilled in the art without the help of the description. Thus, in the event of a discrepancy between clearly defined claims and the description, those elements of the description not reflected in the claims are not, as a rule, to be taken into account for the examination of novelty and inventive step. See, similarly, **T 1514/14** concerning the examination of sufficiency of disclosure.

In **T 2221/10** the board referred to established case law according to which the description can be used as the patent's "dictionary" to assess the correct meaning of ambiguous terms used in claims (see in this chapter II.A.6.3.3). The board, however, also referred to **T 197/10**, pointing out the limits to the interpretation in the light of the description and drawings. See also **T 2328/15** and **T 1642/17**.

In **T 1924/20** the board stated that a skilled reader of a patent claim would, for many reasons, interpret the claims based essentially on their own merits (see e.g. **T 2764/19** and **T 1127/16**). This was because the "subject-matter of the European patent" is defined by the claims and only by them. The board explained that the description and drawings were, however, typically used by the deciding body to determine the above-mentioned "skilled reader" and, hence, the viewpoint from which the claims are interpreted. This meant that, when interpreting the claims, the description and drawings could not be relied on as a sort of fall-back or supplementary-guidance tool for filling up gaps or for resolving inconsistencies in a claim to the patent proprietor's advantage. Such a reliance on the description and the drawings by the patent proprietor would normally fail to convince.

According to the board in **T 177/22**, a given patent claim's subject-matter must be interpreted and determined in a uniform and consistent manner (see **T 1473/19**). This excludes interpreting the same claim differently when assessing sufficiency of disclosure on the one hand, and when assessing novelty and inventive step on the other hand. It also presupposes that the same principles of claim interpretation must be applied when assessing compliance with any of these requirements under the EPC.

In **T 439/22** (OJ 2024, A104) the board concluded that the case law of the boards was divergent on the following questions: a) legal basis for construing patent claims; b) whether it is a prerequisite for taking the figures and description into account when construing a patent claim, that the claim wording, when read in isolation, be found to be unclear or ambiguous; and c) the extent to which a patent can serve as its own dictionary. To ensure the uniform application of the law, the board referred the following questions to the Enlarged Board:

1. Is Art. 69(1), second sentence EPC and Art. 1 of the Protocol on the Interpretation of Article 69 EPC to be applied to the interpretation of patent claims when assessing the patentability of an invention under Art. 52 to 57 EPC? [see points 3.2, 4.2 and 6.1 of the Reasons]

2. May the description and figures be consulted when interpreting the claims to assess patentability and, if so, may this be done generally or only if the person skilled in the art finds a claim to be unclear or ambiguous when read in isolation? [see points 3.3, 4.3 and 6.2 of the Reasons]

3. May a definition or similar information on a term used in the claims which is explicitly given in the description be disregarded when interpreting the claims to assess patentability and, if so, under what conditions? [see points 3.4, 4.4 and 6.3 of the Reasons]

The Enlarged Board issued its decision **G 1/24** on 18 June 2025.

In **T 409/97** the board held that an erroneous statement in the introduction to the description, according to which a process according to the general part of claim 1 was known from a prior art document D1, was of no assistance in interpreting the claim and establishing the subject-matter for which protection was being sought, where this statement contradicted the actual content of D1.

6.3.2 Legal basis for using description and drawings to interpret the claims

Several decisions applying the principle whereby the description and drawings are used to interpret the claims refer to Art. 69(1) EPC 1973 (**T 23/86**, OJ 1987, 316; **T 16/87**, OJ 1992, 212; **T 238/88**, OJ 1992, 709; **T 476/89**; **T 544/89**; **T 565/89**; **T 952/90**; **T 717/98**). Other case law emphasises that Art. 69 EPC 1973 (Art. 69 EPC) and its Protocol are primarily for use by the judicial organs which deal with infringement cases (see e.g. **T 1208/97**, **T 1279/04**, **T 223/05**, **T 1047/11**, **T 56/21**). The board in **T 556/02** made it clear that it applied solely the general principle of law applied throughout the EPC that a document had to be interpreted as a whole (see e.g. **T 23/86**; **T 860/93**,

OJ 1995, 47). Art. 69 EPC 1973 was a specific application of this general principle. See also **T 1871/09**, **T 1817/14**, **T 447/22**.

In **T 1279/04** the board did not share the appellant's (patent proprietor's) view that, for the purposes of assessing novelty in opposition proceedings, claims should be interpreted in accordance with Art. 69(1) EPC 1973 and the Protocol on its interpretation. Art. 69(1) EPC 1973 and its Protocol related to the extent of protection conferred by the patent or patent application, which was primarily of concern in infringement proceedings. They served to determine a fair protection – inter alia by reference to the description and drawings – in circumstances where the claim wording was set in stone. By contrast, in examination and opposition proceedings the value of future legal certainty was paramount. In this forum the function of the claims was to define the matter for which protection was sought (Art. 84, first sentence, EPC 1973). There was no case for anything other than a strict definitional approach (for an interpretation of this approach, see **T 1534/12**), given that in this procedural stage the claim could and should be amended to ensure legally certain patentability, in particular novelty and inventive step over any known prior art. Amendment rather than protracted argument should be the answer to genuine difficulties of interpretation in all aspects of the examination and opposition procedure, it being acknowledged that amendments to a patent as granted should be occasioned by grounds for opposition. See also **T 145/14**.

Likewise in **T 1808/06** the board emphasised that, when the description has to be amended with regard to the requirement of Art. 84 EPC, it was only in situations where the removal of inconsistencies was not possible for procedural reasons (e.g. no amendment possible of the granted version) that – purely as an auxiliary construction – Art. 69(1) EPC could be invoked for an interpretation of the claimed subject-matter.

In **T 1646/12** the board stressed that Art. 69(1) EPC concerned only the extent of protection, which in turn was relevant only for the purposes of Art. 123(3) EPC and in national infringement proceedings. A general requirement that claims be interpreted with the help of the description could not be derived from Art. 69(1) EPC. It was nevertheless a general principle that a term could be interpreted only in context. Terms in a claim therefore had to be interpreted in the overall context of the claims set and the description (see also **T 1817/14**). Two extremes had to be avoided. On the one hand, limiting features mentioned in the description but not in the claims could not be read into the latter (see in this chapter II.A.6.3.4). They could not be inserted this way through interpretation, but only by amending the claims. On the other hand, claims could not be considered in complete isolation from the description. The skilled person interpreting the claim had to at least ascertain whether the expressions used were to be understood in their ordinary literal sense or whether they had a special meaning defined in the description. Likewise, if the claims were obscure, the skilled person had no alternative but to search for clarification both in the other claims and in the description and drawings (see in this chapter II.A.6.3.3). Using the description to interpret the claims was therefore admissible within certain limits, and sometimes even necessary; there was no need to invoke Art. 69(1) EPC.

In **T 1473/19** the board disagreed with the findings in **T 1279/04** and held that Art. 69 EPC in conjunction with Art. 1 of its Protocol can and should be relied on when interpreting

claims and determining the claimed subject-matter in proceedings before the EPO, including for the purpose of assessing compliance with Art. 123(2) EPC. According to the board, interpreting the claimed features for the purposes of establishing the (first part of a) patent claim's extent of protection was not different from interpreting and determining the claimed subject-matter for the purposes of assessing compliance with Art. 54, 56, 83 and 123(2) EPC. Moreover, the general application of Art. 69 EPC and its Protocol in proceedings before the EPO was also required to ensure uniform and consistent claim interpretation, if for example the relevant feature needed to be interpreted not only under Art. 123(3) EPC but – as in the underlying case – also under Art. 123(2) EPC. The board pointed out that national courts applied the rules for the interpretation of claims in Art. 69 EPC and the Protocol in both infringement and revocation proceedings. In addition, the board agreed with the view in decisions **T 2007/19**, **T 1646/12** and **T 556/02** that it was a general principle that a term could be interpreted only in context, so that terms in a claim had to be interpreted in the overall context of the claims set and the description. Nevertheless, in **T 1473/19** the board also stressed that the primacy of the claims according to Art. 69(1), first sentence, EPC limits the extent to which the meaning of a certain claim feature may be affected by the description and the drawings. Decision **T 1473/19** was fully endorsed in **T 450/20**, **T 1494/21** and **T 367/20**. The latter included several decisions of national courts in the contracting states as examples of national case law on claim interpretation according to Art. 69 EPC in respect of revocation proceedings.

In **T 169/20** the board disagreed with the findings in **T 1473/19** that Art. 69(1) EPC, in conjunction with Art. 1 of the Protocol, applies to the interpretation of the claims for the purpose of assessing patentability. The board held that the provisions in Art. 84 EPC and R. 42 and 43 EPC provided an adequate legal basis for claim interpretation when assessing the patentability of an invention. In particular, the requirement that the claims shall be "supported by the description" in Art. 84, second sentence, EPC provided a direct and unambiguous indication of the description's function as an aid for understanding the subject-matter of the claims.

According to the board in **T 438/22**, it is a general and overarching objective, and as such also a "requirement" of the EPC, that authorities, courts and the public interpreting the claims at a later stage should, as far as possible, arrive at the same understanding of the claimed subject-matter as the EPO bodies deciding on its patentability. The only tool for achieving this objective is the patent specification as the expression of a unitary legal title. The description, as an integral part of the patent specification, should therefore also serve this overriding objective, i.e. it should provide a common understanding and interpretation of the claims.

The application of Art. 69(1), second sentence, EPC and Art. 1 of the Protocol on the Interpretation of Article 69 EPC to the interpretation of patent claims when assessing the patentability of an invention under Art. 52 to Art. 57 EPC is addressed in the first question referred to the Enlarged Board in **G 1/24** (see in this chapter II.A.6.3.1).

See also in this chapter II.A.6.3.4 "Reading additional features and limitations into the claims".

6.3.3 Interpretation of ambiguous terms or confirmation of the text of a claim

Many decisions which use the description and drawings to interpret the claims concern the interpretation of relative, ambiguous or unclear terms or cite the description merely to confirm the most obvious interpretation of the text of a claim (e.g. **T 23/86**, OJ 1987, 316; **T 16/87**, OJ 1992, 212; **T 50/90; T 952/90**; **T 439/92**; **T 458/96**; **T 717/98**; **T 556/02**; **T 1089/11; T 2145/13; T 694/20**).

In several decisions the boards have stated that terms used in patent documents should be given their normal meaning in the relevant art, unless the description gives them a special meaning (see e.g. **T 1321/04**, **T 25/15**, **T 1844/15**, **T 2030/20** in which the element "dip tube" was attributed a wider meaning in the light of the description. According to the established case law, the patent document may be its own dictionary (see e.g. **T 311/93**, **T 523/00**, **T 1192/02**, **T 61/03**, **T 1321/04**, **T 620/08, T 2480/11**, **T 1817/14**; see also in this chapter II.A.6.3.5). On this basis, the board in **T 500/01** held that, a claim, the wording of which is essentially identical to a claim as originally filed, can nevertheless contravene the requirements of Art. 123(2) EPC if it contains a feature whose definition has been amended in the description in a non-allowable way (see also chapter II.E.1.14.4 "Amendment of definitions or removal of examples"). In **T 1360/13** the board held that any change in the description or drawings may have an influence on the understanding of a claimed feature, in particular when it must be considered ambiguous in view of a piece of prior art or an allegedly infringing product, and may thus lead to a broadening of the extent of the protection conferred. Any information in the description and/or drawings of a patent directly related to a feature of a claim and potentially restricting its interpretation could not be removed from the patent without infringing Art. 123(3) EPC. An example can be seen in **T 953/22** where amendments to a drawing modified the claimed subject-matter, even if the wording of the claims remained unamended. See also chapters II.E.2.4.2 "Deletion of feature from description where claim remains unchanged" and II.E.2.4.5 "Deletion or replacement of drawings".

According to the board in **T 458/96**, when the technical content of the claims and the description clearly establish how an invention operates, these features cannot be disregarded for the purposes of assessing patentability by interpreting them merely as defining an intended use.

In **T 1023/02** the invention was based on the recognition that the genes for a specific viral protein (ICP34.5) expressed in infected cells determine the ability of herpes simplex viruses to destroy central nervous system tissue. The respondent argued that a post-published document revealed the existence of an ORF-P gene coincident with but anti-sense to the ICP34.5 gene. Therefore, in view of the term "only", the claim had to be interpreted as requiring that the first method step did not interfere with the expression of this ORF-P gene. The board, however, pointed out that it was apparent from the description that the patentee had not envisaged the existence of this gene. The skilled reader would therefore, in the light of the description, not interpret the subject-matter of claim 1 in the way advocated by the respondent. Accordingly post-published knowledge of further technical details and/or complications could not justify this interpretation.

In **T 1409/16** the board considered that both "exclusive disjunctions" and "inclusive disjunctions" could be expressed by the "either [...] or" wording. The fact that another expression ("and/or") was used (in the sense of an inclusive "or") in another claim of the contested patent was not, as such, a compelling reason for concluding that the "either [...] or" wording used in the claim in question must have a different meaning, i.e. that it expressed an exclusive "or". There was no absolute obligation to use a fully coherent terminology for expressing given features if the latter could be expressed in different ways. The person skilled in the art reading the patent would certainly not conclude that the "either [...] or" wording of claim 1 expressed an exclusive "or", since this would mean that the exemplified (hence particularly preferred) embodiments would be excluded from the ambit of the claim. The board held that the "either [...] or" wording could only be considered as expressing an exclusive "or" in cases where the two situations referred to were, due to their very nature, mutually exclusive, i.e. incompatible with each other.

In **T 439/22** the board held that the person skilled in the art would understand the term "gathered sheet", when read in isolation, as defining a sheet folded along lines to occupy a tridimensional space. Accordingly, when assigning this usual meaning to the term, the claimed subject-matter would have to be regarded as novel. However, if the same term was read in a broader but still technically meaningful manner in view of the definition given in the description, the claimed subject-matter would lack novelty. In light of the divergent case law of the boards of appeal regarding claim interpretation, the board decided to refer questions to the Enlarged Board. The second and third questions address the consultation of the description and figures when interpreting the claims to assess patentability as well as whether a definition or similar information on a term used in the claims which is explicitly given in the description may be disregarded when interpreting the claims to assess patentability and, if so, under what conditions (see in this chapter II.A.6.3.1).

6.3.4 Reading additional features and limitations into the claims

For the purposes of judging novelty and inventive step, the description cannot be relied on to read into the claim an implicit restrictive feature not suggested by the explicit wording of the claim (**T 1208/97**, **T 945/99**, **T 681/01**, **T 881/01**, **T 1105/04**, **T 223/05**, **T 1736/06**, **T 299/09**, **T 58/13**, **T 617/18**, **T 1648/18**, **T 1266/19**, **T 530/20**, **T 1208/21**, **T 1628/21**, **T 447/22**). In proceedings before the EPO, where the patentee has the opportunity of cutting down the claims to accord with stricter limits given in the description, the scope of a claim should not be cut down by implying into it features which appear only in the description, as this would deprive claims of their intended function (**T 881/01**).

In **T 121/89** the board used the description to interpret an ambiguous term ("loose ignition charge"), but at the same time stressed that only features recited in or deducible from the claims could be set forth to distinguish the invention from the state of the art. The examples cited in the description did not limit the scope of the claims unless they were explicitly mentioned in them. See also **T 544/89**.

In **T 932/99** claim 1 was directed to a product per se. The claim defined only the structure of a membrane as such, independently from its installation in an apparatus for gas separation. The board pointed out that, for this reason, the indication in the claim "capable

of separating oxygen from oxygen-containing gaseous mixture" merely served the purpose of defining a capability of the claimed membrane, without imparting any limitations on any actual use of the structure claimed. The respondents had argued that, if claim 1 was interpreted in the light of the description, those limitations would be apparent. However, the board held that a distinction had to be drawn between, on the one hand, the fact that it might be necessary to take into account any explicit definition as given in the description for interpreting a claim's term and, on the other hand, the attempt to use Art. 69 EPC 1973 as a basis for reading limitations derived from the description into claims in order to avoid objections based on lack of novelty or inventive step. The latter approach to interpretation, whereby features mentioned only in the description were read into claim 1 as necessary limitations, was incompatible with the EPC (referring to **T 1208/97**). See also **T 2049/07**.

According to the board in **T 939/22,** the limiting definition of the recombinant non-pathogenic Marek's Disease Virus (rMDVnp) in the description could not change the common understanding of the terms of art recombinant nonpathogenic Marek's Disease Virus (rMDVnp) and recombinant herpesvirus of turkeys (rHVT) as used in the claim. The skilled person would understand the terms rMDVnp and rHVT to refer to the genome of a viral vector stemming from a non-pathogenic strain of an MDV serotype. No further limitations were implied by those terms.

In **T 1018/02** the board emphasised that, although a claim must not be interpreted in a way which was illogical or did not make sense, the description could not be used to give a different meaning to a claim feature which in itself imparted a clear, credible technical teaching to the skilled reader. This also applied if the feature had not been initially disclosed in the form appearing in the claim. Otherwise, third parties could not rely on what a claim actually states and Art. 123(2) EPC would become meaningless in respect of amendments to the claims. See also **T 373/01**, **T 396/01**, **T 821/20**, **T 42/22**.

In **T 1404/05** the board stated that Art. 69 EPC and its Protocol were intended to assist a patent proprietor in contending for a broader interpretation of a claim, not for cutting down the scope of a claim. In proceedings before the EPO, if a proprietor wishes to argue for a narrow scope of the claim this should be on the basis of the wording of the claim, and not on the basis of something appearing only in the description, as in such EPO proceedings the proprietor has the possibility, subject to meeting the requirements of Art. 123(2) EPC, of restricting the wording of the claim.

In **T 416/87** (OJ 1990, 415), on the other hand, the board was confronted with the situation where a feature was not included in the claims which the description on its proper interpretation specified to be an overriding requirement of the invention. The board held that, following Art. 69(1) EPC 1973 and its Protocol, the claims might be interpreted as requiring this as an essential feature, even though the wording of the claims when read in isolation did not specifically require such feature (confirmed in an obiter dictum in **T 717/98**). See also **T 2525/11**.

In **T 1473/19** the board held that although Art. 69(1), second sentence, EPC requires that generally account be taken of the description and the drawings when interpreting a claim, the primacy of the claims according to Art. 69(1), first sentence, EPC limits the extent to

which the meaning of a certain claim feature may be affected by the description and the drawings. The board pointed out that this view is fully compatible with the established case law that limiting features which are only present in the description but not in the claim cannot be read into a patent claim. The primacy of the claims also limits the extent to which the description may serve as a dictionary for the terms used in the claims.

According to the board in **T 169/20**, Art. 84, second sentence, EPC implicitly limits the support given by the description for interpreting the claims to the exceptional cases where such support is both necessary and possible. This support should only be resorted to in cases where the subject-matter of the invention needs to be clarified. Moreover, this support is only possible to the extent that there is a correspondence between the description and the subject-matter of the claimed invention. The support of the description should not be used to limit or modify the scope of the claimed features with respect to what a person skilled in the art would understand when reading them.

Such limitations due to the primacy of the claims were confirmed in **T 73/19**, **T 2968/19**, **T 367/20**, **T 450/20**, **T 1494/21**, **T 1628/21** and **T 111/22**.

In **T 450/20** and **T 1494/21** the board emphasised that under Art. 69(1) EPC the description and the drawings can only be used for interpreting features which are already present in the claims, but not for adding further – positive or negative – claim features or for replacing existing claim features by others. The board also pointed out that the application as filed usually cannot provide guidance for interpreting the claims of the patent as granted.

In **T 111/22** the board held that the primacy of the claims in claim interpretation meant that in case of a clear conflict between the claims and the description, the claims took precedence. If a person skilled in the art understood a claim in a certain manner without doubt, taking into account the rules of grammar, the ordinary meaning of the terms used and common general knowledge, this understanding usually took precedence over an incidental and conflicting statement in the description, in particular if that statement was only made in the context of an alleged embodiment. The board concluded that the disputed feature could only be understood so that it was component (ii) – and not the entire amount of carbohydrate in the composition – which comprised 10-45 wt.% of palatinose. Hence, the granted claim 1 contained added subject-matter, contrary to the requirements of Art. 123(2) EPC. To overcome this objection, the appellant had replaced the disputed feature with "15-45 wt.% of component (ii), based on the available carbohydrate composition, consists of palatinose". In the appellant's view, Art. 123(3) EPC was not infringed, since the description had to be taken into account to determine the scope of protection of the granted patent by virtue of Art. 69 EPC. The board disagreed and pointed out that Art. 69(1), second sentence, EPC could not be relied upon to replace a claim feature with a different one which could only be found in the description. Reading the relevant passage of the description into the clear wording of claim 1 as granted to establish compliance with Art. 123(3) EPC would have the consequence that the wording of this claim merely served as an empty shell. This would undermine the principle stipulated in the first sentence of Art. 69(1) EPC and reiterated in decision **T 1473/19** that the claims

have primacy for determining the extent of protection conferred by the European patent. See also II.E.2.3.1c).

6.3.5 Use in the examination relating to the clarity requirement pursuant to Article 84 EPC

In a large number of decisions (see in this chapter II.A.6.3.1) the boards interpreted the claims in the light of the description and drawings in order to establish whether they were clear and concise.

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

Likewise, in **T 860/93** (OJ 1995, 47) the board assumed that the description might be used to determine whether the claims were clear. In so doing it took its cue from the general legal principle whereby the best interpretation is that made from what precedes and what follows. It accepted the reasoning in **T 454/89** (see below), namely that the description could only be used to determine the extent of the protection conferred and not to establish clarity, only in the case of claims which were self-contradictory, but not in general (see also **T 884/93**, **T 287/97**). In several decisions the boards stated that a patent may be its own dictionary (see in this chapter II.A.6.3.3).

However, a number of decisions emphasise the limits to the use of the description and drawings in the examination relating to the clarity requirement.

T 2/80 (OJ 1981, 431) pointed out that a claim did not comply with the requirement of clarity laid down in Art. 84 EPC 1973 if it was not, per se, free of contradiction. It had to be possible to understand the claims without reference to the description (see also **T 412/03**, **T 129/13**, **T 1531/21**). In decision **T 454/89** the board shared this view and explained that Art. 84 EPC 1973 requires that claims must be clear in themselves when read using normal skills, including knowledge of the prior art but not any knowledge derived from the description contained in the patent application or the amended patent. While it was true that Art. 69 EPC 1973 allowed the description to be used to interpret the claims, it was only concerned with the extent of protection conferred as one of the effects of an application or patent whenever that extent had to be determined, particularly for third parties. It was not concerned with a claim's definition of the matter for which protection was sought, as was Art. 84 EPC 1973. In the course of the examination of an application or of an opposition, therefore, the applicant or patentee could not rely on Art. 69 EPC 1973 as a substitute for an amendment which would be necessary to remedy a lack of clarity. The board took the same line in decision **T 760/90**.

In **T 1129/97** (OJ 2001, 273), the board held that the mere fact that the precise meaning of an unclear term ("low alkyl") was expressly disclosed in the description but not in the claims did not mean that the latter met the clarity requirement. The clarity stipulation under

Art. 84 EPC 1973 concerned only the claims, and therefore – according to the established case law of the EPO boards of appeal – required that they be clear in themselves, without there being any need for the skilled person to refer to the description. True, under Art. 69(1) EPC 1973 the description was to be used to interpret the claims. But Art. 69 EPC 1973 concerned only the extent of protection where this was at issue, e.g. with third parties, and not (as in Art. 84 EPC 1973) the definition of the matter to be protected by a claim. Confirmed in **T 64/03, T 56/04**, **T 1265/13**.

In **T 49/99** the board held that since clarity was a claim requirement, a clarity deficiency in the claim wording was not rectified by the fact that the description and the drawings would help the reader to understand the technical subject-matter that the claim was intended to define. See also **T 623/13**, **T 1531/21**.

In **T 56/04** the board pointed out that a claim containing an unclear technical feature prevented its subject-matter from being identified beyond doubt. That was particularly the case if the unclear feature was meant to delimit the claimed subject-matter from the state of the art. The board therefore took the view that a vague or unclear term which was used in the claim and a precise definition which was to be found only in the description could be allowed only in exceptional cases to delimit the claimed subject-matter from the state of the art. Such an exception pursuant – mutatis mutandis – to R. 29(6) EPC 1973 (now R. 43(6) EPC) exists if the precise definition – for whatever reason – cannot be incorporated into the claim, and the precise definition of the vague or unclear term is unambiguously and directly identifiable by a skilled person from the description. In **T 56/04** the board said that an exception was not involved. The specific value of "approximately 1 mm" disclosed in the description could have been incorporated into the claim itself instead of "slightly less than [...]". See also **T 623/13**.

On the extent to which it must be clear from the claim itself how parameters are to be determined when a product is characterised by parameters, see in this chapter II.A.3.6. In a number of decisions it is stressed that the claims must be clear in themselves when read with the normal skills but without any knowledge derived from the description (see e.g. **T 412/02** and **T 908/04**). According to the board in **T 992/02** however, the requirement of conciseness under Art. 84 EPC justified not including the procedure for measuring the parameter in the claim, as this was clearly identified in the description and did not give rise to any ambiguity.

In **T 2968/19** the board stressed that in examination proceedings – in contrast to the interpretation of granted patent claims – the principle that the missing essential features should be incorporated into the claim and that the meaning of the features should be clear for the skilled person from the claim wording alone (see **G 1/04**, point 6.2 of the Reasons) must be satistied first. The appellant submitted that using the description as its own dictionary could be admissible to interpret patent claims in opposition proceedings if features could no longer be objected to under Art. 84 EPC but nevertheless have to be interpreted. However, according to the board, there were limits to the use of the description to interpret the claims (cf. "primacy of the claim" in **T 1473/19**, **T 169/20)**, in particular in so far as features missing in the claim (and not implicitly established taking account of the technical understanding of the terms used in the claim) cannot be read into the claim.

6.3.6 Definition of the scope of protection with regard to infringement not within the EPO's competences

In **T 442/91** the respondents wanted the board to rule on the extent of the protection conferred by what they considered to be broad claims. The board observed that the EPO concerned itself in opposition appeal proceedings with the extent of protection conferred by a patent only for the purposes of examining compliance with Art. 123(3) EPC 1973. Beyond that, interpreting the extent of protection was a matter for national courts dealing with infringement cases. Whilst the EPO made it clear how terms of art used in the claims should be understood, it should not proffer any further interpretation of the patent's future scope beyond that (see also **T 740/96**, **T 323/05**). In line with this thinking, the board in **T 439/92** and **T 62/92** interpreted the claims in the light of the description, stressing that such interpretation was not intended to determine the extent of protection conferred by the patent, but to identify the subject-matter for which protection was sought.

7. Product-by-process claims

7.1. Introduction

Under Art. 64(2) EPC the protection conferred by a process patent extends to the products obtained directly by the process, even if they are not patentable per se. Certain applicants tried to acquire protection for known products by using process claims to define them, arguing that it follows from Art. 64(2) EPC, that a product is rendered novel by the fact that it is produced by means of a new process.

The boards did not accept this line of argument and made a distinction between claims to a new and inventive product defined by its method of manufacture and claims to a new and inventive process, the protective effects of which also extended to the direct products of this process.

The first decision in this regard was **T 150/82** (OJ 1984, 309). The board stated that claims for products defined in terms of processes for their preparation (known as "product-by-process" claims) were admissible only if the products themselves fulfilled the requirements for patentability and there was no other information available in the application which could have enabled the applicant to define the product satisfactorily by reference to its composition, structure or some other testable parameter (established case law, see e.g. **G 2/12**, OJ 2016, A27 and **G 2/13**, OJ 2016, A28; **T 956/04**; **T 768/08**; **T 150/12**).

With regard to product-by-process claims, the requirement of clarity means that the skilled person should be able to determine, either from the claim alone or, by construction of the claim in the light of the description, or by construction in the light of the skilled person's common general knowledge, which identifiable and unambiguous technical features are imparted to the product by the process by which it is defined (**T 967/10**, **T 1988/12**, **T 354/17**, **T 2243/18**). In **T 1988/12** the board rejected the idea that the claim was necessarily clear if a skilled person (in the case in hand a plant breeder) could determine whether or not a candidate plant fell within its terms. The suggestion that the skilled person had to rely on an analysis of a potentially infringing product to know what the subject-

matter for which protection was sought actually was, ran counter to the purpose of Art. 84 EPC.

7.2. Requirement that the claimed product must be patentable

In **T 248/85** (OJ 1986, 261) it was stated that a product could be defined by the use of various parameters, such as its structure or its process of preparation. The use of a different parameter by which to define a particular product could not by itself give the product novelty. Furthermore Art. 64(2) EPC 1973 did not confer novelty upon a claim which was formulated as a "product-by-process" when no novelty existed in such product per se, and did not entitle or enable an applicant for a European patent to include such claims intheir patent which did not satisfy the requirements of Art. 52(1) EPC 1973.

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

These criteria were confirmed and applied in many decisions (see e.g. **T 251/85**, **T 563/89**, **T 493/90**, **T 664/90**, **T 223/96**, **T 59/97**, **T 748/98**, **T 620/99**, **T 1113/10**).

The board clarified the conditions for novelty of product-by-process claims in **T 205/83** (OJ 1985, 363). It stated that the polymer product of a known chemical process was not rendered new merely by virtue of a modification to the process. If a chemical product could not be defined by structural characteristics but only by its method of manufacture, novelty could be established only if evidence was provided that modification of the process parameters resulted in other products. It was sufficient for this purpose if it was shown that distinct differences existed in the properties of the products. This evidence might not include properties which could not be due to the product's substance parameters. See also **T 279/84**, **T 151/95**, **T 728/98**, **T 564/02**, **T 1247/03**.

In **T 300/89** (OJ 1991, 480) it was stated that the application lacked novelty if the claim neither defined the product structurally nor mentioned all the specific conditions needed to obtain necessarily the products whose novelty could be demonstrated, e.g. by means of comparative tests. Similarly, in **T 552/91** (OJ 1995, 100) the board ruled that the claim had to include all the process parameters required for unambiguously defining the claimed substances as inevitable process products. As chemical reactions only rarely took one particular course and therefore only rarely led to uniform substances, it was generally necessary to indicate not only the starting materials and reaction conditions, but also the method by which the reaction mixture was processed to obtain the claimed substances. This case law was confirmed in **T 956/04**, where the board considered that without clearly indicating the specific starting materials and the specific reaction conditions, the "obtainable-by" features as claimed failed to unequivocally define the claimed catalysts as inevitable process products.

In **T 728/98** (OJ 2001, 319) the board stated that the general rule that the level of purity of a low molecular chemical compound could not entail novelty was also valid in the case of a product-by-process claim where the purity level was the inevitable result of the preparation process indicated in the claim. In the case in hand the appellant (applicant) had not been able to prove the existence of an exceptional situation where all attempts had failed to achieve a particular level of purity by conventional purification methods. See also chapter I.C.6.2.4. "Achieving a higher degree of purity of a compound".

In **T 803/01** the board noted that there was no statement whatsoever in **T 205/83** (OJ 1985, 363) which prohibited the presence of parameters relating to impurities in a claim for reasons of clarity. The parameters relating to the purity of the polylactides were technical features in line with R. 29(1) EPC 1973. This was considered to be a relevant criterion for assessing the extent to which the use of purity parameters in a product claim was allowable from the point of view of clarity (**G 2/88**, OJ 1990, 93).

In **T 394/03** the board ruled that improved product quality achieved by means of a process did not generally constitute, in a product-by-process claim, a structural feature giving rise to novelty or inventive step. In the case in hand, a decorated ceramic product was claimed which differed from known products of this type only by virtue of its better quality, which had been achieved by means of the process according to the invention.

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

The criterion laid down in **T 150/82** (OJ 1984, 309), whereby it must be impossible to define the claimed product other than in terms of a process of manufacture is now established case law (see e.g. **T 333/93**, **T 749/95**, **T 950/97**, **T 1074/97**, **T 933/01**, **T 150/12**, **T 863/12**).

In **T 320/87** (OJ 1990, 71) the board stated that product-by-process claims were admissible for hybrid seeds and plants when they were not individually definable biological entities which could be characterised by their physiological or morphological features.

In **T 130/90** the board had to rule on recombinant monoclonal antibodies having two different specificities and produced by a process involving trioma cells or quadroma cells and thus producing antibodies in a native form. The patentability of the process was not questioned. The process known from prior art chemically recombined antibody half-molecules. At issue was the validity of the product claim. The prior art did not disclose how fully re-associated molecules, i.e. with the same structure as native antibodies, which might be contained in the mixture of hybrids, could be screened out and isolated from molecules which were chemically altered. The board allowed a claim for bispecific recombinant monoclonal antibodies comprising intact immunological chains produced by the process claimed in the independent process claims of the patent in suit. Defining the antibodies by their process was the only way of delimiting them vis-à-vis the prior art.

In **T 552/91** (OJ 1995, 100) it was held that where a European patent application relates to chemical substances originally defined by an incorrect chemical structural formula, correction of which is not allowable under R. 88 EPC 1973, replacement of the incorrect

formula by the correct one infringes Art. 123(2) EPC 1973. Nevertheless, the submission of a "product-by-process" claim is compatible with Art. 123(2) EPC 1973 if it contains all the measures required to obtain this result (starting materials, reaction conditions, separation).

7.4. Applicability of the principles for product-by-process claims to use claims

In **T 81/14** the board held that when considering the definition of a product in terms of its production process the principles developed in the jurisprudence for the product-by-process claims are in general to be applied, also in the case of a claim directed to the use of that product. Claims 1-7 of one of the auxiliary requests were directed to a method of producing a sintered cemented carbide body. Claim 8 was directed to the use, for the production of a cutting tool, of a sintered cemented carbide body obtained according to the method of any one of claims 1-7. Hence, claim 8 comprised process and product features and was notionally equivalent to a claim directed to a process for the production of a cutting tool using the sintered cemented carbide body. Applying the principles developed in the jurisprudence for product-by-process claims to claim 8, the board stated that it would have been possible to define the sintered body in terms of structural features. Accordingly, the use of a product-by-process definition in claim 8 resulted in a lack of clarity.

7.5. Process claims containing product features

In **T 1761/19** the board addressed the interpretation of process claims containing product-type features (that could perhaps be described as "process-by-product" claims). According to the appellant, these features defined the process only in so far as they had an impact on the process features. For the board, the analogy with "product-by-process" claims was not valid. That type of claim was allowed where it was impossible to define the product obtained other than in terms of its manufacturing process. That was not comparable to a situation involving a process claim specifying that the process in question concerned a particular product. In that situation, the product feature simply limited the process to its application to that product; it was not necessary or even worthwhile to examine whether the feature had any effect on the process steps themselves.

7.6. Extension of protection conferred by product-by-process claims

In **T 411/89** the board had to decide whether the amendment of a product-by-process claim from "obtained" to "obtainable" extended the protection conferred by the patent. The board took the view that the protection was not extended because the amendment did not modify the definition of the product which was claimed per se from the beginning and because the process used for its characterisation remained the same.

In **T 423/89**, by restricting the claim to only one of a number of manufacturing processes specified in the original claim and disclosed in the description, the patent proprietors had ceased to claim absolute product protection and had undertaken a significant limitation of their claim. There were therefore no objections under Art. 123(3) EPC 1973. The change in category from a product-by-process claim to a manufacturing process claim was also

admissible in this case, as the protection afforded by the granted patent had to extend to all those methods of manufacture covered by the processes described in the claim and disclosed in the patent specification.

In **T 20/94**, however, objections under Art. 123(3) EPC 1973 led to the board's refusal of a change from process claims to a product-by-process claim by way of amendment, as despite the fact that a product-by-process claim was characterised by the process for its preparation, it nevertheless belonged to the category of claim directed to a physical entity and was a claim directed to the product per se. The scope of protection conferred by a product claim exceeded the scope conferred by a process claim under Art. 64(2) EPC 1973. See also chapter II.E.2.7. "Change of claim category".

8. Claims fees

According to R. 45(1) EPC any European patent application comprising more than fifteen claims incurs payment of claims fees in respect of the sixteenth and each subsequent claim. Before 1 April 2008 the number of fee-exempt claims was ten (R. 45(1) EPC in the version in effect before that date and R. 31(1) EPC 1973). For international applications entering the European phase the corresponding provision is R. 162(1) EPC (R. 110(1) EPC 1973).

The Legal Board ruled in case **J 9/84** (OJ 1985, 233) that R. 31(1) EPC 1973 was to be interpreted as meaning that claims numbered 1 to 10 upon filing of the European patent application – or transmittal to the EPO of the international application under the PCT – were exempt from fees, and that claims numbered 11 onwards were not. Accordingly, abandoning a fee-exempt claim after filing – or transmittal – did not have the effect that its fee exemption was transferred to another claim.

8.1. Number of claims

Already in the early years of the EPC, the question had arisen on a number of occasions as to whether part of, or an annex to, the description of a European patent application comprising a series of numbered paragraphs drawn up in the form of claims should be regarded as claims for the purposes of R. 31(1) EPC 1973.

In **J 5/87** (OJ 1987, 295) the application contained, under the heading "Claims", ten claims; however it contained 33 further claims which were annexed to the description as preferred, numbered embodiments presented in the form of claims. The addendum appeared in form as well as in substance only to consist of claims within the meaning of Art. 84 EPC 1973 and R. 29 EPC 1973. Furthermore, the appellant had admitted that the addendum had been included in the application in order to maintain the possibility of making its content a basis for substantive examination. As a result, the applicant was required to pay the claims fee – applicants were not at liberty to ignore the provisions on the form and content of the description and claims contained in R. 27 EPC 1973 and R. 29 EPC 1973.

In **J 15/88** (OJ 1990, 445) the Legal Board decided in a similar case that although the 117 disputed "clauses" in question were numbered and arranged as claims and seemed to define matter in terms of technical features, they were not to be regarded as such since the fact remained that they were never referred to as claims and there were claims elsewhere which were referred to as such.

Decisions **J 16/88**, **J 29/88**, **J 25/89**, **J 26/89**, **J 27/89**, **J 28/89**, **J 34/89** and **T 490/90** all confirmed this opinion. They pointed out that the case dealt with in **J 5/87** was different, since the applicant had indicated an intention to regard the annexes as claims. The intention of the appellant not to have this part considered as claims was more important than the form of the text.

8.2. No refund of claims fees

In **J 3/09** the Legal Board rejected the appellant's request for a refund of the claims fees for claims 16-68 and noted that the legal basis for payment of those claims fees was R. 110(1) EPC 1973. It added that fees, once validly paid, were not refundable unless provision to the contrary was made (see also **J 11/12**). The appellant had not relied on any specific provision of the EPC in its support. In response to the appellant's argument that it was inevitable that the subject-matter of the unsearched claims could not be prosecuted in the application, and had therefore to be considered as abandoned, the board noted inter alia that in the frequent case of an a posteriori objection of non-unity, even if justified, the claims could usefully serve as a basis for later limiting the claimed subject-matter to a more specifically defined but now unitary and searched invention. Whilst the extent to which this was possible depended on the circumstances of the individual case, it remained the position that the payment of claims fees for claims exceeding the number of ten could have a useful purpose on its own independently of the question whether all the claims concerned unitary subject-matter.

B. Unity of invention

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1. Introduction

Under Art. 82 EPC, the European patent application must relate to one invention only or to a group of inventions so linked as to form a single general inventive concept. R. 44(1) EPC (R. 30 EPC 1973) gives an interpretation of the concept of unity of invention where a group of inventions is claimed. For international applications the corresponding provisions are Art. 3(4)(iii) and in particular R. 13 PCT.

As stated in **T 501/91**, the main purpose of Art. 82 EPC is to prevent several unrelated inventions from being dealt with in a single patent application in order to save fees. It also helps to ensure that claimed and granted intellectual property rights are correctly classified. Moreover, it is in the interests of a rational examination procedure that unrelated subject-matter is not lumped together in a single patent application, while related subject-matter should not be needlessly split up (see **T 110/82**, OJ 1983, 274).

Procedural aspects of the assessment of unity, including the payment of further search fees, are governed by R. 64 and 164 EPC (see Art. 17(3)(a), R. 40 PCT for the ISA, and Art. 34(3)(a), R. 68 PCT for the IPEA).

Protests under the PCT in respect of additional fees paid following a non-unity objection by the EPO acting as ISA (R. 40 PCT) or as IPEA (R. 68 PCT) were previously decided on by the boards of appeal (Art. 154(3) and 155(3) EPC 1973), but are now decided on by review panels of the EPO (R. 158(3) EPC, decision of the President of the EPO, OJ 2015, A59). The boards' competence to consider unity in the context of European applications remains unaffected. Given the harmonisation of the definitions concerning unity of invention in R. 13 PCT and Art. 82, R. 44 EPC, the criteria for unity in both systems are the same. Therefore, board decisions rendered according to the former PCT protest procedures ("W" cases) continue to be of interest for the consideration of unity in European patent applications and so many have been included in this chapter.

The Guidelines for Examination in the EPO (April 2025 version) deal with unity of invention at the search stage in Part B-VII, unity as a procedural aspect of substantive examination in Part C-III, 3, and unity as a requirement of the European patent application in Part F-V. For international applications see especially Chapter 10 of the PCT International Search and Preliminary Examination Guidelines, as in force from 1 July 2022, and the Guidelines for Search and Examination at the EPO as a PCT Authority, B-VII, C-V and F-V – April 2025 version.

2. Unity in the context of different types of claims

2.1. Plurality of independent claims

Under Art. 82 EPC, as under R. 13.1 PCT, the application must relate to one invention only or to a group of inventions so linked as to form a single general inventive concept. The second alternative, i.e. the single-concept linked group, may give rise to a plurality of independent claims in the same or different categories (see also R. 43(2) EPC).

In **W 5/92** the board considered it to be implicit in the definition of R. 13.1 PCT that the "invention" be considered in the broadest sense. Thus, according to the former PCT Search Guidelines VII-5 (PCT Gazette No. 30/1992, Sec. IV; No. 29/1993, Sec. IV), the mere fact that an international application contained claims of different categories or several independent claims of the same category was in itself no reason for objection on the grounds of lack of unity (see now guidance in Chapter 10,PCT International Search and Preliminary Examination Guidelines, as in force from 1 July 2022).

R. 44(1) EPC and R. 13.2 PCT provide that where a group of inventions is claimed in a European/international application, the requirement of unity of invention is fulfilled only when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features.

The corresponding provision R. 30 EPC 1973 as in force until 31 May1991 (see also previous R. 13.2 PCT) specified the following three cases in which a combination of

independent claims in different categories was to be considered permitted by Art. 82 EPC 1973:

(a) in addition to a claim for a given product, a claim for a process specially adapted for the manufacture of the product, and a claim for a use of the product;

(b) in addition to a claim for a given process, a claim for an apparatus or means specifically designed for carrying out the process;

(c) in addition to a claim for a given product, a claim for a process specifically adapted for the manufacture of the product, and a claim for an apparatus or means specifically designed for carrying out the process.

The list was not exhaustive and other combinations were permitted if they met the requirements of Art. 82 EPC 1973 (**T 861/92**). The same applied to the old version of R. 13.2 PCT (**W 3/88**, OJ 1990, 126; **W 29/88**, **W 3/89**). In **T 702/93** it was held that this version of R. 30 EPC 1973 did not provide for such a fictitious unity in the case of independent claims in the **same** category. While this fiction was removed with the amendment of R. 30 EPC 1973 and R. 13 PCT (both with effect from 1 June 1991), the principles based on it, as set out in the case law, remain unchanged (**T 169/96**).

In **T 202/83** it was concluded from the old version of R. 30(c) EPC 1973 (see above) that the requirement of unity was not met by every subject-matter for carrying out a process. On the contrary, the provision presupposed that the means for carrying out the process had been specifically designed. Consequently, such a means in connection with the corresponding process did not meet the unity requirement if it was obvious that it could also serve to solve other technical problems.

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

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

In **W 32/88** (OJ 1990, 138) the board was of the opinion that an invitation to pay an additional search fee on the grounds that an international application concerning a process and an apparatus related to two different inventions, whereas the apparatus was specifically designed for carrying out the process, had no legal basis, even if the claims for the apparatus were not restricted to such use (see also **W 16/89**).

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

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

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

In **T 492/91** the board found that, for the purposes of Art. 82 EPC 1973, the whole composition covered by claim 6 (new composition) did not need be the product of the process according to claim 1 (process for preparing known products). It was sufficient for one component of the composition to be such a product where the composition and the process were intended to solve the same technical problem. The board concluded that the scope of claim 6 therefore did not have to be limited to the compositions resulting from the process according to claim 1, thus excluding the compositions obtainable by subsequent mixing.

In **J 13/13** the Legal Board recalled that R. 43(2) EPC and R. 44 EPC govern two distinct matters: R. 43(2) EPC must be complied with even where a patent application claims and describes a group of inventions that form a single general inventive concept, while R. 44 EPC must be complied with even where only a single independent claim is drafted for each claim category.

2.2. Dependent claims

R. 13.4 PCT provides that dependent claims must fulfil the requirement of unity in accordance with R. 13.1 PCT. The EPC makes no comparable express provision. The question has therefore arisen whether this difference means that there is a difference in the way dependent claims are assessed. Board of appeal case law on PCT cases has been uniform: the requirement of unity must also be met by dependent claims (see inter alia **W 3/87**, **W 2/88**, **W 30/89**, **W 32/89**, **W 26/90**, **W 8/91** and **W 54/91**). In EPC cases the boards likewise assume that dependent claims have to meet the requirement of unity. Under the EPC the approach is not as strict as in the case of independent claims: the examination is only carried out in those cases where unity could be problematical (see **T 140/83** and **T 249/89**).

In **W 8/91** it was decided that, where claims were formally dependent, the ISA had to state expressly why they lacked unity; it was not enough simply to say that this was shown directly by the subject-matter as defined by the ISA.

In **W 6/98** the board held that anticipation of the subject-matter of an independent claim might well lead to a situation of non-unity a posteriori, which however could only be established by showing that there was indeed no unifying novel inventive concept common to all dependent claims. The board noted that lack of novelty of the subject-matter of an independent claim did not automatically lead to a posteriori lack of unity for the claims directly or indirectly appended to said independent claim.

The board in **T 129/14** pointed out that, normally, a dependent claim has all the features of its independent claim. If the independent claim comprised one or more special technical features defining a contribution over the prior art, the dependent claim would also comprise them. Hence they would form a single general inventive concept within the meaning of Art. 82 EPC. If the independent claim did not comprise any special technical features defining a contribution over that prior art, e.g. because its subject-matter was not novel, then it would not form any inventive concept. Hence, again no more than one general inventive concept within the meaning of Art. 82 EPC – possibly defined by the additional features of the dependent claim – would result (see Guidelines F-V, 9 – November 2015 version; see now Guidelines F-V, 3.2.3 – April 2025 version).

2.3. Intermediate products

In **T 57/82** (OJ 1982, 306) it was stressed that the subject-matter of an application relating to new chemical end products, processes for their preparation, and to new intermediates for those end products at all events had unity within the meaning of Art. 82 EPC 1973 if all these subject-matters were technically interconnected and integrated into a single overall concept by being oriented towards the end products. In this context, starting materials which were used in a process for preparing end products and which were themselves products of a disclosed, albeit unclaimed, production process were also considered to be intermediates. This principle was confirmed in **T 110/82** (OJ 1983, 274) for low-molecular products. According to that board, an invention relating to new low-molecular end products and to several groups of new low-molecular intermediates invariably had unity if the groups of intermediates prepared and oriented towards the end products were technically closely interconnected with the end products by the incorporation of an essential structural element into the end products and if due account was taken of the regulatory function of Art. 82 EPC 1973 (prohibition of unjustified saving of fees, need for ready comprehensibility).

This was confirmed by **T 35/87** (OJ 1988, 134) and **T 470/91** (OJ 1993, 680). The intermediates in the latter case – unlike those in earlier ones – were not structurally related to each other. However, they provided both the essential structural elements present in the end products. The intermediates of the application were therefore only made available with a view to obtaining the end products and they were sufficiently closely technically interconnected with those end products. Thus, they were integrated into a single overall inventive concept by being oriented towards the end products. This was not prejudiced by

the fact that the two sets of intermediates were not structurally related to each other since the orientation of the intermediates towards the end products permitted the individual technical problems addressed by the intermediates to be combined into a unitary overall problem to the solution of which both sets of purpose-made intermediates contributed.

In **W 35/91** the board ruled that the requirements of unity of invention as set out in R. 13.1 and R. 13.2 PCT were met if the novel intermediates designed to give rise to the novel end products were technically sufficiently closely related by their contribution to an essential structural element of the end products.

In **W 7/85** (OJ 1988, 211) the board stated that there was sufficient technical information to justify a prima facie finding of unity between a claim to a mixture and a claim to one essential component of that mixture or a narrowly defined version thereof. If a finding of unity was justified in cases of chemical intermediates and end products even when, as was often the case, only a part of the intermediate structure was actually incorporated, there was all the more reason to view the intact components and the corresponding compositions in a mixture as technically interconnected by incorporation. The former were not even destroyed when the admixture was prepared and fully retained their properties and functions in the product, unlike typical intermediates, which lost their identity in the process. Thus, both inventions could be considered to fall within the same general inventive concept. In such cases the requirement that the means for preparing the end product should be "specially designed for carrying out the process" appeared to be fulfilled since none of the means led or was related to an end product outside the scope of its definition. In view of this the character of the invention in the component was, prima facie, also dependent on the existence of an invention in the end product.

3. Assessing lack of unity of invention

3.1. General approach – content of claims

In **W 6/97** it was held that the determination of unity of invention must be made on the basis of the contents of the claims as interpreted in the light of the description and of the drawings, if applicable (with reference to Annex B, Part 1(b) PCT Administrative Instructions; see now Annex B, para. (b) PCT Administrative Instructions, as in force from 1 July 2024).

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

3.2. Assessment of lack of unity at the search stage

Lack of unity may be directly evident **a priori**, i.e. before examination of the merits of the claims in comparison with the state of the art revealed by the search (**W 1/96** and **W 6/90**,

OJ 1991, 438). If the objection of lack of unity is raised a priori, the technical problem must be defined solely on the basis of the description and not of the prior art (see **W 50/91**, **W 52/91**, **W 22/92**, **W 52/92** and **T 188/04**).

The powers of the EPO as ISA with regard to the assessment of unity **a posteriori**, i.e. after taking into account the prior art brought to light by the search, were clarified by the Enlarged Board in **G 1/89** (OJ 1991, 155 – referral by a board of appeal in **W 12/89**, OJ 1990, 152) and **G 2/89** (OJ 1991, 166 – referral by the President of the EPO). The referring board asked the Enlarged Board inter alia if an ISA has the power to carry out a substantive examination of an international application in respect of novelty and inventive step when considering under Art. 17(3)(a) PCT whether the application complies with the requirement of unity of invention set forth in R. 13.1 PCT. The President of the EPO requested the Enlarged Board's opinion on whether the EPO as ISA may request a further search fee where the international application is considered to lack unity of invention a posteriori. The referred points of law were dealt with in consolidated proceedings.

The Enlarged Board noted that the procedural separation of search and (substantive) examination under the PCT, as well as under the EPC 1973, led to a certain overlapping because of the functional relationship between search and examination. Thus, although the objective of the search was in principle limited to discovering and reporting on relevant prior art for the purpose of assessing novelty and inventive step, which was ultimately the task of the examining authority (i.e. the IPEA and/or the designated Office under the PCT and the examining division under the EPC 1973), in many instances the search examiner needed to form a provisional opinion on these issues in order to carry out an effective search (for more on this aspect see also the summary in this chapter II.B.4.2. "Examination as to novelty and inventive step").

The Enlarged Board further noted that neither in the PCT itself nor in the Rules under the PCT were there provisions indicating how to decide whether an international application complies with the requirement of unity of invention. However, the PCT Search Guidelines stated that lack of unity may be directly evident "a priori", or only become apparent "a posteriori" (see now para. 10.03 PCT International Search and Preliminary Examination Guidelines as in force from 1 July 2022). They contained a direct reference to the consideration of unity by the ISA on an a posteriori basis, i.e. after an assessment of the claims with regard to novelty and inventive step in relation to the prior art. The corresponding EPO Guidelines showed that under the EPC 1973 it was also clearly foreseen that consideration of unity by the search divisions could be carried out on an a posteriori basis (i.e. formerly Guidelines B-VII, 5; see R. 46 EPC 1973; see now Guidelines – April 2025 version, in particular F-V,4, and R. 64 EPC). Therefore, the Guidelines had on this point to be considered as consistent with the PCT and the EPC 1973.

The Enlarged Board confirmed that the EPO when acting as an ISA and the boards of appeal when deciding on protests under Art. 17(3)(a) PCT were under an obligation to be guided by the PCT Search Guidelines (see Art. 2 of the then applicable agreement between the European Patent Organisation and WIPO). Thus, in **G 1/89** the Enlarged Board held that, as foreseen in these guidelines, an international application may, under

Art. 17(3)(a) PCT, be considered not to comply with the requirement of unity of invention, not only "a priori" but also "a posteriori". According to **G 2/89**, the EPO in its function as an ISA may, pursuant to Art. 17(3)(a) PCT, request a further search fee where the international application is considered to lack unity of invention "a posteriori".The principle whereby the EPO may also find a lack of unity "a posteriori" when carrying out an international search (**G 1/89**, **G 2/89**) applies equally to a European search because in both cases the searches and search reports are virtually identical (see **T 87/88**, OJ 1993, 430).

According to **T 94/91**, Art. 82 EPC 1973 clearly provided that European patent applications must satisfy the criteria of unity of invention without any restriction. There was no difference in the EPC 1973 between "a priori" and "a posteriori" lack of unity. It was of no importance whether the non-unity appeared immediately or only in view of a document found during the search or the examination. This was also the interpretation given in the Guidelines and in **G 2/89**, which, although it related to PCT applications, concerned a similar procedure.

Where the search division makes a finding of non-unity, the applicant is normally informed, along with the partial search report relating to the invention, or group of inventions, first mentioned in the claims, that a further search fee must be paid for the other inventions which it wishes to be covered by the European search report (R. 64(1) EPC). Art. 17(3)(a) PCT lays down the equivalent procedure before the ISA. R. 164 EPC contains special provisions for Euro-PCT applications having entered the European phase. Relevant decisions are summarised in this chapter II.B.6. "Plurality of inventions – further search fees".

3.3. Assessment of lack of unity and of requests for refund of further search fees in examination proceedings

The requirement of unity under Art. 82 EPC has to be satisfied not only by the patent application as filed but also at later stages of the patent granting procedure, i.e. before the examining division, up until grant of the patent. Under R. 64(2) EPC (R. 46(2) EPC 1973) the examining division may disagree with the search division's finding of lack of unity, and the examining division's opinion is decisive in that the latter may order the refund of any further search fee at the applicant's request (see cases below and in this chapter II.B.6.). It lies within the discretion of the examining division to decide that a patent application lacks unity of invention within the meaning of Art. 82 EPC, even if the search division did not raise a similar objection (see **T 178/84**, OJ 1989, 157). See also **T 631/97** (OJ 2001, 13), summarised in this chapter II.B.6.1. "Consequences of non-payment of a further search fee".

In **T 544/88** (OJ 1990, 429) the board ruled that if an applicant, in response to an objection of lack of unity, filed new claims allegedly relating to an invention meeting the unity requirement, examination should be continued even if the other application documents had not been limited to the subject-matter of those claims. However, the examining division could request the applicant to bring the description and drawings into line with the valid claims (R. 27(1)(d) EPC 1973 as in force until 31 May 1991; see subsequent

R. 27(1)(c) EPC 1973, now R. 42(1)(c) EPC) and to delete those parts of the description and drawings which did not refer to claimed inventions (R. 34(1)(c) EPC 1973, now R. 48(1)(c) EPC). It would then be necessary to check in each case whether such adjustments ought to be deferred until allowable claims were submitted.

In **J 24/96** (OJ 2001, 434) the board held that within the framework of R. 46 EPC 1973 it was the task of the examining divisions (and the boards of appeal) to examine whether communications of the search divisions under R. 46(1) EPC 1973 asking for further search fees were justified. R. 46(2) EPC 1973 did not, however, refer to any acts of the search divisions other than communications issued under R. 46(1) EPC 1973. It was therefore not necessary for an examining division to deal in a decision under R. 46(2) EPC 1973 with other objections raised by the applicants in connection with the search, such as that the partial search report was not drawn up in accordance with the Guidelines. The board observed that the examining divisions of course have the possibility of arranging for an additional search to be performed, if they consider a search report delivered by the search division incomplete, but that this had nothing to do with a formal decision issued under R. 46(2) EPC 1973 concerning the refund of further search fees upon request.

In **T 188/00** the board pointed out that the review by the examining division under R. 46(2) EPC 1973 had to be carried out having regard only to the facts presented by the search division in its communication under R. 46(1) EPC 1973. Since in most cases objections against lack of unity were raised having regard to the prior art (i.e. a posteriori), the examining division had to base its review solely on the documents cited in the partial search report and on the specification of the different inventions drawn up by the search division, while taking into account any arguments of the applicant in support of a request for a refund. Concerning the analogous protest procedures under the PCT (R. 40.2(c) and (e) and R. 68.3(c) and (e) PCT), the boards of appeal had ruled that these reviews had to be based exclusively on the reasons given in the invitation to pay additional fees, having regard to the facts and arguments submitted by the applicants (**W 4/93**, OJ 1994, 939). However, in the case in hand the examining division had reasoned that the claims as filed lacked unity a posteriori as a consequence of the finding that claim 1 as filed lacked an inventive step having regard inter alia to document D4, which was not cited in the partial search report. Thus the examining division had not reviewed the finding of lack of unity of invention within the meaning of R. 46(2) EPC 1973, but had carried out a fresh examination on the basis of a new document. Therefore its decision to refuse the refund of a further search fee had to be set aside for formal reasons alone; the appellant's refund request was justified. See also **T 1414/18**, with further references; also **T 2873/19**, in which the refund request was refused.

In **T 2703/18** the board agreed with **T 188/00** to the extent that the examining division may only find that the communication pursuant to R. 64(1) EPC was justified within the meaning of R. 64(2) EPC on the basis of the facts regarding the prior art presented by the search division with that communication, in particular the documents cited in the partial search report including sheet B. On the other hand, the board held that the examining division may well rely on further facts in a finding that the communication under R. 64(1) EPC was not justified, for instance in the circumstances of the case in **T 755/14** or, say, if further evidence shows that the only document cited in the partial search report and relied on in

an a posteriori non-unity finding actually does not belong to the prior art. Such further facts need also not have been submitted by the applicant. In addition, the board disagreed with the view expressed in **T 2526/17** and **T 1414/18** that the scope of the review should also be limited to the arguments presented by the search division. According to the board, in the context of R. 64(2) EPC, the examining division may, in order to find the communication under R. 64(1) EPC to have been justified, complete a reasoning outlined by the search division with the communication but may not replace it by an entirely different reasoning, even if based on the same prior art.

In the order of its decision on a requested refund of (further) search fees, the examining division must clearly specify the request which has been decided on, the extent to which it grants that request and orders a refund, and the outcome for any remaining parts of the request. Allowing a separate appeal against its interlocutory decision under Art. 106(2) EPC is a constitutive decision of the examining division which establishes the possibility of challenging the interlocutory decision by way of an appeal, and therefore it too should be included in the order (**T 756/14**).

3.4. No assessment of lack of unity in opposition proceedings

In **G 1/91** (OJ 1992, 253) the Enlarged Board held that unity of invention did not come under the requirements which a European patent and the invention to which it related had to meet under Art. 102(3) EPC 1973 (Art. 101(3)(a) EPC) when the patent was maintained in amended form. It was consequently irrelevant in opposition proceedings that the European patent as granted or amended did not meet the requirement of unity. It was clear from the "travaux préparatoires" not only that lack of unity was deliberately excluded as a ground for opposition, but also that any lack of unity arising during opposition proceedings as a result of amendment of the patent had to be accepted. Although unity of invention under Art. 82 EPC 1973 was a material requirement, it was still merely an administrative regulation. It served a number of administrative purposes, particularly in demarcating the respective responsibilities of the departments. The administrative purposes of unity were fulfilled in the main up to the time the patent was granted. The purpose of opposition proceedings was to give a competitor the opportunity of opposing unjustified protective rights. He did not also need to be given the opportunity of contesting a patent on the ground of lack of unity. Lack of unity did not in fact rule out patent protection; it could only result in an application being divided to produce two or more patents. See also **T 830/11**.

4. Criteria for determining lack of unity

4.1. Analysis of the technical problem as a precondition

According to the established case law of the boards of appeal, determining unity of invention requires as a precondition an analysis of the technical problem or problems underlying the respective group of inventions (see **W 11/89**, OJ 1993, 225; **W 6/97**, **T 188/04**), i.e. whether or not the subject-matter claimed as the solution to such a problem represents a single general inventive concept (see **W 6/91**; also **T 2248/12** and **T 129/14**). Disregarding this principle would be in itself sufficient justification for the reimbursement of the additional search fees. In **W 8/94** the board held that a discussion of the problem

underlying the claimed subject-matter was required, because only then was it possible to decide whether or not a common special technical feature within the meaning of R. 13.1 and R. 13.2 PCT existed for different embodiments (see **W 11/89**. **W 14/89**, **W 59/90**, **W 14/91**, **W 17/91**; also **T 1414/18**, with further references).

In **W 6/97** the board found that establishing the technical problem underlying a claimed invention or group of inventions in relation to the state of the art should start, as a rule, from what was considered in the description as having been achieved by the claimed invention, since claims directed to compositions of matter at least were normally silent on the technical effects to be achieved by such compositions. As soon as the search revealed prior art which was clearly more relevant than that already acknowledged in the description of the international application, it was necessary to determine what was to be considered as the particular technical problem in view of both the disclosure of the international application as a whole and the prior art thus revealed (see **W 6/91**). Unity of invention might be assessed only after the technical problem had been determined in such a manner.

In **W 17/03** the board was concerned with the investigation of technical relationships for unity. The case is summarised in the next section.

The boards have on several occasions stressed that an alleged lack of clarity in a claim cannot be used as a reason for an objection based on lack of unity (see **W 31/88**, OJ 1990, 134; **W 7/89**, **W 59/90**, **W 9/02**). In **W 21/04** the board observed that according to the established case law the features of an independent claim that the ISA considered not to meet the requirements of Art. 6 PCT could not be disregarded in examining a lack of unity objection, as the IPEA had done here. See also **W 8/07**.

4.2. Examination as to novelty and inventive step

In decision **G 1/89** (OJ 1991, 155; see also opinion **G 2/89**, OJ 1991, 166), the Enlarged Board ruled on the question of the ISA's power to carry out a substantive examination of an international application in respect of novelty and inventive step when considering whether it complies with the requirement of unity of invention (see also referring decision **W 12/89** (OJ 1990, 152).

The Enlarged Board found that in accordance with normal terminology, the term "examination" or "substantive examination" referred to the activities of the authorities responsible for deciding on patentability, such as the examining division of the EPO, or the IPEA and/or the designated Office. Obviously, an ISA did not have any power to carry out such activities; it might only form a provisional opinion on novelty and inventive step for the purpose of carrying out an effective search. This opinion was in no way binding on the authorities referred to above. The same principle applied when an ISA considered that an international application did not comply with the requirement of unity of invention set forth in R. 13.1 PCT on an "a posteriori" basis. Such consideration had only the procedural effect of initiating the special procedure laid down in Art. 17 PCT and R. 40 PCT and was, therefore, not a "substantive examination" in the normal sense of that term. An assessment of whether a single general inventive concept existed was to be undertaken only in so far

as this was necessary to establish whether the invention complied with the requirement of unity when implementing that procedure. Such an assessment was provisional and did not constitute a substantive examination in the sense of an examination as to patentability (see **W 6/90**, OJ 1991, 438).

The Enlarged Board further noted that consideration by an ISA of the requirement of unity of invention should always be made with a view to giving the applicant fair treatment and that the charging of additional fees under Art. 17(3)(a) PCT should be made only in clear cases. In particular, in view of the fact that such consideration under the PCT was being made without the applicant having had an opportunity to comment, the ISA should exercise restraint in the assessment of novelty and inventive step and in borderline cases preferably refrain from considering an application as not complying with the requirement of unity of invention on the ground of lack of novelty or inventive step (see **W 24/90**, **W 23/91**, **W 43/91**). In **W 1/97** the board held that there was no such clear case where the ISA, having already searched part of the subject-matter, was still not in a position to identify several separate inventions.

Following the Enlarged Board's conclusions in **G 1/89** and **G 2/89**, the boards repeatedly used a lack of novelty or inventive step in the general inventive concept underlying the invention to justify a finding of lack of unity (see **W 17/89**, **W 27/89**, **W 18/90** and **W 19/90**). In **W 10/92** the board stressed that the problem-solution approach was to be applied to unity of invention (**W 16/91**, **W 21/91**).

In **W 17/03** the ISA had considered that the absence of common technical features and an allegedly different problem solved would be sufficient to demonstrate lack of unity between groups of inventions. The board suggested that the ISA's approach to the determination of the problem appeared to stem from the belief that what was required was the same analysis as that used to determine the problem when using the problem-solution approach to evaluate inventive step, possibly because differences and problems are involved in both situations. The board stated that it was not convinced that the investigation of technical relationships for unity with the aid of common problems underlying the inventions is necessarily the same as the analysis that is used to determine the problem when using the problem-solution approach to evaluate inventive step. The board gave the following reasons:

(1) The evaluation of unity involves comparing problems solved (or effects achieved) by different claims, whereas the evaluation of inventive step is carried out on a single claim. As a result, when examining unity, the problems solved by different claims must be considered in the light of each other and cannot be determined in isolation in an absolute sense.

(2) In the evaluation of inventive step, the idea is to define a problem based on the distinguishing features that is essentially as narrow as possible, but not involving elements of the solution. On the other hand, in the evaluation of unity, these restrictions do not apply, since the overall object is to find out what the claims involved have in common, i.e. if the respective inventions are so linked as to form a single general inventive concept.

Thus, the specific problems solved by the different inventions with respect to the closest prior art might need gradual refinement, in particular generalisation starting from the problem directly solved, to find out whether or not there was a common denominator that still distinguished the inventions from the said prior art.

5. The single general inventive concept

5.1. General

When deciding on unity of invention, it is mandatory under Art. 82, R. 44 EPC and under R. 13.1 PCT to determine whether or not a group of inventions claimed in an application forms a single general inventive concept.

In **W 19/89** the board decided that the application clearly lacked unity of invention, since the four possibilities comprised by claim 1 related to a further development of the state of the art in different directions, namely by employing different classes of dehalogenation agents having no new technical feature in common. Where at least one solution of the underlying technical problem already formed part of the state of the art, the requirement of a "single general inventive concept" implied that the further solutions to that problem proposed in the application must have at least one new element in common, this new element being normally represented by at least one new technical feature. Since the absence of such a unifying new technical feature was admitted by the applicant, the application related to more than one invention.

A useful analysis of the single general concept was made in **W 6/90** (OJ 1991, 438). The board found that this concept manifested itself in features common to different teachings expounded individually in the same application. It observed that a teaching for the purposes of patent law encompassed not only the immediate subject-matter representing the solution to the problem as defined in the relevant claim, but also its technical consequences which were expressed as effects. It was noted that any subject-matter was defined by structural features and the relationship between them. The relevant effects, i.e. the outcome or results achieved by the invention as claimed, would usually already be apparent from the problem as stated. A single general concept might therefore be said to be present only if a partial identity existed between the teachings in an application deriving from the structural features of the subject-matters claimed and/or the outcome or results associated with those subject-matters.

Where subject-matters of the same category were concerned, a partial identity, generating unity of invention, could result from the structural features of these subject-matters and/or their associated effects. The absence of such an element common to all the different teachings in the application, and hence a lack of unity, might be established a priori under certain circumstances. A lack of unity might, however, also be established a posteriori between the subject-matters of different independent claims or in the remaining subject-matters if the subject-matter of a linking claim was clearly not novel or inventive vis-à-vis the state of the art. The board gave an example of what was meant by the abstract term "single general concept": a product, a process specially adapted for the manufacture of the said product, and a use of the said product, for example, embodied a single general

concept because, on the one hand, the partial identity between the product and its use derived from the structural features of the product and, on the other hand, the partial identity shared by the product and the process specially adapted for its manufacture also derived from the product which was to be considered as the effect or result of this process (see **T 119/82**, OJ 1984, 217).

The board also noted that the criteria governing unity of invention for the purposes of R. 13.1 PCT elucidated above also applied in principle where the inventive step was based chiefly on the discovery of an unrecognised problem (see **T 2/83**, OJ 1984, 265). If the common problem, i.e. the effects to be achieved, was itself already known or could be recognised as generally desirable (a mere desideratum) or obvious, there would be no inventive merit in formulating the problem. If the common structural features were to be found only in the prior art portions of the claims, and if these known features did not help to solve the problem of the combined whole, this might also indicate a lack of unity.

In **W 38/90** the sole common link between the subject-matter of claims 1, 2 and 4 was that the respective features all contributed to the realisation of the same device – a viewing assembly for a door. The board observed that this common pre-characterising feature was confined to indicating the designation of the invention, as part of the prior art; it was not, however, a specific feature interacting with the remaining characterising features and thereby contributing to the various inventions and their effects. Therefore, this sole link had to be rejected as irrelevant as regards any possible contribution to inventiveness. As already concluded, in the absence of any kind of common relevant feature, no unity "a priori" could be recognised.

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

In **T 861/92** the apparatus claimed was specifically adapted for carrying out only one step of the claimed process. The board came to the conclusion that the subject-matter of the claims satisfied the requirements of Art. 82 EPC 1973 as there was a technical relationship between both inventions.

In **W 9/03** the board held that a common problem could establish the unity of different inventions only under certain conditions, for example in the case of a problem invention. According to the applicant, the common problem was considered that of providing a more secure, faster and easier connection setup. The board started from the assumption that the person skilled in the relevant art would normally consider this problem. The common problem was therefore so broadly formulated that it was "itself already known or could be recognised as generally desirable or obvious" (see **W 6/90**); as a result, unity could not thereby be established. See also **T 2482/12**.

5.2. Special technical features and inventive character of the single general concept

R. 13.2 PCT defines the method for determining whether the unity requirement is satisfied in respect of a group of inventions claimed in an international application: "Where a group of inventions is claimed in one and the same international application, the requirement of unity of invention referred to in R. 13.1 PCT shall be fulfilled only when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features. The expression "special technical features" shall mean those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art" (see R. 44(1) EPC).

According to the case law, once such a single, i.e. common, concept was established, it was necessary to consider whether or not the same could contribute to the inventiveness of the various subject-matters claimed in the case. Nothing indicated that this concept was known or belonged to the general knowledge of the person skilled in the art. Since the search examiner did not indicate that the documents cited in the case could exclude such a contribution, it could not be assumed that this could not be the case (**W 17/89**; see **W 6/90**, OJ 1991, 438). In view of this, a single inventive concept had to be attributed to all claims linking all their subject-matters (see **W 22/91**).

In **W 6/90** (see also in this chapter II.B.5.1. above) the board noted inter alia that R. 13.1 PCT also stipulated that the single general concept had to be inventive. Even with a given single general concept there was lack of unity if the concept had no inventive character. The boards of appeal have confirmed the above decision on several occasions (see e.g. **W 31/91**, **W 29/92**, **W 34/92**, **W 45/92**, **W 8/93** and **W 6/97**).

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

In **W 45/92** the board stated that the term "inventive" could not be interpreted as a requirement for the common part to be inventive per se and therefore claimable as such. The investigation in this respect should concentrate on whether or not all or some of such features could contribute to the later detailed consideration of the inventive steps. Only if the state of the art or common general knowledge which had already been taught showed, beyond reasonable doubt, that this was not possible in the circumstances, should non-unity be declared. It further held that the term "same or corresponding special technical features" recognised that the features should define a contribution to the invention vis-à-vis the prior art. As the features in question were also part of the most relevant state of the art, where they were set out in an identical manner, they could not provide such a contribution. Thus, the various inventions, if any, had to lie in the unshared specific characterising features in each case. Since the claims contained no other common feature between them in the characterising part, this confirmed the conclusion of lack of unity (see **W 32/92**, OJ 1994, 239).

In **W 38/92** the board confirmed **W 6/90** (see above) and noted that the common features in the claim groups represented the "sole concept" linking the various subject-matters. The board stated that the remaining question was whether or not any of these specific features in the claim groups or their combination could make a contribution to the inventive steps relating to each claimed subject-matter; if so, this would render the said concept linking the various subject-matters inventive. The board observed that the new R. 13 PCT also required such a contribution by the suggested common "special technical features" over the prior art, i.e. that more than novelty be provided. In **T 94/91** the board made it clear that the general inventive concept could not be equated with the features cited in a claim or in a particular combination of claims. What should be considered was the inventive concept as defined in the claims with due regard to the description and any drawings (see **W 2/95**).

In **W 9/93** the board noted that the intermediate compounds were known, so that these products could not serve as a common inventive concept, and that a technical feature contained in the process claims was also known. The board pointed out that a technical feature which already formed part of the state of the art could not, by definition, make a contribution over the prior art and did not, therefore, qualify as a unifying element within the meaning of R. 13.1 PCT. According to R. 13.2 PCT, as in force from 1.7.1992, an international application could relate to a group of inventions if there was a "technical relationship" among those inventions involving one or more of the same or corresponding "special technical features", i.e. such technical features that defined a contribution which each of the claimed inventions made over the prior art. R. 13.1 PCT did not simply require some link between a group of inventions claimed in an international application, but a common inventive concept. This meant that there must be either a common technical problem or at least, if there was more than one technical problem, there must be one single technical concept behind the solutions of these different problems.

In **T 957/96** the application described a number of processes which did not have any process step in common. According to the board, the decisive fact was that all the processes claimed shared a common technical feature, namely the use of the substantially pure regioisomer, which was essential for solving the technical problem addressed by the application. It was this use of the intermediate compound which formed the common "inventive" concept of all the claimed process variants. This feature constituted a special technical feature which defined the contribution that the claimed invention made over the prior art as required by R. 30(1) EPC 1973 (see now R. 44(1) EPC).

In **W 11/99** (OJ 2000, 186) the board held that if, in an international application, there are claims directed to products and to a process for the manufacture thereof, it could not be assumed that there were no corresponding special technical features within the meaning of R. 13.2 PCT simply because the process could also be used to manufacture other products. The board interpreted the requirement for the presence of "corresponding special technical features" under R. 13.2 PCT in cases where a manufacturing process and products were being claimed in the same application to mean that they could usually be assumed to be present where the production process is new and actually suited to making the claimed products accessible (where appropriate in addition to further products). In such cases the board regards the process as being "specially adapted" to

the manufacture of the claimed products. A narrower interpretation of the terms "specially adapted" and "corresponding special technical features" would not fulfil the legislative purpose of Art. 34(3) PCT and associated R. 13.1 PCT, which, in the board's view, was the same as that of Art. 82 EPC 1973, namely to prevent subject-matters which were not interconnected being claimed in one and the same application. This interpretation accorded with Annex B to the PCT Administrative Instructions mentioned in the PCT Guideline III-7.2 (July 1998 version), where it is stated in Part 1, item (e), that a process is specially adapted for the manufacture of a product if it inherently results in the product (see now Annex B, para. (e) PCT Administrative Instructions, as in force from 1 July 2024). If this condition was met, it was irrelevant whether other products could be obtained using the process.

In **T 106/06** the board referred to the established case law of the boards of appeal according to which a manufacturing process and its resulting products are considered as unitary subject-matter (e.g. **W 2/95** and **W 11/99**). The board gave consideration to the question whether the fact that claim 1 did not relate to a manufacturing process in the usual sense which may be characterised in that the specific end products are envisaged at the outset of the process, but to a process of isolating genes which, in view of its set up, has resemblance to a screening process which, in turn, may be characterised in that the final product is not known at the outset, should have an influence on the assessment of unity. The board held that the decisive question was whether the product had actually been produced by the process and not whether it had been known at the start of it. Therefore, there was no difference in the assessment of unity between a manufacturing process and a screening process and their resulting products.

In **W 18/01** the board pointed out that it followed from the definitions in the Regulations under the PCT and the PCT International Preliminary Examination Guidelines (which are binding on the EPO; see **G 1/89**, OJ 1991, 155, point 6 of the Reasons) that it was normally not sufficient merely to define and examine the common core of a group of inventions, for example by indicating the features which were specified in all the claims defining the inventions of the group. R. 13.2 PCT required an examination of the technical relationship among the inventions in a group. Such a relationship could exist even if the inventions did not involve the same technical features, provided they involved corresponding special technical features. The definition of "special technical features" given in R. 13.2 PCT required an analysis of the contribution which each of the claimed inventions made over the prior art. This first entailed analysing which of the features distinguished the claimed inventions from the cited prior art before their contribution could be examined in the light of the description, in particular the problems solved and the effects achieved by the claimed inventions.

5.3. Unity of single claims defining alternatives ("Markush claims")

Rule 44(1) EPC and R. 13.2 PCT also apply where a single claim defines alternatives ("Markush claim"). According to R. 44(2) EPC and R. 13.3 PCT, the determination of whether a group of inventions is so closely linked as to form a single general inventive concept shall be made without regard to whether the inventions are claimed in separate claims, or as alternatives within a single claim (see also **W 35/91**).

In considering whether the ISA had substantiated its findings of non-unity, the board in **W 3/94** (OJ 1995, 775) referred to the section on the "Markush practice" in Annex B, Part 1(f) of the Administrative Instructions under the PCT, as in force from 1.7.1992 (see now Annex B, para. (f) PCT Administrative Instructions, as in force from 1 July 2024). Here it is stated that the requirement of a technical interrelationship and the same or corresponding special technical features as defined in R. 13.2 PCT shall be considered met when the alternatives are of a similar nature. The section then specifies when alternatives are to be regarded as "of a similar nature".

In **W 1/94**, the EPO acting as ISA had found that the compounds according to the "inventions" it had identified did not have a new structural element. Nevertheless the board concluded that the absence of such an element did not automatically destroy the unity of the invention. On the contrary, it was clear from the PCT Administrative Instructions that a technical relationship must be recognised for a group of alternative chemical compounds, such as all the compounds having a common property or activity, and such a common activity existed in the case in point. The new use could therefore form the general inventive concept linking the subject-matters of the claims in accordance with R. 13.1 PCT and had to be treated as a functional characteristic linking the compounds claimed.

In **W 6/95** the board referred to the PCT Administrative Instructions, binding not only on the ISA but also on the board of appeal acting as the "three-member board" according to R. 40.2(c) PCT (see **G 1/89**, OJ 1991, 155; since 1.4.2005, the references in the PCT Regulations to "three-member board" have been replaced by "review body" – see also in this chapter II.B.1. "Introduction"). The board noted that it followed from Annex B, Part 1(f)(i) PCT Administrative Instructions (now part of Annex B, para. (f) PCT Administrative Instructions, as in force from 1 July 2024) that in order to establish unity of invention "a posteriori", it was not sufficient for all alternatives of chemical compounds covered by a Markush claim to have a common property or activity, i.e. be suitable for solving a common technical problem, because according to item (B)(1) they had, in addition, to have a "significant structural element" in common in order for the alternatives to form unity. The board made it clear that it was, however, not in agreement with the explanation given in Annex B, Part 1(f)(ii) (now Annex B, para.(f)(ii)) PCT Administrative Instructions to assume that the said "significant structural element" had to be novel per se. Rather, this expression meant that in relation to the said common property or activity there had to be a common part of the chemical structure which distinguished the claimed compounds from known compounds having the same property or activity (see also **W 6/97**).

In **T 169/96** the board noted that the fact that claim 1 also comprised a known compound, not covered by claim 2, was of no relevance to the question of unity, because R. 30(b) EPC 1973 (in the version as in force until 31.5.91; also in the version in force thereafter) did not require that there must be a common concept unifying different "means" according to it. It was not relevant here that the three different classes of chemical compounds identified by the examining division comprised completely different chemical structures of a residue. The board observed that Chapter C-III, 7.4a of the then applicable EPO Guidelines, which had been relied on by the examining division, as well as Annex B, Part 1(f) PCT Administrative Instructions (see now Annex B, para. (f) PCT Administrative

Instructions as in force from 1 July 2024), concerning Markush-type claims, rightly stated that the said significant structural element might consist of a combination of individual components linked together. It was not stated there that the combination of individual structural elements had to be novel per se, nor did such a requirement follow from Art. 82 EPC 1973. Rather it followed from that guideline that this expression meant that in relation to the said common property or activity there had to be a common part of the chemical structure which distinguished the claimed compounds from known compounds having the same property or activity (see now Guidelines F-V, 3.2.5 – April 2025 version).

In **W 4/96** (OJ 1997, 552) the board noted that the requirement of a technical relationship as defined in R. 13.2 , first sentence, PCT might be met when all claimed alternatives belong to a class of compounds which might be expected to behave in the same way in the context of the claimed inventions ("Markush claims"). The technical relationship involved those common special technical features that defined a contribution over the state of the art (R. 13.2, second sentence, PCT; see also **W 6/96**, **W 1/10**). However, such contribution could not be recognised on the basis of this expectation if members of the class had already been shown in the prior art to behave in the manner disclosed in the application. The board added that if at least one Markush alternative was not novel over the prior art, the question of unity had to be reconsidered by the examiner, i.e. a posteriori (Annex B, Part l (f)(v) PCT Administrative Instructions in conjunction with PCT Search Guidelines; see now Annex B PCT Administrative Instructions, as in force from 1 July 2024, also PCT International Search and Preliminary Examination Guidelines, as in force from 1 July 2022).

The board also held that an objection of lack of unity could be raised a posteriori with regard to all categories of grouping of alternatives of chemical compounds. An a posteriori assessment of unity had to be made in all circumstances in the same way, since the legal requirement of R. 13 PCT was the same for all cases. Therefore, the a posteriori assessment of unity in cases of a functional relationship within a group of compounds had to be made in a manner corresponding to the assessment in cases of a structural relationship. This was appropriate for compounds related by their structure as well as for compounds related by their function. The structural relationship within the meaning of Annex B, Part l (f)(i)(B)(1) and the relationship within the meaning of Annex B, Part l (f)(i)(B)(2) and (iii) served the same purpose: both tests were intended to show whether the alternative compounds were of a similar nature, as was said in the introductory part of Annex B, Part l(f)(i). These tests were only tools in order to determine whether there was unity of invention as defined in R. 13 PCT.

Claim 1 in **W 34/07** was directed to compositions for the coating of ceramic supports comprising micronised glass frits **and/or** nanosised zirconium hydroxide. The board concluded that the two claimed alternatives neither had in common express features not known in combination from the prior art nor represented two solutions to the same technical problem. The effects achieved by using either micronised glass or nanosised zirconium hydroxide were different and unrelated, although they might lead to "best results", i.e. when using a composition comprising both components.

6. Plurality of inventions – further search fees

If the search division or the ISA raises an objection of lack of unity, a further search fee is payable under R. 64(1) EPC (R. 46(1) EPC 1973) or Art. 17(3)(a) PCT, respectively, for each additional invention to be covered by the second report (for Euro-PCT applications in the European phase, see in this chapter II.B.6.2.).

In **W 2/10** the board pointed out that in **W 4/85** (OJ 1987, 63) and many subsequent decisions, the boards had decided that the requirement to give reasons in an invitation under Art. 17(3)(a) PCT was so fundamental that an unsubstantiated invitation could be regarded as legally ineffective. This was so in the case in question and therefore the additional search fees had to be refunded. See also OJ 2017, A20 for the provisional opinion now issued together with the partial search report.

If the fee is paid in due time applicants may select the single invention or group of inventions which they wish to retain in the (main) application. According to **T 158/12**, with reference to **G 2/92**, this choice cannot be altered once examination of that invention has commenced.

In **T 736/14** the board noted that the EPC contained no explicit provisions about how to proceed if an applicant whose application was non-unitary responded unclearly or in a misleading way to an invitation from the examining division to specify which searched invention it wished to prosecute further. The board held that in such a situation it could not automatically be assumed that the applicant selected the invention covered by the main request for examination. Rather, the examining division had to clarify, e.g. via a further communication, which of the searched inventions the applicant actually wanted it to examine.

6.1. Consequences of non-payment of a further search fee

In view of differing decisions **T 178/84** (OJ 1989, 157) and **T 87/88** (OJ 1993, 430), the President of the EPO referred the following point of law to the Enlarged Board:

"Can an applicant who fails to pay further search fees for a non-unitary application when requested to do so by the search division under R. 46(1) EPC 1973 pursue that application for the subject-matter in respect of which no search fees have been paid or must he file a divisional application for it?"

In the opinion of the Enlarged Board, given in **G 2/92** (OJ 1993, 591), the application could not be pursued for subject-matter in respect of which the applicants had not paid the further search fees. Instead the applicants had to file a divisional application for that subject-matter if they wished to continue to protect it. In the view of the Enlarged Board, it was clear from the procedural system of the EPC that the invention which was to be examined for patentability had to be an invention in respect of which a search fee had been paid prior to the drawing up of the European search report. Part IV of the EPC envisaged that an application progressed after filing from the search division to the examining division. One object of R. 46 EPC 1973 was to implement this procedure by ensuring that an

appropriately extensive search was completed in respect of each individual application before it was examined by the examining division. To this end, in response to an invitation from the search division to pay one or more further search fees in respect of one or more further inventions to which the application related, applicants had to pay such fees if they wished to ensure that one of the further inventions could become the subject of the claims of that application. That was the proper interpretation of R. 46(1) EPC 1973 in context. This confirmed the practice according to **T 178/84**.

In **T 319/96** the initial application lacked unity, but no further search fee was paid. The applicant had argued that, because of the international-type search (Art. 15(5)(a) PCT) carried out by the EPO (in the priority application) for the subject-matter of original claims 4 to 10, it had not forfeited its right to choose and could therefore continue pursuing this subject-matter. It had paid a search fee for each of the two inventions, and two search reports had been prepared by the Office. The board, however, stated that under R. 46(1) EPC 1973 a search fee was to be paid for each further invention if the **European** search report was to cover that invention. R. 46 EPC 1973 did not provide that a search report from another procedure could be substituted for the European search report. The board referred rather to the possibility under Art. 10(2) RFees (see now Art. 9(2) RFees) of a full or partial refund of the European search fee where the Office has prepared an earlier search report on the same subject-matter. **G 2/92** applied also in the present case because in the context of the European procedure only one search report had been drawn up after payment of only one search fee.

In **T 2289/09** the appellant had argued that since it was accepted practice that amendment in a divisional application could be based on subject-matter searched in the parent application, it should also be accepted that subject-matter that had been searched in a divisional was considered searched subject-matter generally and could thus form the basis for amendment in a parent. These circumstances were not explicitly excluded in **G 2/92**. The board disagreed. The Enlarged Board had stated in **G 2/92** that when an applicant failed to pay the requested search fees, that subject-matter could not be pursued in the application for which the search was carried out, and furthermore that "the invention which is to be examined ... must be an invention in respect of which a search fee has been paid prior to the drawing up of the European search report". This statement had significance beyond the reasons given in **G 2/92**. When an applicant for a divisional application sought the benefit of an earlier search, he still had to pay the search fees (R. 36(3) EPC). These were then refunded, conditional on the fulfilment of certain criteria (regulated in the applicable decision of the President of the EPO and notice from the EPO, see OJ SE 1/2010, 322 and 325), namely if the EPO benefited from the earlier search report. There was no provision that would permit the EPO to proceed with search activities, including the examination of the claims in question and their scope, when no search fees were paid for a given part of an application, and also none that would entitle the examining division to request the payment of further search fees for the purpose of examining the usefulness of the earlier search on the divisional application.

In **T 631/97** (OJ 2001, 13) the board held that R. 46(1) EPC 1973 on its proper interpretation does not prohibit a review by the examining division of the search division's opinion on lack of unity where further search fees are not paid. A narrow interpretation of

R. 46(1) EPC 1973 whereby the finding of lack of unity by the search division is considered as final where the additional search fees are not paid would deprive the applicant of an opportunity to dispute that finding during the examination proceedings and would also unjustifiably restrict the power of the examining division on the question of unity to the subject-matter for which search fees were paid. Thus the board did not share the view held in **T 1109/96**. The board found the above interpretation of R. 46(1) EPC 1973 to be in agreement with that of the Enlarged Board in **G 2/92**, and the examination procedure as set out in the Guidelines also to be in line with **G 2/92**. It noted furthermore, with reference to R. 112 EPC 1973, that the practice of search and examination of international applications where the EPO was elected or designated Office was consistent with the above view. This decision was followed in **T 708/00** (OJ 2004, 160) – also referred to in this chapter II.B.6.3.

6.2. Euro-PCT applications

An applicant may pay additional search fees in the international phase if invited to do so by the ISA under Art. 17(3)(a) PCT. Once the application has entered the European phase, R. 164 EPC, as in force from 1 November 2014, allows applicants to obtain, upon payment of a (further) search fee, a search of any invention claimed which was not searched by the EPO in the international phase. Applicants may choose any invention searched by the EPO either in the international phase, in the procedure for supplementary search or in the procedure under R. 164 EPC as a basis for further prosecution of the European phase (see notice from the EPO of 10 June 2014, OJ 2014, A70).

In **T 44/19** the board noted that the hub of the first invention had the same function and addressed the same technical problem as the hub of the second invention identified by the objection as to lack of unity raised by the search examiner. Consequently, during the search for the first invention and having due regard to the description and drawings, the search examiner already had to search for a hub according to the second invention. In the particular circumstances of the case, the board found that it was irrelevant whether the examining division correctly considered that there was a lack of unity in the claims. According to R. 164(2) EPC, the examining division may only ask for the payment of an additional search fee if it considers that in the application documents which are to serve as the basis for examination, an invention (or a group of inventions within the meaning of Art. 82 EPC) is claimed which was not searched by the EPO in its capacity as ISA. The communication under R. 164(2)(a) EPC was therefore not justified and the additional search fee should have been refunded by the examining division under R. 164(5) EPC.

The following decisions concerning the former version of R. 164 EPC are still relevant.

In **J 3/09**, the Legal Board of Appeal confirmed in respect of R. 164 EPC (as then in force) that although the procedure on entry of an application into the European phase where the EPO had acted as the ISA changed with the coming into force of EPC 2000, the responsibility for establishing whether or not the application met the requirements of unity of invention still ultimately rested with the examining division, and the opinion of the EPO acting as the ISA on lack of unity was not final or binding on the examining division. The board observed that the practice of the examining division in this respect remained as

before, noting in particular that to the extent that an objection of non-unity raised by the ISA turned out to be unjustified, the applicant was entitled to have the whole subject-matter of their unitary invention searched. The board in **T 1285/11** followed this reasoning, adding that the fact that the applicant did not pay further search fees or protest fees in the international phase could not be seen as a tacit agreement with the findings of non-unity of the ISA.

For further decisions concerned with the interpretation and application of R. 164 EPC as in force until 31.10.2014, see CLB, 9th edn. 2019, II.B.6.2.

6.3. Applicability of Rule 64, (former) Rule 164(2) EPC or Rule 137(5) EPC

In **T 708/00** (OJ 2004, 160) the board pointed out, with reference to preparatory document CA/12/94 cited in the notice from the EPO in OJ 1995, 409, that the purpose of R. 86(4) EPC 1973 (R. 137(5) EPC) was to deal with the situation arising when amended claims relating to unsearched subject-matter were filed in response to the examiner's first communication. It did not apply when the applicant had not paid the search fee in respect of a non-unitary invention in spite of being invited to do so under R. 46(1) EPC 1973 (R. 64(1) EPC), see also **G 2/92**, OJ 1993, 591. These two rules were complementary in nature.

In **T 1285/11** (mentioned above), in which no further search fees had been paid in response to the ISA's non-unity objection, the examining division refused the application on the basis of R. 137(5) EPC as well as R. 164(2) EPC as in force until 31 October 2014. Referring to **T 708/00**, the aforementioned notice and the Guidelines, the board found that R. 137(5) EPC was not contravened because the subject-matter of the amended claims had already been present in the claims as originally filed. Concerning former R. 164(2) EPC, the board was satisfied that, prima facie, there was a feature that could be regarded as constituting a "special technical feature" (R. 44(1) EPC) establishing unity between "invention 1" and "invention 2" in accordance with Art. 82 EPC. The decision was set aside and the application was remitted for further prosecution.

Reference is also made to chapter IV.B.5. "Amendments relating to unsearched subject-matter – R. 137(5) EPC".

6.4. Dispensing with further search fees

In **W 36/90** and **W 19/89** the board observed that where there was lack of unity in an international application, in particular if the objection was evident a posteriori, the search examiner might decide to supplement the international search with a search on the additional inventions as well as on the first invention. This was so particularly if the concepts of the inventions were very close and none of them required a search in different classification units, so that the search could be performed for all the inventions without creating too much extra work (see PCT Search Guidelines as agreed upon by the Interim Committee for Technical Cooperation at its seventh session in Geneva in October 1977, PCT/INT/5). In such a case no objection of lack of unity should be raised

because charging further fees would be incompatible with the principle of equity vis-à-vis the applicant (see **G 1/89**, OJ 1991, 155; see also e.g. **T 755/14**).

According to **T 806/18**, where an independent claim is found to lack novelty, often a formal objection of lack of unity of invention could be envisaged between two or more groups of dependent claims. However, the search division (or the examining division reviewing a non-unity finding) should bear in mind that unity of invention under Art. 82 EPC is "merely an administrative regulation" (**G 1/91**, OJ 1992, 253) and should give due consideration to the advice from the Guidelines: "Lack of unity is not a ground of revocation in later proceedings. Therefore, although the objection is certainly made and amendment insisted upon in clear cases, it is neither raised nor insisted upon on the basis of a narrow, literal or academic approach. This is particularly so where the possible lack of unity does not necessitate a further search" (Guidelines F-V, 2.2 – April 2025 version; see Guidelines, F-V, 8 – November 2017 version, in force at the time of the contested decision). Hence, in determining whether to request further search fees, the search division should not adopt a purely algorithmic approach, but consider whether it would be reasonable, under the circumstances of the case and in the light of the subject-matter already searched and the prior art found, to demand additional fees for extending the search to the remaining claims. See also **T 2703/18**.

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1. Introduction

Article 83 EPC stipulates that the application "shall" (previously "must") disclose the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art. The related ground for opposition is in Art. 100(b) EPC.

The subject-matter of an application must be sufficiently disclosed at the date of the application (see in this chapter II.C.2.), based on the application as a whole (chapter II.C.3.1.), including examples (chapter II.C.5.3.), and taking into account the common general knowledge of the skilled person (chapter II.C.4.). At least one way of enabling the person skilled in the art to carry out the invention must be disclosed (chapter II.C.5.2.), but this is sufficient only if it allows the invention to be performed in the whole range claimed (chapter II.C.5.4.). Parameters must be sufficiently defined (chapter II.C.5.5.). The disclosure must also be reproducible without undue burden (chapter II.C.6.6.); evidence from post-published documents is allowable under certain circumstances (chapter II.C.6.8.).

The distinction between the requirements for sufficiency of disclosure under Art. 83 EPC and clarity of the claims under Art. 84 EPC (chapter II.C.8.) is important, as examination in respect of the requirements of Art. 83 EPC is still permitted during opposition proceedings, whereas in respect of Art. 84 EPC it is limited to cases where there has been an amendment (see also **G 3/14** in chapter II.A.1.4.).

The issue of whether the invention is disclosed in a manner sufficiently clear and complete and whether the claims have a basis in the description is a question of fact that has to be

answered on the basis of the available evidence and on the balance of probabilities in each specific case. As a rule, the burden of proof lies with the opponent to establish that an invention is insufficiently disclosed (chapter II.C.9.).

Sufficiency of disclosure as applied in biotechnology is considered in this chapter II.C.7., including the issue of broad claims (chapter II.C.7.1.4).

A number of decisions have looked at the monopoly conferred by a patent, how this is linked to the notion of a "technical contribution" and what this means for assessing sufficiency of disclosure; see, for example, the following decisions reported elsewhere in this chapter: **T 409/91** (OJ 1994, 653), **T 435/91** (OJ 1995, 188), **T 1164/11**, **T 1845/14**, **T 797/14** and **T 2119/14 ; T 2038/19 ; T 2015/20 ; T 1779/21 ;** see **T 416/14** (as regards a proprietor's argument that there were no potential effects on the competition). The issue of where the line is to be drawn between Art. 56 EPC and Art. 83 EPC was addressed in e.g. **T 409/17** (point 3.3.3 of the Reasons), referring to **G 1/03** (OJ 2004, 413) and **T 1845/14**; on this point, see also the following decisions: **T 380/05**, **T 1311/15**, **T 1079/08**, **T 862/11**, **T 2001/12**, **T 898/05**, **T 967/09**, **T 116/18** (OJ 2022, A76) ; **T 728/21** ; **T 1779/21**.

2. Date of compliance

Sufficiency of disclosure under Art. 83 EPC requires inter alia that the subject-matter claimed in a European patent application be clearly identified. This requirement must be complied with as from the date of filing because a deficiency in a European patent application as filed, consisting in an insufficient identification of the subject-matter claimed, cannot subsequently be cured without offending against Art. 123(2) EPC which provides that the subject-matter content of a European patent application as filed may not be extended (**G 2/93**, OJ 1995, 275).

The process of making the invention has to be completed on the date of filing or priority. The requirement of sufficiency of disclosure ensures that a patent is only granted if there is a corresponding contribution to the state of the art and if the person skilled in the art is able to carry out the invention (**G 1/03,** OJ 2004, 413, point 2.5.3. of the Reasons).

It is not the purpose of the patent system to grant a monopoly for technical speculations that cannot be realised at the time of filing (**T 1164/11**). See also in this chapter II.C.6.8. "Post-published documents". On monopoly, see the discussion in e.g. **T 1845/14** and the reference to this principle in **T 2015/20**.

According to the board in **T 512/07**, objections under Art. 83 EPC 1973 may under some circumstances be overcome by amending the claims, since thereby the "invention" referred to in Art. 83 EPC may be so changed that it no longer depends on the insufficiently disclosed aspects of the application for its realisation. However, such objections cannot be overcome by amendment of the description and drawings, since the amendment would then add subject-matter to the application as filed. In general, the claimed subject-matter at issue had to be examined for compliance with Art. 83 EPC 1973 on the basis of the application documents as originally filed.

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

3.1. Application as a whole

Sufficiency of disclosure within the meaning of Art. 83 EPC must be assessed on the basis of the **application as a whole** – including the description and claims – (see leading decisions **T 14/83**, OJ 1984, 105; and also **T 169/83**, OJ 1985, 193) and not of the claims alone (see e.g. **T 202/83**, **T 179/87** of 16 January 1990, **T 435/89**, **T 82/90**, **T 126/91**). The drawings must be considered as ranking equally with the other elements of the application when considering whether the requirements of Art. 83 EPC (and Art. 84 EPC) have been satisfied (see **T 169/83**, OJ 1985, 193; **T 308/90** and **T 818/93**). See also **T 1253/04** (point 10 of the Reasons).

In **T 32/84** (OJ 1986, 9) it was pointed out that the fact that certain elements of an invention essential to its operation were not referred to explicitly either in the claims, or in the relevant portion of the description nor shown in the drawing of the invention as claimed did not necessarily mean that the application did not disclose the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art as required by Art. 83 EPC 1973. This decision was cited, inter alia, in **T 391/91**, **T 830/02** and **T 25/09**.

According to established case law, substantially any embodiment of the invention, as defined in the broadest claim, must be capable of being realised on the basis of the disclosure. This implied in particular that an objection of insufficiency could be raised against the subject-matter of any claim, independent or dependent (R. 29(3) EPC 1973, now R. 43(3) EPC). From a legal point of view it was therefore irrelevant whether or not the feature objected to was essential or to what degree the scope of protection conferred by the patent depended on the claim in question (**T 226/85** (OJ 1988, 336), cited in many decisions, for example, **T 1011/01** and **T 1129/09**).

The board in ex parte case **T 206/13** could not accept the appellant's submissions to the effect that preferred or optional features defined in a claim should be disregarded in the assessment under Art. 83 EPC. According to the established case law the requirement of sufficiency of disclosure defined in Art. 83 EPC was only complied with if the disclosure of the invention allowed the skilled person to perform, without undue burden, essentially all the embodiments covered by the claimed invention. This applied in particular to the specific particular embodiments of an invention defined in dependent claims pursuant to R. 43(3) EPC (**T 1011/01**) and, by the same token, to any optional feature defined in a claim, since such a feature also constituted, by its very nature, a particular embodiment of the claimed invention, irrespective of whether the optional feature was qualified as being "preferred" or not.

In **T 797/14** the board came to the conclusion that the essential element of the claimed invention, namely the coating composition Flurotec (TM), was not of public knowledge and that there was also not enough information available to the skilled person for him to reliably determine the composition or structure of the product. The counterpart of a monopoly by a patent is however the disclosure of the invention, in particular of its essential elements, and not the provision or use of a commercial product whose structure and composition are

not public. (On disclosure of a **starting material**, see **T 1596/16**, in which one of the parties had invoked **T 2399/10** and **T 797/14** but the board, having summarised the issues dealt with in those decisions, found that the case in hand was not comparable.)

Disclosure is insufficient if the skilled person, taking into account the entire teaching of the patent, cannot rework an invention which is defined in the claims in a completely clear and comprehensible manner, unless he disregards a meaningful feature (**T 432/10**, see Catchword).

In **T 1170/20** the board noted, in reply to an argument raised by the respondent (patent proprietor), that the requirement for sufficiency of disclosure related to the invention as a whole, not just the part that the applicant or patent proprietor deemed inventive. If any part of the invention defined in the claims could not be carried out, then the invention could be challenged for insufficient disclosure.

The following recent decisions are cited by way of example to illustrate the interaction between the requirements of Art. 83 EPC and the claim interpretation rules: **T 2824/19**, **T 1902/21** and **T 2020/22**, the latter highlighting how taking the patent application as a whole into account, as explicitly stipulated by Art. 83 EPC, can have a bearing on the correct interpretation of the claims (**T 2020/22**, point 2.3 of the Reasons).

3.2. Meaning of terms in the relevant technical field

In **T 1307/17** the board stated that there was a distinction between absorption and adsorption in the context of pure chemistry. However, during the assessment of sufficiency of disclosure, it was essential to verify the meaning of the terms in the technical field of the claimed subject-matter – in this case high-voltage switchgear rather than pure chemistry. In this technical field, the two expressions were used interchangeably.

3.3. Alleged effect not a feature of the claims

According to the case law of the boards of appeal, the requirement of sufficiency of disclosure relates to the invention defined in the claims, and in particular to the combination of structural and functional features of the claimed invention, and there is no legal basis for extending such a requirement also to encompass other technical aspects possibly associated with the invention (such as results to be achieved or technical effects) mentioned in the description but not required by the claimed subject-matter (principle reiterated in e.g. **T 1900/17**, **T 2020/22**).

An objection of insufficient disclosure under Art. 83 EPC cannot legitimately be based on an argument that the application would not enable a skilled person to achieve a non-claimed technical effect (**T 2001/12**, citing mainly **G 1/03** (OJ 2004, 413) but also **T 1079/08**, **T 939/92** and **T 260/98**). Other decisions referring to this principle: **T 1744/14**, citing **T 1845/14**, point 9.8 of the Reasons; **T 1311/15**, point 5.2 of the Reasons; **T 1900/17**, point 2.5 of the Reasons; **T 1943/15**; **T 1502/16**, citing **T 862/11**; **T 45/21**.

It is the board's settled case law that a technical effect is to be taken into account in assessing enablement only if it is explicitly claimed. If it is not claimed, it is irrelevant for enablement whether or not it is actually achieved. The question whether it is achieved might then become relevant when assessing inventive step, namely for the purposes of formulating the objective technical problem (**T 1216/12**, citing **T 862/11** and **T 2001/12**). See also decisions cited in the introduction of the present chapter concerning the line to be drawn between Art. 56 EPC and Art. 83 EPC.

In **T 23/22** the appellant's (opponent's) objection was that the patent did not demonstrate the effect recited in the claim. The board however found that this effect did not limit the claimed use. Accordingly, whether this effect was attained was not a matter to be assessed under sufficiency of disclosure.

T 1311/15 the parties did not dispute that claim 1 did not include any flammability requirement in its wording. It was however also undisputed that the invention aimed at providing non-flammable refrigerant compositions. The question arose whether, when examining the ground of opposition under Art. 100(b) EPC, the intended effect of the claimed subject-matter should be taken into account (issue dealt with by reference to the aforementioned settled case law).

T 2001/12 dealt with the distinction between the requirements of sufficiency of disclosure (Art. 83 EPC), clarity of the claims (Art. 84 EPC) and inventive step (Art. 56 EPC). That decision was cited in **T 862/11**, in which the board addressed the relevance of the technical effect for the purposes of Art. 83 EPC and concluded that a distinction had to be made between how the effect was to be considered in that context and how it was to be considered for the purposes of Art. 56 EPC (see **T 2210/16** for an analysis of these decisions). On the relationship between an objection under Art. 56 EPC and one under Art. 83 EPC, see also **T 1099/16** (use of a known compound performing a new function), in which it was held, in line with **G 1/03**, that, if an effect is expressed in a claim [as in the case in hand, adhesion enhancer], there is a lack of sufficient disclosure [which was not a ground for opposition in the case in hand]. Otherwise, i.e. if the effect is not expressed in a claim but is part of the problem to be solved, there is a problem of inventive step. (Confirmed again by **T 1983/19** with reference to **G 1/03**).

T 206/13 also applied **T 2001/12**, in so far as the examining division, in the context of the assessment of sufficiency of disclosure of claims 1 and 11, had referred to technical aspects which, in its opinion, were not sufficiently disclosed. The board pointed out that these technical aspects were not defined in claims 1 and 11 and, consequently, were not to be considered in the assessment under Art. 83 EPC of the invention defined in claims 1 and 11. The requirement of sufficiency of disclosure related to the invention defined in the claims, and in particular to the combination of structural and functional features of the claimed invention, and there was no legal basis for extending such a requirement also to encompass other technical aspects possibly associated with the invention (in particular, technical features or effects mentioned in the description) but not required by the claimed subject-matter. Such technical aspects might be pertinent in the assessment of other requirements of the EPC (in particular, the requirements of Art. 84 and 56 EPC). Decisions cited in **T 2824/19**, in which the board applied the principles of assessing sufficiency of

disclosure underlined by the appellant (opponent), in particular that the expression "invention" in Art. 83 and 100(b) EPC concerned the subject-matter of the claim (citing specifically **T 206/13** and **T 2001/12**).

In **T 1744/14** the problem set out in the contested patent and the effect(s) underlying it were not part of claim 1. The board acknowledged that in e.g. **T 593/09**, the subjective problem to be solved according to the patent, even though not part of the claims, had been taken into account when deciding on sufficiency of disclosure. However, the question in that case was not whether the claimed products objectively actually solved the technical problem, i.e. demonstrated the technical effects mentioned in the patent, but rather whether, in view of the ill-defined parameter present in the claim, products according to the claim could be selected by the skilled person without undue burden, such that a solution to the alleged problem set out in the patent would have been provided. In case **T 1744/14**, however, the skilled person was able to obtain polymorph II as defined in claim 1 without any undue burden. Hence, case **T 1744/14** was different to that underlying **T 593/09**.

In **T 1469/16** the examining division considered that for the main request to comply with Art. 83 EPC, it was necessary that the skilled person, by carrying out the invention, would have achieved the effect of improved coding performance. However, in the board's view the claim 1 did not express such an effect, and the same applied to the other claims of the main request. This meant that if the effect was not achieved over the whole scope of any of the claims, this was not a problem under Art. 83 EPC but might have an impact on the assessment of inventive step (see **T 939/92**, OJ 1996, 309; **G 1/03**, OJ 2004, 413 and **T 862/11**).

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

4.1. The disclosure is aimed at the skilled person

The claimed invention must be sufficiently disclosed as from the effective date of filing of the application. This disclosure is aimed at the person skilled in the art who may rely on common general knowledge to supplement the information contained in the patent. Textbooks and general technical literature form part of the common general knowledge, which however does not normally include scientific articles and patent literature.

The same level of skill has to be applied when, for the same invention, the two questions of sufficient disclosure and inventive step are being considered (**T 60/89**, OJ 1992, 268(discussion of the skilled person's level of skill); **T 694/92**, **T 187/93**, **T 412/93**). However, the standard of disclosure required for amendments by Art. 123(2) EPC 1973, namely that of being directly and unambiguously derivable, is inappropriate, the criterion being that it must be possible to reproduce the invention on the basis of the original application documents without any inventive effort and undue burden (**T 629/05**; cited in **T 79/08**).

It is the **same skilled person** that has to be considered when construing the subject-matter of a claim. It accordingly follows that the construction of a particular claim should be identical for the assessment of inventive step and sufficiency of disclosure (**T 967/09**). Reiterated and explained again in **T 2164/21** that the common general knowledge of the skilled person is taken to be one and the same in the assessment of inventive step and sufficiency of disclosure.

The skilled person may **use his common general knowledge to supplement the information** contained in the application (**T 206/83**, OJ 1987, 5; **T 32/85**, **T 51/87**, OJ 1991, 177; **T 212/88**, OJ 1992, 28; **T 772/89**). An error in the description is immaterial to the sufficiency of the disclosure if the skilled person can recognise and rectify it using his common general knowledge (**T 206/83**, OJ 1987, 5; **T 171/84**, OJ 1986, 95; **T 226/85**, OJ 1988, 336). Textbooks and general technical literature form part of the common general knowledge (**T 171/84**, **T 51/87**, **T 580/88**, **T 772/89**). Common general knowledge does not normally include patent literature and scientific articles (see **T 766/91**, point 8.2 of the Reasons; **T 1253/04**, point 10 of the Reasons; see also **T 59/18** and **T 1782/21**, in which a single patent was relied on and which refers to **T 412/09** (series of patents); **T 477/18**). Information which can only be obtained after a comprehensive search is likewise not to be regarded as part of the common general knowledge (see also **T 206/83,** JO 1987, 5;**T 654/90**; **T 66/07**). According to the board in **T 475/88**, a disputed claim of common general knowledge must be backed up by evidence. As a rule, demonstrating that the knowledge in question can be obtained from a textbook or monograph will be sufficient.

Common general knowledge is represented by basic handbooks and textbooks on the subject in question; it does not normally include patent literature and scientific articles (**T 2059/13**, point 4.5.1 of the Reasons summarising the established jurisprudence and quoting **T 766/91** and **T 1253/04**).

In **T 2704/18** the board dealt in detail with the part played by the skilled person in the assessment under Art. 83 EPC and reiterated that they could supplement the information in the application (gathered from evaluating the claims, description and drawings) with common general knowledge and could also correct any errors identified (see **T 169/83**, **T 206/83** and **T 629/05**).

In **T 603/22** the board examined the admittance of D23, which had been submitted to establish that the article D6 was an extract from a general chemical journal and should be considered part of the skilled person's common general knowledge. In view of the nature of the document and the reasons given for filing it at the appeal stage, the board admitted D23 into the proceedings under Art. 12(4) and (6) RPBA.

In ex parte **T 553/10** the board pointed out that the passages cited by the appellant disclosed a method for producing lithium nickel manganese cobalt oxides, some of which came under the scope of claim 1. An additional method step essential for preparing oxides covered by the scope of claim 1 was missing. The application did not contain enough information, an issue which could not be resolved by invoking the common general

knowledge. A statement by an **employee** of the appellant was therefore of little probative value for establishing the common general knowledge of the skilled person in this case.

In **T 477/18** none of documents A1, A2 and A3 qualified as evidence for common general knowledge. It was further stressed that the skilled person would not have found sufficient information in A2 and A3 to identify a "shape parameter" that would meet the requirements. A2, A3 were scientific papers which could not on their own be considered to provide evidence of common general knowledge and A1 was a guide for engineers; furthermore there was no evidence that document A1 was indeed used or considered in the relevant circles as a reference textbook. In the board's view, documents A4 and A5 might have qualified as evidence for common general knowledge. Both documents were published after the filing date of the patent application. While post-published documents might provide evidence of common general knowledge at earlier dates, this was not generally the case. In the absence of further evidence that relevant sections in A4 and in A5 referred to common general knowledge at the date of filing of the application, A4 (and A5) were not relevant for the issue to be decided. Therefore, in the absence of a clear definition for the concept of shape parameters in the patent specification and in view of the fact that the patentee did not provide evidence that the missing information formed part of the common general knowledge, the skilled person would not have been in a position to reproduce the claimed subject-matter (Art. 83 EPC not satisfied).

In **T 2305/11** the application did not give details of how to determine the essential feature (maximum solubility pressure of at most 1 000 bar), but the board accepted the appellant's argument that the skilled person knew of suitable methods. It nevertheless found that crucial information was missing because the application did not disclose that, in many cases, no maximum could be found, or how to proceed in those cases. No useful guidance could be found in the description, and the appellant had failed to show how the skilled person could use his common general knowledge to fill in the gaps in disclosure or overcome the lack of guidance.

In **T 2004/14** (absorbent article), the board decided that, in the absence of any indication in the patent in regard to the method (and the test conditions) of determining the absorption capacity, the skilled person would not be able to reliably and repeatedly determine the crucial condition set out in claim 1. The blotter-method was not the only applicable test known by the skilled person and, even if it were, at least the value for the draining pressure to be applied in order to expel interstitial fluids would still be lacking. That, allegedly twenty-four patent publications disclosed the blotter-method did not convince the board since these patents were solely from two corporations. Moreover, it was likely that they would, when applying such a non-standardised blotter-method, perform the test under different conditions, which was exactly what standards aimed to avoid.

In accordance with the established case law (see e.g. **T 206/83**, **T 1040/03**), a detailed disclosure is not necessary if the skilled person, who has common general knowledge at his immediate disposal, is capable of putting the invention into practice without the burden of exercising inventive skill. This principle obviously extends to all variants encompassed by a claim (**T 1018/05**, cited also in **T 2301/12** in respect of variants clearly outside the

scope of practical application of the claimed subject-matter and values of a parameter not obtainable).

The patent must provide guidance enabling the skilled person to identify the process features decisive in **overcoming a prejudice**. The skilled person should not have to work this out himself (**T 419/12**).

In **T 377/17** the board held that the case law since **T 171/84** and **T 206/83** had clearly answered the question what sources of information were to be considered for the purposes of Art. 83 EPC, namely only the patent specification (including any sources cited in it) and common general knowledge, i.e. the knowledge potentially available to any skilled person in the field. This did not include **secret know-how** of individual makers of aerated concreted. How a head of a laboratory would have used such inside know-how to determine or correct parameters either not or inaccurately referred to in the patent specification was thus irrelevant in establishing whether the conditions of Art. 83 EPC were met (the board refused to order an independent expert opinion). The board also refused a request for referral of a question to the Enlarged Board, reiterating on this occasion what was meant by "skilled person" (point 9 of the Reasons).

T 1861/11 concerned an invention relating to user interfaces. The appellant (applicant) chose to disclose the invention by means of a conceptual metaphor, a so-called "3D motion user interface", and the relevant disclosure was very brief. In the circumstances of the case, the board decided that details that the skilled person would need were not disclosed (Art. 83 EPC not satisfied). Moreover, as a matter of principle, a deficiency in disclosure concerning the conceptual fundamentals of the invention could not be remedied without violating the restrictions codified in Art. 123(2) EPC.

Patent specifications cannot normally contribute to the sufficiency of the disclosure unless they are available to the skilled reader of the patent in question (**T 171/84**, OJ 1986, 95). By way of exception, however, patent specifications and scientific publications may be considered to form part of the common general knowledge where the invention is in a field of research so new that the relevant technical knowledge is not yet available from textbooks (**T 51/87**, OJ 1991, 177; see also **T 772/89**, **T 676/94**, **T 1900/08**, **T 2196/15**). In **T 676/94** the board considered that the question whether or not the contents of a technical periodical formed part of the average knowledge of a skilled person when assessing sufficiency of disclosure, should be answered on the basis of the facts and evidence in each particular case.

In **T 1782/21** (vein and skin patterns - biometric information processing device, the application did not provide any information on how to extract from a single image two biometric patterns formed at the surface of a living body and subcutaneoulsy. Sufficiency of disclosure hinged on the common general knowledge. The board looked at various documents submitted by the patent proprietor (in particular D8; see points 10 and 11 of the Reasons) to establish whether they filled the knowledge gaps and demonstrated the common general knowledge. D7 and D8 did not disclose enough information in general, let alone in terms of whether they could be taken as evidence of the common general knowledge. The board noted, with reference to **T 412/09** (series of patent publications)

that D10 was not a "series" and did not present the method in question as commonly known but as an invention made at the time.

References to DVB standards were found insufficient to meet the standards of Art. 83 EPC in **T 1191/04**. In **T 417/13** the size of the PVC particles was an important feature. The particle size may vary to a large extent depending on the method of measurement. The description of the application provided only very limited information. The person skilled in the art had thus to rely on his common general knowledge for the selection of an appropriate method of measurement. The board concluded that in the present case of PVC particles the skilled person would not have considered using any method of measurement, but would have chosen a method relying on sieving, such as a method according to ISO standard 1624. It was also decided that in this case the physical and mathematical facts about particle size measurements were notorious.

In **T 1608/13** the board noted that a patent document is directed to the skilled person, who interprets it in the light of the common general knowledge in the technical field concerned. Consequently, it is not necessary for all the details of the invention to be specifically described in order for a disclosure to be sufficient. In the present case, in the absence of a description in the patent of a specific measuring method for determining the sieving coefficient of a membrane for the separation of toxic mediators from blood by haemofiltration, the skilled person would first look for applicable standards in the field, if present. Whether other methods for carrying out the measurements were available was not decisive as long as there was no evidence that the results in the specific field of the invention would be contradictory depending on the chosen method. The respondent (opponent) did not provide any such evidence.

In **T 521/12** claim 1 could be given different interpretations, in particular, with respect to the relationship between the features of the claim preamble and the features recited in the characterising part. However, as the only issue was sufficiency of disclosure, an interpretation of the claim wording was required only as far as it was relevant for deciding whether Art. 83 EPC was complied with. It was therefore implicit, in the board's view, that the expression "portion of electronic information" in feature (g) could not cover any possible type and format of electronically stored data, but was to be given a meaningful interpretation determined by the function it was expected to perform in the context of the claimed subject-matter. The skilled person wishing to implement the claimed invention would therefore exclude as meaningless and not consistent with the teaching of the application any type of "electronic information" which because of its content and/or format was irrelevant, or unsuitable.

T 658/04 summarised the case law about what forms part of the common general knowledge. The board considered that an expert opinion submitted by the appellant (patent proprietor) which contained general considerations (not supported by verifiable facts) did not form part of the common general knowledge (see also chapter I.C.2.8.1 "Definition of common general knowledge"). See also **T 842/14** (quoting **G 1/92**, OJ 1993, 277), which concerned the requirements that a chemical composition of a commercially available product designated by a trademark in the claim be part of the

common general knowledge of the skilled person; and **T 2196/15** for an example of difficulties in proving the common general knowledge.

In **T 443/11** the board noted that during the course of the proceedings the examining division had argued that claim 1 had to be taken literally. The board disagreed with this statement, since it was established case law of the boards of appeal that claims should be interpreted in the manner that they would be understood by a person skilled in the art. In the context before it the board considered that the skilled person would understand (mathematical operations implemented in electronic devices).

In **T 1516/14** the board stated that the consideration as to whether or not a particular feature distinguished the claimed subject-matter from the prior art, or indeed whether or not it was merely a statement of something that was inherently true, played no role in assessing sufficiency of disclosure. Nor was it for the board to speculate as to why a particular feature was added to the claim in examination proceedings. The **subjective intentions of the patentee** are relevant for the purposes of interpreting the claims only to the extent that these intentions were explicitly formulated in and therefore derivable from the patent specification itself. The board did not rely solely on internal logic or syntax of the claim to arrive at the conclusion that Art. 83 EPC was satisfied; referring a question in this respect to the Enlarged Board was not justified.

In **T 1845/14** the measurement method for determining the short chain branching distribution (SCBD) was defined in claim 1 to be crystallisation analysis fractionation (CRYSTAF®). As regards the disputed SCBD parameter, the board came to the conclusion that determining an SCBD using the CRYSTAF® technique would have been routine for the skilled person in the field in question and that they would have been able to do so, in particular for copolymers prepared in accordance with the synthesis taught in the patent, **ignoring**, in view of their knowledge, the misleading passages of the specification which were manifestly erroneous or unrelated to the determination of the SCBD.

In **T 2133/14** the board stated in its Catchword that "an invention is not insufficiently disclosed in the sense of Art. 83 EPC just because a lack of support in the sense of Art. 84 EPC of a broad claim cannot be resolved by consulting the description". The board observed that the skilled person would have no technical difficulty in implementing a form of interrogation/response-protocol in devices even in a "non-standard scenario" such as a smartphone communicating with a cardiac pacemaker. It also observed that an objection that a claim was too broad to be supported by the description over its full breadth could be addressed by limiting the claim to a breadth which was.

See also **T 383/14** (sorting table for grape harvest) in chapter II.C.6.6.1.

4.2. References may also enable the skilled person to carry out an invention

It is established case law that features not mentioned in the application documents themselves but in a document to which they refer may be incorporated into a patent claim if they unequivocally form part of the invention for which protection is sought. However, all the essential structural features thus disclosed which belong together must be

incorporated into the claim; it is not permissible to single out a particular one (**T 6/84**, OJ 1985, 238; cited in numerous decisions).

In **T 288/84** (OJ 1986, 128), the board held that where an invention relates to the improvement of prior art originally cited in the description of the invention, a feature described in broad terms in the cited document but not mentioned expressly in the invention is sufficiently disclosed if it is realised in the examples of the invention in the form of an embodiment also mentioned in the reference document.

An invention is also sufficiently disclosed if reference is made to another document in the patent specification and the original description, and the skilled person can obtain from this cross-reference the information required to reproduce the invention but not disclosed in so many words in the description itself (**T 267/91**, **T 611/89**). In **T 920/92** the board held that this applied irrespective of the language in which it was drafted; (here Japanese).

However, where the reference document was possibly short-lived advertising material, the applicant was wise to incorporate the published information explicitly rather than by mere reference (**T 211/83**, cited in **T 276/99**).

In **T 737/90** it was explicitly stated that a reference to another document can only be taken into account if the document referred to can be unambiguously identified and the relevant addressees have ready access to it. This depends solely on the facts of the case. Following **T 737/90**, the board in **T 429/96** confirmed that a document incorporated by reference into the text of a European patent application had to become available to the public at the latest on the **publication date** and not on the **filing date** of the European patent application, in order to be taken into account for the purposes of Art. 83 EPC 1973.

The enabling disclosure of the invention in **T 521/10** relied on the content of (US) patent applications incorporated by reference which did not fulfil the requirements set out in **T 737/90**. In order to be validly incorporated, each document must: (i) be available to the Office on or before the date of filing of the application; and (ii) be available to the public no later than on the date of publication of the application under Art. 93 EPC. As neither of the two documents was made available to the public and the only publication originating from the two documents was a continuation-in-part application which was published on a date later than the publication date of the European application at issue, the two documents were not validly incorporated by reference.

In **T 341/04** the question was whether a referenced document, which could be unambiguously identified at the date of filing of the document containing the reference by its document number, but which document itself was "missing" in the sense that it was not available at said date of filing, could be "taken into account" for the purpose of Art. 83 EPC 1973 by relying on information present in a family member of the referenced document. The board answered in the affirmative.

5. Clarity and completeness of disclosure

5.1. General principles

A European patent should provide enough information so that a person skilled in the art can understand and put into practice the claimed technical teaching of the invention on the basis of their **common general knowledge**. According to established case law of the boards of appeal, the disclosure of a patent or patent application should allow a person skilled in the art to successfully perform the claimed invention on the relevant filing date over the whole claimed scope. The disclosure of one embodiment may be sufficient if it allows the desired effect to be obtained without undue burden and with the desired certainty, over the whole claimed scope. In this regard, it is immaterial if some failures occur or some variants are unworkable. The sufficiency of disclosure is a question of fact that must be decided on case-by-case basis. What matters is that, on the relevant date, the average skilled person familiar with the disclosure should be able to perform the claimed invention in line with the inherent technical teaching and produce the claimed subject-matter (**T 1173/00**, OJ 2004, 16, point 3.2 of the Reasons, which, among other things, summarises the case law, with reference to key decisions, namely **T 409/91**, points 2 and 3.5 of the Reasons; **T 435/91**, point 2.2.1 of the Reasons; **T 292/85**, points 3.1.2 and 3.1.5 of the Reasons; **T 612/92**, points 12 and 13 of the Reasons).

The applicable case law is also summarised for example in the more recent decisions **T 2046/19**, **T 867/21**, **T 1298/21**, **T 548/22** and **T 552/22**, and **T 1977/22** (review and analysis of all landmark decisions).

The patent monopoly should be justified by the invention's technical contribution to the art (**T 409/91**, OJ 1994, 653; **T 435/91**, OJ 1995, 188). The need for a fair protection governs both the considerations of the scope of claims and of the requirements for sufficient disclosure (**T 292/85**, OJ 1989, 275).

Where an applicant did not furnish details of the production process in the description in order to prevent the invention from being copied easily and the missing information could not be supplied from the general knowledge of a person skilled in the art, the invention was held to be insufficiently disclosed (**T 219/85**, OJ 1986, 376). In ex parte case **T 219/85** the invention related to a method for treating a gemstone to provide it with an inscription on one facet. The alleged difference between the method and the prior art giving rise to the different result was expressed simply by the indication "under conditions such". On the other hand, in **T 2253/12** the board explained that there was no need for an exhaustive description of generally known technical details to be implemented according to the invention, if such an implementation did not require any undue burden because it was well within the competence of the skilled person (common general knowledge of the skilled person is **to be duly taken into account**).

Compare this chapter II.C.5. with chapter II.C.7. in the field of biotechnology.

Note that for the chapters below the more recent case law contains numerous decisions that have had to address the interaction between the requirement to disclose at least one

way of performing the invention and whether the invention can be performed over its whole scope (for example **T 2046/19**, **T 867/21**, **T 1298/21**, **T 548/22** and **T 552/22**), particularly in light of the technical fields in some cases. This issue of whether the technical field has a bearing on the findings has also been discussed and addressed in the following decisions: **T 2773/18**; **T 500/20**; **T 1983/19**; **T 149/21**; **T 447/22**; **T 174/21**; **T 748/19**.

5.2. Indication of at least 'one way'

An invention is in principle sufficiently disclosed if at least one way is clearly indicated enabling the person skilled in the art to carry out the invention (**T 292/85**, OJ 1989, 275).

The disclosure of one way of performing the invention is only sufficient if it allows the invention to be performed in the whole range claimed (**T 409/91** (OJ 1994, 653), see also **T 1173/00** (OJ JO 2004, 16 point 3.2 of the Reasons), **T 2172/15**, **T 2046/19**, **T 867/21** (see Catchword), **T 174/21**, **T 1298/21** (single experimental set-up sufficient, by contrast to in **T 149/21**), **T 552/22**).

For sufficiency of disclosure (Art. 100(b) and 83 EPC), the board has to be satisfied firstly that the patent specification certainly puts the skilled person in possession of at least one way of putting the claimed invention into practice, and secondly that the skilled person can put the invention into practice over the whole scope of the claim. If the board is not satisfied on the first point that one way exists, the second point need not be considered (**T 792/00**, Catchword).

Disclosing one way of performing the invention may be sufficient as long as this one way also covers the whole claimed scope when combined with the common general knowledge (**T 867/21**).

The question whether the disclosure of one way of performing the invention is sufficient to enable a person skilled in the art to carry out the invention in the **whole claimed range** is a **question of fact** that must be answered on the basis of the available evidence, and on the balance of probabilities in each individual case (**T 409/91**, OJ 1994, 653 – point 3.5 of the Reasons, more recently for example **T 2038/19**).

The findings of decision **T 292/85** (OJ 1989, 275) in relation to possible **variants** for a functional definition (see in particular chapter II.C.5.4a)) have been summarised and applied in later case law, for example in the following key decisions: **T 238/88** (OJ 1992, 709, point 4.1 of the Reasons: "At least one way of carrying out the invention should be described in detail. The disclosure need not include specific instructions as to how all possible component variants could be obtained, as long as …"); **T 60/89** (OJ 1992, 268, point 2.2.7 of the Reasons: it is not necessary that each and every variant can be carried out); **T 19/90** (OJ 1990, 476, Onco-Mouse, fourth part, "consistent approach", and points 3.3, 3.7 and 3.8 of the Reasons); **T 354/97**; **T 1173/00** (OJ 2004, 16, point 3.2 of the Reasons with reference to **T 409/91**; **T 435/91**; **T 292/85** and **T 612/92**); **T 986/21** ("... need not include specific instructions as to how all possible component variants ... should be obtained").

The board in **T 740/90** deemed the reference to **T 292/85** to be inappropriate because the invention in **T 740/90** was defined by parameters rather than in functional terms. It was thus defined clearly, and the only possible variants were in the necessary starting materials for preparing the yeasts covered by the claim. The EPC did not stipulate that various ways of performing the invention had to be described (R. 27(1)(e) EPC). All that mattered in the context of Art. 83 EPC was whether the description included one way of preparing a yeast as described in the claim that a person skilled in the art could reproduce.

The mere fact that only one way of carrying out the invention is indicated does not in itself offer grounds for considering that the application is not entitled to broader claims (**T 242/92**, see also **T 19/90** point 3.3 of the Reasons: "Only if there are serious doubts…"). No concrete evidence was available that the skilled person would be unable to extend the particular teaching of the description to a broader field by using routine methods. In view of the contribution to the art by the present applicant it would be unjustified, in the absence of well-founded reasons, to restrict the claims to the specifically exemplified embodiment (ex parte case **T 242/92**, issues of Art. 84 and Art. 83 EPC considered by the board).

In **T 2046/19** both the opposition division and the respondent (patent proprietor) reasoned that the criterion of sufficiency of disclosure had already been met because the example disclosed one way of performing the invention. The board did not share this view, stating that the established case law meant that the person skilled in the art must be enabled to find working embodiments over the claimed range with reasonable effort. More technical details and more examples may be necessary to support claims of a broad scope (as in the present instance, where the desired result was only defined as a desideratum or result to be achieved). Thus, it must also be considered whether the patent's disclosure allows the person skilled in the art to work over the whole ambit of the claim without undue burden.

In **T 500/20** the board explained that in claimed inventions that did not involve a range of parameter values or compositions, basing an argument of insufficiency on the approach that the invention would not be sufficiently disclosed across the entire breadth of the claim was inappropriate and could be rejected. This was especially so where an invention was directed at a broadly defined concept expressed in terms of generic structural or functional features of an apparatus or of a method. There it normally sufficed to provide a single detailed example or embodiment to illustrate how this concept could be put into practice in such a way that the underlying principles could be understood by the relevant skilled person to the extent that they could reproduce the claimed invention using their common general knowledge without undue burden (decision dealt with in details in this chapter II.C.5.4d)).

In **T 149/21**, the board agreed that the contested patent detailed at least one way of performing the claimed invention and thus satisfied at least R. 42(1)(e) EPC. According to the established case law of the boards of appeal, however, the claimed invention had to be reproducible over the whole claimed scope. It was thus essential to disclose at least **one way** of performing the claimed invention, but this was **not sufficient** to satisfy the requirement of Art. 83 EPC.

In **T 1298/21** a single experimental set-up was sufficient, **in contrast to** the case in **T 149/21**, where the claimed method had explicitly to be able to identify and deal with even unscheduled incidents ("unplanned rolling pause on account of a failure").

In **T 1809/17** the opponent argued that claim 1 was insufficiently disclosed in that it did not specify all essential features. For the board, however, the crucial point was not whether the independent claim defined all essential features but rather whether the patent specification as a whole provided the skilled person with at least one workable example of how the claimed invention could be implemented.

5.3. Examples

Whether or not the disclosure of the patent in suit is sufficiently clear and complete within the meaning of Art. 100(b) and 83 EPC must be decided by appraising the information contained in the examples as well as other parts of the description in the light of the common general knowledge of the skilled person at the priority date (**T 322/93** and **T 524/01**).

However, where the application disclosed the claimed invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art, it then necessarily disclosed at least one way of carrying out the invention disclosed in accordance with R. 42(1)(e) EPC, with the necessary details being derivable from the description including the prior art referred to therein (see e.g. **T 389/87**, **T 561/96** and **T 990/07**). The board in **T 990/07** pointed out that in cases where examples were not indispensable, their omission did not contravene R. 27(1)(e) EPC 1973 (R. 42(1)(e) EPC). This rule only required the insertion of such examples "where appropriate". The jurisprudence of the boards of appeal thus drew a clear distinction between the concepts of "way of carrying out the invention claimed" and "examples" referred to in R. 27(1)(e) EPC 1973. According to this jurisprudence, the detailed description of one way of carrying out the invention claimed had to be interpreted in the light of Art. 83 EPC. It constituted a condition to be met by the description as a whole and was clearly mandatory. In contrast, the presence of examples would only be indispensable if the description would otherwise not be sufficient to meet this requirement. Hence, the purpose of the "examples" evoked in R. 27(1)(e) EPC 1973 appeared primarily to be to complete an otherwise incomplete teaching. See also **T 1918/07**, **T 1169/08** and **T 721/16**, which state that examples did not need to be present in order to satisfy the requirement of sufficient disclosure).

In **T 671/05** the board decided that the amount of technical detail needed for sufficient disclosure was a matter which depended on an assessment of the facts of each particular case, such as the character of the technical field and the actual technical detail disclosed.

As for the further objection of a lack of a specific embodiment, the case law has it that the detailed description of one way of carrying out the claimed invention had to be interpreted in the light of Art. 83 EPC. This constituted a condition to be met by the description as a whole. In contrast, the presence of examples would only be indispensable if the description would not otherwise be sufficient to meet this requirement (**T 2794/17**).

The board in **T 698/18** stated that the application did not contain any embodiment corresponding to the claim's definition, but this alone could not justify the refusal of the application, since the purpose of the "examples" evoked in R. 27(1)(e) EPC 1973 appeared primarily to be to complete an otherwise incomplete teaching and that the application cannot be refused under this provision if the description is considered to describe, despite the [...] lack of examples actually embodying the invention, one way of carrying out the invention (**T 990/07**, Headnote and point 3 of the Reasons). The issue to be decided was whether the application was actually sufficiently complete, despite the absence of concrete embodiments, to allow the skilled person to carry out the claimed invention.

In **T 226/85** (OJ 1988, 336), **T 409/91** (OJ 1994, 653) and **T 694/92** (OJ 1997, 408) the patent or the patent application disclosed only one or very few ways of carrying out the invention. In each of these decisions the boards had held that the disclosure of the specific examples was not sufficient to enable the invention to be carried out as claimed. However, according to **T 617/07**, no principle could be deduced from these decisions that sufficiency of disclosure is always to be denied if there is only example of carrying out an invention. Rather all three decisions emphasised that an objection of lack of sufficiency of disclosure (i) presupposes that there are serious doubts, substantiated by verifiable facts, and (ii) depends on the evidence available in each case whether or not a claimed invention can be considered as enabled on the basis of the disclosure of one worked example.

This approach was confirmed in the more recent decision **T 360/18**, which stated the following. As set out in **T 617/07**, sufficiency of disclosure is not always to be denied **if there is only one example** of carrying out an invention. Rather, an objection of lack of sufficient disclosure (i) presupposes that there are serious doubts, substantiated by verifiable facts, and (ii) depends on the evidence available. In the case at issue, the board was not presented with any verifiable facts that could support the respondent's (opponent's) arguments that the claimed invention could not be put into practice. Nor had the respondent furnished any evidence to refute the appellant's assertion that all the claimed embodiments were stable. The opposition division concluded that the results disclosed in the patent were to be considered contradictory, meaning that a person skilled in the art would have to undertake a research programme to work out for themselves which fibrinogen formulations out of a whole host of possible combinations of divalent metal ions and complexing agents had the desired stability. However, the board did not agree as there were no discernible inconsistencies in the data presented in the patent. Furthermore, the patent pointed to preferred embodiments that were to be considered in the event of any failures.

In **T 721/16** the patent was revoked by the opposition division. The objection of lack of sufficiency of disclosure related to the measurement of parameters defining the polyvinylpyrrolidone powder compositions. The board stated that the difficulty in providing an exact repetition of the examples of the patent in suit was in the case in hand not decisive for concluding a lack of sufficiency of disclosure of the claimed invention and could be left unanswered. It is the sufficiency of disclosure of the combination of technical features of the invention, i.e. as defined by the terms of the claims (see R. 43(1) EPC), which has to

be assessed and not that of the specific exemplified embodiments, which were not in the case in hand the subject-matter of a claim.

In **T 1884/19** the appellant argued a lack of sufficiency of example 7 having regard to an alleged inconsistency between that example and comparative example 2. The board stated that it was however not explained why such an inconsistency would hinder the skilled person from repeating the example on the basis of its description. Furthermore, it was the sufficiency of disclosure of the combination of technical features of the invention, i.e. as defined by the terms of the claims (R. 43(1) EPC), which had to be assessed and not that of an exemplified embodiment, which was not in the present case the subject-matter of a claim. In the absence of any submission by the appellant as to why a lack of reproducibility concerning one example of the patent would result in an insufficient disclosure without addressing the teaching of the patent in suit **as a whole**, including its numerous additional examples, this argument did not convince either (about **T 1884/19**, see also below under chapter II.C.5.5.1a) "Essential parameters").

In **T 2242/16** the appellant (patent proprietor) took the view, based on **T 665/90**, that proving the alleged lack of enablement would have required reproducing an example of the patent in exactly the same way. The board decided that there could be no such requirement in the case in hand, finding that, at least according to the patent's teaching, the precise approach taken in the example was not crucial. The board referred to a number of other decisions (**T 740/90**, **T 406/91**, **T 1712/09**) and to the established case law reported in chapter II.C.5.4. (see a summary of the findings of **T 226/85** and **T 2242/16** in **T 956/21**).

See also **T 500/20** (chapter II.C.5.4d)) in the field of mechanical engineering, stating (Catchword and point 3.6 of the Reasons): in claimed inventions that do not involve a range of parameter values or compositions but are directed at a concept expressed in terms of generic structural or functional features of an apparatus or of a method, it is not enough to demonstrate insufficiency to conceive of an example that falls within the terms of the claim that does not work because it does not achieve the claimed effect fully or at all so that therefore the invention would not be sufficiently disclosed across the entire breadth of the claim.

Decision **T 3178/19** provides an illustration of a case where one single example was not sufficient. The patent provided only one single example exhibiting all the claimed features. The respondent/proprietor cited **T 226/85** to argue that one single example was sufficient, but the board was not convinced. Neither the specification nor the common general knowledge provided adequate instructions for leading the skilled person necessarily and directly towards success over the broad scope of the claim through the evaluation of initial failures or through an acceptable statistical expectation rate in case of random experiments. The opposed patent provided a number of examples for making a resistor with a sintered body from a mixture according to features (b), (c) and (j), but was silent about the specific manufacturing steps. The passages indicated by the respondent did not provide the missing information.

5.4. Invention to be performed over the whole scope claimed

It is established jurisprudence of the boards of appeal that an invention is sufficiently disclosed if it can be performed by a person skilled in the art **without undue burden** in the **whole area claimed**, using common general knowledge and taking into account further information given in the description of the patent or patent application. (Principle recalled for example in **T 518/10**, older case law already stating this principle includes **T 409/91**, OJ 1994, 653; **T 435/91**, OJ 1995, 188).

As already reminded under the present chapter II.C.5.2. "Indication of at least 'one way'", according to the established jurisprudence of the boards of appeal, the disclosure of one way of performing the invention is only sufficient if it allows the invention to be performed in the whole scope claimed (**T 409/91** (using the expression whole range claimed), see also for some other recent examples **T 867/21**, **T 552/22**, and **T 500/20**). This is a question of fact that must be answered on the basis of the available evidence, and on the balance of probabilities in each individual case (**T 409/91**, more recently for example **T 2038/19**). In the cases **T 409/91** and **T 435/91**, it was readily apparent from the teachings provided in the specification of the patents in question that the invention as claimed would not be reworkable over its whole scope (**T 354/97**).

For sufficiency of disclosure (Art. 100(b) and 83 EPC), the board has to be satisfied firstly that the patent specification certainly puts the skilled person in possession of at least one way of putting the claimed invention into practice, and secondly that the skilled person can put the invention into practice over the whole scope of the claim. If the board is not satisfied on the first point that one way exists, the second point need not be considered (**T 792/00,** Catchword). In addition to the requirement that the patent specification shows the skilled person at least one way of performing the claimed invention, there is also the issue of reproducibility over the whole claimed scope (summary of the findings of **T 792/00** by **T 2242/16**).

The mere absence of an embodiment is not sufficient evidence that the invention cannot be performed over the whole range claimed (**T 873/22** summarising the contribution of **T 500/20** (wind turbine), point 3.6 of the Reasons). See also chapter II.C.5.3.

The following chapters organise the case law by topic to highlight some of the most common issues addressed by the boards in the case law. These topics are not necessarily completely unconnected, and some cases may appear in several chapters. Recent decision **T 1977/22** reviewed in detail the case law and landmark decisions about open-ended ranges, and reproducibility over the whole claimed scope.

See also chapter II.C.5.4., and chapter II.C.7.1.2 in the field of biotechnology.

a) Invention defined by its function - variants – technical concept fit for generalisation – broad claims

The disclosure of an invention relating to a composition of matter, a component of which is defined by its function, is not sufficient if the patent discloses only isolated examples but

fails to disclose, taking into account if necessary the relevant common general knowledge, any **technical concept fit for generalisation** which would enable the skilled person to achieve the envisaged result without undue difficulty within the whole ambit of the claim containing the 'functional definition'. Each case has to be decided on the basis of the facts at hand (**T 435/91** OJ 1995, 188, Headnote and point 2.2.1 of the Reasons). The board also specified that there cannot, of course, be a clear-cut answer to the question of **how many details** in a specification are required in order to allow its reduction to practice within the comprehensive whole ambit of the claim, since this question can only be decided on the basis of the facts of each individual case.

Decision **T 435/91** (OJ 1995, 188) related to a claim whose composition comprised a component which was defined only by its function; one of claim 1 essential technical features, the "additive" was defined only by its function. It had to be established whether the description disclosed one way of performing the invention or rather a technical concept fit for generalisation which makes available to the skilled person the host of **variants** encompassed by the "functional" definition of said claim (see point 2.2.1 of the Reasons).

As explained in **T 292/85** (OJ 1989, 275), the need for a fair protection governs both the considerations of the scope of claims and of the requirements for sufficient disclosure. Unless variants of components are also embraced in the claims, which are, now or later on, equally suitable to achieve the same effect in a manner which could not have been envisaged without the invention, the protection provided by the patent would be ineffectual. Thus, it is the view of the board that an invention is sufficiently disclosed if at least one way is clearly indicated enabling the skilled person to carry out the invention. Consequently, any non-availability of **some particular variants** of a functionally defined component feature of the invention is **immaterial to sufficiency as long as** there are suitable variants known to the skilled person through the disclosure or common general knowledge, which provide the same effect for the invention. The disclosure need not include specific instructions as to how all possible component variants within the functional definition should be obtained (**T 292/85**, point 3.1.5 of the Reasons).

In relation to variants, **T 292/85** is cited and repeated by, for example: **T 81/87** (OJ 1990, 250); **T 301/87** (OJ 1990, 335, point 4.3 of the Reasons) and **T 212/88** (OJ 1992, 28, point 3.3 of the Reasons) with reference to **T 281/86**; **T 238/88** (OJ 1992, 709, point 4.1 of the Reasons); **T 60/89** (OJ 1992, 268; in this case, the common general knowledge did not allow any variants to be found); **T 19/90** (OJ 1990, 476); **T 740/90**; **T 456/91**; **T 242/92**; **T 1173/00** (OJ 2004, 16); **T 986/21**.

In **T 740/90**, the opponent invoked decision **T 292/85** to support its assertion of insufficient disclosure. The board stated that decision **T 292/85** related to an invention of which one component, defined in functional terms, was such that either some particular variants were unavailable or some unspecified variants were unsuitable. The board held that the disclosure was sufficient since the skilled person was aware, owing to the disclosure of the invention or the common general knowledge in their field, of appropriate variants that produced the same effect for the invention. The board in **T 292/85** also stated, however, that the disclosure did not need to include specific instructions as to how to obtain all possible component variants within the functional definition.

In **T 206/83** (OJ 1987, 5), the disclosure of a method that allowed only some members of the claimed class of chemical compositions to be obtained was not deemed sufficient for the purposes of Art. 83 EPC (decision referred to in **T 409/91**).

The disclosure of an invention is deemed sufficient if the skilled person can obtain substantially **all** the embodiments falling within the ambit of the claims (**T 409/91**).

The criteria for determining if the invention is disclosed in a manner sufficiently clear and complete are **applicable to any invention, irrespective of the way in which it is defined**. Therefore, it is immaterial whether or not the invention is defined by a **functional** feature (**T 435/91**, OJ 1995, 188, point 2.2.1 of the Reasons; **T 1121/03**, point 3.1 of the Reasons; **T 2172/15**, reiterated more recently in **T 1311/22**, for example, which also repeats the provisions applicable to functional features, including the interaction between different aspects, particularly with reference to chapter II.A.3.5.).

The peculiarity of the functional definition of a technical feature resides in the fact that it is defined by means of its effect. That mode of definition comprises an indefinite and abstract host of possible alternatives, which is acceptable as long as all alternatives are available and achieve the desired result; it therefore has to be established whether or not the patent discloses a technical **concept fit for generalisation** which makes the host of variants encompassed by the functional definition available to the skilled person (**T 1121/03** (no technical concept fit for generalisation – undue burden in carrying out the invention over the whole scope claimed – research programme) and **T 369/05**; **T 671/05** (several considerations on the use of functional features); **T 2128/13**; **T 552/22**; (includes an overview of the case law on functional features), **T 1311/22** (reference also made to the concept of technical contribution)).

A functional definition is acceptable if all alternatives are available and achieve the desired result. For functional definitions of a technical feature, it has to be established whether or not the patent application discloses a technical concept fit for generalisation which made the host of variants encompassed by the functional definition available to the skilled person (**T 552/22**).

The disclosure of one way of performing an invention is only sufficient if it allows the invention to be performed substantially within the whole range claimed. In other words, sufficiency of disclosure presupposes that the skilled person is able to obtain substantially **all** embodiments falling within the ambit of a claim. This principle applies to any invention irrespective of the way in which it is defined, be it by way of a functional feature or not (**T 2172/15**). In **T 2172/15** contrary to the respondent's (patent proprietor's) view, there was no concept fit for generalisation.

With respect to a claimed process defined in a functional manner, i.e. by its outcome, the board in **T 1051/09** concluded that what was lacking was a generalisable teaching applicable within the scope of the claims, i.e. beyond the specific examples.

The board in **T 2038/19** (water absorbent resin particles) stated by explicit reference to principles laid down in **T 435/91** (functional definition of a component) that it was

established case law that the same principle applied when the claim contained a parametric definition and when the subject-matter could not be expressed only in terms of structural feature.

In **T 500/20** the board explained that in claimed inventions that did not involve a range of parameter values or compositions but were directed at a concept expressed in terms of generic structural or functional features of an apparatus or of a method, it was not enough to demonstrate insufficiency to conceive of an example that fell within the terms of the claim that did not work because it did not achieve the claimed effect fully or at all so that therefore the invention would not be sufficiently disclosed across the entire breadth of the claim.

The mere fact that a claim is broad is not in itself a ground for not considering the claimed invention to be sufficiently disclosed (**T 19/90** (OJ 1990, 476 point 3.3 of the Reasons), see also as example **T 2224/08**, **T 447/22**).

In **T 817/11** (cured coatings exhibiting surface enrichment), as the definition of components a) to c) was **very broad**, the subject-matter defined in granted claim 1 encompassed a **huge variety** of possible combinations. That all possible combinations of components a) to c) according to granted claim 1, in any amount, necessarily led to surface enrichment was neither credible, nor was it ever argued during the proceedings, during which the appellant (patent proprietor) even agreed that such was not the case. Therefore, it had to be assessed whether the patent in suit had disclosed a technical concept fit for generalisation that made available to the skilled person the specific combinations (out of the many possibilities encompassed by the subject-matter of claim 1) that did lead to surface enrichment. In other words, whether the skilled person would find sufficient guidance for an appropriate selection of components a) to c) in order to prepare, with a good chance of success, a cured coating exhibiting surface enrichment. **In view of the broad scope** of the claimed subject-matter, it was **not enough** that the patent had provided at least one way of carrying out the invention or that some combinations would achieve the required surface enrichment. The skilled person wanting to prepare a coating according to granted claim 1 was left with the **task of performing** an elaborate program in order to find out which combination of a) film forming materials, b) particles, c) surface active agent and which preparation conditions should be used. The conclusion was in line with e.g. **T 1121/03** and **T 369/05** since the patent did not provide a technical concept fit for generalisation over the whole scope of the claims.

In **T 1638/11**, sufficiency of disclosure was also objected to by the respondents (opponents) alleging that the excessive broadness of the claim which amounted that the description of the patent in suit did not contain a technical concept fit for generalisation. Thus, as in decisions **T 1121/03** and **T 369/05**, the functional definition given in claim 1 was no more than an invitation to perform a research programme. The board did not agree. **T 1121/03** and **T 369/05** did not apply. The technical concept was illustrated by a large number of possible alternatives which made it fit for generalisation, and this in itself only on the basis of the structural features of claim 1. The ambiguity of the functional feature was rather a question of Art. 84 EPC.

More technical details and more than one example may be necessary in order to support claims of a broad scope (**T 612/92**, **T 694/92**, OJ 1997, 408; **T 187/93**). This must be decided on a case-by-case basis. In **T 694/92** the board held that more than one example might be necessary in order to support claims of a broad scope, in cases where the gist of the claimed invention consisted of the achievement of a given technical effect by known techniques in different areas of application (summarise of contribution **T 694/92** in **T 354/97**). See also **T 435/91**, cited at the beginning of this chapter II.C.5.4a)).

In case **T 596/11**, having regard to the broad scope of the claim, more technical details and more than one example were necessary in order to sufficiently disclose the claimed invention. In decisions **T 792/00** and **T 617/07** it was made clear that the disclosure of an invention was only sufficient in the sense of Art. 83 EPC if the skilled person could reasonably expect that substantially all embodiments falling under the claimed invention, which the skilled person would envisage on the basis of the corresponding disclosure and the relevant common general knowledge, could be put into practice. This was not the case here. The argument that the skilled person would use their general knowledge to supplement the information contained in the application, and the reference to decisions **T 206/83**, **T 32/85**, **T 51/87**, **T 212/88**, **T 580/88**, **T 772/89**, **T 231/92** and **T 818/97** was not persuasive. All these decisions refer to general knowledge which is readily available or to cases where a reference is made in the patent in suit to documents which contain the necessary information or references thereto. This was not the case in the current patent specification. Also these decisions state that no undue burden should be put on the skilled person. The board stated there could be no reasonable expectation in the present case that the broadly claimed mineral materials could be properly dissolved in any acidic aqueous solution, at least not within an appropriate time or in a sufficient amount. The step of dissolving a particulate mineral material in an acidic aqueous solution was central to the invention.

b) Impact of claim interpretation, realistic approach and non-working embodiments

According to **G 1/03** (OJ 2004, 413, point 2.5.2 of the Reasons), if a claim comprises non-working embodiments, this may have different consequences depending on the circumstances. Either there is a large number of conceivable alternatives and the specification contains sufficient information on the relevant criteria for finding appropriate alternatives over the claimed range with reasonable effort. If this is the case, the inclusion of non-working embodiments is of no harm (**T 238/88**, OJ 1992, 709; **T 292/85**, OJ 1989, 275; **T 301/87**, OJ 1990, 335). If this is not the case and there is lack of reproducibility of the claimed invention, this may become relevant under the requirements of inventive step or sufficiency of disclosure. If an effect is expressed in a claim, there is lack of sufficient disclosure. This passage of **G 1/03** is analysed in **T 2210/16**; see also **T 875/16** (points 7 and 35 of the Reasons) and **T 1128/22** (in relation to a claim with a broad scope).

In **T 1994/12** (rubber composition), as to the argument that the requirement for sufficiency of disclosure was not met because the skilled person in view of the ambiguity in respect of the nature of the asphalt would not be able to reproduce the examples of the patent, the board stated that sufficiency of disclosure was not concerned with the invention **the**

applicant might have had in mind when drafting the application, but rather with the invention defined by the claims in terms of the technical features of the invention (see R. 43(1) EPC), as is done for assessing other criteria for patentability such as novelty and inventive step.

In decision **T 2824/19** (electrical equipment, insulating layer), the appellant (opponent) argued that the skilled person could not carry out the subject-matter of claim 1 over the whole claimed scope because the expression "variable thickness" had two meanings: a variation in space and a variation in time. According to the appellant, the patent in suit was silent on a variation in time. The board reiterated the principle that the skilled person, when considering a claim, should rule out interpretations which are illogical or do not make technical sense (see chapter II.A.6.1.). Interpreting "variable thickness" to mean a variation in time **would not make technical sense**. The skilled person understood that the role of the insulating layer was to prevent electrical arcs. The claims are there to clearly and concisely define the subject-matter for which protection is sought; they are aimed at the skilled person. Owing to the requirement for conciseness, interpretations that do not make technical sense in the field covered by a claim are excluded, regardless of the legal provisions to be considered. In support of its interpretation of a variation in time, the appellant made reference to a **general dictionary**. The board pointed out that the claim had to be interpreted in the context of the technical field, not in purely semantic terms. By the same token, invoking **T 133/15** was unsuitable for demonstrating that the expression "variable thickness" could have a meaning in terms of time in the field in question because that decision related to a different technical field. It should be noted that the opponent listed various principles applicable to sufficiency of disclosure, referring in particular to claim interpretation and the requirement of Art. 83 EPC; the board agreed with the principles set forth.

In **T 1716/21**, with respect to the argument that a plurality of "previous readings" allegedly existed for which the invention could not be put into practice, the board noted that as long as the skilled person upon consideration of the entire disclosure and of the common general knowledge could infer which embodiment would work and which would not, a claimed invention was sufficiently disclosed even if a broad construction of the claim might also encompassed embodiments which did not work (see in particular **T 2773/18**, and similarly **G 1/03**, point 2.5.2 of the Reasons, second sentence).

In ex parte decision **T 748/19**, the application related to identifying events in scenes under surveillance. The board agreed that it might sometimes be the case that "technically unreasonable" instances of the claimed subject-matter should not be detrimental to sufficiency under Art. 83 EPC. When the "technically unreasonable" instance was a contrived one, i.e. one which the skilled person would, in view of the provided teaching and of the claimed generalisation, not consider the claim to cover, this instance should not be covered. However, non-contrived instances where it was clear that the claim intended to cover them, should be taken into account for assessing sufficiency of disclosure (**even if "technically unreasonable"** – a claim to a teleporting machine). The requirements of Art. 83 EPC were not met in the case in hand.

In **T 174/21**, in the respondent's (patent proprietor's) view, the common patent-law practice of drafting claims as a generalisation of the description's disclosure inherently meant that some "non-working embodiments" could not be explicitly ruled out. The board noted, however, that the issue at hand was not whether certain embodiments "worked" or not. Instead, it concerned whether the skilled person could carry out the claimed method over the "whole scope claimed". To establish whether that was the case, the "whole scope claimed" had to indeed be determined through the eyes of the skilled reader, i.e. based on objective criteria and closely following the wording of a claim. This practice avoided taking into account **embodiments** which were **theoretically possible but not "technically meaningful"**. **However**, this did not mean that only those claim interpretations could be considered "technically meaningful" where the requirements of the EPC were met (see **T 2210/16**). The respondent contested that the skilled reader would consider a "microphone characteristic" to be a "frequency-dependent ear-independent characteristic" within the meaning of feature (c). The board considered it as a technically meaningful interpretation of claim 1. The board also dealt with the respondent's objection that the board had raised the issue applicability over the whole range ex officio (see point 2.2.2 of the Reasons). In conclusion the ground for opposition under Art. 100(b) EPC prejudiced the maintenance of the opposed patent in its granted form.

On the basis of the contested patent and their common general knowledge, the skilled person specified in Art. 83 EPC should be able, across all technical fields, to carry out the claimed invention over the whole scope, i.e. in accordance with all technically feasible interpretations that a skilled reader would consider using objective criteria on the basis of their common general knowledge. The examination under Art. 83 EPC should thus take account of **all "technically sensible" claim interpretations** (**T 149/21**). Aspect of this decision applied in **T 124/22** (cloud-modeling of an industrial automation system).

In **T 867/21** the invention related to an antenna device for a hearing instrument. The board first dealt extensively with the interpretation of claim 1, which was a relevant issue in this case. The board then moved onto reproducibility, finding that the patent in suit disclosed at least one way of performing the claimed invention. The board considered that under Art. 83 and 100(b) EPC, the "invention" was that disclosed in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art. The "invention" was to be regarded as "the invention defined in the claims", in line with the concept of an invention used in Art. 52, 54 and 56 EPC. By extension, the "invention" –and accordingly the issue of whether it was reproducible– turned on the entirety of the claimed features. The application or patent thus always had to disclose all possible **embodiments that were technically sensible** for the skilled person and covered by the features of the claim, in a manner sufficiently clear and complete for them to be carried out by a person skilled in the art. With this in mind, the requirement of reproducibility could be deemed satisfied only if the skilled person was able to rework the invention defined in the claims over the whole claimed scope using the information in the application or patent and the relevant common general knowledge. However, this requirement did **not** mean that the application or patent had to disclose **separate, specific** ways of performing each and every technically sensible embodiment covered by the claim. Rather, for embodiments covered by the claim but not expressly disclosed in the description, reproducibility could also be derived from the common general knowledge, in some cases together with the one way explicitly disclosed

in the description. In this respect, disclosing one way of performing the invention might be sufficient as long as this one way also covered the whole claimed scope when combined with the common general knowledge. Reproducibility therefore presupposed that the application or patent clearly and completely disclosed at least one way for the person skilled in the art to put the claimed invention into practice over the whole claimed scope (see Catchword).

Ex parte case **T 553/23** related to determining the location of objects in a loading compartment of a delivery vehicle using optical position recognition. The examining division rejected the application essentially because none of the requests met the reproducibility requirements. In relation to the assessment of the main request (not allowable), the board first recalled that Art. 83 EPC was only satisfied if an effect set out in the claim could be reproduced. The examining division had rightly questioned the reproducibility of the claimed teaching on the grounds that part of the field of vision could be hidden from the optical position determination system. The auxiliary request (allowable) related to objects arranged side by side, i.e. no longer to the transportation of just one object or to the problematic multi-layer arrangement. Unlike with the multi-layer arrangement with objects stacked one on top of the other, it could generally be accepted that the claimed teaching was reproducible. The case law of the boards of appeal does not require the invention to be reproducible in every conceivable theoretical configuration. According to the board (see Catchword): "When a claim is drafted, the aim is generally to define a device under optimal conditions. If the skilled person can deduce **what works and what does not** in consideration of the disclosure and the common general knowledge, then a claimed invention is sufficiently disclosed even if a broad interpretation includes subject-matter that does not work. In the case in hand, the skilled person can immediately identify and rule out situations that do not achieve the desired effect (for instance due to a concealed line of view) and can react with an adapted position determination device. The board has no reason to doubt that the skilled person, using their common general knowledge, would adapt the functional feature of an optical position determination device to the proportions of the objects being transported." (See also point 3.5 of the Reasons.)

Generally speaking, and in accordance with Art. 84 EPC in combination with R. 43(1) and 43(3) EPC, claims only define the essential features of the invention. For every claim worded in this way, it would be very easy to find embodiments that are covered by the claim but cannot be put into practice for various reasons. This is not prejudicial as long as the skilled person is aware of this and knows how to arrive at workable embodiments according to the invention (see **G 1/03**, point 2.5.2 of the Reasons). There is no reason to require that the wording of a claim explicitly rules out any conceivable embodiment covered by that wording but which a person skilled in the art would immediately take to be unworkable (**T 1857/20**, point 9.3 of the Reasons).

In **T 2374/13** the board stated that contrary to the statements in **T 292/85** (point 3.1.5 of the Reasons) and **T 435/91** (point 2.2.2 of the Reasons), no suitable variants were known to the skilled person through the disclosure of the application or common general knowledge. Moreover, in the absence of any criteria on how to determine resemblance to a receptor site or how to select appropriate functionalised monomers, the skilled person

was unable to distinguish between workable and non-workable embodiments (see **T 731/00**, point 3 of the Reasons) or to transform occasional failure into success within reasonable bounds (**T 931/91**, point 3.2 of the Reasons and **T 14/83**, point 6 of the Reasons).

c) Speculative subject-matter

According to decision **T 517/98** (grains of superconductor material – density), the patent in suit had only shown the way of achieving the goal to some extent and within set limits, but certainly not over the whole ambit of the claim. In the board's judgement, broad protection such as that claimed was unjustified since such a claim encompassed **speculative subject-matter** which could not be produced by the skilled person without inventive ingenuity (see also **T 409/91**). The main request failed (Art. 83 EPC). See also **T 748/19** (application limited to presenting a concept) and **T 2046/19** below.

In **T 2046/19**, both the opposition division and the respondent (patent proprietor) reasoned that the criterion of sufficiency of disclosure was **met already because the example disclosed one way** of performing the invention. The board, with useful reference to the principles laid down in the case law, did not share this view. It found that claim 1 and the opposed patent as a whole merely provided a **general concept of a speculative nature**. The opposed patent did not provide any generalisable teaching that would give guidance to the person skilled in the art in **finding working embodiments** across the scope claimed.

d) Objection of lack of sufficiency by technical field – approach in mechanical engineering and case law discussion

Decisions **T 2773/18**, **T 500/20** and **T 1983/19** started a discussion on how far the principles applied to mechanical engineering. These three decisions were specific to the field of mechanical engineering as opposed to the field of chemistry in particular. This sub-section summarises both the approach taken in the case law of the boards of appeal and the discussion of this approach, in particular in **T 149/21**; **T 149/21** has been cited and repeated in numerous decisions since. Given that this case law is relatively new, this edition restates in detail the relevant reasons set out in the cited decisions.

In **T 2773/18** (mechanics) the patent concerned a wind turbine with a cooling device using outside air, in particular for marine environments. In support of an alleged lack of sufficient disclosure concerning the expression "upper part of the tower", the appellant (opponent) argued that not only was the claim was not limited to an offshore wind turbine but the dimension of the lower and upper parts was also not limited to a minimum size or height. The scope of claim 1 thus covered embodiments where the inlet was located quite low above sea level and therefore unable to achieve the technical effect of drawing outside air with a low water and salt content. This argument failed to convince the board, not least because it misapplied **case law developed in the field of chemistry** – for where a claimed invention was in a compositional range or other range of values but the associated effect was perhaps not proven or plausible for large parts of that range – to an invention claimed in the field of mechanics, even though it claimed no ranges. By its very nature, a

claim in the field of mechanics, which – often in functional or other generic terms – attempted to capture the essence of some specific machine or mechanical structure (or its operation), was schematic and allowed for some breadth of interpretation. It might be that, on clever construction, subject-matter could be found to be covered by that breadth that might not solve the problem or achieve the desired effect. However, this was normally not an issue of lack of disclosure, but rather of claim construction. Whether the claims, description and figures provided the skilled person with sufficient information to carry out an invention was a purely technical question that was separate from that of what reasonably fell within the ambit of the claim wording. In the board's view, if the skilled person, upon consideration of the entire disclosure and possibly using common general knowledge, could **infer what would and what would not work**, a claimed invention was sufficiently disclosed, even if a broad construction might also encompass what did not work. In the case in hand, the skilled person would be able to directly recognise and exclude embodiments which obviously would not achieve the effect sought. In particular, the skilled person would disregard an upper part placed much lower than 30 metres above sea level. The board thus confirmed the opposition division's positive assessment of sufficiency (Art. 100(b) EPC).

The board (in mechanics) in **T 500/20** (wind turbine) stated that the general argument made in mechanics that the invention would not be sufficiently disclosed across the entire breadth of the claim misapplied an approach developed mainly in the field of chemistry for inventions where a central aspect of the claimed invention was a range of compositions or of parameter values. In claimed inventions that did not involve a **range of parameter** values or compositions but were directed at a concept expressed in terms of generic structural or functional features of an apparatus or of a method, it was not enough to demonstrate insufficiency to conceive of an example that fell within the terms of the claim that did not work because it did not achieve the claimed effect fully or at all so that therefore the invention would not be sufficiently disclosed across the entire breadth of the claim (see Catchword). The board further specified that to successively argue insufficiency in a case such as this a very high burden of proof applied.

In **T 1983/19**, the mechanical board dealt with the issue of reproducibility of the invention "across the whole claimed scope" in mechanical engineering. Appellant II (opponent) had argued that the skilled person could not achieve the alleged effect for all variants covered by the claim. The board was not convinced. What mattered was that the patent illustrated to the skilled person one way of performing the invention. The case law developed in particular in the field of chemistry, according to which the invention had to be reproducible over the whole claimed scope, could not be applied to mechanical engineering without making some compromises. Almost every mechanical claim covered countless embodiment examples that were conceivable but unworkable. Yet, this did not mean the invention as such could not be carried out (see also **T 2773/18**). For example, if it was obvious to any person skilled in the art that slide rings and counterpart rings made of a ceramic material or hard metals could not be deformed by a bellows-like spring means, as argued by appellant II, then the skilled person would simply not use any such slide rings or counterpart rings when putting the invention into practice. However, this did not imply that the skilled person was unable to carry out the invention. The board therefore held that

the ground for opposition under Art. 100(b) EPC did not prejudice the maintenance of the patent as granted.

The mere fact that claim is broad is not in itself a ground for not considering the claimed invention sufficiently disclosed (**T 447/22**). The board in **T 447/22** wished to emphasise that objections of insufficiency of disclosure that question whether the invention can be carried out over the entire breadth or the whole range of the claims had their roots in case law that was mainly developed in the field of chemistry for inventions where a central aspect of the claimed invention was a range of compositions or of parameter values (see **T 2773/18**, **T 1983/19**, and **T 500/20**). In the field of mechanics, however, such objections were rarely successful. In the case in hand, the skilled person would readily exclude exotic embodiments that were not used in practice, such as pipes arranged at a very small angle relative to one another, even if these would theoretically fall under the claimed subject-matter.

In **T 149/21** (electrical engineering board), the invention related to a method for reducing the energy consumption of a rolling mill installation. The opposition (Art. 100(b) EPC) had been rejected. At the oral proceedings before the board, the respondent (patent proprietor) argued that under the case law of the boards of appeal it was sufficient for the application as originally filed to disclose at least one way of performing the invention in order to satisfy the requirement of Art. 83 EPC. It was thus immaterial whether the claimed scope also covered other "exotic" scenarios. The board agreed that the contested patent detailed at least one way of performing the claimed invention and thus satisfied at least R. 42(1)(e) EPC. According to the established case law of the boards of appeal, however, the claimed invention had to be reproducible over the whole claimed scope. It was thus essential to disclose at least **one way** of performing the claimed invention, but this was **not sufficient** to satisfy the requirement of Art. 83 EPC. Moreover, the board emphasised that this case law was not generally limited to the technical field in question, as the same criterion had been confirmed and applied multiple times not just in chemistry but also in the fields of electrical engineering, physics and mechanical engineering. In the board's view, characterising this case law by technical field would be difficult to reconcile simply because the EPC had to be applied in a harmonised way as regards the requirement of reproducibility.

However, the board in **T 149/21** did note that recent decisions in mechanical engineering (see **T 2773/18**, **T 500/20** and **T 1983/19**) had found that the criterion "across the whole claimed scope", which had originated from the field of chemistry, was not necessarily applicable to other technical fields like mechanical engineering. In this regard, it had been pointed out in **T 1983/19**, for example, that the case law developed in particular in the context of chemistry, according to which the invention had to be reproducible "over the whole claimed scope", could not be carried over to mechanical engineering without making some compromises, since almost every mechanical claim covered countless embodiment examples that were conceivable but unworkable. As per **T 1983/19**, however, this did not mean that the "invention as such" could not be carried out. Rather, it was sufficient if the patent illustrated to the skilled person just one way of performing the invention. The appellant had also invoked this argument in the case under discussion. However, the board was of the view that while disclosing one way of performing the claimed invention

may be sufficient to satisfy the requirement of R. 42(1)(e) EPC, this would not necessarily satisfy Art. 83 EPC. Rather, the case law has it that, on the basis of the contested patent and their common general knowledge, the skilled person specified in said article should be able, across all technical fields, to carry out the claimed invention over the whole scope, i.e. in accordance with all technically feasible interpretations that a skilled reader would consider using objective criteria on the basis of their common general knowledge. In other words, the board found that all "technically sensible" claim interpretations had to be taken into account in the Art. 83 EPC examination, but an interpretation did not necessarily have to meet the requirements of the EPC in order to be considered "technically sensible". The requirement that the disclosure allowed the claimed invention to be put into practice "across its whole scope" was also consistent with the fundamental policy aim that the exclusive right granted by the scope of a patent should always be justified by the actual contribution made by the patent to the art. In the board's view, the case in hand did not constitute an exception in this regard. The contested decision was ultimately reversed and the patent revoked.

In **T 174/21**, the invention concerned a method of estimating an acoustic transfer quantity by employing a hearing instrument and a hearing instrument therefor. With reference to **T 2773/18**, the respondent (patent proprietor) expressed some doubts as to the applicability of the "whole range claimed" requirement in the field of audiology. However, the board considered that these doubts were unfounded, referring in this respect to the conclusions drawn in **T 149/21**.

In **T 748/19** (video surveillance), the board was aware of discussions in recent decisions and agreed with **T 149/21** that there was **no basis in the EPC for applying different standards** for compliance with Art. 83 EPC **depending on the technical field**. The board considered also **T 1983/19**.

e) Objection of insufficient disclosure based on the subject-matter of a dependent claim

In **T 2007/16** the opposition division had referred to what it called the "main rule" for Art. 83 EPC, according to which only one way to perform the invention needed to be clear to the skilled person. It had argued that a patent could not conflict with Art. 83 EPC if those skilled in the art could perform the subject-matter of an independent claim, irrespective of whether they could perform the subject-matter of a dependent claim. The board could not endorse this approach; the "main rule" asserted by the opposition division had no basis in the EPC or in the case law of the boards of appeal. A dependent claim directed at a particular embodiment could give rise to an objection under Art. 83 EPC if the skilled person did not know how to obtain this embodiment. Also, a dependent claim directed at subject-matter that the skilled person would not know how to obtain indicated that the invention defined in the corresponding independent claim was not sufficiently disclosed over the whole scope encompassed by the claim.

See also the board's reasoning on dependent claims in **T 1942/21** (parameter – range with no upper limit).

f) Case law assessment in specific cases

The case law has already been assessed in other chapters, so this section provides additional case law examples.

In **T 1064/15** the invention related to barbed suture-needle combinations useful for connecting body tissue in various surgical contexts. Claim 1's requirements could be implemented for circular cross-sections, but the question of sufficiency of disclosure arose for non-circular cross-sections. The respondent (patent proprietor) himself intended the teaching of the patent to be applicable to both circular and non-circular cross-sections and specifically sought protection for both types of embodiment. It would be insufficient and disproportionate if the sole disclosed possibility of carrying out the invention with circular cross-section elongated bodies were enough to satisfy the requirements of sufficiency of disclosure. Such an approach could not have been intended by the legislator, because in the board's view this would go against the general principle that the protection obtained with the patent had to be commensurate with the disclosed teaching. When it came to non-circular cross-sections, this was not the case for the patent in suit. On the basis of the patent disclosure as a whole, taking common general knowledge into account, the person skilled in the art was not able to determine which dimension was meant by the diameter (SD) for an essential part of the claim, or in other words, with a needle having a given diameter, he did not know how to select the cross-section dimension of a non-circular suture in order to improve the closure strength, which was supposed to be an essential part of the teaching of the patent in suit (**T 1064/15**, which is cited and summarised in **T 1756/16**).

In **T 1128/22** the appellant (opponent) invoked **T 1064/15** in support of its arguments against the patent. The board held that **T 1064/15** did not reflect the circumstances in the case at issue since the appellant had not specified any parameter in the claim that would be unidentifiable in certain scenarios covered by that claim. The board also considered that the opponent's arguments merely showed that the scope of claim 1 was broad (see chapter II.C.6.3.).

In **T 623/16** (OLEDs) the description proposed varying a **plurality of parameters** to achieve a white emitting device. There was no indication in the claims that several parameters, such as concentration and thickness on the one hand and the addition of a blocking layer (or other parameters) on the other, should be varied at the same time. If the skilled person were to make a first experiment and obtain a device which did not emit white, they would find no explicit guidance in the patent for deciding on what to start with to yield white emission. Thus, guidance had to be given in the claims as to which features were essential for carrying out the invention over the whole range in order to achieve a device emitting white light. Once the skilled person was aware that these features were crucial for carrying out the invention, changing only concentration and thicknesses was no longer an undue burden. The description provided enough details on carrying out the invention. Claim 1 of the main request did not comprise features that were essential to the invention and crucial to carry it out over the whole range claimed. Omitting these features led to a device that did not emit white light (Art. 83 EPC not complied with). With

amendments introducing the essential features, it was no longer an undue burden for the skilled person (new first auxiliary request satisfied Art. 83 EPC).

In **T 2728/16** the board held that even if it accepted that the skilled person would have been motivated to and could have optimised and selected adequate parameters to avoid (in practice) non-functional systems, the skilled person had no instructions as to how to readily implement a working system with two apertures where one aperture was unsealed. As for ten apertures, there was no guidance how to make it work with at least one of the apertures unsealed. Hence, claim 1 covered systems with two or ten apertures having a mean seal resistance of less than 30 Mohm, described to generally fail, which could by no means be optimized or improved to render them functional. The illustrative examples were just a few of many embodiments that were non-functional and fell under the scope of protection of claim 1. Thus, any system ranging between two and ten apertures per sample wells, in line with this rationale, fell as well. The board considered that the patent did not disclose a technical concept fit for generalisation, thus the majority of the systems encompassed by claim 1 were not available to the skilled person. A teaching how the non-functional embodiments could be made functional was not at the disposal of the person skilled in the art even after reading the patent.

In **T 239/13** of 5 July 2017, claim 1 as granted did not require the "granules" to be acidic. The board considered that a solution of the claimed granules per se might have an alkaline pH despite the presence of some acidic component. As regards acidic granules, the description – which dealt exclusively with acidic granules – provided the skilled person with technical information and guidance sufficient to enable him to prepare, without undue burden, acidic granules having "improved storage properties" across the whole ambit of claim 1. As regards alkaline granules, in the absence of a concrete teaching the skilled person would have to start a research programme. The board concluded that the skilled person, following the teaching of the description, was not provided with technical information and guidance sufficient to enable him to prepare granules as claimed without undue burden and across the whole ambit of claim 1.

In **T 2224/08**, regarding the standards set for sufficiency of disclosure, the appellant (opponent) referred to decision **T 10/86**. However, this decision related to a situation where the only means disclosed for solving the technical problem was considered unsuitable, i.e. **non-working**, and alternative means were not available to the skilled person on the basis of their general knowledge. Contrary to this, the patent under appeal disclosed a working embodiment in example 4, it listed several alternative embodiments in examples 1 to 3, and it suggested a number of strains suitable for the claimed use. The appellant also referred to decision **T 32/85**, which related to a case where the skilled person, trying to achieve a functionally defined result, had to establish numerous parameters by trial and error. This was considered an undue burden. In the present case there was only one parameter which in the board's view could be readily assessed by several methods.

In **T 1583/17** the invention concerned the use of coated films. The board stated that it was important to note that there was a difference between whether or not a product met a **pre-set quality requirement** (here: the absence of glossy spots) and whether or not it met the requirements set out in a claim. That the quality of the coatings obtained did not

satisfy the intended quality standard did not mean that those coatings did not satisfy the requirements of claim 1, which was the only relevant point when discussing sufficiency of disclosure. The alleged lack of enablement over the entire range had not been shown.

5.5. Parameters

If an essential feature of the invention is expressed by a parametric definition, the question is whether the parameter is so defined that the person of the art, on the basis of the disclosure of the patent as a whole and using his common general knowledge, could identify, without undue burden, the technical measures leading to the claimed subject-matter (**T 61/14**).

This section looks at the case law on parameters, which often addresses them in the context of methods of measuring them. Parameters are also dealt with elsewhere in this chapter: II.C.6.6.4 "Forbidden area of the claims" and II.C.8.2. "Article 83 EPC and clarity of claims".

5.5.1 Ambiguous parameters

a) Essential parameters

In **T 815/07** (absorbent article defined by reference to a parameter range to be measured by a specified method) the board pointed out (Catchword) that the purpose of a parameter contained in a claim is to define an essential technical feature of the invention. Its significance is that the presence of this technical feature contributes to the solution of the technical problem underlying the invention. The method specified for determining the parameter should therefore be such as to produce **consistent values**, so that the skilled person will know when he carries out the invention whether what he produces will solve the problem or not. This decision was cited (and endorsed) in **T 120/08**, **T 593/09** and **T 1305/15**. According to **T 593/09** ("ill-defined ("unclear", "ambiguous") parameter"), the assertion that the skilled person is unable to determine whether he is working within the claimed scope as such is not a valid basis for denying sufficiency of disclosure (see point 4.1.4 of the Reasons). What is decisive is whether the parameter is so ill-defined that the skilled person is not able, on the basis of the disclosure as a whole and using his common general knowledge, to identify (without undue burden) the technical measures (e.g. selection of suitable compounds) necessary to solve the problem underlying the patent at issue. The board in **T 1845/14** (see below) disagreed with some of the findings made in these decisions. Neither **T 256/87** (point 17 of the Reasons) nor **T 815/07** (point 6 of the Reasons) was followed by **T 1960/14** in relation to the issue whether the skilled person would know whether he was working within or outside the scope of the claim.

In **T 59/18** the relaxation ratio was an essential feature affecting the final properties of the obtained film and, thus, was relevant for solving the technical problem addressed in the patent. Therefore, in accordance with the decisions **T 593/09** and **T 2403/11**, the lack of clarity of the term "relaxation ratio" necessarily affected the sufficiency of disclosure since it was not possible to realize the process for preparing the claimed multilayer film without knowing how to achieve, to measure and to control this ratio.

In **T 147/12** the board held that the conclusion reached in **T 815/07** could not be applied to the present case. In **T 815/07**, claim 1 had pertained to an absorbent article comprising an absorbent core and a crotch region defined by its absorbent capacity relative to the absorbent core's total absorbent capacity, the absorbent capacity being determined by test method A. The board had found that the structure of the article claimed would have an effect on the actual amount of liquid absorbed. Because the patent did not provide adequate information about the tested articles as regards their structure, materials or regions, the test method defined in claim 1 resulted in totally arbitrary values for the crotch region's absorbent capacity. The claimed subject-matter was therefore not sufficiently disclosed. In **T 147/12**, however, the alkali metal content only depended on its method of determination; it did not depend on any variable or feature characterising the process claimed.

In **T 808/09** (cartridge for use in a beverage preparation machine / liquid chocolate ingredient), the board considered that the patent failed to enable the measurement of the essential parameter of the invention, i.e. the viscosity of the liquid chocolate ingredient. Even if this viscosity feature had been shifted into a preamble of method claim 1 and supposing this preamble had been directed to the prior art, this shifting of the feature would still not have solved the problem of insufficiency. For a reference to prior art in the preamble to adequately serve this purpose the patent in suit still needs to contain all the necessary information in sufficient detail in order to enable the person skilled in the art to perform the invention. In the case before the board this would require information as to the viscosity measurement device to be used and the parameters to be observed. All this information was missing.

T 1845/14 decided that in case of an unclear parameter defined in a claim whose values required in the claim are indicated in the specification to be essential to solving the problem underlying the patent at issue, the ability of the skilled person to solve that problem by reproducing what is claimed is **not a suitable criterion** for assessing sufficiency of disclosure when the problem or an effect derivable from it are not explicitly or implicitly part of the definition of the claimed subject-matter (point 9.8 of the Reasons). **T 1845/14** addressed the rationale of **T 593/09**, **T 815/07**, **T 172/99** and **T 608/07** ("promise of the invention" is rather an issue of inventive step) and stated that all the decisions cited above relating to a parameter mentioned in a claim whose definition was ambiguous are based on a definition of the term "invention" which does not refer to the combination of features defined by the terms of the claim under consideration but rather to the inventive idea or concept the inventor had in mind that led the patentee to seek protection for what is claimed. The board in **T 1845/14**, making detailed reference in its reasons to landmark decisions such as **T 435/91** (OJ 1995, 188) and **T 939/92** (OJ 1996, 309), was convinced that, provided that the problem indicated in the patent in suit was not implied by the wording of the claims in terms of, for example, an effect or a functional definition, there was no apparent justification to deny a contribution to the art justifying a patent monopoly merely because the claimed subject-matter could not be considered to solve a problem initially indicated in the description. The term "invention" corresponds, in accordance with R. 43(1) EPC, to the specific combination of features in the claim, as was reminded in **G 2/98** (OJ 2001, 413), whose definition is used when issues of priority, novelty and inventive step are considered. The board in **T 1845/14** did not see any reason to consider

a different meaning of the term "invention" in relation to the issue of sufficiency of disclosure. There is no reason to define the invention on the basis of an effect alleged in the patent to be achieved by the claimed subject-matter or on the basis of specific conditions for measuring a parameter when the wording of the claim does not require this. The invention is defined by the terms of the claims, which should be given their broadest technical sensible meaning in the context they appear. The board said that its position was also supported by **G 1/03** (OJ 2004, 413 – concerning non-working embodiments).

The decision in **T 1845/14** was endorsed on this point by the subsequent case law in **T 1900/17**, **T 409/17**, **T 1260/16**, **T 189/16**, **T 1744/14**, **T 45/21**, **T 1310/22** (to what corresponds the term "invention" is addressed under point 2.1 of the Reasons). No decision taking issue with **T 1845/14** was found. In **T 786/15** the board decided, in view of the possibility of calibrating the method of measuring the Tg parameter by reverse engineering (parameter not ambiguous), that the case law on ambiguous parameters (in particular **T 1845/14**) did not apply.

The more recent decision **T 1884/19** endorses **T 1845/14**. The board in **T 1884/19** specified that **T 1845/14** did not agree with the rationale provided in **T 137/01**. It held that in a case of an alleged unclear parameters defined in a claim, whose values required in the claim might be essential to solving the problem underlying the patent at issue, the ability of the skilled person to solve that problem, when seeking to carry out the invention, was not a suitable criterion for assessing sufficiency of disclosure, where the problem was not part of the definition of the claimed subject-matter. In **T 1884/19**, operative claim 6 defined three parametric ranges, but a further technical effect which would be achieved by these parametric requirements was not part of the definition of that claim. The appellant also argued a lack of sufficiency of example 7 having regard to an alleged inconsistency between examples (See above the reasons of **T 1884/19** in this respect under the present chapter II.C.5.3.).

Other decisions concerning the measurement of essential parameters: **T 83/01** (specific mean diameter), **T 1250/01** (Sears number), **T 808/09** (viscosity).

b) Several known methods of determining a parameter

In both **T 485/00** and **T 225/93**, three methods were known in the art for the determination of the specific surface area of a $CaCO_3$ particle. In neither case did the description or common general knowledge indicate a preference for one of them. In **T 485/00**, the board held that reproducing an example and measuring the surface area of the resulting product by two or three well-known methods did not represent an undue burden for the skilled person. In **T 225/93**, however, the board found that, as there were three different measuring methods which did not always lead to the same result, this amounted to an **undue burden**.

T 473/15 observed that the conclusions of **T 225/93** could not be applied since in that case the principles underlying the possible methods of measurement were completely different from each other (permeability, photometry and adsorption), contrary to the case at hand, and in that case the parties agreed that the different methods yielded different results. On

the contrary, in case **T 473/15** the appellants (opponents) did not provide evidence for the presence of major deviations between the different definitions for fiber diameter.

In **T 147/12**, the objection of the appellant (opponent) was not that no method of determination of the alkali metal content in polyethers existed. Rather, the gist of its argumentation was that D7 (scientific publication), D8 (a study) and D11 (experimental report provided by the opponent) showed that the value obtained for the alkali metal content in the polyether depended on the analytical method used for its determination. The board stated that even if the conditions of measurement lead to **variations** of the value of the alkali metal content as argued by the appellant, this **alone** did **not** constitute a lack of sufficiency of disclosure regarding the claimed subject-matter as a whole since it had not been shown that the uncertainty concerning the alkali metal content affected the claimed process to such an extent that the skilled person wishing to perform the process would face an undue burden. The appellant had shown that the uncertainty concerning the method of determination of the alkali metal content meant that the skilled person could not ascertain whether the value he would obtain was within or outside the claimed range. It was, however, not shown that as a result of that uncertainty, the skilled person would fundamentally be prevented from obtaining a polyether according to claim 1. The board stated that **T 83/01** (skilled person not in a position to perform any measurement of the claimed parameter) and **T 815/07** (test method defined in claim 1 resulting in totally arbitrary values) were not applicable to the present case.

In **T 345/16** the board considered that measuring a "particle size", a conventional parameter in the technical field concerned, would merely require selecting and applying any of the well-known methods used in the field, for which no undue burden or inventive skill would be required. The appellant (opponent) argued that the patent in suit did not include any information as to how the "particle size" should be measured, and that this would lead to significant inconsistencies in the results. The board was not convinced by this reasoning, since any possible inconsistency resulting from the choice of a particular measuring method (among a number of well-known available alternatives) would only affect the demarcation of the scope of protection and not the ability to carry out the invention. In this respect the board noted that, in line with a number of decisions in the case law (see e.g. **T 378/11**, dealing precisely with the parameter "particle size"), problems of demarcation had to be dealt with under Art. 84 EPC and not under Art. 83 EPC. Since the feature "particle size" was part of the claims as granted, the board was not competent to assess compliance with Art. 84 EPC (**G 3/14**). The board also noted that there was no requirement in claim 1 to measure the primary particle size and the agglomerate particle size simultaneously rather than sequentially. Furthermore, a number of well-known optical methods were available which would allow both a simultaneous (e.g. visual analysis of the agglomerated particles to estimate the size of the agglomerates and the primary particles identifiable in these agglomerates) and a sequential measurement to be carried out. In any case, the appellant had not provided any evidence in support of its allegations.

In **T 1154/12** the respondent (opponent) contended that the patent lacked sufficient disclosure because it did not define the method which should be used for measuring and calculating the "average particle size" called for in claim 1. The board was not persuaded by this argument. It was undisputed that several methods of measuring or calculating the

average particle size were conceivable to the skilled person. Whether or not the use of several kinds of measuring or calculating the average particle size led to different results was, however, a matter of determining the boundaries of the independent claim, i.e. a matter of clarity rather than sufficiency of disclosure (see **T 378/11**).

In **T 2666/17** confirmed and summarised the findings in **T 815/17** (problem if the parameter is ill defined) and noted that surface tension was a well-known parameter which could be measured using known methods. That the measuring method would lead to different results would not prevent the skilled person from reproducing the invention but would simply raise doubts as to whether certain embodiments at the margins of the scope of the protection fall within the forbidden area or not (issue of Art. 84 EPC).

In **T 1960/14** (parameter – melting point of a palm oil fraction), the board stated that the skilled person (common general knowledge) was aware of three suitable standard methods. The respondent (opponent) asserted that these methods provided significantly different results but did not submit any experimental evidence. In view of tests disclosed in D22, the board concluded in agreement with the patent proprietor that all three methods provided very similar results with uncertainty only at the edges of the claimed ranges. **T 1960/14** endorsed the finding in **T 608/07** that for an insufficiency arising out of ambiguity it is not enough to show that an ambiguity exists, in this case at the margins of the claimed melting point range due to the lack of any indication of the measuring method. It will normally be necessary to show that this ambiguity deprived the skilled person of the promise of the invention. In the case at issue, the respondent (opponent) had not submitted any technical evidence to that effect. The respondent in **T 1960/14** also referred to **T 575/05** and argued that in a similar situation a board had decided that although standards were available, the patent did not provide sufficient guidance as to which one should be used (invention insufficiently disclosed). However according to the board in **T 1960/14**, unlike in **T 575/05**, where many commonly used but not clearly defined methods of determining a parameter were available and thus led to a high degree of uncertainty for the skilled person trying to carry out the invention, at the priority date of the patent in suit there were only three clearly defined standard methods of determining the melting point of palm oil fractions, which produced very similar results with a fairly minor degree of ambiguity/uncertainty only at the margins of the claimed range. The issue of Art. 84 EPC was also addressed (**T 256/87** and **T 815/07** not followed).

In **T 786/15** numerous methods of measuring the parameter Tg existed and the skilled person was aware of three ways, but the patent did not indicate any method for its measurement. To determine whether the Tg parameter was "so ill defined", it had to be investigated which methods would be considered by the skilled person. Referring to **T 608/07** (point 2.5.2 of the Reasons), the board concluded that the alleged ambiguity arose at the edges of the values recited in claim, but this in itself could not lead to a finding of insufficiency of disclosure.

See also in this chapter: **T 492/92** (two methods suggested by applicant) and **T 1414/08** (parameter tensile strength – paper - not considered unusual – but no specific method of measuring disclosed – several standardised test methods in the art – consequences – end values ambiguous – scope – issue of Art. 84 EPC); **T 557/22** (that the parameter could be

easily measured did not mean that the skilled person would be in the position to determine which steps needed to be taken to fulfill the parameter requirements).

c) No or incomplete information on method of determining parameter

Where the calibration of (undisclosed) test conditions may be achieved although the methods of determination of the parameter are incompletely described, the invention may be sufficiently disclosed. See for example **T 1062/98**. On calibration, see also chapter II.C.6.6.8.

The fact that no direct independent method of specifically determining the parameter has been described is not in itself prejudicial to the sufficiency of the description where the claims do not relate to a method of determining the parameter (**T 256/87**, a case concerning Art. 84 and 83 EPC, with respect to an amended claim).

In **T 83/01** (essential parameter – diameter of water droplets in a plastic fat-continuous spread – particularly difficult to measure) the board held that where the skilled person had no reason to doubt the definition of the parameter given, but there was no indication in the patent how to measure this parameter, the patent failed to fulfil the requirements of Art. 83 EPC 1973.

The board in **T 2403/11** (see Catchword) acknowledged that an ambiguity of a parameter in the claim was not enough in itself to deny sufficiency of disclosure. Whether such an ambiguity led to insufficiency of disclosure was to be decided on a case-by-case basis (see **T 593/09** and **T 472/14**). The case at issue was different from **T 882/03**, which also concerned viscosity and where the variations resulting from the ambiguity were only minor, and from **T 492/92**, where the skilled person knew which method to choose. In **T 2403/11** the method and the measurement parameters to be chosen were not known to the skilled person. The board in **T 466/05** (also relating to viscosity) likewise drew a contrast with **T 492/92** on the basis that the skilled person in the case before it did not even know which parameter (i.e. which measure of the molecular weight) of the claimed polysaccharide should be determined. For other decisions relating to viscosity, see e.g. **T 805/93**, **T 808/09** and **T 482/09**.

According to **T 492/92** (no need to specify one of the several available analytical methods): where it is obvious that a skilled person would select a particular analytical measuring method (none being disclosed in the patent), balancing its simplicity and convenience against the required accuracy, the requirements of Art. 83 EPC are met. In **T 492/92** it was considered that the fact that two methods suggested by the appellant did not necessarily lead to identical results when measuring a specific parameter was not sufficient evidence that a skilled person could not determine this parameter of the claimed compositions with the required accuracy.

In **T 2096/12** the skilled person could not know, from the disclosure in the patent, which measurement method should be employed to establish the claimed thickness parameter. The board agreed with the statements in **T 593/09** and emphasised that the absence of a test method for a parameter which was a claimed feature did not lead by itself to the issue

of insufficient disclosure. In a case where, for example, ranges for length or width of a clearly structured article were concerned, the parameters could be established unambiguously and without doubt. However, in each case it had to be evaluated on a case-by-case basis whether this was possible. When the extent of the protection conferred by the patent is not defined and cannot be reliably determined – such as in the case at issue where neither the claims nor the description provided a clue for how to interpret the parametrical feature of the claim, it can only be concluded that the requirement of Art. 100(b) EPC was not met.

In **T 1583/17** the invention concerned the use of coated films. As regards determining the thickness of the coating, it was undisputed that neither claim 1 nor the description indicated a method to be used for this and it was also undisputed that different methods were available to the skilled person and that these methods might produce different results. The mere fact that a claim was unclear or its scope ambiguous did not automatically mean that the invention it defined was not sufficiently disclosed. The board recalled the case law and observed that, in the majority of cases, the absence of an indication of a method for measuring a parameter had been regarded as a problem under Art. 84 EPC only. The board stated that the absence of an indication of a method for measuring the thickness did not prevent the skilled person from practising the claimed invention and was therefore not objectionable under Art. 100(b) EPC. As the claimed invention was not restricted to thicknesses measured by a particular method, the skilled person was free to use any suitable method. The selection of a suitable method did not involve an undue burden since measuring the thickness of a coating or of a layer in general was an absolute standard procedure for which many commonly known methods were available. The board observed that the invention would possibly **not be sufficiently disclosed if** it could only be carried out with coatings having a thickness **measurable only with a specific, yet undisclosed method**. The board stressed again that no specific degree of soft touch was required according to the claimed subject-matter (a crucial difference from **T 225/93**). The board concluded that there was no evidence on file that showed that the absolute thickness of the coating and thus the selection of a method for measuring the thickness was critical for carrying out the invention, i.e. for producing a coating having a thickness in the claimed range and a certain degree of soft touch.

In **T 1064/15** the person skilled in the art was faced with the undefined parameter "diameter (SD)" and did not know how to choose the cross-section in order to obtain the desired technical effect. For the conditions of sufficiency of disclosure to be fulfilled it is not enough to be able to manufacture an object falling under the wording of a claim. That object must also exhibit the alleged or desired technical effect obtained with that invention (**T 815/07**). The field of non-circular cross-sections is far wider than that of circular ones, since it encompasses an enormous variety of shapes. This made it even more important to know how the key parameter of such shapes, namely the diameter, was determined.

In **T 875/16** (optical control of hair growth) the board stated that the concept of duration of the pulse, as it appeared in claim 1, was vague and its use affected the claim's clarity. While the presence of this unclear parameter in the claim was not, in itself, sufficient to show that the skilled person could not reproduce the claimed device without undue burden, its presence was not without consequences for the issue of sufficiency, since the skilled

person would not be able to rely on a clear definition of the parameter when attempting to reproduce the invention over the whole ambit of the claim. As to the discussion in relation to the whole ambit of the claim, the board found, in particular, that the effect – a degree of reduction in growth – was not specified and there was no indication as to how it was to be measured. This lack of any indication of how the claimed effect was measured was particularly problematic since it constituted the technical contribution of the invention over known devices.

In **T 417/13** (PVC particles) the size of the PVC particles was an important feature of the invention. A skilled person needed to be capable of establishing which PVC particles had the appropriate size, as defined in the claims. The results for the particle size might vary to a large extent depending on the method of measurement. The description of the application provided only very limited information that could lead to the selection of a particular method of measurement. The person skilled in the art had thus to rely on his common general knowledge for the selection of an appropriate method of measurement. A person skilled in the art would be aware of the existence of the ISO standards. Thus, contrary to the situation in **T 225/93** (no indication of suitable method), the skilled person in **T 417/13** would have chosen a particular method (no evidence supplied by opponent on file as to the effect of measurement conditions on whether Art. 83 EPC requirements met).

In **T 1900/17** the board decided after detailed reasoning that the ambiguity, due to the lack of definition of the method of calculation of the claimed parameter (calculated ClogP value for a nonionic surfactant), had not been shown to lead to an insufficiency, not even by following the rationale of **T 1845/14**.

T 2399/10 concerned a case where a starting material could not be provided, not only because no method was described, but also because it was characterised by an undefined parameter and therefore could not be identified. The patent thus did not disclose how to produce the alumina particles needed to obtain the claimed composition. This situation differed from cases where the features of the end product described in the patent were not clearly defined, which frequently resulted in a lack of clarity. Instead, it was a starting material which had not been here defined clearly enough. Since there was therefore inadequate information to select the **starting material**, the claimed composition could not be produced. This typically meant there was insufficient disclosure. (On disclosure of a starting material, see also **T 1596/16**).

See also **T 1305/05** and **T 1553/16** (unusual parameter – method of measurement kept secret) in this chapter II.C.5.5.3.

d) Effect of ambiguous parameter on claim interpretation

Where inventions are defined by claims containing unclear features, e.g. **ambiguous parameters**, which cannot be clarified in the light of the description, the effect sought may be the only means of understanding such inventions. This effect must then be taken into consideration and assessed under Art. 83 EPC with a view to establishing whether the invention can be reproduced (see **T 862/11**).

According to **T 1845/14** (two contradictory definitions of a parameter): The ambiguous definition of a parameter in a claim may result in the scope of the claim to be broader than the patentee might have intended. In such a case the question arises whether the teaching of the patent in suit, which was directed to the claimed subject-matter having regard to a specific meaning of that parameter (which, however, was omitted), would nevertheless have enabled the skilled person to carry out the invention outside of the scope intended by the patentee, using common general knowledge and a reasonable amount of experimentation.

In **T 1845/14** the board stated that the invention for which sufficiency of disclosure had to be assessed is defined by the terms of the claims, whose meaning had to be construed in view of the ambiguous definition of the parameter (CDBI). Following the normal rule of claim construction, terms used in a claim, such as parametric definitions, should be given their broadest technical sensible meaning in the context in which they appear and having regard to the common general knowledge. Concerning the CDBI, there was no evidence that it had a recognised meaning in the art at the priority or filing date of the patent in suit and the contradiction between the two definitions of it provided in the specification could not be resolved. Thus, this wording must be broadly construed to cover both definitions provided in the specification. Then the ambiguous definition of a parameter in a claim may result in the scope of the claim to be broader than the patentee might have intended. It was undisputed that the whole teaching provided in the specification related to only one definition of CDBI provided in the specification. Even accepting that the teaching was sufficient for one of the two definitions, the patent proprietor did not indicate how the skilled person, based on their common general knowledge, would have been in a position to complement the teaching contained in the patent in suit to prepare with reasonable effort the copolymers in accordance with the second definition of the CDBI which did not belong to the group of polymers in accordance with the first definition of CDBI. The subject-matter of claim 1 has not been shown to be enabled in the whole range claimed, and the main request was refused (Art. 100(b) EPC).

In **T 482/09** (viscosity) the boards held that, in opposition and any ensuing appeal proceedings, the result of using such an indefinite term in a claim was that it could not be taken to determine the limits to the protection sought, so that novelty and inventive step had to be assessed in the light of the prior art identified on the basis of all its technically meaningful possible interpretations. If the term had no specific meaning whatsoever, it would even lose entirely its effect of delimiting the claimed subject-matter from the relevant prior art.

5.5.2 Open-ended parameter features

Recent decision **T 1977/22** reviewed in detail the case law and landmark decisions about open-ended ranges, and reproducibility over the whole claimed scope.

In **T 1697/12** the claims covered, through open-ended ranges, embodiments that could not be obtained with the process disclosed in the patent, but which might be obtainable with different methods still to be invented in the future (insufficiently disclosed invention). Related decisions: **T 61/14** (point 5 of the Reasons, along the same lines, range not

achievable over whole scope), **T 2344/12** (point 1.1.2 of the Reasons, along the same lines, open ended range not sufficiently disclosed), **T 517/98** (point 1.5 of the Reasons, similar, no teaching for whole range), **T 615/19** (point 1.2 of the Reasons, conclusions of **T 1697/12** not applicable, implicit limitation of open-ended range due to the existence of other features) and **T 398/19**, summarised below, in which the board rejected objections to **open-ended ranges** starting with "at least …" or "at most …" which the opponent had raised in relation to preparation methods that were still to be invented, invoking **T 1697/12** and **T 113/19** and the German Federal Court of Justice's decisions X ZR 32/17 and X ZR 34/17 in support of its arguments.

The decision in **T 398/19** contains detailed reasons on the issue of a parameter defined by open-ended ranges. The opponent had objected to open-ended ranges of the kind starting with "at least …" or "at most …", alleging that they were not sufficiently disclosed. The board observed that the sole fact that certain features were expressed in terms of open-ended ranges was not enough to support an objection of insufficient disclosure, especially where, as in the case in hand, the description and the examples contained precise information on how to prepare one or more specific products having all the claimed features. Besides, it was common practice in the technical field concerned to characterise a product in terms of open-ended ranges and the claimed subject-matter often omitted parameters equally important for the claimed product's efficacy. Defining a product by all its structural parameters would clearly be impossible, and indeed often unnecessary in view of the invention's purpose. Lastly, the board observed that defining a parameter by an open-ended range by no means precluded the later invention of new methods whereby parameters having values very far from those claimed and so likewise patentable could be obtained. The board found that the requirements of Art. 83 EPC were met, endorsing the findings in **T 113/19**, **T 1018/05** and **T 624/08**, and holding **T 1697/12** to be inapplicable to the case in hand.

In **T 2702/19** (small diameter medical devices containing visualisation means), the board found that the person skilled in the art would not be able to derive from the patent, using their common general knowledge, a limit for the values of the maximum outer diameter of the medical device below which they would immediately exclude variants as being clearly outside the scope of practical application of the claimed subject-matter. As argued by the respondent (opponent), the patent did not disclose how to carry out the invention over the whole effective claimed range of the maximum outer diameter of the medical device. The appellant (patentee) also alleged that **T 2773/18** confirmed that values of a parameter not obtainable in practice could not justify an objection of insufficiency of disclosure. But the board was not convinced that the situation dealt with in **T 2773/18** was comparable to the case at hand since the relevant claim in that decision did not contain an open-ended range. (Similar cases to **T 2702/19** include **T 2401/19** and **T 953/21**; oral proceedings in these cases were held consecutively).

In case **T 1708/22** the board considered that the "total light transmittance" was inherently limited by the other features of claim 1. The open-ended range hence did not lead to insufficiency of disclosure.

In **T 1942/21** it had to be determined whether the patent gave the skilled person adequate instructions on how to obtain high proportions of methane in the synthesis gas. The appellant (patent proprietor) argued that this was not an issue as there would not have been any reproducibility problem had a lower limit not been specified for methane. The board disagreed. Accepting this argument would imply that any restriction added to a claim by way of a non-reproducible parameter would be allowable since the broader claim without the parameter would indeed be unlikely to have reproducibility issues. However, it is established case law that when an essential feature of an invention is expressed by a parameter, it has to be determined whether the parameter is defined so as to allow the skilled person, on the basis of the disclosure as a whole and using common general knowledge, to identify (without undue burden) the technical features that lead to the claimed subject-matter. This viewpoint was also in keeping with decisions that deemed dependent claims, i.e. those with restrictions, not to be reproducible despite there being no such sufficiency objections in relation to the broader independent claim. For the case in hand, this meant that the patent had to contain adequate instructions on how to implement the now essential feature over the entire scope since this feature defined the result to be achieved, namely a methane proportion of more than 12 vol.% in the synthesis gas. Since synthesis gas containing less methane was already known, this feature was the crux of the invention. Therefore, the teaching of the patent should enable this new feature to be obtained over the whole scope claimed. Although the case in hand related to a result to be achieved from a chemical reaction rather than to a physical parameter, it was still similar to **T 1697/12** cited in the case law, in which some realistic values could not be achieved by the claimed method, resulting in sufficiency being denied. Here, adding the amount of methane in the synthesis gas rendered this an essential feature (R. 43(3) EPC), leading to the question of how the claimed aim could be achieved across the whole scope claimed. The patent contained information on how to exceed the lower limit of methane (12 vol.%), yet it did not contain any information on how to achieve methane amounts of 20 to 25%, which arguably were not considered unrealistic. While it was true that the open-ended range was restricted by the method per se (reaction with water vapour), it was undisputed that this restriction did not rule out methane values in the range of 20 to 25 vol.%. The board acknowledged that there were decisions related to a physical parameter in which the open-ended range was not considered an issue. However, that was not the case here. Since the parties agreed that the claim encompassed methane levels of 20 to 25 vol.% and that the teaching of the patent was lacking in this regard, the subject-matter of claim 1 was not considered reproducible.

5.5.3 Unusual parameters

Where unfamiliar parameters have been used to define the solution to a technical problem, the patentee is under a particular obligation to disclose all the information necessary to reliably determine the new parameter, in accordance with **T 172/99**, **T 815/07**, and **T 593/09** (as recapitulated in **T 1845/14**).

In **T 172/99** the board found that in the case of claimed subject-matter relying on a newly formulated and hence unfamiliar parameter to define the solution of a technical problem by which a relevant effect is achieved, the patentee is under a particular obligation to disclose all the information necessary reliably to define the new parameter not only (i) in a

formally correct and complete manner such that its values can be obtained by a person skilled in the art without undue burden, but also (ii) in a manner which reliably retains the validity of the parameter for the solution of the technical problem for the application or patent in suit as a whole in the sense that the values routinely obtained will not be such that the claimed subject-matter covers variants incapable of providing the relevant effect or, therefore, of solving the associated technical problem (followed in numerous decisions; see, for example, **T 914/01**, **T 179/05**, **T 75/09** and **T 1287/15** (dispute whether unfamiliar parameter (yes) – patentee's particular obligation identified in **T 172/99** not met)).

The board in **T 54/17** cited the settled case law that two requirements had to be met for the purposes of Art. 100(b) EPC: the skilled person had to be able, firstly, to derive from the patent specification at least one way of carrying out the claimed invention and, secondly, to carry out the invention over the whole range claimed. The board held that the (second) requirement was particularly important, especially where a claim contained unusual parameters (parameters "operational result" and "reaction pattern" – certain meaning in German – not readily understood here as having a technical meaning). The board referred to the conditions listed in **T 172/99**. The board concluded that the skilled person was unable to carry out the invention.

The board in **T 602/10** found that the proprietor had deliberately decided to use a method for determining rugosity which was different from the one commonly used in the state of the art. It was therefore its duty to provide full information with regard to the means and the procedures for implementing said method. In general terms, when the issue of sufficiency concerned the description of a method for determining a parameter, the less common the method the more accurate the information provided in the description should be. In the case at issue, in the absence of any known prior-art work applying the same method used in the patent for measuring the rugosity, the skilled person had to rely primarily on the teaching of the patent to put the method into practice.

The board in **T 1287/15** decided that the "incremental adsorption capacity" parameter was a newly formulated and hence unfamiliar parameter. This case was similar to **T 172/99**, but was not comparable with **T 231/01**, in which the relevant parameters had been sufficiently described by reference to their measuring methods. In **T 1287/15** the principal issue was the understanding of the notion and not so much the availability of a measuring method, but considerations in the Catchword of **T 172/99** were nevertheless relevant. The patent proprietor (appellant) was under a particular obligation to disclose all information necessary to reliably define the new parameter it had chosen to introduce although an established parameter was available. That particular obligation, identified in **T 172/99**, had not been met.

In **T 1414/08** the board observed that sufficiency of disclosure might be questionable if specific values of an unusual parameter are formulated in a patent as essential to the invention but no method of measuring that parameter is either known in the art or disclosed in the patent. But in the case at hand the parameter (tensile strength) was not unusual. Depending on the method of measurement, there exists an uncertainty as to the actual end values of the range for the tensile strength mentioned in the independent claims (issue of Art. 84 EPC rather than of Art. 83 EPC).

In **T 1553/16** the board held that the issue at stake was not related to an alleged ambiguity in the determination of a parameter, which in some cases could indeed be a matter of clarity, but rather to a lack of essential information needed to run a specific procedure (namely the APTF-2 procedure), which had not been shown to be usual in the art but was necessary to determine an unusual feature (F time) mentioned in the operative claims. In other words, the lack of information did not result in the claim being unduly broad or unclearly delimited, but derived from the presence of a parameter which was in itself very specific, but whose method of measurement had been **kept secret**.

See also **T 1452/16** (unusual parameters – alleged prior use – public availability of a product): addressing the fact that it had been possible for the patent proprietor to obtain and test samples, the board found that, when samples manufactured after the priority date were tested, it was legitimate to ask whether the results obtained were representative of the ratios present in the prior-art samples. However, where a patent proprietor used a parameter not used in the prior art, it bore the burden of proving that the prior art did not fall within the terms of the claim.

When a parameter is not deemed to be an unusual parameter, the burden of proof cannnot be reversed (see **T 388/15**, **T 1406/14** and **T 1424/18**). The board in **T 557/22** stated that evidence that the parameter was usual in the art was not submitted by the respondent/patent proprietor.

Other decisions: **T 1764/06** (no benefit of the doubt – see Catchword); **T 288/06** (unusual method of measuring parameter); **T 815/07**; **T 484/05**; **T 1995/15** (implicit feature – where an unusual parameter is used, onus is on the applicant to establish novelty over prior art if there no reason to doubt that the prior art implicitly meets the parameter); **T 615/19** (decisions establishing insufficient disclosure owing to unclear or inadequate information on the method of determining an unusual parameter held inapplicable to case in hand because the skilled person would not have encountered any difficulty). **T 1813/22** (uncommon parameter measured by a successor model (LPA17) of a machine (LPA07) – unavailibility of model LPA07 – parameter ill-defined); **T 1900/17** (fabric conditioners – use of a calculated partition coefficient such as ClogP for selecting nonionics – thorough discussion of whether ClogP was an unusual parameter) ; **T 2943/18** (the board decided that the parameter was not unusual as alleged by the respondent (opponent)).

Further decisions on the burden of proof or unusual parameters but not in relation to Art. 83 EPC (non-exhaustive list):

In **T 131/03**, which related to novelty, the board observed that, once an opponent had established a strong presumption that unusual parameters used to define the claimed subject-matter were inherently disclosed in the prior art, the patent proprietor could not simply claim the benefit of the doubt. It was instead incumbent on it to establish to what extent the parameters it had chosen to use to define its invention actually distinguished the claimed subject-matter from the prior art. This decision is cited in **T 172/20** in relation to the assessment of novelty, with the board ruling that the parameter was not unusual as asserted by the respondent (opponent). Ultimately, the opponent bore the burden to prove that the patent was not novel over prior art document A5.

For references regarding unusual parameters, see **T 1920/09** (ex parte – novelty – unusual parameter and presumption); **T 2383/18** (novelty) and **T 555/18** (inventive step); **T 2037/22** (unusual parameter – sufficiency of disclosure and novelty – no reversal of burden of proof).

6. Reproducibility

6.1. Repeatability

In **T 281/86** (OJ 1989, 202) it was held that there is no requirement under Art. 83 EPC 1973 according to which a specifically described example of a process must be exactly repeatable. Variations in the constitution of an agent used in a process are immaterial to the sufficiency of the disclosure provided the claimed process reliably leads to the desired products. See also **T 292/85** (OJ 1989, 275); **T 299/86** (OJ 1988, 88); **T 181/87**, **T 212/88** (OJ 1992, 28); **T 182/89** (OJ 1991, 391) and **T 19/90** (OJ 1990, 476).

In **G 1/03** (point 2.5 of the Reasons) the Enlarged Board indicated that a lack of reproducibility of the claimed invention is relevant under the requirements of sufficiency of disclosure if the technical effect is a technical feature of the claim, since then it is a feature characterising the subject-matter claimed (**T 1079/08**). A lack of reproducibility of the claimed invention (i.e. a failure of the claimed features to deliver the effect aimed for) is seen to represent, in the case of an effect which is not expressed in a claim but is part of the problem to be solved, "a problem of inventive step". If an effect is expressed in a claim, there is lack of sufficient disclosure (**G 1/03**, OJ, 2004, 413, and **T 939/92**, OJ 1996, 309, cited by **T 2001/12**, **T 1845/14**, **T 2210/16**).

According to established case law, the requirement of sufficiency of disclosure of Art. 83 EPC is not met if an effect expressed in the claim cannot be reproduced (summary of the case law in **T 1473/13**; see also **T 1845/14**). **T 1473/13** and **T 1845/14** were cited more recently in ex parte case **T 553/23**.

It is also noted that the case law states, with reference to **T 1437/07**, that the **requirement of an enabling disclosure** for a prior art document is **the same** as the requirement of sufficiency of disclosure for a patent (**T 1045/21**, **T 654/20**, **T 2916/19**, **T 380/16**).

6.1.1 Artificial neuronal network

In **T 161/18** the application used an artificial neural network to transform the blood pressure curve measured on the periphery into the equivalent aortic pressure. As regards how the **neural network** according to the invention was trained, the application disclosed only that the input data should cover a wide range of patients differing in age, sex, constitution type, state of health, etc. to prevent the network from becoming specialised. However, it did not disclose what input data were suitable for training the network or even a suitable set of data for solving the technical problem in question. As a result, the skilled person could not reproduce the network's training and so could not carry out the invention. The invention, which was based on automated learning, in particular in connection with an artificial neural network, was thus insufficiently disclosed, because the training it involved

could not be reproduced owing to a lack of disclosure in this regard. See also **T 702/20** on the technical nature of a neural network implemented on a computer.

In **T 1669/21** the appellant (patent proprietor) maintained that the invention was disclosed clearly and completely in the patent even though there was no specific embodiment example. The calculation model according to the claim was a machine-learning model. Owing to rapid progress made in the field, creating a suitable machine-learning calculation model was now part of the common general knowledge (by contrast with the situation in **T 161/18**), so no specific disclosure was required. The invention was aimed at developing a "comprehensive solution" for predicting the wear state of the refractory lining of a metallurgy vessel. In the board's view, the term "calculation model" was not limited to a machine-learning model, even in connection with an adaptation ("adapted"). Therefore, the model being "adapted" was not synonymous with the model being "adaptive", i.e. self-adapting or self-learning. Claim 1 thus was not limited to a machine-learning method. The patent did not provide an example of or pointers towards the relationships to be modelled for a calculation model of this kind. For this reason alone, the main request did not meet the requirements of Art. 83 EPC. There were many different options for configuring a calculation model. However, neither the patent nor the general technical knowledge presented contained any information on the specific requirements. As such, the skilled person was faced with a significant obstacle to reproducing the invention as early as when selecting a specific suitable machine-learning calculation model. And even if the skilled person were able to find a suitable model, they alone would have to select combinations from the multitude of possible input values. Each individual attempt by itself would represent a considerable burden. Absent any concrete workable embodiment example as a starting point in the patent and any specific guidance on which parameters were relevant, there was also no evidence that invention could essentially be reproduced using a calculation model trained in accordance with the claim. In this regard, the appellant maintained that this was unnecessary because it was precisely the essence of machine learning that the ability to predict the output variable without any knowledge of the causal relationships was acquired by self-learning through training; the impact of irrelevant input variables was filtered out automatically in the process. The board held that the patent specification did not contain any specific workable embodiment example or any pointers or criteria for selecting suitable concrete parameters within the claimed categories. As for the volume and quality of the training data (see also **T 161/18**), the calculation model had only been trained on a relatively small dataset. The contested patent did not mention the presented procedure for carrying out the invention or disclose how the training data were acquired. The appellant was unable to plausibly show that the calculation model could be successfully trained using such a limited set of training data. Thus, the disclosure of the patent was vague and incomplete even in relation to the decisive aspect for the success of the invention – the training data. The lack of detail in the disclosure of the patent was disproportionate to the breadth of the claimed invention and the resulting burden placed on the skilled person to fill in the gaps in order to carry out the invention over the whole scope. **G 1/03** was invoked but unsuccessfully.

In ex parte case **T 1539/20** (method of monitoring performance of an application system distributed across a plurality of network connected nodes), claim 1 was directed to a computer-implemented method comprising an automated step of "mapping" (concerning

which term, Art. 84 EPC issues were raised) a given distributed application system to a hierarchical model, however the application as filed did not contain any information explaining how a skilled person could implement the "mapping" process in software. The appellant also submitted that the presence of non-working embodiments in the claim was of no harm, provided that the specification contained sufficient information on the relevant criteria to identify the working embodiments. However the board's objection to claim 1 was not that its scope encompassed specific non-working embodiments.

In ex parte case **T 1191/19**, concerning Art. 56 EPC, the board recalled that the mere application of a known machine learning technique to problems in a particular field was a general trend in technology (**T 161/18**, point 3.6 of the Reasons) and could not be inventive as such. -Concerning specifically Art. 83 EPC, the board noted that the application did not disclose any example set of training data and validation data, which the meta-learning scheme required as input. The application did not even disclose the minimum number of patients from which training data should be compiled to be able to give a meaningful prediction and a set of relevant parameters. In particular, the structure of the artificial neural networks used as classifiers, their topology, activation functions, end conditions or learning mechanism were not disclosed (citing **T 161/18**, point 2 of the Reasons). At the level of abstraction of the application available, disclosure was more like an invitation to a research programme. Under these circumstances, the skilled person could not reproduce without undue burden the application of the meta-learning scheme of AX1 (scientific publication) to solve the problem of predicting personalised interventions for a patient in processes, the substrate of which was neuronal plasticity.

In ex parte case **T 1526/20** the application related to a computer-implemented "liveness testing method" for distinguishing between live faces and impersonations based on 2D images. The board found that the skilled person had to have had doubts that the model provided the information necessary for reliable liveness testing. The application provided no reasons as to why this model was correct, nor results to show that the proposed way of extracting object-related information correctly distinguished live from fake objects.

In ex parte case **T 606/21** (method for evaluating predictions of trajectories by autonomous vehicles, including generating a Deep Neural Network, or DNN), the examining division considered that the application did not clearly disclose how the DNN model could provide a reliable output at the time of testing because it was fed with an incomplete input. The input at the time of testing only included the predicted trajectory, not the actual trajectory. The board considered the method comprised two main states, the first stage related to the generation of a deep neural network, DNN, and the training of this DNN by inputting pairs of trajectories in order to analyse the similarity of these trajectories and to improve the accuracy of this analysis. The board considered that there was a lack of disclosure regarding the second stage, the testing and evaluation stage.

In ex parte case **T 509/18** the invention related to a driver alertness detection system configured to use a classification training process to register the driver's head position and eye vector at several pre-determined points within the vehicle, configured to save a matrix of inter-point metrics to be used for a look-up-table classification of the driver's attention state. In the board's view, the application did not teach how to derive from the "matrix of

inter-point metrics" a "look-up-table classification of the driver's attention state", with such a "look-up-table classification" permitting to decide on the driver's attention state. The skilled person would not know how to construct a "look-up-table classification" and consequently how to decide on the driver's attention state based on the video camera's image of the actual position of driver's head and eyes at a given instant. The step of comparing the video's camera image with this look-up table classification – in order to assess the driver's attention state – required instructions and teaching concerning the kind of information to be extracted from a given video camera image and concerning the method and the criteria to be applied in order to compare; no such disclosure was to be found.

6.2. Hypothetical embodiments

In **T 515/00** the board pointed out that an invention cannot be considered to be irreproducible merely because a claim encompasses a hypothetical embodiment which lies outside the breadth of the claim as determined by the Protocol on the Interpretation of Art. 69 EPC 1973, which embodiment cannot be reproduced (endorsed in **T 519/07**).

See also **T 24/18** (point 1.7 of the Reasons).

6.3. Variants

If the only embodiment disclosed with concrete details in a patent is not disclosed in a manner sufficiently complete for the claimed invention to be carried out by a person skilled in the art on the date of priority with respect to the fundamental scope of said invention, it is of no significance with regard to the question of sufficient disclosure whether on the relevant date of filing a variant could have been carried out if the variant, although it is covered by the wording of the patent claim, does not fall within the fundamental scope of the claimed invention with regard to the teaching of the patent due to a lack of comparable technical success (**T 1173/00**, OJ 2004, 16). The board went on to state that if an invention is insufficiently disclosed, it is of no relevance whether it was objectively impossible to provide the **missing information** on the date of priority. The decisive issue is whether the invention is disclosed in a manner sufficiently complete for it to be carried out by an average person skilled in the art on the date of priority, with knowledge of the patent and on the basis of that person's common general knowledge.

In **T 1128/22** (cylindrical box with a cork plug), the appellant (opponent) maintained in particular that the skilled person would have trouble selecting the shaping method and parameters depending on the material selected for the receptacle, since there was no single rolled-edge technique that would work for all cellulose-based materials. The skilled person would thus have to make too many selections from among the numerous methods and operating parameters. The opponent also asserted that Art. 83 EPC could only be satisfied if the disclosure of the invention allowed a person skilled in the art to implement substantially all the embodiments covered by the claimed invention without undue burden (with reference to **T 1064/15**). The expression "cellulose-based material" included all possible materials containing cellulose, such as wood, bamboo and banana leaves, as well as textiles such as cellulose acetate, viscose, rayon or modal. With wood, any attempt

to fold it perpendicularly to the fibres would risk breaking those fibres. Therefore, unless a person skilled in the art knew the type of material being used, they would not be readily able to identify a single suitable technique to implement a rolled-edge receptacle. The board was not convinced by the appellant's arguments; they merely demonstrated that the scope of claim 1 was broad since it did not specify either the material or the method used to obtain the rolled edge. The fact that a claim has a broad scope was not in itself evidence that the skilled person would be unable to carry out the invention. In relation to a different argument, the board noted that with certain cellulose-based materials such as wood, the skilled person might, in some circumstances (which would also need to be demonstrated by the appellant), be unable to carry out a method for obtaining a rolled edge (as argued by the appellant). However, this did not necessarily cast doubt on whether the skilled person would be able to carry out the invention (Art. 83 EPC). As set out in decision **G 1/03** (OJ 2004, 413, point 2.5.2 of the Reasons): "Either there is a large number of conceivable alternatives and the specification contains sufficient information on the relevant criteria for finding appropriate alternatives over the claimed range with reasonable effort. If this is the case, the inclusion of non-working embodiments is of no harm".

As regards alternatives, see also in this chapter II.C.5.2., II.C.5.4., II.C.7.1.2 and II.C.7.1.4.

6.4. Use to which invention is put

Where a disadvantage of an invention (in this case the risk of injury to users) could prevent its use, this is not an obstacle to reproducibility provided that the otherwise desired result is achieved by the technical teaching disclosed in the patent in suit (**T 881/95**, see also **T 468/09**). An Art. 83 EPC objection concerning the absence of any detailed indication of the **use** envisaged for the products cannot succeed, as Art. 83 EPC merely requires the invention to be sufficiently disclosed (see e.g. **T 866/00**).

6.5. Reach-through claims

In **T 1063/06** (OJ 2009, 516) the board held that a formulation of a claim whereby functionally defined chemical compounds were to be found by means of a new kind of research tool using a screening method set out in the description constituted a reach-through claim which was also directed to future inventions based on the one now being disclosed. The applicant was entitled to claim patent protection only for his actual contribution to the art and not to reserve an unexplored field of research.

In case **T 3122/19** (identifying a subgroup of cancer patients for treatment with FGFR inhibitors), the opponent argued – based on **T 1063/06 –** that the skilled person was not able to identify all compounds falling within the broad dual-function definition of the claim without undue burden and, accordingly, such alternatives were not available to the skilled person. The board considered the invention underlying the case at hand was not the same situation as in **T 1063/06**, in which any kind of compound (without guidance in terms of chemical structure or other selection rules) would have to be screened for the desired enzyme-stimulating activity. In the case at hand, the functional definition had two levels. As a consequence there was a large pool of candidates. Testing for the second level activity against cancer cells (as described in the application as filed) would not have had

to be carried out by trial and error on randomly selected compounds, but only on a limited selection of compounds. No evidence was provided to show that a large proportion of FGFR inhibitors would fail this test (in which case identifying active compounds would be an undue burden on the skilled person).

Decision **T 1170/20** deals with reach-through claims. The appellant (opponent) asserted that the feature "an electrically insulating gas containing at least one fluorinated compound with a global warming potential (GWP) of less than 3 500" meant that the claim was a reach through claim, i.e. that the claim related to a chemical compound defined in functional terms only. The board agreed with the appellant. By contrast, the board disagreed with the respondent's (patent proprietor's) assertion that "the patent contains sufficient information to enable a person skilled in the art to find, with reasonable effort, appropriate variants of fluorinated compounds suitable for the electrically insulating gas of the medium and/or high-voltage gas-insulated electrical apparatus defined in claim 1 of the patent". In the board's view, the contested patent did not appear to state any criteria, general information or general guidelines that might guide the skilled person to find – among the broad classes of claimed compounds – those that satisfied the constraints imposed by the claim. The respondent also maintained that considering the claim at issue to be a reach-through claim was a misapplication of the Guidelines F-III.9. – November 2019 version. According to the respondent, that chapter of the Guidelines related to biotechnology inventions and, even more crucially, to compounds characterised solely by their effect or function. That was not the case here as GWP was an accepted, common parameter that was easy to determine for any given compound. However, contrary to the respondent's assertion, the technical field of a claim is immaterial if the claim is deemed to be a reach-through claim. The fundamental notion of not allowing reach-through claims is explained in the above-mentioned chapter of the Guidelines. The claim at issue covered all compounds that have a GWP of less than 3 500 and act as a medium and/or high-voltage insulating gas. The patent did not clearly identify those compounds apart from indicating that they contained fluorine. The board stressed that finding suitable compounds would pose a challenge. The respondent merely maintained – without furnishing any evidence – that a person skilled in the art would be able to find suitable compounds using ordinary skill alone and that the GWP could be determined for any suitable compound. However, that was exactly the case described in the Guidelines – the respondent was attempting to patent what had not yet been invented, and the fact that it was possible to test for the effects used to define the compounds did not confer sufficiency on the claim. The claim in fact constituted an invitation to perform a research programme.

6.6. Reproducibility without undue burden

The disclosure must be reproducible without undue burden.

6.6.1 Occasional failure

It suffices for the disclosure of an invention that the means intended to carry out the invention are clearly disclosed in technical terms which render them implementable and that the intended result is achieved at least in some, equally realistic, cases (**T 487/91**).

The occasional failure of a process as claimed does not impair its reproducibility if only a few attempts are required to transform failure into success, provided that these attempts are kept within reasonable bounds and do not require an inventive step (**T 931/91**). The skilled person is used to occasional failures when testing a technical teaching (**T 14/83**, cited in **T 1133/08**).

In ex parte case **T 1111/14** (human hepatocytes), the board, disagreeing with the department of first instance's finding on Art. 83 EPC (infringed), cited the above finding from **T 931/91** and added that, as a matter of fact, occasional failure was the rule rather than the exception in the technical field at issue.

A claim is an attempt to define a device in terms of ideal conditions, i.e. those required for its theoretically optimal or nominal operation. However, when considering a claim, the skilled person will readily understand that the conditions of actual operation will not be the ideal ones defined there. In **T 383/14** (sorting table for grape harvest), the board found that, on reading the claim at issue, the skilled person would immediately grasp how the table would operate **in practice** after a harvest and so understand its terms in a sense compatible with the actual operation of all mechanical devices, whose reliability or success rate was always less than 100% and even lower in the specific case of sorting or grading.

The board in **T 38/11** summarised the case law for making a case of insufficiency of disclosure (identifying gaps in information), and in the case at issue stated that the appellant (patentee) itself argued that a synergistic effect of a composition depended on a range of parameters and was rather an exceptional situation. As such parameters were not disclosed, it followed that the patent did not suffer from an occasional failure, but from a lack of a concept fit for generalisation. The situation may be aptly denoted as an invitation to carry out a research programme, based on trial and error, with limited chances of success (see **T 435/91** (OJ 1995, 188) and **T 809/07**). In accordance sufficiency of disclosure could not be acknowledged.

In **T 2728/16** the board concluded that the patent did not disclose a technical concept fit for generalisation, thus the majority of the systems encompassed by claim 1 were not available to the skilled person. A teaching of how the non-functional embodiments could be made functional was not at the disposal of the person skilled in the art even after reading the patent. Thus, the non-functional systems of claim 1 were not the result of an occasional failure that could be tolerated and turned into a success without undue burden, but of a systematic occurrence. The decisions **T 487/91**, **T 931/91** and **T 107/91**, cited by the respondent (patent proprietor), were thus not applicable. The board did not agree with the respondent that the reported failure rate of 2% of the experimental runs meant that 98% of the systems covered by claim 1 provided meaningful results. The experimental runs described in the patent did not encompass substantially all embodiments falling under claim 1.

In **T 603/22** (method for milling PAEK scales to obtain a powder having an average diameter of less than 100 µm), the board held that the failures in this case were not "occasional" since the patent did not show that the claimed results were achieved in at least some cases (see also **T 487/91**). This was in fact a case of systematic failure. The

appellant (patent proprietor) also relied on the case law to maintain that the necessary trial and error was acceptable. The board held that the case law stipulated limits on trial and error (see the section below in this chapter II.C.6.7.).

6.6.2 Routine selection

Reproducibility is not impaired if the selection of the values for various parameters is a matter of routine and/or if further information is supplied by examples in the description (**T 107/91**).

The board in **T 764/14** concluded that the skilled person was able, based on common general knowledge and corresponding routine variation of experimental conditions, to complement the information contained in paragraph [0031] of the patent in suit and, thus, to determine (possibly with some slight uncertainty but) without undue burden the surface Na baseline value for a given carrier.

In **T 1170/20**, relating to a reach-through claim, the respondent (patent proprietor) argued, inter alia, that if a metal having a particular thermal capacity or electrical resistance were claimed, it would not be necessary to disclose a list of all possible metals or alloys with that parameter. The board was not convinced by this argument, maintaining that it was to be decided on a case-by-case basis whether the required effort involved solely the skilled person's ordinary skill and routine practice or constituted an undue burden. The difference between the example put forward by the respondent and the claimed insulating gases was that the former could be identified by the skilled person using their standard knowledge and skill, but the latter could not.

In **T 552/22** the board stated that overexpression of SetA in E. coli was one way of performing the claimed invention that was disclosed in the patent. However, claim 1 was not limited to the overexpression of SetA. While the patent mentioned SetB and SetC, it reported no data on these two proteins or any explanation, reasoning or technical basis. The skilled person wanting to perform the claimed invention had to test the Set family members including SetB and SetC with no guarantee that any of the tested proteins would work. In view of the case law summarised by the board, this amounted to an undue burden, even if it involved routine experimentation.

See also **T 2164/21** in which neither the application as filed nor common general knowledge provided the skilled person with any information that would reliably guide them to the amino acid substitutions which resulted in an antibody fulfilling the functional requirements of the claim. The fact that methods for generating an antibody with a specific mutation, methods for assessing deamidation and methods for antigen-binding activity were described in the application, were well known to the skilled person of the application and were routine on the priority date of the application did not mean that the invention could be put into practice without undue burden. If the skilled person could only determine by conducting experiments whether they had selected a parameter (in this case, the amino acid replacing the glycine) in such a way that a satisfactory result would be achieved (in this case, an antibody with reduced susceptibility to deamidation and 70% or more of the antigen-binding activity of the original antibody) without the confidence that such result

could be achieved at all, this constituted an undue burden, even if it involved routine experimentation.

See also chapter II.C.6.6.8 "Calibration and identifiable measurement method".

6.6.3 Wrong citations

Wrongly citing a method of measuring an essential product parameter may constitute insufficient disclosure (**T 1250/01**, applied in **T 484/05** (unusual parameter)). In **T 1250/01** the consequence of an error in the description was that no method for measuring an essential parameter was disclosed and, thus, the skilled person was not able to make any measurement of the relevant essential parameter (decision cited in **T 206/08** (detergent compositions) but found inapplicable to the case in hand).

6.6.4 Forbidden area of the claims

There is a clearly predominant opinion among the boards that the definition of the "forbidden area" of a claim should not be considered as a matter related to Art. 83 and 100(b) EPC (**T 1811/13**, **T 647/15**, **T 646/13**).

In other words, according to established case law of the boards of appeal, the question of whether a skilled person is working or not within the claimed scope ("forbidden area" of a claim) is related to the definition of the scope of protection sought (Art. 84 EPC) and not to the sufficiency of disclosure of the invention (Art. 83 EPC) (as summed up in **T 1673/15**). See also CLB, 9th edn. 2019, for an overview of the earlier – or now at least minority – case law taking a different view.

See also chapter II.C.8.2. "Article 83 EPC and clarity of claims".

6.6.5 Non-disclosed steps

There is no requirement in the EPC that the claimed invention may be carried out with the aid of only a few additional non-disclosed steps. The only essential requirement is that each of those additional steps be so apparent to the skilled person that, in the light of his common general knowledge, a detailed description of them is superfluous (**T 721/89**).

6.6.6 Machine not available

In **T 1293/13** the claims limited the determination of air permeability of the garment to a particular method and to a particular machine ("Frazier 750"). However, the machine "Frazier 750" no longer existed, such that this machine could not be used for determination of the claimed values. The insertion of a feature defined as determinable by a specific machine which possibly was not – but certainly is no longer – publicly available, leads in this case to the invention not being disclosed in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art.

In **T 1714/15** the board noted that the DROP-WEIGHT TESTER RTD-5000, as described in claim 1, was uncontestedly never available. Rather, the known apparatus was a DROP-WEIGHT TESTER RDT-5000 (emphasis by the board). The respondent (patent proprietor) argued that it had provided evidence that the apparatus with the correct designation was available at the priority date and at the date of filing of the patent in suit. Thus the invention as defined in claim 1 was enabled at that point in time, which the board accepted. However, the board stated that an invention had to be enabled throughout the **whole lifetime** of a patent (**T 1293/13**). This was not the case here. The respondent stated that there was no proof that the apparatus recited in claim 1, with the correct designation, did not exist somewhere in the world. However, the respondent had stated in its reply to the grounds of appeal that the contentious apparatus had become unavailable. In such a case, following the principle of "negativa non sunt probanda" (**T 2037/18**), the burden of proof that the apparatus had ceased to exist was not on the opponent. Rather, the proprietor had to prove that such apparatus was still available. In the absence of such proof the board concluded that the apparatus was no longer available, (requirements of Art. 83 EPC not met). Case law applied in **T 1813/22** (unavaibility of machine LPA07 – uncommon parameter measured by a successor model LPA17 – issue whether the operating manuals of two machines with different product codes ("LPA07" and "LPA17") contained the same details with respect to the methods to be used).

6.6.7 Experiments

The requirement of sufficient disclosure is intended to ensure that the skilled person can carry out the invention without having to do their own research or performing an unreasonable number of experiments. It is not met if they still cannot successfully carry it out after a few instructive attempts and, instead, must first employ their own inventiveness (**T 312/88**, point 3.3 of the Reasons; **T 516/99**, point 3 of the Reasons).

The legislative purpose of Art. 83 EPC is to ensure that the skilled person can reproduce the invention without his own research or undue experimentation. Experiments are an undue burden if their primary aim is to find the solution to the problem but not if they are carried out merely to determine the numerical limits of a functionally defined range (**T 312/88**). They should quickly give a reliable picture of how the products can be produced or manufactured (**T 475/88**). However, it is not necessary for the experimental data filed with the patent in suit to be an exact repetition of the worked examples of the patent, as long as the experimental work can be regarded as being within the scope of the invention (**T 674/96**).

For experiments to be considered reasonable, the application need not disclose the best and easiest method; a long and complicated route which is nevertheless clearly successful may be considered reasonable (**T 412/93**).

The board in **T 1133/08**, faced with a multitude of options for selecting suitable materials, dimensions and procedural parameters which were merely outlined in the part of description relating to embodiments, found that there was no specific information describing in detail at least one way of carrying out the invention claimed. Experiments were needed to solve the problem (i.e. identify **parameters** and conditions resulting in a

sinusoidal profile), and, as established in **T 312/88** in conjunction with **T 68/85** and **T 18/89**, such experimentation had to be considered unduly burdensome. If an invention had several variants, it was very important first of all to describe as many as possible in detail, rather than merely outlining them, to show the skilled person that the invention could be carried out in practice across the entire breadth of the claims. Here, not one single way of carrying out the invention was apparent, nor had any subsequently been demonstrated, e.g. on the basis of experiments. The board also analysed **T 14/83**, contrasting it with **T 412/93** (genetic engineering).

In **T 345/09** (method for manufacturing parts with very high mechanical properties) the board found that the skilled person, faced with a lack of relevant examples relating to the invention's essential mechanical features, would have had to carry out a number of tests in order to arrive at it. Given the number of mechanical features (at least eight) and parameters (fourteen), combined with the ranges to be applied to these parameters and the repetitions of tests – needed for some mechanical features having to be guaranteed before and after quenching – all of which were essential to carry out the invention, the research programme facing the skilled person was, the board concluded, so extensive that it amounted to an undue burden.

6.6.8 Calibration and identifiable measurement method

In **T 641/07** (measurement method could be identified by reproducing an example), the main issues the board had to deal with were whether measurement methods could be identified, whether an incorrect reference to a measurement method could be corrected and whether details of how to perform the method of measuring one of the parameters could be ascertained. The board held, citing **T 485/00**, that when a skilled person was enabled to reproduce the invention, and it was sufficient for him to reproduce one of the examples in order to identify the method employed to measure the value of a parameter, there was no insufficiency in the description since the identification procedure in question could not be regarded as involving an undue burden.

The board in **T 1224/15** was, in particular, unconvinced by the argument that measuring the level of a polyamide's crystallinity was insufficiently described. The documents produced proved that this feature and the method of measuring it were among the skilled person's capabilities as at the invention's date of priority. The skilled person was therefore capable of supplementing the instructions given in the patent on how to measure the relevant parameters. The patent also contained a number of examples that were detailed enough to enable the skilled person to reproduce some of them and so identify or calibrate the measurement method used (see **T 641/07**). Lastly, the argument was not supported by any tangible evidence or (failed) attempt to reproduce the examples. The board was thus unconvinced that there was any lack of information in the patent that prevented the invention claimed from being carried out.

In **T 786/15** the board considered that, since it was possible for the skilled person to calibrate the method of measurement of the Tg by reverse engineering, the Tg parameter recited in claim 1 was not ambiguous, even at values close to the end ranges. Article 83 EPC was fulfilled in this case.

For other decisions dealing with the calibration of a method in the context of Art. 83 EPC, see **T 1712/09** (no attempt at calibration made – burden of proof), **T 1062/98** and **T 485/00** (possibility of calibrating methods of determining the relevant parameters), and **T 45/09**.

6.6.9 Analytical measuring methods

Where it is obvious that a skilled person would select a particular analytical measuring method, (none being disclosed in the patent), balancing its simplicity and convenience against the required accuracy, the requirements of Art. 83 EPC are met (see e.g. **T 492/92**). This is the case even if the two different analytical methods proposed by the patentee give significantly different results with the same composition. It also suffices if the person skilled in the art would assume that it was most likely that a certain method was used and this assumption could be tested in the light of the information given in the examples of the patent in suit (**T 143/02**). However, where there are different measuring methods which do not always lead to the same result, this can amount to an undue burden, as in **T 225/93**. In **T 930/99**, the board considered **T 225/93** inapplicable, as there was only one measurement method before them. The respondent's argument that there would be legal uncertainty, since third parties would not know whether they were working within or outside the range specified, was clearly an argument based on lack of clarity, which was not a ground of opposition and so could not be considered (see also in this chapter II.C.8.2.).

See also chapter II.C.5.5.1 "Ambiguous parameters", where the issue of methods of determining parameters is likewise addressed.

6.6.10 Chemical compounds

According to **T 954/05**, the structural definition of a chemical compound may not be replaced in a claim by the mere juxtaposition of a feature purportedly representing a complete chemical structure and of a functional feature if on the one hand the first feature comprises an indefinite number of compounds and there is no systematic selection rule based on the feature in question enabling the skilled person to identify the claimed compounds, and on the other hand the second, functional feature is not identifiable in the indefinite list of compounds potentially suitable for such a function because there is no indication of a typical standardised test for determining its presence or absence.

In **T 544/12** the board confirmed that a definition of a group of compounds in a claim by both structural and functional features is generally acceptable under Art. 83 EPC as long as the skilled person is able to identify, without undue burden, those compounds out of the host of compounds defined by the structural feature(s) in the claim which also fulfil the claimed functional requirements (following **T 435/91**, OJ 1995, 188, and **T 1063/06**). In **T 544/12** it was up to the skilled person to identify within the almost infinite host of alternatives covered by the structural definition of claim 1 those compounds that were phosphorescent. Claim 1 extended to classes (of iridium complexes) that were entirely different from the concept as argued by the proprietor (non-compliance with Art. 83 EPC). The board did not share the view taken by the German Federal Court of Justice (Bundesgerichtshof) in its decision of 11 September 2013 (X ZB 8/12).

See also **T 959/08** (requirement that a functional feature be implemented also highly relevant for Art. 83 EPC – no concept fit for generalisation – undue burden) and chapter II.A.3.5. "Functional features".

6.6.11 Trademark

The very detailed decision **T 842/14** concerned a chemical composition of a product designated by a **trademark** (see also **T 270/11** and **T 623/91**). According to **T 667/94**, **T 325/13**, and **T 1383/10**, when the products designated by trademarks are essential for carrying out the invention, the requirements of Art. 83 EPC are fulfilled if these products are available to the skilled person not only at the priority and filing dates of the patent but also during its **whole lifetime** (in **T 842/14** no certainty that the composition would remain unchanged). In this regard, the board in **T 1714/15**, referred, in this case in relation to a device that was now unavailable, to the previous passage as a confirmation of the fact that a patent has to be enabled throughout its whole lifetime, especially when the feature under consideration is a product which is marketed under a trademark. Note that **T 842/14** contains extensive reasoning on the distinction between the requirements of Art. 83 EPC and those of Art. 54 EPC (especially in view of **G 1/92**, OJ 1993, 277).

In the more recent ex parte case **T 872/20** the appellant contested the examinings division's finding that the added feature would contravene Art. 83 EPC because it would relate to a trademark. Apart from the fact that the appellant relied on a website printout with no date, the board pointed out that the products and their composition may evolve over time while the corresponding trademark remains unchanged. Hence, using a trademark induces de facto a lack of clarity in the claimed subject-matter, which has to remain unchanged for legal certainty (Art. 84 EPC).

6.7. Trial and error

Even though a reasonable amount of trial and error is permissible when it comes to sufficiency of disclosure, e.g. in an unexplored field or where there are many technical difficulties, the skilled person has to have at his disposal, either in the specification or on the basis of common general knowledge, adequate information leading necessarily and directly towards success through the evaluation of initial failures (**T 226/85**, OJ 1988, 336; following **T 14/83**, OJ 1984, 105; **T 48/85**, **T 307/86** and **T 326/04**; see also **T 2220/14**, highly complex technical field). Where the skilled person can only establish by trial and error whether or not his particular choice of numerous parameters will provide a satisfactory result, this amounts to an undue burden (**T 32/85**; see also **T 2237/09**, concerning a combination of parameters). Nor can sufficiency of disclosure be acknowledged, if, for an invention which goes against prevailing technical opinion, the patentee fails to give even a single reproducible example (**T 792/00**. See also **T 397/02**, **T 1440/07** and **T 623/08**).

In case **T 2220/14**, in the board's view, since the technical field to which the invention related was highly complex (methods of modifying eukaryotic cells), the average amount of effort necessary to put a written disclosure into practice in this field would be rather high and involve a considerable amount of trial and error. The board added that there is no

requirement in the EPC, either at the priority or filing date, that the applicant must have carried out the claimed invention. The board concluded that it had no reason to doubt that the invention as claimed in claims 1, 5 and 6 was sufficiently disclosed as required by Art. 83 EPC.

Where the person skilled in the art has to find out by trial and error which, if any, compound meets the parameter set out in the claim, this constitutes an undue burden. The fact that this could be done by routine experimentation was not sufficient for the subject-matter claimed to meet the requirements of Art. 83 EPC. Nor did the question whether or not the parameter could be reliably determined play a role (**T 339/05**). In **T 123/06** the board found that the **functional definition** of the device was no more than an invitation to perform a research programme, the skilled person only being able to establish through trial and error whether the claimed device was achieved. This amounted to an undue burden.

According to **T 1063/06** (OJ 2009, 516), a functional definition of a chemical compound (in this case in a **reach-through claim**) covered all compounds possessing the capability according to the claim. In the absence of any selection rule in the application in suit, the skilled person, without the possibility of having recourse to his common general knowledge, had to resort to trial-and-error experimentation on arbitrarily selected chemical compounds to establish whether they possessed the capability according to the claim; this represented for the skilled person an invitation to perform a **research programme** and thus an undue effort (following **T 435/91**). See also **T 1140/06**.

Following **T 1063/06**, the board held in **T 852/09** that since the enhancers to be used were characterised in functional terms only and the claim merely represented for the skilled person an invitation to perform a research programme, the skilled person could not carry out the invention within the entire scope claimed without undue burden (see also **T 155/08**).

In **T 2070/13** the board indicated in its preliminary opinion that an adequate test method for anti-adherence was lacking and that no suitable compounds were defined within the claimed families of compounds. In particular, the argument of the respondent (patent proprietor) that the skilled person could carry out the invention by way of routine optimisation using standard procedures was not convincing. The board stated that no standard procedure was disclosed in the patent in suit and none was referred to during the whole proceedings. Even if a specific model test procedure were used to determine the anti-adherence, this did not significantly reduce the extent of the experimental programme required to identify the appropriate anti-adherent materials. The board concluded that the skilled person was unable to identify suitable materials displaying anti-adherence due to the large number of potential materials listed, several of these listed materials also describing large families of compounds; the skilled person would be faced with an experimental programme in order to establish which of the listed materials satisfied the claimed criterion of anti-adherence.

If the patent claims require that a specific aim should be achieved (in this case, that a specific value of a parameter should not be reached), then there is no guarantee that the invention can be carried out in accordance with Art. 100(b) EPC if the patent affords the

skilled person no clue as to how he can achieve this aim outside the scope of the embodiments without an undue burden of research (**T 809/07**).

In **T 518/17** the board stated that a reasonable amount of trial-and-error experimentation might be acceptable for the purposes of finding that a claimed invention could be carried out without undue burden. This, however, presupposed that sufficient information was available that led the skilled person directly towards success through the evaluation of initial failures. Based on the evidence on file, the board considered that information on critical process variables was lacking here. The skilled person would therefore need to repeat the lengthy optimisation and improvement process, without any guarantee of success. Such a situation was often described in the case law as an invitation to perform a "research program" and considered to amount to an undue burden.

In **T 1734/20** the skilled person could only find out by trial and error whether or not a particular choice of compounds and conditions would provide a satisfactory result. The absence of any selection rule here amounted to an undue burden of conducting further research. Document D8 submitted by the appellant/opponent which was admitted in the proceedings confirmed that not every claimed combination of adsorbents, desired, and undesired compounds leads to success.

In **T 603/22** (scale milling method), the board held that the failures here were systematic, not occasional. The appellant (patent proprietor) also relied on the case law under which a reasonable amount of trial and error by the skilled person could be accepted, maintaining that the necessary trial and error was acceptable. However, the board held that the case law stipulated limits on trial and error. The condition imposed by the case law (**T 226/85**, point 8 of the Reasons; **T 518/17**) was not satisfied in this case, as set out by the board from a technical perspective in point 2.4 of the Reasons.

6.8. Post-published documents

Sufficiency of disclosure must, in principle, exist at the effective date of a patent, while post-published documents may be used as evidence that the disclosure is reproducible without undue burden only under certain circumstances.

In **T 116/18** (OJ 2022, A76) the issue of post-published evidence led to a referral to the Enlarged Board (see decision **G 2/21**, OJ 2023, A85). In essence, this referral was concerned with inventive step (Art. 56 EPC) – the patent proprietor had cited a piece of post-published evidence to demonstrate that the problem was solved and that the alleged technical effect was achieved. The referral contains a definition by the board of the term "post-published evidence". The board identified three main lines of case law: **T 1329/04**, **T 609/02**, **T 488/16**, **T 415/11**, **T 1791/11** and **T 895/13** of 21 May 2015 ("ab initio plausibility" – plausibility was ultimately not established in these decisions); **T 919/15**, **T 578/06**, **T 2015/20**, **T 536/07**, **T 1437/07**, **T 266/10**, **T 863/12**, **T 184/16** ("ab initio implausibility" – plausibility was ultimately established in these decisions); **T 31/18**, **T 2371/13** ("no plausibility" line of case law).

In **G 2/21** (OJ 2023, A85) the Enlarged Board noted in points 10 and 11 of the Reasons that the board in **T 116/18** had explicitly found that the ground for opposition pursuant to Art. 100(b) EPC was not relevant for deciding on the appeal. According to the Enlarged Board, the referred questions could therefore not be rephrased by adding a reference to sufficiency of disclosure and Art. 83 EPC. The Enlarged Board was nevertheless aware of the case law, in particular concerning second medical use claims where the notions of "plausibility" had been used ; the Enlarged Board quoted the main case law (points 73-77 of the Reasons) and stated that the scope of reliance on post published evidence was much narrower under sufficiency of disclosure (Art. 83 EPC) compared to the situation under inventive step (Art. 56 EPC). The Enlarged Board stated that in order to meet the requirement that the disclosure of the invention be sufficiently clear and complete for it to be carried out by the person skilled in the art, the proof of a claimed therapeutic effect has to be provided in the application as filed, in particular if, in the absence of experimental data in the application as filed, it would not be credible to the skilled person that the therapeutic effect is achieved. A lack in this respect could not be remedied by post-published evidence (point 77 of the Reasons).

The fact that experimental data were not published until after the filing date of the application is not prejudicial to their nature as evidence of physical phenomena, which occur independently of any publication date (**T 416/14**). See also **G 2/21**, point 91 of the Reasons, according to which evidence submitted by a patent applicant or proprietor may not be disregarded solely on the ground that such evidence, on which the effect rests, had not been public before the filing date of the patent application in suit and was filed after that date.

Even though sufficiency of disclosure must, in principle, be established at the priority date, post-published documents can be used as evidence that the claimed concept can be put in practice. Accordingly, the board decided to consider documents in spite of their late filing (**T 1164/11** related to an invention going against generally accepted scientific principles).

In **T 2070/13** the board observed that D16 – a patent specification – failed to provide any guidance as to how anti-adherence might be determined; the document was post-published with respect to the patent in suit and its disclosure was thus of no relevance to the sufficiency of disclosure thereof.

See also **T 2037/22** (proof of a claimed technical effect which is not a therapeutic effect).

See also in this chapter II.C.7.2. "Level of disclosure required for medical use – credible effect". The case law before G 2/21 can be found in the CLB, 10th edn. 2022.

6.9. Post-published standard

In **T 1290/23** the patent concerned an "AP" and an "STA" communicating with each other as well as respective methods. The board was not convinced that the reference to "IEEE Standard 802.11ax" made in claim 1 should be decoupled from the remaining features in the manner suggested by the respondent (patent proprietor). The patent proprietor indeed alleged that the issue of whether or not the AP of claim 1 complied with IEEE

Standard 802.11ax was not defined by claim 1; only the preamble of claim 1 referred to IEEE Standard 802.1 1ax. The rest of the features of claim 1 did not contain such a reference. According to the patent proprietor, the AP could coexist in the wireless network with other devices operating in accordance with IEEE Standard 802.11ax, without the need to be itself compliant with this. Moreover, the gaps in D5 could be easily filled. As indicated by the opponents, the "AP" was a key element of the "wireless network". It could not "facilitate multi-user communication" without being "in compliance with IEEE Standard 802.11ax". Nor was compliance with the earlier IEEE Standard 802.11ac sufficient to satisfy this requirement. Thus, in the board's view an AP "for facilitating multi-user communication in a wireless network operating in compliance with IEEE Standard 802.11ax" should at the very least operate in conformity with the known principles - however broad - defined for the upcoming IEEE Standard 802.11ax, at the latest, by the patent's date of filing. The opponent did not deny that D5 (a pre-version of the Draft of the IEEE Standard 802.11ax) was available online at the opposed patent's filing date. However, D5 included several TBD ("To Be Defined") statements. This showed that numerous features of the IEEE Standard 802.11ax had not been defined at the time of its publication. All subsequent drafts of the same standard had been published after the filing date. The board concluded that features were subject to changes from version to version (of a standard), but the gaps in the teaching of D5 were not small details that could be finalised using arbitrary choices or straightforward analogies with preceding versions. On the contrary, the skilled person would be expected to develop on their own an operational AP on the basis of a very early and incomplete specification. The board considered that this endeavour could not succeed without undue burden. The first-instance decision was set aside and the patent revoked.

7. The requirement of sufficiency of disclosure in the biotechnology field

7.1. Clarity and completeness of disclosure

7.1.1 General

The principles elucidated under chapters II.C.4. and II.C.5. above are also applicable to biological inventions. In particular, reference should be made to the case law laid down by the boards in **T 281/86** (OJ 1989, 202), **T 299/86** of 17 August 1989 date: 1989-08-17 and **T 409/91** (OJ 1994, 653). Issues related to completeness of disclosure are also discussed by the boards in context with inventive step (see e.g. **T 1329/04**, **T 604/04**, **T 898/05**) and industrial applicability (see e.g. **T 870/04**, **T 641/05**, **T 1452/06**, chapter I.E.). Whether the application discloses sufficient information making it plausible that the claimed polynucleotides or polypeptides have the alleged technical effect was considered a matter of inventive step (**T 743/97**; **T 1329/04**) or industrial applicability (**T 1165/06**, **T 1452/06**), whereas the relevant question under Art. 83 EPC 1973 was whether the description was sufficiently clear and complete for the skilled person to prepare the claimed products (**T 743/97**).

In **T 449/90** the board considered that the requirements of Art. 83 EPC 1973 had been satisfied where the claimed degree of inactivation ("substantially") of the Aids virus could be demonstrated with sufficient certainty. Complete inactivation of the life-threatening virus

– which the opponent had argued was necessary – was indeed highly desirable, but not an issue under Art. 83 EPC 1973, given the claim as worded.

7.1.2 One way of implementing invention over whole scope of claim

For sufficiency of disclosure (Art. 100(b) and 83 EPC), the board has to be satisfied firstly that the patent specification certainly puts the skilled person in possession of **at least one way** of putting the claimed invention into practice, and secondly that the skilled person can put the invention into practice over the **whole scope of the claim**. If the board is not satisfied on the first point that one way exists, the second point need not be considered (**T 792/00**, Catchword).

Other example decisions related to this principle: **T 811/01**, **T 1241/03**, **T 364/06**; see also **T 1727/12** on the notion of "Biogen sufficiency" and **T 1845/14**, in which the board confirmed that, as indicated in **T 1727/12**, "so-called Biogen insufficiency" is not part of the established case law of the boards of appeal.

The scope of the patent should be justified by the technical contribution to the art (**T 612/92**, repeated again in **T 2038/19** with reference to **T 435/91** (OJ 1995, 188)). The necessary extent of disclosure is assessed on a case-by-case basis having regard to the essence of the invention (**T 694/92**, OJ 1997, 408). Whether the disclosure of one way of performing the invention is sufficient to enable a person skilled in the art to carry out the invention over the whole claimed range is a question of fact that must be answered on the basis of the available evidence, and on the balance of probabilities in each individual case (**T 2038/19**).

In **T 292/85** (OJ 1989, 275) the invention at issue concerned a recombinant plasmid comprising a homologous regulon, heterologous DNA and one or more termination codons for expression in bacteria of a functional heterologous polypeptide in recoverable form. The application was refused by the examining division on the grounds that not all embodiments falling within the broad functional wording of the claims were available. The board, however, held that the non-availability of some particular variants was immaterial as long as there were suitable variants known which provided the same effect.

According to **T 740/90**, which summarises the findings of **T 292/85**, decision **T 292/85** related to an invention of which one component defined in functional terms was such that either some particular variants were unavailable or some unspecified variants were unsuitable. The board held that the disclosure was sufficient since the skilled person was aware, owing to the disclosure of the invention or the common general knowledge in their field, of appropriate variants that produced the same effect for the invention. The board in **T 292/85** also stated, however, that the disclosure did not need to include specific instructions on how to obtain all possible component variants within the functional definition. The invention in **T 740/90** was defined by parameters, not in functional terms. It was thus defined clearly, and the only possible variants were at the level of the necessary starting materials for preparing the yeasts covered by the claim. The EPC did not stipulate that various ways of performing the invention had to be described (R. 27(1)(e) EPC). All that mattered in the context of Art. 83 EPC was whether the description included one way

of preparing a yeast as described in the claim that a person skilled in the art could reproduce.

Similarly, in **T 386/94** (OJ 1996, 658) the patent specification provided a technically detailed example for the expression of preprochymosin and its maturation forms in E. coli. It suggested the possibility of expressing these proteins in micro-organisms in general. The board held that the invention was sufficiently disclosed because one way to carry out the invention was clearly indicated and the state of the art contained no evidence that foreign genes could not be expressed in organisms other than E. coli. The principles set out in **T 292/85** (OJ 1989, 275) were also applied in **T 984/00** (where the invention lay in the use of the T-region of the Agrobacterium without the genes of the T-region of wild type Ti-plasmids to avoid the deleterious effects of these genes on the target plant) and in **T 309/06** (where the appellant had disclosed a novel group of enzymes characterised by useful properties and the board allowed the appellant to claim the enzymes independently of their origin).

As for the amount of detail needed for a sufficient disclosure, this depends on the correlation of the facts of the case to certain general parameters, such as the character of the technical field and the average amount of effort necessary to put into practice a certain written disclosure in that technical field, the time when the disclosure was presented to the public and the corresponding common general knowledge, and the amount of reliable technical details disclosed in a document (see **T 158/91**; **T 694/92**, OJ 1997, 408; **T 639/95**; **T 36/00**; **T 1466/05**; **T 2220/14**).

As noted in **T 2172/15**, sufficiency of disclosure presupposes that the skilled person is able to obtain substantially **all** embodiments falling within the ambit of a claim. This principle applies to any invention irrespective of the way in which it is defined, be it by way of a functional feature or not. In **T 2172/15**, under another line of argument, the respondent (proprietor) submitted that the case law in relation to generic claims had established that not every embodiment or variant covered by a generic group of compounds had to be assessed for enablement. Rather, the provision of a concept fit for generalisation in the patent was the decisive issue to be taken into account. The board stated that claim 1 was not limited to a set of compounds or a generic group of compounds to be used in a dark extension step, but explicitly mentioned the use of a single nucleotide monomer having certain functional properties, including the ability to pair with three types of nucleotides. However, such a monomer was neither disclosed in any of the available documents including the patent, nor was a teaching for its production. Thus, contrary to the respondent's (patent proprietor's) view, there was no concept fit for generalisation.

See also in this chapter II.C.5.4.

7.1.3 Repeatability

An invention may also be sufficiently disclosed where results are **not exactly repeatable**. Variations in construction within a class of genetic precursors, such as recombinant DNA molecules claimed by a combination of structural limitations and functional tests, were immaterial to the sufficiency of disclosure provided the skilled person could reliably obtain

some members of the class without necessarily knowing in advance which member would thereby be made available (**T 301/87**, OJ 1990, 335).

The claimed subject-matter in **T 657/10** included an "elite event", i.e. a particular event resulting from a random method (for which the expectations always range from nil to high) and having at least one surprising, advantageous property. There was ample jurisprudence of the boards of appeal on "elite events". Although the specific random methods and resulting products with (normal) average properties might well be known in the prior art, the presence of a particular product with an unexpected advantageous property might justify the recognition of an inventive step. However, the disclosure has to enable a skilled person to obtain the particular product resulting from the "elite event" without the need to repeat the random method de novo, i.e. he must be able to obtain the particular product without having to rely on pure chance again. In the case before the board these requirements were not fulfilled.

In **T 326/22** the appellant opponent by reference with **T 657/10** argued that the antibody as defined in claim 1 was insufficiently disclosed in the patent application as a matter of principle because this required a de novo generation of further CD47 antibodies by a process that was based on chance. The board agreed with the appellant insofar as the process of immunising an animal with the CD47-IgV antigen disclosed in example 1 of the patent application for generating further CD47 antibodies was based on chance. However, there were no indications available to the board that the CD47-IgV antigen or the discontinuous epitope on CD47 as defined in claim 1 were uncommon in the sense that the generation of further antibodies against them required specific conditions or circumstances. In the absence of evidence to the contrary, the claimed epitope thus represented a standard epitope on a standard antigen. The board found therefore, that the disclosure in the patent application of solely one antibody (2A1) and its derivatives as such was not evidence that the generation of 2A1 was based on chance. The appellant's submission in this regard was not based on verifiable facts and hence not persuasive. The board considered the cases **T 435/20**, **T 1466/05** and **T 657/10** alleged by the opponent as not applicable to the case at issue.

7.1.4 Broad claims

The mere fact that a claim is broad is not in itself a ground for considering the application as not complying with the requirement for sufficient disclosure under Art. 83 EPC. Only if there are serious doubts, substantiated by verifiable facts, may an application be objected to for lack of sufficient disclosure (see **T 19/90**, OJ 1990, 476, point 3.3 of the Reasons). See also **T 612/92**, **T 309/06**, **T 617/07**, **T 351/01**, **T 21/05**, **T 1188/06**, **T 884/06**, **T 364/06**, **T 2038/19**, **T 1634/17**.

In some cases, more technical details and more than one example were found necessary in order to support claims of a broad scope, for example where the essence of the invention was the achievement of a given technical effect by known techniques in different areas of application and serious doubts existed as to whether this effect could readily be obtained for the whole range of applications claimed, more technical details and more than one example may be required (see **T 612/92**; **T 694/92**, OJ 1997, 408; **T 187/93** and **T 923/92**,

OJ 1996, 564). In **T 694/92** incomplete guidance was given. The claimed subject-matter concerned a method for genetically modifying a plant cell. In fact, the board held that the experimental evidence and technical details in the description were not sufficient for the skilled person to reliably achieve, without undue burden, the technical effect of expression in any plant cell of any plant structural gene under the control of any plant promoter. Further cases where more than one example was required can be found in this chapter II.C.7.4.

In **T 19/90** (OJ 1990, 476) the claimed invention was defined by the incorporation of an activated oncogene sequence into the genome of non-human mammalian animals in general. The examining division refused the application on the grounds that in the light of the differences among different animals, it could not be assumed that the sole example given – mice – could be extended to all other non-human mammalian animals and the claims were thus unrealistically broad. The board disagreed.

In **T 636/97** it was emphasised that it is a fundamental principle of patent law that a claim can validly cover broad subject-matter, even though the description of the relevant patent does not enable every method of arriving at that subject-matter to be carried out. Otherwise no dominant patent could exist, and each developer of a new method of arriving at that subject-matter would be free of earlier patents. In **T 694/92** (OJ 1997, 408) the board held that, where an invention relates to the actual realisation of a technical effect anticipated at a theoretical level in the prior art, a proper balance must be found between, on the one hand, the actual technical contribution to the state of the art by said invention, and, on the other hand, the terms in which it is claimed, so that, if patent protection is granted, its scope is fair and adequate. The board highlighted the interrelation between the requirements of Art. 84, 83 and 56 EPC 1973. See also **T 187/93**.

In **T 2249/16** the contested decision had found fault with the claims on the grounds that they covered an extremely large number of possible of compounds or methods and were also broad in comparison with the examples. The board held that this was not enough alone to establish insufficient disclosure.

The boards reiterate the principle that the fact that a claim has a broad scope was not in itself evidence that the skilled person would be unable to carry out the invention.

On broad claims, see in particular chapter II.C.7.3. below, which deals with antibodies defined by functional features. See also the basic principles in this chapter II.C.5.4a).

7.2. Level of disclosure required for medical use – credible effect

7.2.1 Preliminary remark

It should first be noted that **G 2/21** (OJ 2023, A85) reiterates the basic principles derived from existing case law, essentially with reference to **T 609/02** (see above) for sufficiency of disclosure. Indeed, although **G 2/21** dealt with inventive step, the Enlarged Board stated that, as the terminological notion of plausibility is mainly to be found in the case law of the boards with regard to the patentability requirement of sufficiency of disclosure, the

Enlarged Board accepted the appropriateness of a comparative analysis and comparative considerations in this regard (point 73 of the Reasons). The Enlarged Board departed from the concept of "plausibility"**.** It held that the **term "plausibility"** that is found in the case law of the boards of appeal and relied upon by the referring board (**T 116/18** of 11 October 2021) **did not amount to a distinctive legal concept** or a specific patent law requirement under the EPC, in particular under Art. 56 EPC and Art. 83 EPC. It rather described a generic catchword seized in the jurisprudence of the boards of appeal, by some national courts and by users of the European patent system (point 92 of the Reasons). See also chapter I.D.4.3.3a).

See **G 2/21**, in particular points 74 and 77 of the Reasons, for a reiteration of the basic principles; these are the most commonly cited points in the case law of the boards as regards sufficiency of disclosure of a therapeutic effect following **G 2/21**.

For confirmation of how **G 2/21** applies to questions of sufficiency, see e.g. **T 1779/21** and **T 979/23** (both about Dravet syndrome, a serious disease), and **T 294/20** (point 5 of the Reasons). Regarding the **limits** of this applicability, see **T 2037/22** (point 3.3 of the Reasons) regarding a non-therapeutic effect.

7.2.2 Principles established by the case law – Requirement of suitability for the therapeutic effect rendered credible

The case law reported below includes the landmark decisions establishing the applicable principles and examples of decisions subsequently taken in specific cases that recapitulate and apply those principles.

The boards of appeal have recognised that in the context of the requirement of sufficiency functional features require particular attention, as such features are defined by means of an effect that has to be achievable (see **G 1/03**, point 2.5.2 of the Reasons, case law repeated or summed up many times cited by **T 2015/20**).

According to the established case law of the boards of appeal, attaining the claimed therapeutic effect is regarded as a functional technical feature of claims relating to a further medical use. In order to meet the requirement of sufficiency of disclosure of Art. 83 EPC, the therapeutic efficacy of the composition and dosage regime for the claimed therapeutic indication must therefore be credible (principle reiterated in e.g. **T 421/14** (dosage regime involving twice-daily treatment – multiple sclerosis), where the claims related to a further medical use). Decision **T 294/20** stated that the Enlarged Board's statements in **G 2/21** could be seen to have endorsed the jurisprudence of the boards of appeal that attaining a claimed therapeutic effect was a limiting functional technical feature of a claim directed to the use of a substance or composition in a method of treatment.

The decision in **T 1959/15**, in which granted claim 1 was a second medical use claim in the format of a purpose-restricted product claim pursuant to Art. 54(5) EPC, summarises the applicable approach (point 4.2 of the Reasons): According to Art. 54(5) EPC, patentability is not excluded for substances or compositions comprised in the state of the art for a specific use in a method referred to in Art. 53(c) EPC, provided that such use is

not comprised in the state of the art. When a technical effect (which, in the case of a second medical use claim, is the therapeutic effect) is a feature of a claim, whether this effect is achieved by substantially all embodiments covered by the claim is a question of sufficiency of disclosure. Hence, because the subject-matter of second medical use claims is commonly limited to a known therapeutic agent for use in a new therapeutic application, it is usually only necessary that the patent renders it plausible that the known therapeutic agent (i.e. the product) is suitable for the claimed therapeutic application (i.e. the purpose: the technical effect). This decision was cited by **T 3122/19** notably in relation to the issue of an alleged "reach through" claim. As for plausibility, see the findings of **G 2/21** above for the current state of the law.

T 1868/16 also stated that it is established jurisprudence of the boards of appeal that, for Art. 83 EPC to be complied with, unless this is already known to the skilled person at the priority date, the application must disclose the suitability for the claimed therapeutic use (see **T 609/02**, point 9 of the Reasons; **T 433/05**, point 28 of the Reasons; **T 801/06**, point 25 of the Reasons). Clinical data are not always required. Mere verbal statements are however not enough. The patent application must provide some information in the form of, for example, experimental tests showing that the claimed compound has a direct effect on a metabolic mechanism specifically involved in the disease. In vitro examples may be sufficient, if for the skilled person they directly and unambiguously reflect the therapeutic application. Post-published evidence may be taken into account, but only to back up the findings in the application (see **T 609/02**, point 9 of the Reasons). The board in **T 1868/16** considered that the application as filed did not contain any evidence that rendered the claimed therapeutic effect plausible. The effect was not derivable from the common general knowledge either. (On the issue of evidence of a therapeutic effect and the type of evidence, see also the section in this chapter II.C.7.2.3).

In **T 609/02** the board pointed out that where a therapeutic application is claimed in the form allowed by the Enlarged Board in **G 5/83** (OJ 1985, 64), i.e. in the form of the use of a substance or composition for the manufacture of a medicament for a defined therapeutic application, attaining the claimed therapeutic effect is a functional technical feature of the claim (see **G 2/88**, OJ 1990, 93, and **G 6/88**, OJ 1990 114, for non-medical applications). As a consequence, under Art. 83 EPC, unless this is already known to the skilled person at the priority date, the application must disclose the suitability of the product to be manufactured for the claimed therapeutic application (summaries of the points established by these decisions as regards claimed therapeutic effects can be found in, for example, **T 2571/12**, point 5.2 of the Reasons; **T 1437/07**, reported below, point 37 of the Reasons; **T 421/14**, point 2.3 of the Reasons; **T 2015/20**, which contains some very detailed and instructive findings on the point; **T 395/18**, point 4.3. of the Reasons; and **T 899/14**, points 2.4 and 2.5 of the Reasons). In decisions such as **T 2181/08**, **T 338/10**, **T 1685/10**, **T 943/13** and **T 2059/13**, the boards have cited the approach taken in **T 433/05** and **T 609/02** and applied it to the specific cases before them.

The board in **T 294/20** (rendered after **G 2/21**), adressing how the suitability may be derived from the patent or application, recalled relevant passages from the **leading decision T 609/02**, inter alia: "It is required ... the claimed compound has a direct effect on a metabolic mechanism specifically involved in the disease ...". The burden to show the

suitability was on the applicant (**T 294/20** quoting **G 1/03**, OJ 2004, 413, point 2.5.3 of the Reasons).

In **G 2/21** (OJ 2023, A85) the Enlarged Board, addressing the case law related to Art. 83 EPC, first refers to **T 609/02** to illustrate the applicable law and then lists a series of board decisions in line with **T 609/02** (see **G 2/21**, points 75 and 76 of the Reasons). The Enlarged Board stressed that while the issues of sufficiency of disclosure (Art. 83 EPC) and inventive step (Art. 56 EPC) and their assessment were clearly to be treated separately and on their own, it was aware of the case law in particular concerning second medical use claims where the notion of "plausibility" had been used. In **G 2/21**, the Enlarged Board summarised the case law (point 74 of the Reasons) as follows. A technical effect, which, for example, in the case of a second medical use claim was usually a therapeutic effect, was a feature of the claim, so that the issue of whether it had been shown that this effect was achieved was a question of sufficiency of disclosure under Art. 83 EPC. Hence, because the subject-matter of second medical use claims is commonly limited to a known therapeutic agent for use in a new therapeutic application, it is necessary that the patent at the date of its filing **renders it credible** that the known therapeutic agent, i.e. the product, is **suitable for** the claimed therapeutic application. The legal and historical background to the patentability of further medical uses was explained in decision **G 2/08**. The Enlarged Board in **G 2/21** departed from the concept of "plausibility"**.** It held that the term "**plausibility**" that is found in the case law of the boards of appeal, does **not** amount to **a distinctive legal concept or a specific patent law requirement** under the EPC, in particular under Art. 56 EPC and Art. 83 EPC. It rather describes a generic catchword seized in the jurisprudence of the boards of appeal, by some national courts and by users of the European patent system (point 92 of the Reasons).

T 1779/21 highlighted how the principles set out in **G 2/21** applies in relation to Art. 83 EPC and how they worked in the assessment of sufficiency of disclosure. In **T 687/19** a referral to the Enlarged Board was requested specifically for a question in relation to post-published evidence and Art. 83 EPC. The request was rejected by the board on the basis of the law applying and citing precisely in this respect **G 2/21**.

The suitability of the claimed composition for the defined use needs to be disclosed in the patent, "unless this is already known". The disclosed utility of the claimed composition may thus also **derive its credibility from the prior art**, even if this prior art does not represent common general knowledge (**T 728/21** with reference to **T 609/02**).

Concerning the case law relating to Art. 83 EPC after **G 2/21**, on the credibility requirement, the following cases, in addition to **T 728/21** (credibility at the filing date was satisfied) should also be mentioned (in brackets key points addressed the decisions): **T 1779/21** (not credible even taking into account the prior art); **T 25/20** (no investigations or explanations, the purported mode of action merely amounted to a guess – not credible); **T 1394/21** (antibodies, credible therapeutic effect on the basis of the evidence in the application as filed, the common general knowledge and the prior art); **T 209/22** (credibility applied but without explicit mention of case **G 2/21** – based on information provided in the application, strong presumption that dual therapy was effective and once daily dosage

regime feasible – both aspects credible); **T 1057/22** (credible from the information given in the application as filed that the claimed combination of fish oil and juice leads to the claimed therapeutic effects); **T 2790/17** (even though experimental data were provided in the application as filed, not credible that the claimed therapeutic effect was achieved); **T 197/22** (the patent did not provide the skilled person with a sufficient disclosure to generally enable the therapeutic use of the claimed formulation – general suitability was not credibly disclosed because in view of D64 (prior art) and A106 (published only shortly after priority date) serious doubts prevailed – the board was not convinced that the patent provided actual proof); **T 853/22** (even accepting the argument that in a case where the technology was relatively new, the credibility of the effect could be established by relying on prior art, irrespective of whether it represented common general knowledge (**T 609/02** and **T 728/21**), the board did not find any support in the cited prior art which rendered the claimed effect credible).

The board in **T 814/12** held that it is established case law of the boards of appeal for a medical use claim to fulfil the requirements of Art. 83 EPC, unless this is already known to the skilled person at the priority date, that the patent has to disclose the suitability of the product to be manufactured for the claimed therapeutic application. A claimed therapeutic application may be proven by any kind of evidence as long as it reflects the therapeutic effect on which the therapeutic application relies (**T 814/12**, referring to **T 609/02** in particular). In **T 814/12** the board considered that by analogy the same requirements of Art. 83 EPC applied for diagnostic use claims.

In **T 895/13** of 21 May 2015 the board stated that, pursuant to decision **T 609/02**, attaining the claimed therapeutic effect was a functional technical feature of a claim drawn up in the Swiss-type form. In its view, the same principle applied to purpose-related product claims drawn up in accordance with Art. 54(5) EPC. Accordingly, the therapeutic effect provided by the claimed subject-matter was to be examined in the context of the assessment of sufficiency of disclosure (Art. 83 EPC) (see **G 1/03**, point 2.5.2 of the Reasons) and not, as in the decision under appeal, in the context of the assessment of inventive step.

In **T 1437/21**, the board stated that the assessment of sufficiency of disclosure of the utility of a medicament as a requirement for patentability was to be distinguished from the assessment of a medicament for market authorisation by an agency such as the FDA as reported in document D77 submitted by the opponent in support of its allegation that the patent failed to sufficiently disclosed the suitability.

The board in **T 1779/21** and **T 979/23** noted that treatment by therapy did not per se necessitate the complete cure of the disease, or even the addressing of its cause, but did include the alleviation of symptoms. See also chapter I.B.4.5.1.

In **T 2178/21**, in relation to "functional requirement", the board detailed the distinction between claims drafted as a method claim or as a second medical use claim under Art. 54(5) EPC defining a known product for a specific new use, and as in the case at issue a product claim stating an intended use. Here the product was claimed as such and it had to be merely suitable for the intended use. The board specified that the purpose defined

in the claim was not necessarily therapeutic. While hemostasis might be considered therapeutic, non-therapeutic applications were also covered.

7.2.3 Evidence of therapeutic effect

In **G 2/21** (OJ 2023, A85) the Enlarged Board summarises the applicable principles in relation to therapeutic effects, mostly with reference to earlier case law, as follows.

The scope of reliance on post published evidence is much narrower under sufficiency of disclosure (Art. 83 EPC) compared to the situation under inventive step (Art. 56 EPC). In order to meet the requirement that the disclosure of the invention be sufficiently clear and complete for it to be carried out by the person skilled in the art, the **proof** of a claimed therapeutic effect has to be provided in the application as filed, in particular **if**, in the absence of experimental data in the application as filed, it would **not** be **credible** to the skilled person that the therapeutic effect is achieved. A lack in this respect cannot be remedied by post-published evidence." (**G 2/21,** point 77 des motifs).

The board in **T 294/20** discussed the findings of **G 2/21**, notably in relation to the issue of proof and to which extent **G 2/21** confirmed the existing case law. The board, adressing how the suitability may be derived from the patent or application, recalled a relevant passage from the **leading decision T 609/02**: "It is required that ... the claimed compound has a direct effect on a metabolic mechanism specifically involved in the disease ...". The appellants relied on decision **T 950/13** to argue that such information may be in the form of a "plausible technical concept". However, the board considered that a "plausible technical concept" might not be stretched to include a mere hypothesis which had not to be supported by any evidence. Instead, the board confirmed the principles developed in decision **T 609/02** that, "it is not always necessary that results of applying the claimed composition in clinical trials, or at least to animals are reported. Yet, this does not mean that a simple verbal statement [...] is enough to ensure sufficiency of disclosure [...]. It is required that the patent provides some information in the form of, for example, experimental tests, to the avail that the claimed compound has a direct effect on a metabolic mechanism specifically involved in the disease, this mechanism being either known from the prior art or demonstrated in the patent per se." (**T 609/02**, point 9 of the Reasons). The board stated that the burden to show the suitability was on the applicant (**T 294/20** quoting **G 1/03,** OJ 2004, 413, point 2.5.3 of the Reasons). The board stated that this burden could not be discharged or shifted to the EPO or the public by merely alleging that a claimed therapeutic effect had to be regarded as having been demonstrated as long as it had not been disproven.

In **T 979/23**, as well as early parent case **T 1779/21**, the board noted that **G 2/21 endorsed** the conclusions in decisions **T 609/02**, **T 754/11** and **T 887/14**. The expression "proof of a claimed therapeutic effect" in **G 2/21**, point 77 of the Reasons could not therefore be interpreted as a deviation from the established case law in the context of second medical uses; it does not apply a stricter requirement than the established case law prior to decision **G 2/21**. Rather, by referring in the same sentence to a particular situation in which "in the absence of experimental data in the application as filed, it would not be credible to the skilled person that the therapeutic effect is achieved", the Enlarged Board confirmed that

means other than experimental data in the application as filed could establish proof of a claimed therapeutic effect. What was required, however, in the absence of experimental evidence, was for the patent or the application as filed to provide some information demonstrating that the claimed compound had a direct effect on a metabolic mechanism specifically involved in the disease, this mechanism being either known from the prior art or demonstrated in the patent itself (see **T 609/02**, points 5 to 9 of the Reasons). The board in **T 1779/21** concluded that a contribution to the state of the art which enables the skilled person to carry out the invention had to be present in the application as filed.

The Enlarged Board construes the term "plausibility" differently compared with the earlier case law (see in particular points 72 and 92 of the Reasons). The Enlarged Board departed from the concept of "plausibility"**.** It held that the term "plausibility" **did not amount to a distinctive legal concept** or a specific patent law requirement under the EPC, in particular under Art. 56 and 83 EPC.

The question is whether or not the skilled person, having regard to the disclosure of the patent and the common general knowledge at the relevant date of the application, would have considered that the compounds referred to in the claim are suitable to achieve the therapeutical effect (see **T 609/02**, point 9 of the Reasons). Or, in other words, whether it was plausible (or, in yet other words, whether it was credible) that the therapeutic effect could be achieved by the claimed composition (as recapitulated in **T 966/18**).

Either the application must provide suitable evidence for the claimed therapeutic effect or it must be derivable from the prior art or common general knowledge. The disclosure of experimental results in the application is not always required to establish sufficiency, in particular if the application discloses a plausible technical concept and there are no substantiated doubts that the claimed concept can be put into practice (**T 950/13** citing ex parte case **T 578/06** which related to proof that the technical problem had been properly solved to justify its wording as part of the assessment of inventive step; **T 578/06**, which summarises the notions of plausibility and post-published documents, is cited in **G 2/21** (OJ 2023, A85), point 60 of the Reasons. The board in **T 294/20** had to deal with the appellants' (patent proprietors') argument, relying on **T 950/13,** that such information might be in the form of a "plausible technical concept"; in this context the board (see present section supra) relied on and confirmed principles developed in **T 609/02**, and discussed the "plausible technical concept" in **T 950/13**.

Decision **T 950/13** was cited by the respondent (proprietor) in **T 25/20** in which the invention concerned methods and compositions for treating symptoms associated with Post-Traumatic Stress Disorder (PTSD) using Cyclobenzaprine. Claims 1 and 6 related to second medical uses of a composition comprising cyclobenzaprine. According to the respondent, the situation was analogous to that underlying **T 950/13**. In both cases, the application as filed **did not contain experimental evidence**. Nevertheless, in each case the mode of action of the drug was disclosed. Hence credibility of the technical concept should also be acknowledged in the present case. However, in the board's view the purported mode of action of cyclobenzaprine in the present case was not a mechanism at the molecular level which was of generally recognised importance for the disease or the symptom to be treated. Instead, the application as filed offered as support for the purported

mode of action merely the known suitability of cyclobenzaprine for treating sleep disturbances associated with various conditions other than PTSD. This suitability alone was not sufficient to establish credibility in the present case because there were substantiated doubts about the purported mode of action and the technical concept based on it. This was different from **T 950/13**, in which the board did not identify such doubts.

A claimed therapeutic application may be proven by any kind of evidence as long as it reflects the therapeutic effect on which the therapeutic application relies (**T 814/12**, referring to **T 609/02** in particular).

G 2/21, which ruled in particular on taking **post-published documents** into account for inventive step, states on the basis of the principle of free evaluation of evidence that evidence submitted by a patent applicant or proprietor to prove a purported technical effect relied upon for acknowledgement of inventive step of the claimed subject-matter **may not be disregarded solely on the ground that** such evidence, on which the effect rests, had not been public before the filing date of the patent in suit and was filed after that date (see points 90-91 of the Reasons).

In **T 1210/20** the board found that the appellant's contention that according to the point 77 of the Reasons of **G 2/21**, proof of a technical effect was unconditionally required in the application as filed, was not correct. Rather, this paragraph refered to the requirement for proof in the application as filed in particular if it would not be credible to the skilled person that the claimed therapeutic effect was achieved on the basis of the application as filed. The corollary was that if a therapeutic effect was rendered credible by the application as filed, then such proof – in terms of concrete experimental data – might not be necessary. The board further explained that point 74 of the Reasons in **G 2/21** was consistent with point 77 in that it does not state that proof in the application as filed is a requirement for sufficiency of disclosure to be acknowledged. In order to fulfill the requirements of sufficiency of disclosure, it was enough that the application as filed rendered the claimed therapeutic application credible.

Interpretation of **G 2/21** –– in relation to Art. 83 EPC – as to whether proof such as experimental data is required in the application, can be found in **T 1210/20** already mentioned and can also be found in the following decisions for example : **T 1779/21**, **T 25/20**, **T 116/18** of 28 July 2023 (referring board's decision, points 11.12.3 and 11.12.3 of the Reasons), **T 853/22**; **T 294/20** (also discusses the level of proof).

Regarding the **limits** of the applicability of **G 2/21**, see **T 2037/22** (point 3.3 of the Reasons) in relation to a non-therapeutic effect. Indeed, the board in **T 2037/22** (PBAT resin composition), addressed the issue of proof of a claimed technical effect which was **not a therapeutic effect** and stated that the (opponent) appellant's argument relying on **G 2/21** was based on a generalisation of analysis made by the Enlarged Board which exclusively concerned the case law relating to claimed therapeutic effects; the Enlarged Board in **G 2/21**, however, did not make such a generalisation.

a) Plausibility of therapeutic effect – case law prior to G 2/21

Without negating the solutions reached by numerous decisions in the earlier case law, cited in particular in **G 2/21** itself, the Enlarged Board in **G 2/21** departed from the concept of "plausibility". It held that the term "plausibility" that is found in the case law of the boards of appeal and relied upon by the referring board (**T 116/18** of 11 October 2021) **did not amount to a distinctive legal concept** or a specific patent law requirement under the EPC, in particular under Art. 56 and 83 EPC. It rather described a generic catchword seized in the jurisprudence of the boards of appeal, by some national courts and by users of the European patent system (point 92 of the Reasons).

The case law prior to **G 2/21** often referred to the notion of plausibility, and it was frequently noted that if a therapeutic application is to be accepted as sufficiently disclosed, the application or the patent, respectively, and/or the common general knowledge has to provide some information rendering it technically plausible for the skilled person that the claimed compounds can be applied for the claimed therapeutic use (**T 1599/06** citing **T 609/02**).

In relation to a novelty issue, the board in **T 1437/07** (Botulinum toxin) held that a disclosure in a prior art document is novelty-destroying only if the teaching it contains is reproducible. It held that this need for an enabling disclosure was in conformity with the principle expressed in Art. 83 EPC. Thus, the requirements of sufficiency of disclosure are identical for a prior art document and a patent. In this context, with reference to the principles set out in **T 609/02** (point 9 of the Reasons), it concluded that the main claim lacked novelty over prior art document R21. Moving on to the objection under Art. 83 EPC for an auxiliary request, the board in **T 1437/07** reiterated that the requirement of sufficiency of disclosure is considered to be fulfilled with respect to a claim to a second medical use if the disclosure in the patent or the common general knowledge enables the skilled person to obtain the compound to be applied and to apply it, and if there is evidence that the intended therapeutic effect can be achieved. The board in that case also stated that just because a patent disclosed an effect which had not in reality been achieved, there was no reason – in the absence of convincing evidence that the effect could not be achieved – for it to doubt that the effect could be achieved (point 38.1 of the Reasons).

The board in **T 899/14** decided that, contrary to the view taken by the appellant (patent proprietor), it was not sufficient merely to describe an administration regimen to be followed, without any evidence of the therapeutic efficacy of the proposed treatment. The appellant had not argued that it was common general knowledge but instead **relied on the examples**. The question was thus whether the information presented in the examples could render the alleged efficacy credible, or at least establish its initial plausibility. The board also noted that while results of clinical trials or animal studies were not always necessary to establish sufficiency of disclosure, a mere verbal statement in the application was not enough to establish even the initial plausibility of an alleged therapeutic benefit.

Having reiterated the applicable principles (point 4.2 of the Reasons), the board in **T 1959/15**, where granted claim 1 was a second medical use claim in the format of a purpose-restricted product claim pursuant to Art. 54(5) EPC, found that the patent in this

specific case, besides amounting to an invitation to perform a research programme and thus an undue burden, showed an effect (on cardiomyopathy) for only two exemplary compounds having the desired capability. Since these two compounds were structurally very similar, it was not plausible that all possible (structurally distinct) compounds having this capability would have the same effect.

b) Consideration of post-published documents

While the Enlarged Board in **G 2/21** (OJ 2023, A85) was predominantly concerned with inventive step, it addressed many different points of law, stating in particular that the **term "plausibility"** that is found in the case law of the boards does **not** amount to **a distinctive legal concept** or a specific patent law requirement **under the EPC** (point 92 of the Reasons). And evidence submitted by a patent applicant or proprietor to prove a technical effect relied upon for acknowledgement of inventive step of the claimed subject-matter **may not be disregarded solely on the ground that** such evidence, on which the effect rests, had not been public before the filing date of the patent in suit and was filed after that date (points 56 and 91 of the Reasons, concerning more specifically inventive step; see also the more general conclusion in point 90). See also in this chapter II.C.6.8. This decision does not fundamentally negate the earlier case law (see also points 72, 75 and 76 of the Reasons); it provides a framework but essentially leaves it to the boards to decide on a case-by-case basis (see also point 43 of the Reasons) concerning here post-published evidence lacking prima facie relevance, remarks from the Enlarged Board formulated in relation to inventive step.

The case law since **G 2/21** generally no longer refers to the notion of plausibility, making reference instead to **G 2/21**, which lays down the criteria for taking post-published evidence of a therapeutic effect into account.

Among the later case law referring to **G 2/21** in relation to the assessment of sufficiency of disclosure, see for example (key points stated in brackets): **T 209/22** (the credibility was further corroborated by a post-published document), **T 1057/22** (post-published evidence D27 merely supplemented the information provided in the application as filed – D27 was not necessary in order to consider credible the claimed therapeutic effects but only supported that conclusion) ; **T 2735/19** (credibility was acknowledged, post-published evidence D11 considered and the credible therapeutic use confirmed) ; **T 1796/22** (D1 contained experimental evidence that allowed the consideration of post-published D41, which confirmed the effect).

The board in **T 2037/22** (proof of a claimed technical effect which is not a therapeutic effect) stressed that **G 2/21** exclusively concerned the case law relative to claimed therapeutic effects.

Reiteration of the principles set out in the case law prior to **G 2/21** – reference to plausibility – consequences of plausibility for whether post-published documents considered.

In **T 184/16** the board recalled that a precondition for taking into account post-published evidence to demonstrate a certain effect was that it was already plausible at the filing date

that said effect was obtained (seworking every day e **T 488/16**, **T 1329/04** and **T 433/05**). Plausibility was acknowledged, and post-published evidence was taken into account, for example in cases where there were no "prima facie serious doubts" about plausibility (**T 108/09**, **T 1760/11** of 13 November 2012, **T 919/15**; by contrast, in **T 1329/04** there were prima facie serious doubts). In the case in hand, the application as filed did not contain any experimental evidence as regards the disputed plausibility, i.e. the plausibility of the claimed compounds being SGLT2 inhibitors. It was thus necessary to determine whether plausibility could be acknowledged in view of the common general knowledge and the prior art. The board considered it plausible that the therapeutic effect was indeed obtained. Post-published evidence D4 (comparative examples filed by the respondent/patent proprietor) could be taken into account. The fact that SGLT1 inhibition might contribute to this effect as well and was not tested in D4 was not relevant. Furthermore, the appellant (opponent) bearing the burden of proof for its assertion, the board could not conclude, in the absence of any such evidence, that compounds with large substituents were not suitable to obtain the therapeutic effect defined in claim 12. Sufficiency of disclosure was considered to be satisfied.

In **T 391/18** Claim 1 of the main request was directed to a combination of active ingredients (TMC278 and a NRTI (nucleoside or nucleotide reverse transcriptase inhibitor)) for treating HIV infection in a regime of once-daily administration. The patent did not contain any evidence on combinations of TMC278 with NRTIs. The initial plausibility – in view of the common general knowledge – could not be equated with meeting the requirement of Art. 83 EPC, but nevertheless allowed the board to consider post-published evidence. Post-published document D26 (report with clinical trials for authorisation) was thenconsidered but appeared insufficient to make credible that every possible combination of TMC278 with NRTIs that were therapeutically effective by once-daily administration would be suitable for treating HIV in a once-daily dosage regime. To find suitable combinations and their corresponding doses among all the possibilities covered by claim 1, carrying out an undue amount of research was needed. In the **field of pharmaceutical combinations**, **drug-drug interactions** need to be assessed for each drug combination to find whether and at which dose the combination is therapeutically effective. Such an assessment involves clinical studies which cannot be considered routine tests. Even if, as argued by the respondent (patent proprietor), the number of NRTIs suitable for once-daily administration were not particularly high, the research required would go far beyond what may be seen as routine testing. Therefore, there existed serious doubts substantiated by verifiable facts. But claim 1 of auxiliary request 24, limited to encompass the combination tested in D26 met Art. 83 EPC.

In ex parte case **T 2015/20** the examining division found that it was not plausible that aclidinium bromide was suitable for treatment of asthma. The application only presented experimental results concerning treatment of COPD (chronic obstructive pulmonary disease), whereas it was part of the common knowledge, as presented by D5, that COPD and asthma were distinct diseases with different mechanisms involved. The board observed that the information in D5 did not cast doubt on the statement in the application about the effectiveness of treatment. Concerning the post-published document D6, it merely warned that the use of "Duakllir Genuair" in asthma had not been officially authorised, which was per se not a ground for any serious doubts regarding the claimed

utility of aclidinium in the treatment of asthma. In conclusion, no serious doubts could support the objection of lack of sufficient disclosure. Neither **T 609/02** nor the later jurisprudence signalled a deviation from the established jurisprudence, in particular with respect to the precondition of serious doubts for a convincing argument of lack of sufficiency. The board took the view that in the present case the defined utility of aclidinium in treatment of asthma did not go against any prevailing opinion in the prior art. In this context the board considered the statement in the application, that the treatment of respiratory disorders, particularly asthma and COPD, with aclidinium was most effective upon administration by inhalation in a dosage of about 400 µg metered nominal dose to represent a significant technical teaching, which was far from an invitation to perform a research programme and which did not prima facie lack plausibility. This teaching was as such **falsifiable**, in the sense that it was open to challenge, and was therefore considered to represent information in the form of a specific technical contribution which went beyond some insufficient verbal statement. The board held that sufficiency was therefore not to be denied following its assessment that no serious doubts had come about with respect to the defined utility. The board turned to the examination of inventive step itself, considering in this respect also the question of plausibility.

In **T 966/18**, which includes detailed technical reasoning, the board was convinced that the medical use of claim 1 was plausible on the basis of several cited documents illustrating the knowledge of the skilled person, taken together with the relevant disclosure of the patent. It concluded that the body of knowledge evidenced had made the skilled person aware of a link between the reduction of α-synuclein aggregation and the treatment of Lewy body disease. Later published evidence was also taken into account and confirmed this conclusion.

On post-published documents, see also chapter II.C.6.8.

c) Consideration of post-published documents limited: cannot remedy a fundamental insufficiency of disclosure

Post-published evidence may be taken into account, but only to back up the findings in the application in relation to the use of the compound(s) as a pharmaceutical (**T 609/02**, **T 950/13**).

If the description in a patent specification provides no more than a vague indication of a possible medical use for a chemical compound yet to be identified, more detailed evidence cannot be used later to remedy the fundamental insufficiency of disclosure of such subject-matter (**T 609/02**). Where the therapeutic effect is a functional technical feature of the claim, the application must disclose the suitability of the product to be manufactured for the claimed therapeutic application and evidence filed later cannot be used to remedy a fundamental insufficiency of disclosure (point established in **T 609/02**, as summarised in **T 1045/13**).

In **G 2/21**, the Enlarged Board summarises this case law (primarily **T 609/02**) and then lists a series of decisions in line with **T 609/02** while reiterating the main reasons (points 75 to 77 of the Reasons). Among these principles, **G 2/21** states that in order to meet the

requirement that the disclosure of the invention be sufficiently clear and complete for it to be carried out by the person skilled in the art, the proof of a claimed therapeutic effect has to be provided in the application as filed, in particular if, in the absence of experimental data in the application as filed, it would not be credible to the skilled person that the therapeutic effect is achieved. **A lack in this respect cannot be remedied by post-published evidence**.

Since the case law on this point prior to **G 2/21** has been confirmed, it remains applicable. At the end of each section, decisions following **G 2/21** are specifically highlighted first, confirming that post-published evidence cannot remedy an initial lack of disclosure.

Referring to **T 609/02**, the board in **T 433/05** recalled that where a therapeutic application was claimed in the Swiss-type form, attaining the claimed therapeutic effect was a functional technical feature of the claim. As a consequence, under Art. 83 EPC 1973 the application had to disclose the suitability of the product to be manufactured for the claimed therapeutic application (see also **T 1685/10**). Note, however, that according to **G 2/08** (OJ 2010, 456), where the subject-matter of a claim is rendered novel only by a new therapeutic use of a medicament, such claim may no longer have the format of a so-called Swiss-type claim as instituted by decision **G 5/83** (OJ 1985, 64). Following **T 609/02**, the board in **T 801/06** recalled that a claimed therapeutic effect **may be proven by any kind of data** as long as they clearly and unambiguously reflect the therapeutic effect. Thus, the fact per se that the experiments in the patent were not carried out with a "real" metastasis was not sufficient to deny sufficiency of disclosure.

In **T 2571/12** (treatment of schizophrenia with glutathione), the board stated that there was no evidence at all either in the patent or in the available prior art for a therapeutic effect of glutathione precursors for any of the claimed disorders, and hence the post-published document, allegedly supporting such an effect inter alia for bipolar disorders, likewise could not been taken into account for the assessment of sufficiency of disclosure.

In **T 1045/13**, concerning a second medical use claim worded in accordance with Art. 54(5) EPC, the board stated that the application as filed did not provide any indication of the principle underlying the relationship between the activity of the pharmaceutically active agent, i.e. the NGF, and the therapeutic effect, i.e. the alleviation of the symptoms of the psychological conditions claimed. The description did not provide any information on the mechanism of action of NGF. No background references were cited that linked NGF to the therapeutic effects to be obtained, and no in vitro assays were provided to illustrate any such effect. In the complete absence of such information, the experimental evidence on file was of decisive importance. But the evidence in the application as filed did not constitute a sufficient disclosure. Indeed, the experimental evidence consisted of eleven examples relating to various conditions but did not cover all the conditions defined in claim 1; each example related to a single patient only, contrary to the common practice in order to allow statistical analysis of the results. Also, in the absence of a control group, placebo effects could not be excluded. The post-published evidence might be taken into account, but only to back up the findings in the patent application. Post-published evidence could not establish sufficiency of disclosure on its own. They did not need therefore to be

discussed. For sufficiency of disclosure, it is not relevant what the respondent (patent proprietor) was aware of, but decided not to disclose.

Decisions since **G 2/21** confirming that post-published evidence cannot remedy an initial lack of disclosure. For example (key points stated in brackets): **T 1779/21** (therapeutic effect was not credible; post-published data was not taken into account ; **T 2790/17** (even though experimental data was provided in the application as filed, the therapeutic effect was not credible so that post-published evidence could not be taken into account) ; **T 197/22** (a lack of sufficiency of disclosure cannot be remedied by post-published evidence – the patent proprietor's argument relying on the post-published document D39 was therefore not persuasive) ; **T 166/22** (there were serious doubts substantiated by verifiable facts; post-published evidence D24 was therefore not taken into consideration); **T 853/22** (the effect not credibly disclosed could not be remedied by post-published document D8).

In **T 552/22** the lack of disclosure could not be remedied by post-published evidence and the board specified that the **right to be heard** did not entail the right to have post-published evidence considered.

d) Whether opponents can cite post-published documents

See, in this chapter II.C.7.4., the decision **T 1872/16**, in which the board stated that opponents were free to use whatever evidence they chose to substantiate their serious doubts. This also applied to the date on which the evidence was generated.

e) Invoking G 2/21 for evidence of a non-therapeutic effect

The board in **T 2037/22** (PBAT resin composition) dealt explicitly with the allegation of the appellant (opponent) that evidence D4 and D5 should not be taken into account, since it would be derivable from decision **G 2/21** that a lack of sufficiency of disclosure could not be remedied by post-published evidence. In the board's view, the appellant's argument relying on **G 2/21** was based on a generalisation of analysis made by the Enlarged Board which **exclusively** concerned the case law relative to **claimed therapeutic effects**. The Enlarged Board, however, had not made such a generalisation, let alone undertaken any analysis of the case law concerning any other type of effect in relation to sufficiency of disclosure. There was in particular no indication that the Enlarged Board in **G 2/21** was of the view that in order to meet the sufficiency requirement, proof of a claimed technical effect which was not a therapeutic effect had to be provided in the application as filed, let alone in general for a parametric or functional definition meant to provide a limitation of the subject-matter defined otherwise in terms of structural features.

f) Types of evidence of a therapeutic effect and consideration of clinical trials

In **T 2218/16** (gene therapy of motor neuron disorders – scAAV9 vector), the board summarised that, according to the established case law, the provision of evidence in the patent application for a claimed effect was not a prerequisite for patentability, if, based on the data in the patent application/patent, or on common general knowledge, it was

plausible that a product (here: scAAV9) was suitable for the claimed therapeutic applications (the decision also contains a detailed summary of the case law on the burden of proof; see the full point 32 of the Reasons).

All kinds of experimental data have been accepted by the boards. It has also been repeatedly emphasised that "it is not always necessary that results of applying the claimed composition in clinical trials, or at least to animals are reported" (**T 1273/09** citing **T 609/02**). Reiteration of the principles and application in **T 294/20**, which predominantly refers to passages of **T 609/02** and discusses the findings of **G 2/21**.

In **T 421/14** (dosage regime involving twice-daily treatment – multiple sclerosis), the claims related to a further medical use. All objections raised by the appellants (opponents) concerned the credibility of the alleged therapeutic efficacy. The respondent relied on the data and analysis of a clinical trial. It was known that only a proportion of patients responded to the treatment. The existence of a population of non-responders was also confirmed by the inventors' own results. In the board's view, the existence of these non-responders was not a reason to find the disclosure insufficient, and the treatment of non-responders did not have to be excluded or disclaimed; that a substantial proportion of patients were non-responders was a common phenomenon.

T 338/10 concerned a claim for a second therapeutic use in which the active ingredient was a "first allergen" and the therapeutic use the treatment or prevention of an allergy caused by a different, second allergen. The board found that there was no experimental data in the patent proving that a first allergen could be used to treat an allergy caused by a different allergen.

In **T 1777/12** claims 1 and 10 were medical use claims and related to the use of a PYY agonist in the manufacture of a medicament for treating a metabolic disorder in an obese or overweight subject. Clinical trials are not required to establish suitability. It may suffice that in vitro or in vivo data directly and unambiguously reflect the therapeutic effect on which the claimed therapeutic application relies or, alternatively, that there is an established relationship between the physiological activities of the compound under consideration and the disease in question. The board concluded that the disclosure in the patent demonstrated the suitability of PYY for achieving a beneficial effect in all of the claimed therapeutic applications by reducing weight or weight gain.

A post-published document reporting that no proven effective vaccine against HSV was available did not prove the non-workability of the invented vaccine, since there might have been other reasons, e.g. regulatory reasons, for not producing vaccines according to the invention. Furthermore, for compliance with the requirements of Art. 83 EPC 1973, it was not necessary to undertake and disclose clinical trials (**T 1023/02**).

For the acceptance of sufficient disclosure of a therapeutic application, it is not always necessary for results of clinical trials to be provided at the relevant date, but the patent/patent application must provide some information showing that the claimed compound has a direct effect on a metabolic mechanism specifically involved in the disease. Once this evidence is available from the patent/patent application, post-published

evidence may be taken into account to support the disclosure in the patent application (**T 433/05**). In **T 1045/13** the board agreed with the statements made in **T 433/05** and **T 801/06**, but in case **T 1868/16** (suitability of everolismus for treating PNETs), no data or plausible technical concept was present in the patent.

See also **T 1210/20** and decisions **T 1779/21** and **T 979/23** which, besides specifically addressing the particular case of serious diseases (see below), analyses the general statements in **G 2/21** regarding evidence.

g) Level of proof required in case of a serious disease

The board in **T 979/23** referred in its communication (Art. 15(1) RPBA) to parent case **T 1779/21** and the reasoning therein**,** both cases dealing with Dravet syndrome. Although the skilled person could conclude, from the data in the patent or the application as filed, that fenfluramine in combination with valproate alleviated some symptoms of Dravet syndrome, it was not clear whether this also applied in the case of a monotherapy. In view of the serious nature of the disease, additional circumstances had to be borne in mind when deciding whether "proof of a claimed therapeutic effect" was provided in the application as filed. In this particular case, where an incorrect therapeutic decision could lead to irreversible damage, the level of proof required had to be at least such that the skilled person had reason to assume that the standard valproate treatment could be discontinued and replaced by fenfluramine without worsening the patient's condition. In **T 979/23**, the respondents (patent proprietors) alleged that **T 1779/21** incorrectly took the severity of the disease into account, which implied a higher standard. The board did not agree because what was assessed in **T 1779/21** was whether it was credible that fenfluramine monotherapy could achieve a therapeutic effect in Dravet syndrome. **Achieving a therapeutic effect would mean** that the therapeutic treatment resulted in at least an amelioration of the patient's condition in some way. This was in particular the case if not treating the disease would have irreversible consequences. If, however, it was not credible that fenfluramine monotherapy lowered the number of epileptic seizures in comparison to other established treatments, a relative worsening of the patient's condition had to be expected, since monotherapy means that no additional treatment is permitted. The board in **T 979/23** did not identify any legal or technical errors in decision **T 1779/21**.

7.2.4 Pharmaceutical compositions

In **T 1616/09** the board pointed out that, for the purposes of Art. 83 EPC, the level of disclosure in the application which is required for claims directed to pharmaceutical compositions or kits is not the same as that which is required for medical-use claims. For claims directed to pharmaceutical compositions or kits it is in principle sufficient that the application provides information which allows the skilled person to produce the composition or kit, and that there are no substantiated doubts that it could indeed be used in therapy. For second medical use claims, on the other hand, it is required not only that the composition itself is disclosed in an enabling way but also that its suitability for the claimed treatment is **plausibly** disclosed in the application. In the case of a claim directed to a pharmaceutical composition comprising two classes of compounds which had both already been used in therapy in the prior art, there was a priori no reason to doubt that

such a pharmaceutical composition could be produced; no specific functional effect had to be demonstrated. In the case of second medical use claims, if the claimed therapeutic effect was already known to the skilled person at the priority date, it was not necessary to demonstrate it in the application. According to **T 1616/09**, **T 609/02** does not apply to compositions but only to second medical use claims (see also **T 1592/12**, which also states that it is not sufficient to show that the skilled person can apply the claimed dosage regime, points 16-17 of the Reasons).

7.2.5 Field of pharmaceutical combinations (drug-drug interactions)

See **T 391/18** above on the need in the field of pharmaceutical combinations to assess drug-drug interactions for each drug combination.

7.2.6 Medicament directed to a specific group of patients

T 1491/14 concerned a medicament whose novel feature was that it was directed to a specific group of patients. A lack of sufficiency was alleged on the basis, in particular, that the skilled person was not able to identify the group of patients. Contrary to the opponent's arguments, it was not necessary to measure a physical or chemical parameter to identify the patients. This view was confirmed by the expert declarations (standard practice for a physician to question the patient). The fact that there were no standard questionnaires for this purpose did not create an impasse (anamnesis). While there might sometimes be uncertainty, this amounted to a lack of clarity rather than a lack of sufficiency. As the technical features in question (definition of the patient group) were already present in the claims as granted, and the cause of uncertainty was not the amendment, this issue was not within the scope of the opposition appeal proceedings (see **G 3/14**).

In **T 166/22** independent claims 1 and 6 as granted were directed to the use of a combination of at least four components for maintaining or increasing body weight in an elderly human above 65 years of age. Examples 3, 4, 9 and 10 of the application as filed contained evidence related to the effect. It was common ground that age-related body weight development is parallel in mice and humans. The matter of dispute between the parties arose from the fact that the application as filed provided evidence of a body weight increase in adult mice while the effect required by claims 1 and 6 was to stop or reverse body weight decline in elderly humans. There was no evidence on file that, on the priority date, the mice tested in examples 3, 4, 9 and 10 constituted established or generally recognised models for body weight development in elderly humans. The respondent (patent proprietor) referred to D19, but in the board's view the skilled person would not assume that such an effect was credible from the evidence in the application as filed. The respondent also referred to D18, however D18 did not constitute common general knowledge, nor was it cited in the application as filed. Therefore, the content of D18 would not affect the skilled person's assessment of whether the claimed subject-matter was sufficiently disclosed on the filing date. The board therefore concluded that there existed serious doubts substantiated by verifiable facts. In accordance with the finding of **G 2/21** (point 77 of the Reasons), the proof of the effect recited in claims 1 and 6 had to be provided in the application as filed. A deficiency in this respect could not be remedied by

post-published evidence. Therefore, the evidence in post-published D24 (clinical study filed in response to the board's preliminary opinion) could not be taken into consideration.

7.2.7 Disclosure for some side effects

In **T 2444/18** the board said that it it had been rendered credible that a mixture of isoleucine, leucine and valine might reduce certain side effects of sorafenib. The board agreed, however, with the opponent's view that this teaching could not be extended to different side effects for the following reasons. Even if admitted, the disclosure of document D10 (post-published evidence) on the potential utility of BCAAs against one further side effect would not remedy the absence of a substantiated general concept that would allow the teaching of example 1 to be extended to all conceivable side effects. The patent proprietors also argued that the wording of claim 1 "for use in reducing a side effect" required only one side effect to be reduced. The board arrived at a different conclusion. Claim 1 of the main request did not specify a particular side effect. If BCAAs as defined in claim 1 were administered to a patient to reduce or prevent a side effect other than bleeding, e.g. tinnitus, this was an alternative embodiment covered by claim 1. The therapeutic efficacy of BCAAs in preventing or treating tinnitus (and other side effects not covered by example 1) was not supported by evidence and was not rendered credible in the application as filed.

7.3. Level of disclosure required for antibodies

In **T 431/96** the skilled person seeking to reproduce the invention would have had to produce monoclonal antibodies by routine methods and test them singly in an assay. Although this might possibly involve some tedious and time-consuming work, it was nothing out of the ordinary since the techniques for the production and selection of hybridomas were common routine techniques at the priority date of the patent in suit.

In **T 435/20** the board acknowledged by reference to **T 431/96** that raising and screening antibodies involved only routine experimentation. However, this was ony the case if the skilled person knew from the disclosure in the patent or from common general knowledge (i) which antigens were suitable for raising antibodies having the desired properties and (ii) which screening processes should be used to select these antibodies without undue burden. In decision **T 435/20** the board said that the conclusion reached in decision **T 431/96**, that the generation of antibodies to known antigens was routine, did not apply.

The board in decision **T 1103/22** (definition of active site disputed by parties in relation to sufficiency of disclosure) notably said – with reference to **T 435/20** – that it was common general knowledge that it was not a matter of routine to make antibodies against some epitopes (in particular non-linear ones) and this could require considerable inventive skill. Since insufficient disclosure cannot be remedied by post-published documents, they were not taken into account.

Concerning screening processes for selecting antibodies, contrary to the appellant's (opponent's) view, the board in **T 326/22** considered that the case differed from **T 435/20**, **T 1466/05** and **T 657/10**. For the board, it was credible that the skilled person would arrive

without undue burden at further antibodies falling within the scope of claim 1. The board also referred to **T 431/96**.

In **T 2164/21** neither the application as filed nor common general knowledge provided the skilled person with any information that would reliably guide them to the amino acid substitutions which resulted in an antibody fulfilling the functional requirements of the claim. The fact that methods for generating an antibody with a specific mutation, methods for assessing deamidation and methods for antigen-binding activity were described in the application, were well known to the skilled person and were routine on the priority date of the application did not mean that the invention could be put into practice without undue burden. The board then considered the settled case law as to when experimentation and testing was reasonable.

The board found that the essential issue to be considered in **T 601/05** of 2 December 2009 was whether or not the patent enabled the production of human monoclonal antibodies binding with high affinity to soluble TNF and, consequently, whether or not the skilled person could practise the invention over the whole scope of the claim (following **T 792/00**). On the evidence before the board it did not.

In **T 1466/05** the question arose whether the availability of a hybridoma producing one specific antibody together with a general description of the epitope recognised by this antibody put the skilled person in the position to obtain further antibodies with the same specificity. The board observed that similar questions had arisen in various cases decided by the boards of appeal, and different boards had given different answers depending on the circumstances of each case (**T 510/94**, **T 513/94**, **T 349/91**, **T 716/01**).

In **T 1466/05** the claim was not restricted to monoclonal antibodies defined by reference to the deposited hybridoma. As the application did not disclose any specific antigen for preparing further antibodies as claimed, the board considered that a skilled person seeking to prepare such antibodies would have had to embark on **a research programme** without any teaching in the application as how to achieve the desired specificity which amounted to an undue burden (cited in this respect by **T 760/12**; see also **T 435/20**, including on technical aspects very detailed reasons, where the facts were considered by the board comparable to the facts underlying **T 1466/05**).

In **T 424/21** (therapeutic antibodies and Fc fusion proteins) the disputed claim was formulated in the form of a **first medical use**. According to the board, the Enlarged Board in **G 5/83**, although not commenting explicitly on Art. 83 EPC, also saw no general issue of sufficiency of disclosure for a broad first medical use claim and did not see the need for the inventor to "restrict himself ... to a specified therapeutic purpose". The board in the case in hand could not derive any requirement from the EPC whereby a patent would have to show that a compound was suitable for each and every disease in order for a first medical use to be sufficiently disclosed. Instead, it was sufficient to show that the compound was suitable for at least one particular medical use, as was the case in the patent at issue. The present case was different from the situation underlying decision **T 604/04** (sufficiency of disclosure denied in relation to a first medical use).

Concerning the second medical use claims (claim 6 in the "Swiss-type" format, claim 7 in the purpose-restricted product claim format) in **T 760/12**, the technical effect, which was the therapeutic effect, was expressed in the claim. When the technical effect is expressed in the claim, the issue of whether this effect is indeed achieved over the whole scope of the claim is a question of sufficiency of disclosure (**G 1/03**, OJ 2004, 413, point 2.5.2 of the Reasons). Hence, under Art. 83 EPC, unless this is already known to the skilled person at the priority date, the application must disclose the suitability of the product to be manufactured for the claimed therapeutic application (**T 609/02**, point 9 of the Reasons). The board concluded that it was not sufficiently disclosed in the patent that a single monoclonal antibody as defined in the claim potentially exerted the therapeutic effect as claimed.

The claim at issue in **T 405/06** was directed to immunoglobulins with certain stated features. The question to be answered was whether a skilled person would have found at the filing date in the application as filed a sufficiently clear and complete disclosure of the precise structure of such an immunoglobulin in order to be in a position to prepare it over the broad range of the claim. Although the claim was not limited to immunoglobulins obtained from camelids, the experimental part of the description as a whole and the corresponding figures dealt exclusively with camel immunoglobulins and the general part of the description did not contain a complete disclosure of any non-camelid immunoglobulin either. The requirements of Art. 83 EPC 1973 were thus not satisfied, as the skilled person would be left with the task and burden of finding out how the teaching relating to camelid immunoglobulins could be extended to products of different origins (e.g. human immunoglobulins) falling within the broad area of the claim.

The application the subject of **T 433/07** concerned broadly reactive opsonic antibodies that react with common staphylococcal antigens. The board held that the invention was insufficiently disclosed; the application did not disclose either any serotype cross reactive monoclonal antibody or the isolation of an antigen associated with the serotype cross protective response required by the claim. A European patent application containing a claim referring to a method of production had to provide the skilled person with the means to produce the desired product. If this was not the case, this shortcoming could not be overcome by telling him exactly how the desired product had to look and which screening criteria had to be applied to find it.

In **T 617/07** the claim at issue concerned monoclonal antibodies and synthetic and biotechnological derivatives thereof defined by structural and functional features. The board found that, given his common general knowledge, the skilled person would be able, in a possibly time-consuming but straightforward manner, to provide antibody variants having the functional requirements indicated in the claim. There was no doubt that the structural definition in the claim included antibodies that did not have the desired function but, when attempting to rework the invention the skilled person would on the basis of his knowledge be able to avoid non-functional variants. Therefore, because the skilled person knew how to achieve antibodies with the desired function on the basis of a particular known antibody, he was not in the situation of having to sort out non-functional variants in a burdensome manner.

In **T 386/08** the patent concerned humanised antibodies with framework sequences. It disclosed not only one, but many examples. The board pointed out that the concept of sufficiency of disclosure over the whole scope of the claim did not mean that, for a disclosure to be considered as sufficient, it had to be demonstrated that each and every conceivable embodiment of a claim could be obtained; see **G 1/03** (OJ 2004, 413). There may be situations where the specification contains sufficient information on the relevant criteria for finding appropriate alternatives ("variants") over the claimed range with reasonable effort. Under these circumstances the non-availability of certain variants encompassed by the claim at the priority date is considered immaterial for the sufficiency of disclosure. For an example where this was not so, see **T 601/05**. The current situation however was different in that the patent described quite a number of appropriate alternatives and in that the allegedly non-obtainable variants were "hypothetical" variants. The requirements of Art. 83 EPC were fulfilled.

Article 83 EPC was not complied with in **T 941/16** (anti-PSMA antibody). The board decided that, in the absence of any examples of a claimed antibody/fragment, the general information in the patent application and the common general knowledge, taken together, could not be considered to provide the information necessary to allow the skilled person to reliably obtain substantially all of the claimed antibodies/fragments fulfilling the functional requirements of the claim. For particular combinations of complementarity-determining regions (CDRs) it was not credible that a humanised antibody/fragment with the properties defined in claim 1 would be obtained. Readily performing the invention across the entire scope of the claim placed an undue burden on the skilled person. Lastly, the board, with reference to **G 1/03** (OJ 2004, 413, point 2.5.2 of the Reasons), dealt with the argument made by the appellant (applicant) that patent applications in the field of biochemistry should not be treated worse than those in the other fields of classical chemistry (presence of **non-working embodiments** in a generic chemical formula).

As regards claims directed to antibodies defined by **functional features** (i.e. by their ability to perform a certain function), it was stated in the Guidelines G-II, 5.6.1.3 – March 2023 version: "If an antibody is defined exclusively by functional properties, it has to be carefully assessed whether the application provides an enabling disclosure across the whole scope claimed". As to the related case law, the boards held Art. 83 EPC not to be met in the following decisions: **T 1466/05**, **T 601/05**, **T 1389/13**. For examples of cases in which sufficient disclosure was established, see **T 2045/09** and **T 845/19** (antibody defined, after limitation, by structural and functional features). See also Guidelines G-II, 6 – April 2025 version .

For other decisions concerning antibodies, see **T 32/17** (definition of an antibody by reference to a deposited hybridoma – R. 31 EPC); **T 1708/18** (several aspects related to the antibodies discussed in the context of novelty).

7.4. Whether opponents can cite post-published documents

In **T 1872/16** (claim 1 was drafted in the form of a purpose-limited product claim pursuant to Art. 54(5) EPC) the suitability of an IL-13 antibody as defined in the claim for the

treatment of specific forms of asthma had to be assessed. The application did not contain any experiments testing the suitability of the antibodies and did not disclose a link between IL-13 and the specific forms of asthma recited in the claim. The appellant (patent proprietor) disputed that the respondents-opponents could use post-published documents (i.e. D23, post-published clinical trial) to refute the suitability of a claimed compound for a claimed therapeutic application, submitting that only documents available at the effective date of the patent could be taken into account. The board explained that the standard established in the case law was that serious doubts had to be substantiated by verifiable facts. The opponents were free to use whatever evidence they chose to substantiate those serious doubts. This also applied to the date on which the evidence was generated. There might be cases where the serious doubts could only be properly substantiated by facts which were obtained after the effective date of the patent (see **T 219/01** in relation to a medical use claim and lack of sufficient disclosure on the basis of post-published clinical trial). The respondents could therefore base their arguments on document D23. In the board's view, with the patent not containing any examples of antibodies which had been shown to be suitable for treating severe asthma, it was sufficient for the respondents to show one embodiment which was not suitable. On the basis of D23 the skilled person would have had serious doubts as to the suitability of the antibody for treating severe asthma. The requirements of Art. 83 EPC were not met.

7.5. Factors contributing to a finding of undue burden

In **T 187/93** there were experimental uncertainties in the patent application. The board found that the skilled person, when trying to obtain the same technical effect with a different glycoprotein would have experienced lack of predictability, which amounted to an undue burden.

In **T 2006/08**, although no experimental details were provided for factor IX in the patent in suit, the board considered that no undue experimentation would be required to carry out the method steps. It was plausible that the claimed process achieved an improvement of the in vivo function of factor IX. The requirements of Art. 83 EPC were fulfilled.

Similarly, in **T 727/95**, the board found that the invention relied too much on chance. The claimed subject-matter included a "microorganism designated Acetobacter and having the ability of microorganisms [...]". The board observed that by including the phrase "having the ability of", the claim covered not only Acetobacter microorganisms derived from the deposited strains, but also Acetobacter microorganisms which had the stated characteristics in common with the deposited strains. In the board's judgment, finding other stable, cellulose high-producing Acetobacter strains in nature was a chance event, and relying on chance for reproducibility amounted to an undue burden in the absence of evidence that such chance events occurred and could be identified frequently enough to guarantee success. The board concluded that the claim was not repeatable without undue burden over the entire breadth of the claim.

The claimed subject-matter in **T 639/95** concerned a method for producing PHB biopolymers in a host transformed with genes encoding the enzymes ß-ketothiolase, acetoacetyl-CoA reductase and polyhydroxy butyrate (PHB) synthetase. The board found

that the experimental plan for identifying and isolating the PHB gene was very general. Some references were missing and/or incomplete. There were no results and no details which could facilitate the repetition of the work. The board thus held that the total amount of experimental effort necessary amounted to an undue burden for the skilled person.

However, in **T 412/93**, where errors and omissions prejudiced the reproducibility of one of the examples in toto and of another example in part, the reproducibility of the invention was not affected, as the examples were alternatives to previous ones.

In **T 612/92** further scientific research would have been necessary in order to carry out the invention in some of the areas claimed. The board held the requirements of Art. 83 EPC 1973 were not fulfilled because there were serious doubts as to whether such a method could be performed over the whole range that was claimed (see **T 694/92**, OJ 1997, 408).

However, in **T 223/92** the disclosure enabled those skilled in the art to reproduce the invention, possibly in a time-consuming and cumbersome way, but, in the given circumstances, without undue burden of experimentation and without needing inventive skill (see also **T 412/93**).

T 1456/06 concerned the level of disclosure required for enablement of a claim directed to peptide vaccines. It was apparent from the prior art that the development of peptide-based vaccines to treat cancer – the sole specific type of vaccine mentioned in the application as filed – was not only extremely laborious, but also fraught with uncertainties. The application as filed did not disclose any telomerase peptide which might – plausibly – be regarded as a suitable candidate for a vaccine, nor did it contain either technical information as to how to identify possible candidate peptides, or instructions on how to proceed in case of failure. The board concluded that identifying immunogenic fragments of the telomerase protein suitable for the manufacture of a vaccine by a trial and error procedure constituted an undue burden to a person skilled in the art.

The application in **T 1364/08** concerned viruses for the treatment of cellular proliferative disorders. It provided no experimental data proving that the claimed adenovirus was able to replicate in cells having an activated Ras-pathway but not in normal cells. No data was present demonstrating that such a virus could be useful for the treatment of Ras-mediated cell proliferative disorders. However, based on what was described in the application as filed and taking into account what was known in the prior art, it was credible that the modified adenovirus specified in the claim would have been effective for the treatment of Ras-mediated cell proliferative disorder. Post-published evidence could therefore be taken into account to back up this evidence (following **T 609/02**).

In **T 1846/10** the invention under consideration related to the preparation of a live vaccine against L. intracellularis which relied on the use of attenuated L. intracellularis bacteria. L. intracellularis is the causative agent of proliferative enteropathy in pigs, also known as porcine proliferative enteropathy (PPE). To be suitable as a live vaccine strain, the attenuated bacteria must fulfil the following three criteria: (i) apathogenicity, which means that they do not cause the disease; (ii) be suitable and retain immunogenicity, which

means that they induce protective immunity in the animal host, and (iii) genetic stability, which means that they do not revert to being pathogenic or conversely become too attenuated. This was undisputed among the parties.

The skilled person, wanting to carry out the claimed invention, could not rely on his common general knowledge or the prior art to obtain suitable attenuated L. intracellularis bacteria. The patent had to provide the necessary guidance for the successful implementation of the claimed invention. The board concluded that the guidance provided by the patent did **not** allow the skilled person to obtain an attenuated L. intracellularis strain **without undue burden** or inventive step.

The skilled person was taught by the patent that he had to test the passaged strain, but only to confirm attenuation. The L. intracellularis strain suitable to carry out the invention not only had to be less virulent than the corresponding wild type strain, but also had to fulfil the additional two criteria of appropriate immunogenicity and genetic stability. Relying on the guidance provided by the patent and not knowing why the strain used in example 5 did not protect the vaccinated animals he would have had no reason to assume that the number of passages had to be increased. The person skilled in the art would not be inclined to consider the intervals disclosed in the description of the patent as mere lower limits but would have understood these indications as concrete ranges. The board concluded that example 5 of the patent represented evidence that the skilled person, by following the guidance of the patent, would fail to obtain an attenuated strain of L. intracellularis suitable for the preparation of a live vaccine.

In **T 1376/11** the board concluded that the only way disclosed in the application to arrive at the paprika plants of the invention started from parental Capsicum annuum NM varieties, such as Capsicum annuum NM 1441. The public availability of these parental plants at the priority date of the application was therefore a mandatory requirement for the skilled person to reproduce the invention. In the absence of evidence that Capsicum annuum NM 1441 was publicly available, the board concluded that the application did not disclose the subject-matter of claim 1 in a manner sufficiently clear and complete for it to be carried out by the skilled person.

In **T 435/20**, in which very detailed, technical aspects concerning antibodies were at issue, based on the evidence on file, the board considered that critical information on the antigen suitable for raising antibodies with the desired properties and screening assays for reliably identifying them was lacking. Moreover, the board saw no evidence that antibodies binding at the claimed epitope could be generated frequently enough and could be identified reliably enough to guarantee success. Therefore, the functional definition of the claimed antibody amounted to an invitation to perform a research program without any guarantee of success. Such a situation was considered to amount to an undue burden for the skilled person.

7.6. Requirements relating to nucleotide and amino acid sequences

Under R. 30(3) EPC, where the applicant has not filed the necessary sequence listing prescribed in R. 30(1) EPC, the EPO shall invite him to furnish it on payment of a fee. In

J 7/11, the Legal Board held that such invitations cannot be given orally only – a telephone call was, given the short time available, useful, but had to be followed by a written invitation enumerating all objections raised. Failure to do so amounted to a substantial procedural violation.

In **J 8/11** the crucial issue on appeal was the interpretation of the term "disclosed" in R. 30(1) EPC, namely the question whether a patent application which related to the use of polypeptides well known in the prior art and which identified these polypeptides by their common names and by database accession numbers concerning specific representative sequences had to be regarded as "disclosing" amino acid sequences. The Legal Board concluded that prior art sequences do not require the filing of a sequence listing and that the Receiving Section had been wrong to apply R. 30 EPC. With reference to **J 7/11** the Legal Board pointed out that the Receiving Section is restricted to a merely formal examination of the sequence listing requirements.

The board in **T 2437/13** (coronavirus, nucleic acid, protein and methods for the generation of vaccine, medicaments and diagnostics) decided in relation to priority rights that, since the nucleic acid sequences depicted in Table 3 and sequences having at least 95% sequence identity could be generated by standard techniques, there was no need for a virus to be deposited under R. 31(1) EPC.

7.7. Deposit of living material

If an invention involves the use of or concerns biological material which is not available to the public **and** which cannot be described in the European patent application in such a manner as to enable the invention to be carried out by a person skilled in the art, the invention shall only be regarded as being disclosed as prescribed in Art. 83 EPC if a sample of the biological material has been deposited with a recognised depositary institution not later than the date of filing of the application (R. 31(1)(a) EPC) and if the application fulfils the other requirements set out in R. 31 EPC (**T 2068/11**, see also **G 2/93**, OJ 1995, 275). See also Guidelines F-III, 6 – April 2025 version on sufficiency of disclosure for biological material.

The disclosure of a microorganism need not depend on a deposit according to R. 28 EPC 1973 where the microorganism is sufficiently disclosed by other means (**T 2068/11**, cited by **T 1338/12**, which is very detailed on this issue; see also the more recent decision in **T 1045/16**, relating to plant material, and **T 1376/11**).

It is already the boards' firmly established case law that, where biological material is unreservedly and unrestrictedly available to the skilled person and the public – in other words, where it is sufficiently disclosed by other means – there is no need to deposit it to meet the requirements of Art. 83 EPC (**T 1338/12**, point 12 of the Reasons).

As part of the 2000 EPC revision, for greater clarity and consistency, R. 27a, 28 and 28a EPC 1973 were restructured, trimmed and incorporated (as R. 30 to 34 EPC) into the chapter on biotechnological inventions (see OJ SE 1/2003, 164, OJ SE 5/2007, 44, and 54). New R. 31 EPC deals with the deposit of biological material, new R. 32 EPC with

the expert solution to availability and new R. 33 EPC with the availability of the deposited biological material as from the date of application of the European patent application (OJ SE 5/2007, 46; see also OJ 2017, A55 (CA/D 3/17), OJ 2017, A60 and A61 (notice)). The term "micro-organism" was replaced by "biological material" in 1996 (see OJ 1996, 390) – see R. 26(3) EPC for the definition of "biological material".

In **T 1045/16** the board recalled that together with Art. 83 EPC, special provision is made in R. 31 EPC for inventions which involve the use of or concern biological material which is not available to the public and which cannot be described in the European patent application. In the case at hand, it was not in dispute that there was no deposit of such material with a recognised depositary institution as set out in R. 31(1)(a) EPC. The board explained that a deposit according to the Budapest Treaty was necessary under R. 31(1)(a) EPC only in cases where the relevant biological material was not available to the public. It had to be determined whether or not the relevant biological material in question had been made available to the public. According to **G 2/93**, R. 28(1) EPC 1973 (R. 31(1) EPC 2000) refers to Art. 83 EPC and serves to substantiate and to supplement the general requirements of that Article for a specific group of inventions for which a mere written description is not sufficient. Therefore, the board found that the provisions of R. 28(1) EPC 1973 were **subordinate to the requirements of Art. 83 EPC**. The requirements of Art. 83 EPC are **not time limited**. Thus, to be considered "available to the public" in the sense of R. 31(1) EPC, a biological material must be available in a manner that allows the skilled person to be certain that they can obtain it at least over the term of the patent. Deposit with a **non-Budapest Treaty institution** cannot ensure availability to the public. In the case at hand, the availability of plants of the accession PI313970 from the US National Plant Germplasm System was not sufficient. Further, the mention of the biological material in a scientific publication did not per se establish that said material was available to the public in the sense of R. 31(1) EPC. The claimed invention did not meet the requirements of Art. 83 EPC.

In **T 1338/12** the board held, contrary to the examining division, that the application at issue was subject to the EPC 1973, specifically R. 28 EPC 1973 on depositing biological material. The board referred to the boards' established case law (see **T 2068/11**). What had to be established in the case in hand was whether the requirement in R. 28(3) EPC 1973 (corresponding to R. 33(1) EPC) had in fact been met, i.e. whether the T. thermophilus strain, variant GY1211, in question had been unreservedly and unrestrictedly available to the skilled person or the public on the relevant date. The board considered that the mere fact that this strain had been disclosed in two **scientific publications** was not enough by itself to meet that requirement. While the editors of a scientific journal could require that the authors of an article make the biological material publicly available, they could not be sure that they had always done so. Any request for a sample of the biological material had to be addressed directly to the authors themselves, so it was always left ultimately to their discretion whether to issue it.

7.7.1 Substantive law questions

Rule 31(1)(b) EPC requires that the application as filed give such **relevant information** as is available to the applicant **on the characteristics** of the deposited biological material.

Details of what is meant by "relevant information" can be found in the Guidelines (see F-III, 6 – April 2025 version).

In decision **T 418/89** (OJ 1993, 20) the characteristics of the monoclonal antibodies produced by the deposited strain were different from those mentioned in the claims. It was not possible to produce monoclonal antibodies from the deposited hybridoma using techniques recommended by the depository institution. The requirements of Art. 83 EPC 1973 were thus not met. A disclosure could not be regarded as sufficient if it was only possible to reproduce the invention after repeated requests to the depository institution and by applying techniques considerably more sophisticated than those the latter recommended. Nor could the scope of the patent be restricted to what had been deposited, as the characteristics of the deposit differed from the written disclosure in the patent. Thus, a mere deposit of a hybridoma **without any corresponding written description** did not provide a sufficient disclosure. Similar conclusions were reached in decisions **T 495/89** and **T 498/94**.

Rule 31(1) EPC cannot be interpreted such that there is an obligation to deposit material to facilitate the reproduction if the invention can be repeated on the basis of the written description, even if this should be a much more cumbersome way than by merely growing the deposited micro-organism (see e.g. **T 223/92**).

Similarly, in **T 412/93** the board stated that the need for a deposit cannot be introduced by reference to the concept of undue burden. This concept relates more to cases where the route that the reader is to follow is so poorly marked that success is not certain such as in **T 418/89**. If the road is certain but long and laborious, the patentee is under no obligation to assist the disclosure by making actual physical samples available. The board felt that to come to the opposite conclusion would be effectively to introduce a requirement to make the best mode immediately accessible to the public, and such a requirement is not part of the European patent system (see also **T 431/96**).

With respect to the question whether the reproducibility of specific micro-organisms (e.g. plasmids or viral strains) was assured by the written description in the absence of a deposit, the board, after careful examination of the written disclosure, held in some cases that the information provided in the application was sufficient to lead the skilled person reliably to the same micro-organisms (**T 283/86**, **T 181/87**); in other cases it was not (**T 815/90** of 20 October 1997, **T 816/90**; see **T 2542/12**, commercial fish farms in Norway – not a reliable source; also **T 1338/12**, scientific publications).

The board in **T 32/17** decided (Catchword) that the deposit of a hybridoma under R. 31 EPC for compliance with the disclosure requirement of Art. 83 EPC did not in itself convey any technical information about the molecular structure of the monoclonal antibody produced by that hybridoma, such as its amino acid sequence.

7.7.2 Procedural law questions

a) Conversion into deposit under the Budapest Treaty

T 39/88 (OJ 1989, 499) affirmed the principle that one important purpose of R. 28 EPC 1973 (R. 31 EPC) is to make the availability of the deposited organisms independent of any consent by the depositor. The board observed that the proper way of bringing a deposit originally filed for another purpose (here a US application) into line with the requirements of the EPC system was to formally convert the deposit into a deposit under R. 28 EPC 1973 (in the case of a deposit made on the basis of a special agreement between the EPO and the depositary institution) or into a deposit under the Budapest Treaty (which automatically covered R. 28 EPC 1973), as the case might be (see also **T 239/87**, **T 90/88**, **T 106/88**).

In **T 2068/11** a Lactobacillus strain had originally been deposited with a Japanese depositary institution that was not recognised under the Budapest Treaty and not listed by the EPO. The board ultimately decided that this deposit's conversion after filing of the European patent application had been too late; the application could not refer to the international deposit (application refused).

b) Late submission of deposit number

According to R. 28(1)(c) EPC 1973, the application had to state the depositary institution and the file number of the deposited biological material. In **G 2/93** (OJ 1995, 275) the Enlarged Board held that the provisions of R. 28 EPC 1973 were subordinate to the requirements of Art. 83 EPC 1973. The indication of the file number (accession number) of a culture deposit in a patent application was substantive because, under the EPC, it was instrumental in enabling a person skilled in the art to carry out the invention. The Enlarged Board therefore held that, contrary to the ruling in **J 8/87** (OJ 1989, 9), the information concerning the file number could not be submitted after expiry of the time limit set out in R. 28(2)(a) EPC 1973 (i.e. sixteen months after the date of filing of the application or, if priority is claimed, after the priority date).

As for the term "publication" within the meaning of R. 28(2)(a) EPC 1973, second part of sentence, in the context of a European application filed as an international one, see **T 328/04**.

See **T 227/97** (OJ 1999, 495) for the board's decision that reestablishment of rights may be available for the time limit set by R. 28(2)(a) EPC 1973 and R. 13*bis*.4 PCT.

c) Biological material deposited by a person other than the applicant

The board in **T 2266/10** concluded that the information submitted met the requirements of R. 31(1)(d) EPC. In **T 1338/12** and **T 2542/12**, by contrast, the boards refused applications on the basis that the declarations at issue had not been submitted in time.

8. The relationship between Article 83 and Article 84 EPC

8.1. Article 83 EPC and support from the description

The patent claims must clearly define the subject-matter for which protection is sought under Art. 84 EPC. In **T 94/82** (OJ 1984, 75) it was held that this requirement was fulfilled in a claim to a product when the characteristics of the product were specified by parameters relating to the physical structure of the product, provided that those parameters could be clearly and reliably determined by objective procedures which were usual in the art. In such a product claim, it sufficed to state the physical properties of the product in terms of parameters, since it was not mandatory to give instructions in the claim itself as to how the product was to be obtained. The description, however, had to fulfil the requirements of Art. 83 EPC 1973 and thus enable the person skilled in the art to obtain the claimed product described in it (see also **T 487/89**, **T 297/90**, **T 541/97**). Nor should this be understood as also referring to those variants falling under the literal wording of the claim but which the skilled person would immediately exclude as being clearly outside the scope of practical application of the claimed subject-matter, for example, claims including an open-ended range for a parameter where it was clear for a skilled person that the open-ended range was limited in practice. Values of the parameter not obtainable in practice would not be regarded by the skilled person as being covered by the claims and thus could not justify an objection of insufficiency of disclosure (**T 1018/05**). See also **T 1943/15** ("open-ended range").

It is of relevance whether a problem falls within Art. 83 or Art. 84 EPC when taking into consideration that examination in respect of the requirements of Art. 83 EPC is still permitted during opposition proceedings, whereas in respect of Art. 84 EPC it is limited during opposition proceedings to those cases where there has been an amendment (see **T 127/85**, OJ 1989, 271; see also **T 301/87**, OJ 1990, 335; **T 1055/98**; **T 5/99**). With regard to the examination in respect of Art. 84 EPC during opposition proceedings see also chapter II.A.1.4.; and recent decision **G 3/14**, confirming the jurisprudence exemplified by **T 301/87**).

In **T 292/85** (OJ 1989, 275) the stated grounds for the refusal were that the disclosure was not sufficient under Art. 83 EPC 1973 and there was consequently a lack of proper support under Art. 84 EPC 1973. The board pointed out that in appropriate cases it is only possible to define the invention (the matter for which protection was sought, Art. 84 EPC 1973), in a way which gives fair protection having regard to the nature of the invention which had been described by using functional terminology in the claims. The need for fair protection governs both the considerations concerning the scope of claims and the requirements for sufficient disclosure. The board found that an invention is sufficiently disclosed if **at least one way** is clearly indicated enabling the skilled person to carry out the invention.

In **T 409/91** (OJ 1994, 653; ex parte) and **T 435/91** (OJ 1995, 188; inter partes) it was pointed out that the protection conferred by a patent should correspond to the technical contribution to the art made by the disclosure of the invention described therein, which excludes the patent monopoly being extended to subject-matter which, after reading the patent specification, would still not be at the disposal of the skilled person. The available

information must enable the skilled person to achieve the envisaged result within the whole ambit of the claim containing the respective functional definition without undue difficulty, and the description with or without the relevant common general knowledge must provide a fully self-sufficient technical concept as to how this result is to be achieved. **T 409/91** was followed up in **T 713/98**, where the board stated that the requirement of understanding a claim characterised by a functional feature defining a result to be achieved was one of clarity and the requirement of implementing it was one of support, both within the meaning of Art. 84 EPC 1973. Implementation, viewed in relation to the disclosure as a whole, was highly relevant to the question of sufficiency under Art. 83 EPC 1973. See also **T 1225/07** and **T 1311/22** (functional features).

In the inter partes case **T 435/91** (OJ 1995, 188), one of the essential technical features was defined only by its function. It was not possible to identify, on the basis of the information contained in the patent specification or of common general knowledge, compounds other than those specifically mentioned as bringing about the desired effect. The board held that the compositions must all be available to the skilled person if the definition was to meet the requirements of Art. 83 EPC 1973.

However, as long as there are no concrete grounds for believing that the invention cannot be carried out within the whole range claimed, there is no reason for not allowing more broadly based claims in an application (**T 242/92**, **T 484/92**). In opposition proceedings the opponent bears the burden of proving that the invention cannot be carried out within the whole range claimed (**T 418/91**, **T 456/91**, **T 548/91**). See in this chapter II.C.9.

In **T 1404/05** the board found that where a claim is vaguely formulated and leaves several constructions open as possibilities, and on one of these constructions part of the subject-matter claimed is not sufficiently described to be carried out, the claim is open to objection under Art. 100(b) EPC. To avoid this objection the claim needs to be explicitly restricted to a construction which is also possible on the vague formulation of the claim, but which construction is not open to an Art. 100(b) EPC objection. The mere fact that the description makes clear that this latter construction is the one intended does not mean that the claim can be treated as being confined to this latter construction. Art. 69 EPC and the Protocol were intended to assist a patent proprietor in contending for a broader interpretation of a claim than perhaps its wording warranted, not for cutting down the scope of a claim.

In **T 553/11** the board pointed out that if the proprietor wishes to argue for a narrow scope of a claim, this should be on the basis of the ordinary wording of the claim, and not on the basis of something appearing only in the description (following **T 1404/05**). The board also referred to **T 681/01**, where it was emphasised that the normal rule of claim construction is that the terms used in a claim should be given their ordinary meaning in the context of the claim in which they appear. The description may not be used to rewrite the claim and **redefine** the technical features required by the claim in a way not warranted by the wording of the claim itself. In particular the description cannot be relied on to exclude subject-matter from the claim which the ordinary meaning of the terms used would include as part of what is claimed. See also chapter II.A.6.3. "Using description and drawings to interpret the claims".

In **T 1188/15** the skilled person had no requirement to interpret the claim in a more limited sense in the light of a specific embodiment of the description to which the claim was not limited, the claim itself imparting a clear and credible technical teaching to the skilled reader.

In **T 1691/11** claim 1 of all requests included the features of "at least two independent programmable motors" and "at least one of the transferring devices being coupled to each of the programmable motors". These features were clear and unambiguous. The clear linguistic structure of the claim did not allow for any different interpretation. Additionally, a discrepancy between the claims and the description was not a valid reason to ignore the clear linguistic structure of a claim and thus to interpret the claim differently (see also **T 431/03**). When the wording of a claim is perfectly clear it needs to be considered under Art. 83 EPC, rather than undertaking another speculative interpretation of the claim.

T 2182/11 concerned the second aspect of the appellant's (opponent's) objection relating to the alleged impossibility of carrying out the claimed invention over the whole range claimed because of the vague claim language. The board had in particular stated in its preliminary opinion that the expression "register with" was very broad. The board stated that breadth of an expression was really a matter concerning the clarity requirement of Art. 84 EPC rather than a ground for opposition. In as far as the objection was to be considered under Art. 83 EPC, the mere fact that a **term is broad** does not prevent a skilled person from carrying out the invention.

8.2. Article 83 EPC and clarity of claims

If it is argued that insufficiency arises from a lack of clarity, it is generally not sufficient to establish a lack of clarity of the claims in order to establish lack of compliance with Art. 83 EPC 1973. Rather, it is necessary to show that the patent as a whole (i.e. not only the claims) does not enable the skilled person – who can avail himself of the description and his common general knowledge – to carry out the invention (see **T 1811/13**, **T 646/13**).

There is now a clearly predominant opinion among the boards that the definition of the "forbidden area" of a claim should not be considered as a matter related to Art. 83 and 100(b) EPC (**T 1811/13**, **T 646/13**). Decision **T 626/14** does not call this into question, according to the board in **T 250/15**.

When undefined parameters are used in the claims and no details of the measuring methods are supplied, the question arises whether there is a problem with respect to Art. 83 or Art. 84 EPC. The answer to this question is important because in opposition proceedings the patent can be examined for its compliance with Art. 83 EPC without any restriction. Compliance with Art. 84 EPC is however examined only in cases where there has been an amendment. In its decision **G 3/14** (OJ 2015, A102) the Enlarged Board reiterated the principles governing the extent to which patents amended in opposition proceedings can be examined for compliance with Art. 84 EPC. A more detailed account of its decision can be found in chapter II.A.1.4.

T 1845/14 (broadness of the claim arising from lack of clarity and sufficiency) specified that the ambiguous definition of a parameter in a claim may result in the scope of the claim to be broader than the patentee might have intended. In such a case the question arises whether the teaching of the patent in suit, which was directed to the claimed subject-matter having regard to a specific meaning of that parameter (which, however, was omitted), would nevertheless have enabled the skilled person to carry out the invention outside of the scope intended by the patentee, using common general knowledge and a reasonable amount of experimentation.

8.2.1 Minority – or earlier – case law

In some decisions (for example, **T 123/85**, **T 124/85**, **T 172/87**, **T 358/88**, **T 449/90**, **T 148/91**, **T 267/91**, **T 697/91**, **T 225/93**, **T 378/97**, **T 387/01**, **T 252/02**, **T 611/02**, **T 464/05**, see recently **T 626/14**) the absence of information in the application on methods for measuring undetermined parameters in the application was considered a problem with respect to Art. 83 EPC.

8.2.2 Majority case law

To provide a quick overview of the law applicable at present, the currently predominant approach is set out in the first section. However, it should be borne in mind that the debate around this issue has still been ongoing in relatively recent case law (see in this chapter II.C.8.2.2c)).

a) Currently predominant approach

Two decisions in particular have affirmed the applicable law, setting out the now predominant approach after summarising and analysing the case law to date: **T 1811/13** (decision in English - lack of clarity vs. insufficiency of disclosure) and **T 647/15** (decision in French). An example of a decision in German is **T 548/13**.

While these decisions were not the first (see e.g. **T 2290/12**) to take the approach currently applied by the majority of the boards, their findings are taken here to illustrate the point.

The approach is as follows: "today there is agreement or at least a clearly predominant opinion among the boards that the definition of the "forbidden area" of a claim should not be considered as a matter related to Art. 83 EPC." The board added that: "This is not to say that a lack of clarity cannot result in an insufficient disclosure of the invention. However, in such a case it is not sufficient to establish that a claim lacks clarity, but it is necessary to establish that the application or patent, as the case may be, does not disclose the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art. In other words, it is not sufficient to establish a lack of clarity of the claims for establishing lack of compliance with Art. 83 EPC 1973; it is necessary to show that the lack of clarity affects the patent **as a whole** (i.e. not only the claims) and that it is such that the skilled person – who can avail himself of the description and his common general knowledge – is hindered from carrying out the invention".

As already stated, these decisions are not the first ones that represent the currently applied approach. Examples of decisions prior **T 1811/13** that also follow the current majority approach: **T 1948/10**, **T 608/12**, **T 2331/11**, **T 1507/10**, **T 943/00**, **T 960/98**, **T 619/00**, **T 396/02**, **T 1033/02**, **T 452/04**, **T 466/05**, **T 1586/05**, **T 1015/06**, **T 1250/08**, **T 593/09**, **T 1507/10**, **T 2331/11**, **T 2290/12**, **T 647/15**, **T 548/13**, **T 466/05**, **T 2290/12**, **T 1886/06**, **T 1608/13**, **T 608/07**.

The decision in **T 608/07** (hidden objection) is very often cited (especially its point 2.5.2 of the Reasons) in the case law, including even in recent decisions, e.g. in **T 786/15** (Tg parameter – ambiguity at the edges of the values); **T 1627/17**; **T 1768/15**; **T 1960/14** (melting points of palm oil fraction); **T 1608/13** (definition of a sieving coefficient); **T 1285/15** (example of a hidden clarity objection); **T 593/09** (also referring to **T 815/07** and Kirin-Amgen Inc v. Hoechst Marion Roussel Ltd [2004] UKHL 46 of the United Kingdom's House of Lords). In **T 593/09** (ill-defined parameter) the board held (see Catchword and point 4.1.4 of the Reasons) that what is decisive for establishing insufficiency within the meaning of Art. 83 EPC is whether the parameter, in the specific case, is so ill defined that the skilled person is not able, on the basis of the disclosure as a whole and using common general knowledge, to identify (without undue burden) the technical measures (e.g. selection of suitable compounds) necessary to solve the problem underlying the patent at issue. The decision in **T 593/09** (essential parameter for preparation of a product) is in turn frequently cited still in recent case law, e.g. **T 1305/15** (Zeta potential of hollow fibre membrane – severe lack of information concerning the ZP measurement method – ill-defined parameter not reliably measurable – Art. 83 EPC not satisfied); **T 1526/09** (vague definition of parameter affected clarity but did not prevent reproduction of the claimed product); **T 2403/11**; **T 786/15**.

Examples of decisions since **T 1811/13** endorsing the predominant view: **T 417/13** ; **T 548/13** ; **T 2319/14** ; **T 1698/16** ; **T 1900/17**.

In **T 646/13** the board considered a request for a referral to the Enlarged Board filed in view of a divergence between **T 1811/13** and **T 464/05** but refused it on the ground that this alleged divergence instead illustrated a development in the case law.

T 626/14, which endorsed **T 464/05**, likewise analysed the decisions in **T 1811/13** and **T 464/05**. The board in **T 250/15** held that **T 626/14** did not call the case law confirmed in **T 1811/13** into question and declined to make a referral to the Enlarged Board, considering that **T 626/14** and **T 464/05** concerned a particular constellation in a certain technical field.

The board in **T 1845/14** took issue with the approach taken in some decisions to defining the term "invention" for the purposes of Art. 83 EPC. Addressing the rationale of **T 593/09**, **T 815/07**, **T 172/99** and **T 608/07**, it found that, although the expression "promise of the invention" in light of Zipher Ltd v. Markem Systems Ltd referred to in **T 608/07** could be understood to correspond to the indication in the description of the patent of the technical benefits provided by the claimed subject-matter, this decision from the High Court (UK) makes clear that not fulfilling the "promise of the invention" is rather an issue of inventive step. The board in **T 409/17** considered **T 1845/14** and **T 593/09.**

b) Reiteration and/or illustration of predominant case law in recent case law

In **T 45/21** the appellant (opponent) alleged that the invention was insufficiently disclosed because the patent did not teach the temperature at which the pH was to be determined. The board stated that the assertion that the skilled person was unable to determine whether they were working within the claimed scope as such was not a valid basis for denying sufficiency of disclosure. The mere fact that a degree of variability existed in a claimed parameter could not as such lead to a finding of insufficiency of disclosure, if the influence of this variability on the possibility for the skilled person to carry out the claimed invention was not established. The board agreed with the appellant that the patent proprietor must not benefit from any lack of clarity in the patent. This was however not to say that such a lack of clarity must, on its own, necessarily lead to the rejection of the claim request or revocation of the patent for lack of sufficient disclosure. As explained in **G 3/14** (see point 55 of the Reasons), a granted claim may turn out not to comply with Art. 84 EPC but such non-compliance must be lived with. To the extent that the alleged pH variation by up to 0.2 units led to a lack of clarity, the appellant did not show the effect of this lack of clarity on the assessment of sufficiency of disclosure.

c) Case law before the now established approach

The case law prior to the two aforementioned decisions affirming that there was a predominant opinion among the boards (**T 1811/13** and **T 647/15**) already included a number of decisions favouring the same approach. For details of these decisions and the rest of this earlier case law, readers are referred to the CLB, 9th edn. 2019.

d) Debate around the majority and minority lines of case law and alleged divergence in the case law

This section reports on decisions since **T 1811/13** which have addressed the case law on the relationship between Art. 83 EPC and Art. 84 EPC and on (refused) requests for referrals of questions about this to the Enlarged Board.

The board in **T 626/14** (thickness of fibrous composite – variability in measurement) considered it important to mention that **T 1811/13** and **T 647/15** – with essentially identical reasoning as regards Art. 83 EPC – sought to question the way in which Art. 83 EPC objections were reasoned in decisions such as **T 464/05**. Yet, **T 1811/13** and **T 647/15** themselves concentrated only on an individual aspect in **T 464/05**, namely "the area covered by the claim", without addressing the actual findings in that decision regarding Art. 83 EPC. **T 1811/13** and **T 647/15** did not cause the board in **T 626/14** to see anything which would undermine the reasoning in **T 464/05** concerning Art. 83 EPC. More recently in **T 250/15** the board held that **T 626/14** did not challenge the case law. **T 250/15** declined to make a referral to the Enlarged Board and considered that **T 626/14** and **T 464/05** concerned a **particular constellation** in a certain technical field.

In **T 646/13** the opponent's request for a referral hinged on an alleged contradiction between decisions **T 1811/13** and **T 464/05** on the issues of clarity of the claims and sufficiency of disclosure. The board concluded that these cases concurred in that an

unclear definition of the boundaries of the claim pertained to Art. 84 EPC 1973. Application of the principles set out in decisions **T 464/05** and **T 1811/13** would not lead in the circumstances of **T 646/13** to different results. Finally and more importantly, as explained in decision **T 1811/13**, decision **T 464/05** forms part of a line of jurisprudence established between 2004 and 2007, not generally followed since then. There is now a clearly predominant opinion among the boards that the definition of the "forbidden area" of a claim should not be considered as a matter related to Art. 83 and 100(b) EPC 1973, the alleged contradiction between decisions **T 464/05** and **T 1811/13** does not exist. Rather than being in conflict, these decisions illustrate a **development of the case law** on a particular question over an extended period of time.

9. Evidence

9.1. General principles

According to established case law of the boards of appeal, a successful objection of insufficient disclosure presupposes that there are serious doubts, substantiated by verifiable facts. In inter partes proceedings, the burden of proof initially lies with the opponent, who must establish, on the balance of probabilities, that a skilled person reading the patent, using common general knowledge, would be unable to carry out the invention. This initial burden on the opponent may shift to the patent proprietor once the opponent has successfully discharged its burden of proof.

Indeed, a successful objection of a lack of sufficiency of disclosure presupposes that there are serious doubts, substantiated by verifiable facts (see e.g. decision **T 19/90**, OJ 1990, 476 and decision **T 890/02**, OJ 2005, 497). In order to establish insufficiency of disclosure in **inter partes proceedings**, the burden of proof is upon an opponent to establish, on the balance of probabilities, that a skilled person reading the patent, using common general knowledge, would be unable to carry out the invention (see decision **T 182/89**, OJ 1991, 391). Citing **T 182/89** on this point, the board in **T 406/91** stated that a **mere statement** that one of several examples in a patent had been repeated once "exactly as described" without obtaining exactly the results claimed in the patent was in principle inadequate to release the opponent from that burden (see **T 406/91**, as well as **T 418/91**, **T 548/91**, **T 588/93**, **T 465/97**, **T 998/97**, **T 499/00**, **T 751/00** and **T 967/09**).

The board in **T 642/22** stated that **T 19/90** (successful objection based on serious doubts substantiated by verifiable facts) did not mean that the opponent necessarily had to provide evidence such as experimental data showing that the claimed furan levels could not be achieved. Instead, the existence of verifiable facts which may give rise to doubts as to the sufficiency of the disclosure could be inferred from the patent itself or from common general knowledge (**T 2038/19**, **T 1187/20**).

On how to determine who bears the burden of proof at the appeal stage, see **T 1138/20** for general considerations, and more specifically **T 1076/21** on objections under Art. 83 EPC.

In view of all the issues addressed in **T 1076/21** and its confirmation and clarification of key concepts and how they interrelate, specifically with regard to Art. 83 and 100(b) EPC and the law of evidence, this recent decision deserves to be reported in detail here.

Confirmation and clarification in **T 1076/21** of the principles of the law of evidence in relation to Art. 83 EPC:

In **T 1076/21** the respondent (opponent), referring to **T 585/92**, argued that, because the opposition division had revoked the patent, the appellant (patent proprietor) bore the burden of proving that the patent was sufficiently disclosed. The appellant disputed that the respondent had successfully discharged its initial burden of proof. The board concluded that the burden of proof regarding the facts, arguments and evidence on the substance (which initially lay with the opponent) did not shift to the proprietor just because the patent had been revoked due to an alleged insufficient disclosure. The board recalled that only if there were serious doubts, substantiated by verifiable facts, could an application (or a patent) be objected to for insufficient disclosure (**T 19/90**). After the grant of the patent, there was a legal presumption that the patent met the requirements of the EPC. This presumption could be rebutted. The weight of the submissions required to rebut the presumption depended on its strength. A strong presumption required more substantial submissions than a weak one. In the context of the ground of opposition of sufficiency of disclosure, the strength depended on the way the invention was disclosed in the patent (**T 63/06**, **T 55/18**). The initial burden on the opponent to provide facts, arguments and evidence for an assertion of an insufficient disclosure could shift to the patent proprietor once the opponent had successfully discharged its burden of proof by submitting sufficient facts, arguments and evidence to rebut the presumption of sufficiency (**T 338/10**, **T 2218/16**). However, this shift could only be caused by sufficient submissions on the substance; formal reasons alone, like the mere existence of the opposition division's decision to revoke the patent, did not lead to a shift of the burden of proof on the substance. If the reasoning in the impugned decision as such was found to be wrong, there could not be any shift of the "burden of proof on the substance" (**T 499/00**, **T 1608/13**).

Linked to the burden of proof was the "burden to substantiate a case". Thus, the opponent first had to provide facts and argue why these facts supported its assertion (**T 182/89**). This burden of substantiating facts and arguments was then followed by the burden of proving these facts, which was normally done by submitting evidence. **Only** in the exceptional case of a **weak presumption** of validity due to a lack of information in the patent could the submission of **plausible arguments alone be sufficient** (**T 63/06**, **T 1558/11**). The two aspects were often referred to together as the burden of proof.

This might have led to the misconception that any decision finding insufficiency would lead to the burden of proof being shifted to the patent proprietor. However, when distinguishing the "burden to substantiate a case" from the "burden of proof on the substance", the board found that it could be clearly deduced from the case law that after a decision by the opposition division allowing an objection of insufficiency, it was down to the patent proprietor to substantiate on appeal why that decision was wrong. However, the burden of proof on the substance (and in consequence the benefit of the doubt) only shifted if the opposition division's assessment that the presented facts, arguments and evidence had

been sufficient to discharge the opponent's burden of proof turned out to be correct. The appellant bore the burden of substantiating the appeal. The board nevertheless noted that an appeal case did not necessarily need to be substantiated by submitting facts and evidence that countered the arguments and evidence presented by the opponent. It could also be substantiated by submitting why the opposition division's reasoning on insufficiency was flawed and why the burden of proof on the substance still lay with the opponent.

The patent proprietor in **T 1076/21** had substantiated its appeal, whereas the respondent had not submitted evidence that the guidance in the patent was insufficient or shown that the allegedly unusual parameter was indeed unusual, which meant it had not discharged its burden of proof on the substance. The opposition division had not been unable to base its decision on verifiable facts as required. There had been no shift of the burden of proof to the patent proprietor. As regards another aspect, the board concluded that since the parties had made contradictory but unsubstantiated assertions concerning facts, the patent proprietor ought to be given the **benefit of the doubt** (**T 72/04**).

Application of **T 1076/21** in case law:

In **T 127/22** the board, with reference to **T 1076/21,** said that the burden of proof did not shift to the proprietor solely by the fact that the patent had been revoked in opposition proceedings due to the alleged insufficient disclosure. In the present case, however, there were further reasons that justified a shift in the burden of proof to the proprietor. When the patent did not give any information as to how a feature of the invention could be put into practice, only a weak presumption existed that the invention was sufficiently disclosed. In such a case, the opponent could discharge their burden by plausibly arguing that common general knowledge would not enable the skilled person to put this feature into practice. In the present case there was only a weak presumption in favor of the proprietor. The board came to the conclusion that in the absence of any indication or any clear guidance on the testing conditions, it was not possible to reliably and accurately determine the relative gas flows in different zones of the catalyst article.

In case **T 1708/22** (allegedly ill-defined density parameter – but different methods known - accessible commercial product of which composition could be determined – lack of evidence provided by opponent), with reference to **T 1076/21**, the board decided that the burden of proof had not shifted to the appellant (patent proprietor) just because the opposition division had arrived at the conclusion that the patent did not meet the requirements of Art 83 EPC.

The following sections deal with some particular aspects related to evidence. On the special case of parameters, see also chapter II.C.5.5.3. On second medical uses, see chapter II.C.6.8. "Postpublished documents" and II.C.7.2. above and e.g. the recent decisions **T 1394/21**, **T 2790/17**, **T 1210/20**, and **T 1779/21**, with reference to **G 2/21** (OJ 2023, A85, points 74 and 77 of the Reasons).

9.2. Consequences of a strong or weak presumption for sufficiency of disclosure

The board in **T 63/06** (see "Headnote") agreed that the opponent generally bears the burden of proving insufficiency of disclosure. When the patent does not give any information as to how a feature of the invention can be put into practice, only a weak presumption exists that the invention is sufficiently disclosed. In such a case, the opponent can discharge his burden by plausibly arguing that common general knowledge would not enable the skilled person to put this feature into practice. It is then up to the patent proprietor to prove the contrary, i.e. that the skilled person's common general knowledge would enable the skilled person to carry out the invention. As set out in the previous section, see the findings of **T 1076/21** regarding the overview and interpretation of the case law **T 63/06** and the related issues.

The board in **T 1171/16** made it clear that **T 63/06** did not conclude that, for the burden of proof to be shifted, it was necessary for the patent not to give any information whatsoever as to how a feature of the invention could be put into practice.

The board in **T 61/21** stated that whether a strong or weak presumption of sufficiency exists must be considered on the facts of each individual case.

T 2176/21 refers briefly to a basic principle summarised by **T 1076/21** while also touching on the scope of other principles deriving in particular from **T 63/06**. As a rule, the appellant (as the opponent) bears the burden of proving insufficient disclosure (see **T 1076/21**). In addition, a weak presumption as per **T 63/06** has to be substantiated and any point of reference demonstrated. It does not follow from **T 63/06** that the absence of an example automatically implies a weak presumption or that any weak presumption would automatically be rebutted. In the case at issue, the appellant had not actually presented or demonstrated any specific circumstances implying a weak presumption of sufficiency or set out how this might be rebutted in a second step. No such circumstances were apparent either.

For explanations of the application of **T 63/06**, see for example **T 338/10**, in which the board found that the opponent's reasoned arguments had shifted the **burden of proof**, and, to the same effect, **T 518/10**. see **T 792/00**, point 9 et seq. of the Reasons (burden of proof in case of a hypothetical experimental protocol). See also **T 491/08**; **T 347/15**; **T 1845/17** (ambiguous parameter); **T 2218/16** (gene therapy of motor neurone disorders – scAAV9 vector) with detailed reasons.

The board in **T 59/18** the respondents (opponents) had convincingly argued that the term "relaxation ratio" having the meaning intended by the appellant was not to be found in textbooks and did not represent common general knowledge, the burden of proof for establishing sufficiency was clearly on the appellant/patent proprietor.

In **T 2119/14** (unusual parameter) the board, referring to **T 63/06**, held that the existence of an undue burden resulted from the almost infinite number of coating compositions that fell under the structural definition given in claim 1, and the established absence of a teaching in the patent in suit as to how select in an appropriate and straightforward manner

the components of the coating composition so as to meet the unusual parametric requirement of claim 1. As a consequence, the onus of proving that the preparation of the coating compositions over the whole scope for which protection was sought did not necessitate an undue amount of work for the skilled person rested with the patent proprietor (here: appellant).

The board in **T 2401/19** noted that when the patent does not give any information as to how a feature of the invention could be put into practice, only a weak presumption existed that the invention was sufficiently disclosed. In such a case, the opponent could discharge its burden of proof by plausibly arguing that common general knowledge would not enable the skilled person to put this feature into practice.

In **T 557/22** the board found the appellant (opponent) was correct when noting that the specification did not teach how the parametric requirement was to be achieved. The specification did not provide the skilled person with a set of instructions indicating how to select the monomers and their relative amounts. It did not even provide a single example. Evidence that the parameter was usual in the art or that suitable common general knowledge was available to the skilled person in order to fill the gap was also not submitted by the respondent. The board decided that a weak presumption that the invention defined in claim 5 was sufficiently disclosed (and conversely a strong presumption for a lack of sufficiency of disclosure) resulted from the absence of any teaching in the specification relating to the measurement of the unusual parameter, the means to achieve the parametric value defined in said claim and an example meeting the condition. Even if one agreed with the respondent that the parameter defined in claim 5 could be **easily measured**, this would not mean that the skilled person would be in the position to determine which steps had to be taken in order to fulfil the parametric requirements. Although the respondent's argument that the specification would comprise plenty of teaching to work the invention might be valid for independent claim 1, on which claim 5 referred to, this was not true for the invention defined by the terms of claim 5. The respondents allegation of a lack of successfull objection was not persuasive. In the present case, the serious doubts arose from the fact that no teaching at all was provided in the specification and the absence of any further indication, or evidence in this respect, as to what the skilled person would do in order to fulfil that additional condition with a reasonable amount of experimental work.

A further example of a verifiable fact casting doubts on sufficiency of disclosure is given in **T 2038/19** (water-absorbent resin particles), applying **T 63/06.**

9.3. Objection of insufficient disclosure rejected – examples

The established case law of the boards of appeal is that a finding of lack of sufficient disclosure presupposes serious doubts, substantiated by verifiable facts. The facts put forward by the examining division in ex parte case **T 1020/11** to justify a finding of lack of sufficient disclosure were based on a potential problem which might occur between different antigens in combination. There were however no verifiable facts on file that demonstrated that interference was a problem in the present, specific case. In the absence of such verifiable facts relevant to the specific case, the board could not find the objection

of lack of sufficient disclosure persuasive (see also inter partes case **T 872/13** concerning a pharmaceutical composition) – the opponent described a number of possible difficulties that the skilled person might encounter, but did not raise any serious doubts substantiated by verifiable facts – in this case the skilled person was in a position to modify the method of Example 8 in order to obtain the desired result – routine modifications).

T 1437/07 (Botulinum toxin for treating smooth muscle spasm) dealt with the objection that it was not credible that the therapeutic effect could be achieved because the treatment disclosed in Example 9 had not actually been carried out. The board referred inter alia to R. 42(1)(e) EPC, according to which not even the presence of an example was mandatory. Therefore, just because a patent disclosed an effect which had not in reality been achieved, there was no reason – in the absence of convincing evidence that the effect could not be achieved – for the board to doubt that the effect could be achieved. The board rejected the objection.

As proof that an invention has been insufficiently disclosed, the boards require that the attempt to repeat it must fail despite following the conditions given in the examples. This requirement is not fulfilled where the opponent repeats the patented process under **conditions** covered by claim 1 but **differing** in many respects from those applying in the contested patent's examples (**T 665/90**).

An invention should be reproduced using the examples given. Insufficiency cannot be proven on the basis of laboratory trials when the only embodiment exemplified in the patent is an industrial fermentation process (**T 740/90**, Active dry baker's yeast). The conditions described in the patent for carrying out the invention were industrial conditions, not laboratory conditions as implemented by Mr L (affidavit submitted by the opponent-respondent). The appellant convinced the board that the scale of the tests had a non-negligible impact on how the method parameters were controlled and thus on the features of the dry yeast obtained. Even though this scale had not been stated as being decisive for achieving the desired object, it still held true that the only embodiment example in the patent had been carried out on an industrial scale, so the respondent, seeking to prove that the invention was not reproducible, should have used the same conditions as in the available example. Since Mr L's test had not been carried out on the same scale, it could not be considered valid for this reason alone, regardless of the other disputed points on the test conditions. The respondent, bearing the burden of proof, had failed to demonstrate that the invention had not been described in a manner sufficiently clear and complete.

The disclosure was also considered sufficient where the opponent had only used equivalents of the surfactants given in the patent, as he had not discharged his burden of proof (**T 406/91**).

In **T 1712/09**, the board held that the opponent had failed to prove that the method of measuring the parameters was unworkable. The tests referred to in its experimental reports had been carried out using measuring apparatus different from that described in the patent, and so not as instructed there. The board found that no attempt had been made to reproduce the invention (no attempt at calibration), which was the first condition for an objection under Art. 100(b) and 83 EPC. It cited **T 815/07** (need for consistent values) and

T 1062/98 and **T 485/00** (possibility of calibrating methods of determining the relevant parameters). The board in **T 548/13** held that the case law on parameters (which included **T 815/07**) did not apply since the case before it did not concern a quantitative parameter.

In **T 45/09** too, the opponent's test conditions were called into question since the tests had been carried out using a commercially available product. Observing that two products of the same brand but available on the market at different times would not necessarily have the same properties, the board found that it had not been established that the properties had been the same in this specific case. The board also considered the issue of calibrating the method of measuring the parameter. The board concluded that the opponent had failed to show that the method of measuring the parameter could not be reproduced and thus to prove insufficient disclosure. It was, indeed, for the opponent to do so, and it could have discharged its burden of proof by attempting to reproduce the method using at least one of the claimed silica.

In **T 378/11** (particle size), the values disclosed in claim 1 referred to the average particle size. **No proof** had been submitted by the appellants/opponents that the lack of any indication as to the precise kind of average particle size hindered the skilled person from carrying out the invention at issue. The board found that the skilled person could select those kinds of mean values falling within the range 10-500 mym in order to prepare a composition according to the invention at issue. Whether or not the use of two kinds of mean values would lead to different results was a matter of clarity, rather than sufficiency of disclosure.

In **T 1089/15** the board, recalling the established case law on a successful objection (e.g. **T 19/90** OJ 1990, 476, point 3.3 of the Reasons), found that the appellant (opponent) had not filed any evidence in support of its case and relied in its arguments on mere allegation. At the oral proceedings too, the appellant had merely referred to its written submissions, and thereby chosen not to submit arguments countering the position expressed by the board in the communication (Art. 15(1) RPBA) sent in preparation for those oral proceedings.

In case **T 1863/21** the patent's examples were particularly relevant for assessing sufficiency of disclosure. The board considered that the invention as disclosed could be accepted as sufficiently disclosed. To support the argument that the invention was sufficiently disclosed over the whole scope, the patent proprietor filed additional experimental data (D15); the appellant (opponent) filed D15a two days before oral proceedings before the opposition division, in which the data in D15 were statistically analysised. The appellant did not criticise the test set-up used in the patent. It even conceded that the results in the patent's examples might show an effect. However, the appellant alleged that the result was not achieved over the entire scope of claims 1 and 2. The appellant did not provide its own experimental data in order to argue this point. Instead, its only line of argument on this aspect was based on a statistical analysis of the results shown in the figure of D15. The board concluded that even if one were to follow the appellant's conclusion that the results in D15 were indeed not statistically relevant, such a conclusion would not be decisive in changing the board's assessment on sufficiency of disclosure. The appellant would have had to raise serious doubt that the

invention was not sufficiently disclosed over the entire scope. Under the circumstances of the present case, and in view of the patent's examples, the appellant's finding on the statistical relevance of the data in D15 was not sufficient to raise doubt that could be qualified as serious. The board made some remarks about convincing evidence and statistical analysis (see points 3.8 and 3.9 of the Reasons, and chapter III.G.4.2.3a)).

9.4. Burden of proof on the opponent – special cases

In **T 347/15** the board endorsed the case law on evidence (Art. 83 EPC) and, having found that the application did not contain detailed information about how to put the invention into practice, applied the reasoning given in **T 491/08**. In the case in hand, the opponent (appellant II) would have had to perform a large number of costly tests to prove that the invention could not be carried out, whereas a single example from appellant I (patent proprietor) would have been enough to prove that it could. The board concluded that appellant II (opponent) had discharged its burden of proof by submitting comprehensible and plausible arguments giving rise to serious doubts about whether the skilled person could carry out the invention as claimed. That meant it had then been up to appellant I (proprietor) to prove the contrary, i.e. that the invention could be carried out, but it had failed to do so. In particular, the board found that, owing to the lack of information in the patent, carrying out the invention went beyond the usual know-how of the skilled person.

In the field of mechanics in **T 500/20** the board said in its Catchword that in claimed inventions that did not involve a range of parameter values or compositions but were directed at a concept expressed in terms of generic structural or functional features of an apparatus or of a method, it was not enough – in order to demonstrate insufficiency – to conceive of an example that fell within the terms of the claim that did not work because it did not achieve the claimed effect fully or at all so that therefore the invention would not be sufficiently disclosed across the entire breadth of the claim. To successively argue insufficiency in a case such as this, a very high burden of proof applied; the party had to demonstrate through cogent argument based on the underlying principles, if necessary supported by evidence, that the claimed concept did not work because it did not achieve the desired effect in any measure or indeed was counter to the laws of nature. Or the party must demonstrate that the disclosure lacked information on an important aspect of the claimed invention, without which the skilled person could not realise the claimed invention without undue burden. The appellant (opponent) failed to present any such arguments.

In **T 970/16** (use of the cellulase in laundering process), the board stated that the opponents, which indeed did not file themselves any evidence, discharged their burden of proof by relying on the available evidence X29 (experimental report filed by the patent proprietor) and by plausibly arguing that common general knowledge would not enable the skilled person to realize the disputed benefits. The required technical effect was due in the present case to a hypothetical mechanism not yet being part of common general knowledge as stated in the patent. The skilled person, in view of the unsuccessful results of X29, would be obliged to start a research program.

In **T 557/22**, in the absence of a proper argumentation relating to the lack of ability of the skilled person to prepare an orthodontic appliance as defined by the terms of claim 6, i.e.

according to the alleged ambiguously defined subject-matter, there was no reason for the opposition division to take a position on that issue. Accordingly, contrary to the appellant's (opponent's) view, the contested decision did not lack substantiation with respect to the issue of sufficiency of disclosure of claim 6.

9.5. Burden of proof shifted to the patent proprietor

This section sets out several example cases in which it was decided that the burden of proof had shifted to the patent proprietor. Please also refer to the longer summary of **T 1076/21** in the introduction to chapter II.C.9. and the section regarding the application of the case law **T 63/06** in chapter II.C.9.1.

In **T 1886/19** the board found that owing to the weak presumption of sufficient disclosure (lack of any information in the patent application to put the invention into practice; **T 3012/18**) and the evidence furnished by the opponent (respondent), the opponent had discharged the initial burden of proof and it had now shifted to the patent proprietor (appellant), which had failed to prove that the invention could be carried out without undue burden.

In **T 1187/20** the board found that the burden had shifted to the patent proprietor (respondent) to prove how the contradictions in claim 1 could be resolved. Among other things, the board stated that under the circumstances, the opponent did not have to provide any additional experimental evidence to substantiate the serious doubts; there was a weak presumption of sufficiency, with reference to **T 63/06**. The board also stressed that not only was there uncertainty about the limits of the claim, but it was also impossible to determine the crux of the invention and how the compound of claim 1 was determined.

9.6. Taking account of doubts

An appellant (opponent) is not required to prove that carrying out the invention is inherently impossible; it need only adduce understandable arguments casting doubt on whether the invention can be carried out over the whole scope of the conferred protection on the basis of the patent specification and, if necessary, common general knowledge (**T 809/13**).

The board in **T 1299/15** observed that it was established case law that the opponent (here: appellant) bore the burden of proving an alleged lack of enablement. However, since the patent specification did not describe any embodiment, the appellant in this case could not take such an embodiment as a basis for proving the lack of enablement; instead, it could only invoke a lack of **plausibility** in support of its case. Having done precisely that, it had shifted the burden of proving the contrary to the patent proprietor (respondent) and, that being the case, the board ultimately decided that the doubts had to go that party's detriment. (See also **T 805/17** on the burden of proof and means of evidence in a case where a patent contained so little information that it was considered insufficient even in combination with the skilled person's common general knowledge – dental reconstruction – doubts about availability of a method of manufacturing a blank with the claimed properties).

In ex parte case **T 2249/16** the board applied the principle that doubts need not be proven by way of experiments but must at least be substantiated in a technically plausible manner. It observed that the contested decision did not set out any reasons or arguments as to why the skilled person would be unable to carry out the invention.

In **T 1634/17** (production of therapeutic antibodies), the board decided that there was no evidence on file showing that homologs, orthologs and functional fragments of the known mouse ADAM6 protein were not available to the skilled person or that inventive skill or undue burden were required from the skilled person to achieve them. Even if doubts were raised by appellant II (opponent), they were not serious or supported by verifiable facts.

9.7. Burden of proof wrongly allocated at first instance

T 55/18 is an example of a case where the board found that the opposition division had been wrong to put the burden of proof on the patent proprietor. On this shifting of the burden of proof, the board held, in particular, that the fact that the appellant (patent proprietor) had filed two pixelated and fuzzy photos (obtained by optical microscopy – means not appropriate for investigating the presence of nanometer particles in suspension) could not as such relieve the respondent (opponent) of the burden of proof. Ultimately, the objection was found not to be substantiated by verifiable facts. Since the respondent had not shown that a skilled person could not carry out the invention, or at least not convincingly put the ability to do so in **doubt**, a lack of sufficient disclosure could not be established. One of the respondent's arguments was that every step of the claimed method had to be sufficiently disclosed, but the patent did not disclose how to carry out step (d) because there was no specific indication of the dimension or the method for measuring it. But, observing that claim 1 did not comprise a step of measuring the dimension of the suspension elements, the board held that the absence of this specific indication did not affect the reproducibility.

In **T 2571/12** the board disagreed with the conclusions of the opposition division that because no evidence had been provided by the opponent to show that any neuropsychiatric disorder could not effectively be treated using a glutathione precursor the patent in suit was considered as disclosing the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art. It is the patent that has to demonstrate the suitability of the claimed treatment for the claimed therapeutic indication. As explained, for example, in decision **T 609/02**, a simple verbal statement that compound X may be used to treat disease Y was not enough to ensure sufficiency of disclosure: rather, it is required that the patent provides some information in the form of, for example, experimental tests, to the avail that the claimed compound has a direct effect on a metabolic mechanism specifically involved in the disease, this mechanism being either known from the prior art or demonstrated in the patent per se.

9.8. Consequence of an invention going against generally accepted scientific principles

It was held in **T 541/96** that if an invention seems to offend against the generally accepted laws of physics and established theories, the disclosure should be detailed enough to

prove to a skilled person conversant with mainstream science and technology that the invention is indeed feasible, the onus being on the applicant (see also **T 1023/00**, **T 1785/06**, ex parte case **T 1842/06** (memory of water), **T 1329/07**, **T 1796/07**, **T 1620/12**, **T 1603/13** (violation of laws of physics – thermodynamics – energy conservation), **T 1485/17** (low frequency signal inherent to only biological systems), **T 2345/19** (hydrinos)). The more a new invention contradicts previously accepted technical wisdom, the greater the amount of technical information and explanation is required in the application to enable the invention to be carried out by the average skilled person to whom only that conventional knowledge is available (**T 1785/06**).

In ex parte case **T 2340/12**, the application related to a space energy implosion unit. The board observed that it did not understand how the torsion field or space energy was to be measured. The appellant (applicant) claimed that over 40,000 Internet citations could be found concerning "Space Energy". But no specific Internet citation was cited which could serve to explain the concepts of torsion field or space energy. The applicant only referred to "indirect" measurements carried out but did not elaborate on the nature of these experiments or on their relevance for the claimed invention despite having been invited to do so in the provisional opinion issued by the board. The examining division raised criticisms regarding the experiments. The appellant emphasised that the EPC does not contain any requirements for such experimental evidence to be provided. The appellant further questioned the competence of the examining division to require such evidence. The board stated that in the case of inventions in **fields of technology without any accepted theoretical or practical basis**, the case law of the boards of appeal has established that the application should contain all the details of the invention required for the effect to be achieved (see **T 541/96**, point 6.2 of the Reasons). This was the direct consequence of the fact that the skilled person will be unable to rely on common and accepted general knowledge when dealing with inventions in such fields. The board stated that there is no provision in the EPC according to which the grant of a patent depends on the filing by the applicant of evidence that the claimed invention performs satisfactorily in the form of results of experimentation. The filing of such results is **not** to be seen as **an obligation** imposed on the applicant **but**, in contrast, as a right, providing the applicant with the **opportunity to convince** the examining division (or the board) that it erred in its initial findings. The decision includes findings on the burden of proof in **ex parte** cases (see for example, the summary of the rules established by the case law for inter partes cases given in **T 967/09**, point 6 of the Reasons).

In **T 518/10**, the board looked at the rules concerning the burden of proof of insufficiency, which was, as a general rule, on the opponents. In the case at issue, the appellant (patent proprietor) had asserted that, against the prevailing technical opinion, by using the extraction method described in the patent in suit the skilled person was able to obtain from marine and aquatic animal material an extract comprising compound (II). The respondents denied this and provided evidence that compound (II) could not be obtained when working according to the general method described in the patent. Under these circumstances the burden of proof was on the appellant to show that the method in the patent worked as alleged. The mere assumption that compound (II) could theoretically be present in an extract due to the krill's diet on algae was not evidence that could disprove the respondents' experimental reports or discharge the burden of proof resting on the

appellant. The board also did not share the appellant's opinion that it was for the respondents, after having failed to obtain the claimed extract by following the teaching of the patent, to embark on a **research programme** in an attempt to find a compound which, according to the prevailing technical opinion, was not expected to be found in the first place, and for the presence of which not even the patent in suit provided conclusive evidence.

in **T 1273/09** the board had serious doubts that the claimed **homeopathic treatment** of hypertension could be reliably and reproducibly achieved by the mixture claimed for the following reasons, namely (i) because on the standards of "conventional" medicine and science it was inconceivable that a homeopathic medicament which did not contain any active substance achieved specific therapeutic effects and (ii) because on the standards of homeopathic medicine it was inconceivable that a homeopathic medicament that was not applied according to homeopathic principles could achieve **specific therapeutic effects**. The board could not conclude that the disclosure in the application – and this was the only source of information in the case at issue – put the skilled person in a position to achieve the claimed treatment of hypertension in a reliable and reproducible manner. The reason was **not**, as suggested by the appellants, a mere, **unsubstantiated "disbelief"**. Rather, the conclusion was drawn by taking into account the quality and quantity of available evidence.

In ex parte case **T 1164/11** the board was not aware of any known physical mechanism by which the light could force into skin the molecules of a medicament contained in the matrix of a solid medicinal solution. The board has serious doubts as to the alleged interaction between the light emitter (laser) and the molecules and as to the claimed result (molecules penetrating the skin). The appellant (applicant) conceded that there may be a **lack of any scientific explanation** but maintained that the claimed device led to a "surprising effect", even if the mechanisms occurring at the skin were not actually known. The board agreed that an invention could still be sufficiently disclosed despite a lack of a sound scientific explanation as long as the surprising effect has been convincingly demonstrated. However, the initial application did not contain any test results or experimental evidence that could indicate how the light improved the penetration of the medicament molecules into the skin. It is not the purpose of the patent system to grant a monopoly for technical speculations that cannot be realised at the time of filing.

The board in **T 2015/20** stated that it was established jurisprudence that sufficiency of disclosure cannot be acknowledged, if an invention goes against a prevailing technical opinion and the patent fails to give even a single reproducible example (**T 792/00**, **T 1164/11**, **T 1273/09**).

If the patent contains a single example described in the form of a hypothetical experimental protocol and this example has to be taken as the basis for showing that the invention is sufficiently disclosed, the patent proprietor bears the burden of demonstrating that this protocol works as described in practice. Evidence that a variant of the protocol works is unlikely to be sufficient (**T 792/00**). In **T 397/02**, however, the patent in suit disclosed a specific humanised version of a mouse antibody, along with several specific variants. Therefore, this situation was not comparable with **T 792/00** (or **T 984/00**), in which there

was no disclosure of a single specific example of the claimed subject-matter. It was thus down to the appellant-opponent to prove that the invention could not be carried out.

9.9. Miscellaneous – argument based on potential effects on competition rejected by the board

In ex parte case **T 416/14** the application documents did not contain any experimental data which could be used to verify the claims, and the appellant (applicant) had not submitted any such data as evidence. The appellant was right that Art. 83 EPC did not per se require experimental data for sufficient disclosure. However, in the absence of any supporting evidence and in light of the evidence to the contrary, the board was not convinced that the appellant was actually able to fabricate a switch that could withstand the claimed field strength without breakdown. Nor could the board accept the argument that a patent on an invention which could not be carried out would be of no harm; Art. 83 EPC was a requirement of the EPC that had to be fulfilled, irrespective of what **potential effects on competitors** a patent might or might not have.

See also chapter III.G.5.1.2d) "Sufficiency of disclosure".

D. Priority

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1. Introduction

1.1. EPC provisions on priority

According to Art. 87(1) EPC, any person who has duly filed, in or for (a) any State party to the Paris Convention or (b) any Member of the WTO, an application for a patent, a utility model or a utility certificate, or his successor in title, shall enjoy, for the purpose of filing a European patent application in respect of the same invention, a right of priority during a period of twelve months from the date of filing of the first application.

Articles 87 to 89 EPC provide a **complete, self-contained code of rules on claiming priority** for the purpose of filing a European patent application (see **J 15/80**, OJ 1981, 213, confirmed in e.g. **J 9/07**, **G 1/15**, OJ 2017, A82, **G 1/22** and **G 2/22**, OJ 2024, A50, point 25 of the Reasons). However, since the EPC – according to its preamble – constitutes a special agreement within the meaning of Art. 19 Paris Convention, it is clearly intended not to contravene the basic principles concerning priority laid down in the latter (see **T 301/87**, OJ 1990, 335; **G 3/93**, OJ 1995, 18, **G 2/98**, OJ 2001, 413 and **G 1/22** and **G 2/22**, point 25 of the Reasons).

Article 87 EPC as well as Art. 88(2), (3) and (4) EPC pertain to the **material conditions** under which priority rights may be derived from an earlier application. Art. 88(1) EPC concerns the **procedural requirements** to be met by an applicant desiring to take advantage of the priority of an earlier application, namely the filing of a declaration of priority and other documents with the EPO. These procedural requirements are further specified in the Implementing Regulations (R. 52 to 54 EPC). Art. 89 EPC prescribes the **effect of a priority right**, i.e. that the priority date shall count as the date of filing of the European patent application for the purposes of the delimitation of the prior art under Art. 54(2) and (3) EPC. In other words, the priority right allows the exclusion of everything that has become prior art between the priority date and the filing date (often referred to as "intermediate prior art") for the assessment of patentability (**G 1/22** and **G 2/22**, point 26 of the Reasons).

In **G 1/22** and **G 2/22** the Enlarged Board referred to the four requirements underlying Art. 87(1) EPC, which can be set out as the following questions: "who?", "where?", "what?" and "when?" (**G 1/22** and **G 2/22**, points 58 and 91 of the Reasons, see also **T 844/18** summarised in this chapter II.D.2.7.1). The question whether the applicant of the later application is entitled to claim the priority of the earlier application (the issue of "who"), in particular as a successor of the applicant of the priority application, is often referred to as "**formal priority**" or "formal validity of the priority". This question was addressed in **G 1/22** and **G 2/22** (see in this chapter II.D.2). The "same invention" criterion of Art. 87(1) EPC (the issue of "what") is often referred to as "**substantive priority**" or "substantive validity of the priority" and was the subject of two referrals to the Enlarged Board: **G 2/98**, OJ 2001, 413 and **G 1/15**, OJ 2017, A82 (see in this chapter II.D.4). The other two requirements are covered in this chapter II.D.3 ("where"), II.D.1.2 and II.D.2.4.2 ("when").

1.2. Purpose of the priority right

The right of priority is generally regarded as one of the cornerstones of the Paris Convention. Its **basic purpose** is to safeguard, for a limited period, the interests of a patent applicant in its endeavour to obtain international protection for its invention, thereby alleviating the negative consequences of the principle of territoriality (**T 15/01**, OJ 2006, 153, cited in **G 1/22** and **G 2/22,** OJ 2024, A50, point 54 of the Reasons). The rules of the Paris Convention and the self-contained priority system of the EPC should be construed in a manner which ensures that the above-mentioned general purpose is fulfilled as far as possible (**T 15/01**, OJ 2006, 153, confirmed in **T 5/05**, cited in **G 1/22** and **G 2/22**, point 54 of the Reasons).

For the person filing a patent application in a state addressed in Art. 87(1) EPC, the priority system means that it has the option to file a bundle of subsequent applications for the same invention in a freely selected group of other territories where each of the later (national or regional) applications may benefit from the priority date of the first application. The priority period of twelve months on the one hand allows for an evaluation by the applicant as to where patent protection should be sought. On the other hand, the clear limitation of the period provides legal certainty to third parties who ought to know the geographical limitations of the patent protection they may be confronted with (**G 1/22** and **G 2/22**, point 55 of the Reasons).

1.3. Internal priorities

In view of Art. 87(1) and (2) EPC, the priority system adopted by the European legislator also recognises "**internal priorities**" (**T 15/01**, OJ 2006, 153). In this context the question of **double patenting** has arisen – relevant decisions, in particular **G 4/19** (OJ 2022, A26) on the points of law referred to the Enlarged Board in **T 318/14** of 7 February 2019 (OJ 2020, A104), can be found in chapter II.G.

1.4. Checks for validity of the priority right during examination and opposition proceedings

The EPO does not normally check the validity of a priority right during examination. A check must be made, however, if relevant prior art has been made available to the public within the meaning of Art. 54(2) EPC on or after the priority date claimed and before the date of filing (priority interval) or if the content of the European patent application is totally or partially identical with the content of another European application within the meaning of Art. 54(3) EPC, such other application claiming a priority date within the above-mentioned period (Guidelines F-VI, 2.1 – April 2025 version). In opposition proceedings this applies where prior art is invoked in connection with a ground for opposition under Art. 100(a) EPC in relation to which the priority date is of decisive importance (Guidelines D-III, 5 – April 2025 version). Failure by the respective division to check the validity of the priority right in the circumstances described has been held to be a **substantial procedural violation** (see **T 16/89**, **T 737/95**, **T 2170/08**). On publications during the priority interval, see also **G 3/93** (OJ 1995, 18), summarised in chapter II.D.6.1.

1.5. Evidence, correction and restoration

For issues of evidence concerning the validity of the priority claim, see in this chapter II.D.2.4.3. For decisions on the correction of the priority declaration, see chapter IV.A.8. **J 13/16**, a decision concerning the remedy of restoration of the right of priority under R. 49*ter*.2 PCT, is reported in chapter VI.3.2.3.

2. Right of priority of the applicant or its successor in title

2.1. General

Pursuant to Art. 87(1) EPC, a right of priority, that is, the right to claim priority for a European patent application from the filing date of an eligible "first application" or "previous application" **originates in the applicant of a first application** (**T 205/14**, cited by the Enlarged Board in **G 1/22** and **G 2/22**, OJ 2024, A50, point 83 of the Reasons). The right of priority may, in accordance with Art. 87(1) EPC, also be invoked by the "**successor in title**" of the person who filed the first application. By reference to the "successor in title", it is recognised that the right of priority, being a legal right, **may be transferred** from the original applicant to a third person (see e.g. **T 62/05**, **T 5/05**, **T 382/07**, **T 1933/12** and **T 517/14**).

According to the board in **T 205/14**, it is generally accepted that the right of priority is transferable independently of the corresponding first application and may be transferred to a third person for one or more countries only (**T 62/05**). It is an independent right until it is invoked for one or more later applications to which it becomes an accessory, and it has to be distinguished from the right to the patent deriving either from substantive law or from the status of being the applicant of the first application (**T 205/14**, with further references; see also **T 969/14**; and **T 1201/14**, with further references).

The board in **T 969/14** held, with reference to Enlarged Board decision **G 1/15** ("Partial priority", OJ 2017, A82), that once it is acknowledged that partial priority rights exist they must also be transferable separately. This, however, has consequences for the remaining priority right, because the assignor is left with a limited right. On partial and multiple priorities, see also in this chapter II.D.6.

2.2. Competence of the EPO to assess priority entitlement

2.2.1 Question referred to the Enlarged Board in consolidated cases T 1513/17 and T 2719/19

In **G 1/22** and **G 2/22** the Enlarged Board concluded that the EPO **is competent** to assess whether a party is entitled to claim priority under Art. 87(1) EPC (**G 1/22** and **G 2/22**, OJ 2024, A50, points 112 and 130 of the Reasons, point I of the Order).

Prior to **G 1/22** and **G 2/22**, in most cases where the boards had to assess whether the applicant of a subsequent application was entitled to claim priority under Art. 87(1) EPC the boards had tacitly assumed that they had jurisdiction for such assessment. In **T 844/18**, where this jurisdiction was challenged, the board affirmed its jurisdiction. Moreover, the board did not see a possibility for applying Art. 60(3) EPC by analogy to the right to claim priority under Art. 87(1) EPC. These views were confirmed in **T 2431/17** (together with **T 844/18**, cited by the Enlarged Board in **G 1/22** and **G 2/22**, point 58 of the Reasons). Notwithstanding, the EPO's jurisdiction had been questioned by boards of appeal in several cases (see **G 1/22** and **G 2/22**, points 47, 58 and 59 of the Reasons). This led the board in **T 1513/17** and **T 2719/19** to refer the following question to the Enlarged Board:

"Does the EPC confer jurisdiction on the EPO to determine whether a party validly claims to be a successor in title as referred to in Article 87(1)(b) EPC?". To cover all situations where the right of an applicant to claim priority is relevant in proceedings before the EPO, this question was rephrased by the Enlarged Board as: "**Is the EPO competent to assess whether a party is entitled to claim priority under Article 87(1) EPC?**".

The referring board asked the Enlarged Board a second question concerning the "PCT joint applicants" approach. This is covered in this chapter II.D.2.5.3.

2.2.2 Distinction between title to the subsequent application and priority right

According to the Enlarged Board, in the context of the EPC and the proceedings before the EPO, a **strict distinction** should be made **between the title to the subsequent application** (i.e. the right to the European patent) **and the priority right**. The title to the subsequent application, on the one hand, is subject to national property laws. Its transfer is governed by national laws (to be determined in accordance with national conflict of law rules) and assessed by national courts in view of Art. 60(3) EPC. The right to claim the priority date for the subsequent European application, on the other hand, is a right **created under the autonomous law of the EPC and the Paris Convention**, the transfer of which should also be assessed under the autonomous law of the EPC (**G 1/22** and **G 2/22**, point 129 of the Reasons). See also **T 205/14** in II.D.2.1.

In proceedings before the EPO, the applicant shall be deemed to be entitled to exercise the right to the European patent (Art. 60(3) EPC). The EPO has no power to decide a dispute as to whether a particular applicant is legally entitled to apply for and be granted a European patent in respect of the subject-matter of a particular application. Prior to grant, the determination of questions of entitlement to the right to the grant of a European patent is governed by the Protocol on Recognition. After grant, the national courts are competent to decide on disputes about the title to the European patent for each of the designated contracting states (**G 1/22** and **G 2/22**, point 79 of the Reasons, see also chapter IV.A.4).

According to the Enlarged Board in **G 1/22** and **G 2/22**, **Art. 60(3) EPC is not applicable to disputes about the transfer of the priority right**, neither directly nor by analogy. In a codified system that has adopted the principles set forth in Art. 31 and 32 of the Vienna Convention, a judge can establish rules going beyond the literal meaning of a legal provision (whether by analogy or otherwise) only if there is a lacuna in the law. The Enlarged Board concluded that there is no lacuna in this respect that could be filled by the application by analogy of Art. 60(3) EPC (**G 1/22** and **G 2/22**, point 89 of the Reasons).

2.3. Application of the autonomous law of the EPC to the transfer of priority rights

Since the creation, the existence and the effects of priority rights are governed only by the EPC (and by the Paris Convention through its relationship with the EPC), **priority rights** are autonomous rights under the EPC and **should be assessed only in the context of the EPC**, regardless of any national laws. Consequently, the **entitlement to claim priority** (and any related assignments of priority rights) **should** also **be assessed under the autonomous law of the EPC** (**G 1/22** and **G 2/22**, OJ 2024, A50, points 83 to

86 of the Reasons). The exclusive application of the autonomous law of the EPC to the transfer of priority rights removes the need for conflict of law rules and the application of national laws, thereby eliminating two main reasons invoked against the EPO's competence to assess whether a party is entitled to claim priority under Art. 87(1) EPC (**G 1/22** and **G 2/22**, point 130 of the Reasons).

The Enlarged Board endorsed the assessment of priority entitlement under the autonomous law of the EPC but not necessarily all rules discussed in the case law predating **G 1/22** and **G 2/22** (**G 1/22** and **G 2/22**, point 86 of the Reasons, see also points 68 and 69 of the Reasons citing **T 62/05**, **T 577/11**, **T 205/14**, **T 517/14**, **T 1201/14** and **T 1946/21**, summarised in this chapter II.D.2.7.). According to the Enlarged Board, the autonomous requirements for the valid transfer of priority rights should **not be stricter than national rules** applicable to the transfer of priority rights or other property rights. On the contrary, the EPO should **adapt itself to the lowest standards** established under national laws and **accept informal or tacit transfers** of priority rights under almost any circumstances. For example, the autonomous law of the EPC should not require that the assignment of priority rights be in writing and/or signed on behalf of the parties to the transaction (see **T 62/05**, cf. **T 205/14** and **T 517/14**) since this would establish a high threshold in view of the national laws (**G 1/22** and **G 2/22**, points 69 and 100 of the Reasons, see also in this chapter II.D.2.7.3c)).

Even the requirement that the transfer of the right of priority needs to be concluded before the filing of the subsequent European application is questionable in the Enlarged Board's view (cf. **T 577/11** and **T 1946/21** reported in this chapter II.D.2.7.4). If there are jurisdictions that allow an ex post ("nunc pro tunc") transfer of priority rights (see the discussion of such transfers under US law in **T 1201/14**) the EPO should not apply higher standards. However, the allowability of a retroactive transfer of priority rights may have limited practical relevance if priority entitlement is presumed to exist on the date on which priority is claimed for the subsequent European application (**G 1/22** and **G 2/22**, point 100 of the Reasons, see in this chapter II.D.2.4; see also **T 2360/19** of 5 March 2024 in this chapter II.D.2.6).

According to the Enlarged Board, it cannot be excluded that **in the context of the rebuttal of the presumption** of entitlement to priority**, national laws need to be considered** as well (**G 1/22** and **G 2/22**, points 111 and 133 of the Reasons; see in this chapter II.D.2.4.1).

2.4. Rebuttable presumption of entitlement to claim priority

2.4.1 Introduction

In **G 1/22** and **G 2/22** the Enlarged Board concluded that there is a **rebuttable presumption** under the autonomous law of the EPC **that the applicant** claiming priority in accordance with Art. 88(1) EPC and the corresponding Implementing Regulations **is entitled to claim priority**. This presumption is justified in view of the purpose of the priority rights, the lack of formal requirements for the transfer of priority rights and the presumed common interest of the priority applicant and the subsequent applicant (**G 1/22** and **G 2/22**, points 101 et seq. of the Reasons and point I of the Order). The considerations leading to

the presumption of priority entitlement apply to any case in which the subsequent applicant is not identical with the priority applicant but receives the support of the priority applicant required under Art. 88(1) EPC (**G 1/22** and **G 2/22**, point 107 of the Reasons). See also **T 2719/19** of 20 November 2023, **T 2360/19**, **T 2516/19**, **T 2689/19**, **T 521/18** of 7 March 2024, **T 2224/21**, **T 2643/16** of 3 June 2024, **T 1975/19**, **T 419/16** of 24 June 2024 in this chapter II.D.2.5.3, II.D.2.5.4 and II.D.2.6.1.

According to the Enlarged Board, the presumption should be rebuttable since in rare exceptional cases the priority applicant may have legitimate reasons not to allow the subsequent applicant to rely on the priority (**G 1/22** and **G 2/22**, points 106 to 108 of the Reasons and point II of the Order).

The rebuttable presumption **also applies** in situations where the European patent application derives from a PCT application and/or where the priority applicant(s) are not identical with the subsequent applicant(s). See in this chapter II.D.2.5.1 and II.D.2.6.1.

The presumption of priority entitlement and its rebuttal are, like the priority entitlement in general (see in this chapter II.D.2.3), subject to the autonomous law of the EPC only. There is no room for the application of national laws on legal presumptions and their rebuttal. It cannot be excluded, however, that **in the context of the rebuttal of the presumption national laws need to be considered** as well. For example, the existence of legal entities being parties in transfers of priority rights may be relevant and may need an assessment under national laws (**G 1/22** and **G 2/22**, points 111 and 133 of the Reasons; for the application of national law to determine whether a legal entity exists, see **G 1/13** (OJ 2015, A42) summarised in chapter V.A.2.4.3d)). For case law prior to **G 1/22** and **G 2/22** where national law was considered, see in this chapter II.D.2.7.2.

If the requirements under Art. 88(1) EPC are not fulfilled, the subsequent applicant is **barred from claiming priority** for this reason alone. The fulfilment of these procedural requirements is not covered by the presumption. This is reflected in the Order in **G 1/22** and **G 2/22** where compliance with Art. 88(1) EPC and the corresponding Implementing Regulations is set as a condition for the rebuttable presumption of priority entitlement. (**G 1/22** and **G 2/22**, point 132 of the Reasons and point I of the Order).

2.4.2 Relevant time for presumption and rebuttal

Priority entitlement is not relevant before the priority is claimed by the subsequent applicant in accordance with R. 52 EPC, normally at the filing date of the subsequent application or otherwise within 16 months from the filing date of the priority application. Consequently, the **presumption** of entitlement **exists on the date on which the priority is claimed** and the rebuttal of the presumption must also relate to this date. Later developments cannot affect the rebuttable presumption (**G 1/22** and **G 2/22**, point 109 of the Reasons).

2.4.3 Reversal of the burden of proof and strong presumption

The rebuttable presumption involves the **reversal of the burden of proof**, i.e. the party challenging the subsequent applicant's entitlement to priority has to prove that this entitlement is missing. If there is a strong presumption, the hurdle for rebutting it is higher than in the case of a weak presumption (**G 1/22** and **G 2/22**, point 110 of the Reasons, citing **T 63/06**).

The presumption that the subsequent applicant is entitled to the priority right is a **strong presumption** under normal circumstances since the other priority requirements (which establish the basis for the presumption of priority entitlement) can usually only be fulfilled with the consent and even cooperation of the priority applicant (**G 1/22** and **G 2/22**, point 110 of the Reasons). The party challenging the entitlement can thus **not just raise speculative doubts** but must demonstrate that specific facts support serious doubts about the subsequent applicant's entitlement to priority. See **T 2719/19** of 20 November 2023, **T 2360/19** of 5 March 2024, **T 521/18**, **T 2643/16** of 3 June 2024 and **T 419/16** of 24 June 2024 in this chapter II.D.2.5.4 and II.D.2.6.1. See also **T 1698/21**.

In **T 2224/21** the appellant (opponent) challenged the applicant's entitlement to priority and argued that, because the relevant information relating to the disputed transfer was non-public information in the possession of the respondent (patent proprietor), the burden of proof lay with the respondent. Applying **G 1/22**, the board held that a rebuttable presumption of priority entitlement applied. The appellant had only raised speculative doubts not supported by evidence. On the contrary, the evidence presented by the respondent reinforced the strong presumption. In this context, it was not apparent to the board why the alleged failure by the respondent to provide written evidence in the form of commercial contracts or agreements between the parties should go to the detriment of the respondent. Moreover, the appellant was not in a position in which any evidence for rebutting the presumption of entitlement would only be at the hands of the respondent. The board concluded that the respondent was entitled to the priority.

According to the board in **T 1975/19**, considering that **G 1/22** establishes a strong presumption of validity and places the burden on the opponents to prove the contrary, the lack of evidence of a transfer of the right to priority to the subsequent applicant could not be equated with a proof that this transfer did not take place. Absent any further circumstances, evidence of a transfer of the right to priority to a third party other than the subsequent applicant, did not amount either to a proof that this right to priority was not, in turn, further transferred to the subsequent applicant. Indeed, as explained in **G 1/22**, the presumption also applies if the title to the subsequent application has not been acquired from the priority applicant but from a third party having the right to the invention in the respective territory. This presumption applied all the more in the case at hand as all parties involved were legal persons belonging to the same group and their employees.

See also **T 521/18** and **T 518/22** in chapter II.D.2.5.4, where the board applied the presumption to patent applications cited as prior art.

2.4.4 No restriction on who can challenge priority entitlement

In **G 1/22** and **G 2/22** the Enlarged Board noted that in the EPC there are no restrictions on who can file an opposition. If the EPO is competent to assess all aspects of priority together with all patentability requirements ex officio in examination proceedings or on the request of an opponent, the EPO cannot refuse to assess a priority entitlement objection based on who raised the objection. The rebuttable presumption concerning priority entitlement, however, substantially limits the possibility of third parties, including opponents, to successfully challenge priority entitlement (**G 1/22** and **G 2/22**, point 117 of the Reasons).

2.5. Joint applicants for the subsequent application

2.5.1 Introduction

A requirement for a valid priority claim is that the European patent application is filed by the applicant of the first application (i.e. the priority applicant) or by its successor in title. There are generally two factual situations before the boards involving a plurality of co-applicants for the priority application or the subsequent application or both. In the first, covered in this chapter II.D.2.5, an applicant is added in the subsequent application, i.e. the priority application is filed by one or more applicants and the subsequent application is filed by those applicants and one or more additional applicants (see e.g. **T 1933/12**, **T 2719/19**, **T 2643/16**). In the second, covered in this chapter II.D.2.6, not all applicants for the priority application are named in the subsequent application (see e.g. **T 382/07**, **T 844/18**, **T 2360/19**).

2.5.2 "Joint applicants" approach

The "joint applicants" approach concerns, in the most simple case, the situation where a party A is applicant for the priority application and parties A and B are applicants for the subsequent application, for which the priority is claimed. In this situation, party B can benefit from the priority right to which its co-applicant A is entitled; a separate transfer of the priority right to party B is not needed according to this approach. This approach has been acknowledged by the boards for regular European patent applications (**G 1/22** and **G 2/22**, OJ 2024, A50, points 10 and 118 of the Reasons, citing **T 1933/12** and the referring decision; see also in this chapter II.D.5.2).

2.5.3 "PCT joint applicants" in G 1/22 and G 2/22

The second question referred to the Enlarged Board in **G 1/22** and **G 2/22** concerned a special situation occurring where a party, typically the inventor(s), files a US priority application (also in the form of a provisional application) which is then used as priority application for a later PCT application designating one party (typically still the inventor(s)) for the US only and another party (typically the employer of the inventor(s)) for regional European patent protection. Before the "America Invents Act" of 2011 entered into force, only the inventor(s) could be applicants in a US patent application. The priority application

underlying the referral (filed in 2004) had to be filed by the inventors under the then applying laws.

In the two cases underlying the referral in **G 1/22** and **G 2/22,** i.e. **T 1513/17** and **T 2719/19**, the priority claim had been found to be invalid by the opposition division and the examining division respectively. This had led to the revocation of the patent (**T 1513/17**) and the refusal of the application (**T 2719/19**) for lack of novelty. The application on which the patent was granted in **T 1513/17** (and from which the application derived in **T 2719/19**) was filed as an international application under the PCT (the "PCT application"). It named (i) the three inventors as applicants for the US only and (ii) other (legal) persons including the appellant ("Party B") as applicants for all other designated States. The PCT application claimed priority from a US provisional application filed in the name of the three inventors. The opposition division and the examining division found the priority claim to be invalid because only one of the three inventors had assigned the priority right to Party B prior to the filing of the PCT application. Thus, intermediate publications were novelty-destroying.

Even if the "joint applicants" approach had been acknowledged by the boards for regular European patent applications (see in this chapter II.D.2.5.2), the use of this approach for a PCT application with different applicants for different designated territories had been questioned in the referring decision. The referring board referred two questions to the Enlarged Board. For Question I, concerning the EPO's competence to assess priority entitlement, see in this chapter II.D.2.2.1. Question II was as follows:"(II) If question I is answered in the affirmative

Can a party B validly rely on the priority right claimed in a PCT application for the purpose of claiming priority rights under Article 87(1) EPC in the case where:

1) a PCT application designates party A as applicant for the US only and party B as applicant for other designated States, including regional European patent protection and

2) the PCT application claims priority from an earlier patent application that designates party A as the applicant and

3) the priority claimed in the PCT application is in compliance with Article 4 of the Paris Convention?".

The Enlarged Board held that **the rebuttable presumption** that the applicant claiming priority in accordance with Art. 88(1) EPC is entitled to claim priority (see II.D.2.4.1 above) **also applies** where the European patent application derives from a PCT application and/or where the priority applicant(s) are not identical with the subsequent applicant(s). Moreover, the Enlarged Board **endorsed the concept of an implied agreement** (see in this chapter II.D.2.5.5). According to the Enlarged Board, a general decision on the viability of the "PCT joint applicants" approach was not needed. The concept of an implied agreement should allow an assessment leading to the same result as the "PCT joint applicants" approach in most cases (**G 1/22** and **G 2/22**, points 118 to 121 of the

Reasons). For the application of this decision by the referring board in **T 2719/19** of 20 November 2023, see in this chapter II.D.2.5.4 (the appeal was withdrawn in **T 1513/17**).

2.5.4 Application of G 1/22 and G 2/22 by the boards – joint applicants for the subsequent application

G 2/22 was first applied in **T 2719/19** of 20 November 2023, the referring case in **G 2/22** (summarised in this chapter II.D.2.5.3). The board recalled that the Enlarged Board had decided that there was a rebuttable presumption under the autonomous law of the EPC that the applicant claiming priority in accordance with Art. 88(1) EPC and the corresponding Implementing Regulations was entitled to claim priority and that this presumption also applied in the factual situation of the case in suit. Moreover, the Enlarged Board had ruled that in the situation of the case in hand, where the PCT application was jointly filed by party A (as inventors and as applicants for the US only) and party B (as applicants for all other designated States), and claimed priority from an earlier patent application designating party A as the applicant, the joint filing implied an agreement between party A and party B, allowing party B to rely on the priority, unless there were substantial factual indications to the contrary. According to the board, no substantial factual indications to the contrary were mentioned in the decision under appeal nor was the board aware of any. The board concluded that the appeal was allowable (the priority was valid) and remitted the case to the examining division with the order to grant a patent.

G 1/22 and **G 2/22** has also been applied in the context of patent applications cited as prior art documents. In **T 521/18**, an appeal by the patent proprietor against the decision of the opposition division to revoke the patent for lack of novelty of the subject-matter of claims 1 and 5 of auxiliary request 3 (main request on appeal) over the disclosure of document D4. The opposition division had held that D4, filed in the name of a corporation (designated for the States outside US) and ten inventors/applicants (designated for the US only) was entitled to priority from application P4 (D4a) filed in the name of seven out of the ten inventors/applicants of D4. The board held that the strong presumption of entitlement applied in the case in hand. Such presumption could only be rebutted in the presence of "serious doubts" based on facts or clear indications to the contrary. In the board's opinion the evidence submitted by the appellant was not suitable to rebut the presumption. See also **T 518/22**.

See also **T 2224/21**, reported in this chapter II.D.2.4.3, **T 2643/16** of 3 June 2024 and **T 2132/21**.

2.5.5 Implied agreement

In **G 1/22** and **G 2/22** the Enlarged Board concluded that in the absence of substantial factual indications to the contrary, the joint filing of a PCT application by party A and party B sufficiently proved that the parties had entered into an implied agreement allowing party B to rely on the priority (**G 1/22** and **G 2/22**, point 125 of the Reasons, point II of the Order).

According to the Enlarged Board, since the considerations leading to this conclusion not only apply in the context of PCT applications, the concept and the conditions for an implied

agreement equally apply to co-applicants directly filing a subsequent European application if at least one of the co-applicants was an applicant for the priority application. They do not apply, however, to co-applicants for the priority application who are not involved in the subsequent application (see in this chapter II.D.2.6.2).

To put into question the implied agreement, evidence would be needed that an agreement on the use of the priority right has not been reached or is fundamentally flawed. Factual indications putting into question the implied agreement have to be of a substantial nature and have to be presented by the party questioning the implied agreement. Moreover, the implied agreement is to be assessed under the autonomous law of the EPC, which does not foresee any formal requirements for the transfer of priority rights (**G 1/22** and **G 2/22,** point 125 and 126 of the Reasons). See **T 2719/19** in this chapter II.D.2.5.3.

In **T 2132/21** the patent claimed priority from a US application filed in the name of four inventors. In the filing of the PCT application leading to the patent, the four inventors were named as applicants for the US only and a corporation was named as applicant for all other states. The appellant (opponent) argued that the priority was not valid because there was no evidence that the priority rights had been transferred to the respondent before the PCT application was filed. Applying **G 1/22** and **G 2/22**, the board held that the joint filing of the PCT application, in the absence of evidence to the contrary, was sufficient proof of an implied agreement on the joint use of the priority right.

2.6. Not all applicants for priority application named in subsequent application

2.6.1 Rebuttable presumption applies

Prior to **G 1/22** and **G 2/22** the opposition divisions and the boards had applied the "**all applicants**" (or "same applicants") **approach** in the situation where not all applicants for the priority application are named in the subsequent application. See in particular **T 844/18** in this chapter II.D.2.7.1, where the board found the priority claim to be invalid because not all of the applicants of certain US provisional applications from which priority was claimed were named as an applicant in the application leading to the patent in suit.

In **T 2360/19** the patent was based on a European patent application which was a divisional application of an earlier European patent resulting from an international PCT application. This PCT application claimed priority from 12 US provisional applications (P1 to P12). The opposition division, applying the so-called "all applicants" approach, had found that priority was not validly claimed from P1, P2, P5 and P11 because these had been filed by joint applicants (Party A1 or Party A2 being among them) and neither Party A1 nor Party A2 were named as applicants in the PCT application (and consequently in the patent in suit). This had led to the revocation of the patent for lack of novelty. The patent proprietors (appellants) had appealed the decision of the opposition division.

Applying **G 1/22** and **G 2/22**, the board recalled that the presumption of entitlement to priority applied to any case in which the subsequent applicant was not identical with the priority applicant, and thus also to a plurality of co-applicants for the priority application regardless of the extent to which that group overlapped with the co-applicants of the

subsequent application. This was the situation in **T 2360/19** and thus the presumption of a validly claimed priority applied. Relying on documentation pertaining to an inventorship dispute, the opponents argued that the appellants had not provided evidence that they were entitled to the priority rights. According to the board, however, the presumption in **G 1/22** and **G 2/22** stated that the appellants did not have to provide such evidence, but the opponents had to rebut the presumption (see in this chapter II.D.2.4.3). As there was no evidence to rebut the presumption, the board found the priority claims to be valid. See also **T 2516/19** and **T 2689/19**.

2.6.2 No agreement can be implied

According to the Enlarged Board in **G 1/22** and **G 2/22**, no agreement can be implied in the situation underlying **T 844/18** because an agreement (regardless its form) can only be held against parties who were involved in the facts establishing the agreement. Co-applicants for the priority application who were not involved in the subsequent application may not be deemed to have consented to the reliance on the priority right by the other co-applicants. However, the subsequent applicant may still be entitled to claim priority since the rebuttable presumption of entitlement does not depend on whether the involved applicants acted as co-applicants at any stage (**G 1/22** and **G 2/22**, point 128 of the Reasons, see also in this chapter II.D.2.5.5).

2.7. Case law prior to G 1/22 and G 2/22

2.7.1 The "all applicants" approach applied by the boards prior to G 1/22 and G 2/22

In **T 844/18** the core issue to be decided was this: "A and B are applicants for the priority application. A alone is the applicant for the subsequent application. Is a priority claim valid even without any assignment of priority right from B to A?" One of several applicants for certain US provisional applications from which priority was claimed had not been named as an applicant in the application leading to the patent in suit. The appellants (patent proprietors) challenged the long-established "all applicants" (or "same applicants") approach applied by the opposition division in line with the boards' case law.

The board found the ordinary meaning of the term "any person" in Art. 87(1) EPC to be ambiguous in all language versions (cf. Art. 4A(1) Paris Convention, Art. 31(1) Vienna Convention). It agreed with **T 15/01** (OJ 2006, 153) that the object and purpose of the Paris Convention (cf. Art. 31(1), 33(4) Vienna Convention) was to "safeguard, for a limited period, the interests of a patent applicant in his endeavour to obtain international protection for his invention" and that "the international priority provisions contained in the Paris Convention ... assist the applicant in obtaining international protection for his invention". Rejecting the appellants' interpretation of "any person", which would allow A alone to file another application in another country claiming the same invention without involving B, the board reasoned that the object and purpose of the Paris Convention could not form the basis for favouring one or some persons to the detriment of all other persons who had originally formed part of the group filing a patent application. Moreover, the priority provisions of the Paris Convention had remained essentially unchanged since 1883 and there had been no EPO or national case law clearly adopting the appellants' interpretation.

The bar for overturning long-established case law and practice should be very high because of the disruptive effects a change could have. See also **T 788/05** in this chapter II.D.5.2.

See, however, **T 2360/19** in this chapter II.D.2.6.1.

2.7.2 National laws considered

Prior to **G 1/22** and **G 2/22**, national law was consistently applied to the succession in title addressed in Art. 87(1) EPC. In **G 1/22** and **G 2/22**, however, the Enlarged Board held that the entitlement to claim priority (and any assignments of priority rights) should be assessed under the autonomous law of the EPC (see in this chapter II.D.2.3). The Enlarged Board also noted that it cannot be excluded that in the context of the rebuttal of the presumption of entitlement to priority, national laws need to be considered as well (see in this chapter II.D.2.4.1). It follows that some of the decisions in this section are now of limited application.

a) Determination of the applicable national law

With regard to the formal requirements for the transfer of the right of priority, the board in **T 1201/14** observed that, as the EPC contained neither guidance nor conflict of law provisions for that purpose, national law was commonly relied upon by the departments of the EPO entrusted with the procedure. The board also acknowledged that there was no established jurisprudence of the boards as to the national law generally applicable to this question. As noted by the board in **T 205/14**, in some cases the determination of the applicable national law seemed to have been straightforward in view of the circumstances of the respective cases. In **J 19/87** all circumstances relevant to the transfer of the right to priority (residence, place of business, state of the first filing, assignment contracts) related to UK law, and the board applied this national law to the question of entitlement to priority. Similarly, in **T 1008/96** all circumstances relevant to the transfer of the right to priority were connected with Italy and thus with Italian law. See also **T 493/06** and **T 725/14**.

In **T 160/13**, concerning a transfer within a corporate group, the patent in suit was filed as an international application by an affiliate with a place of business in France. It claimed the priority of a German utility model application, which had been filed by an affiliate with place of business in Germany. Here, the place of business of the transferor, the state of filing of the first application and the assignment declaration by the transferor (e-mails sent by an employee of the German affiliate) were factual elements connected to German territory. Only the place of business of the transferee tended to the application of a law other than German law. The board confirmed that the opposition division had rightly examined the transfer of the priority right on the basis of German law.

In **T 205/14** the board considered both the law applicable to the legal relationship between the transferor and the transferee of the priority right and the law of the state of filing of the first application and concluded that the former – in this case the law of the state of the employment relationship between the applicants (inventors) of the US provisional

applications from which priority was claimed and the patent proprietor (here the law of Israel) – determined the transfer. See also **T 517/14**.

In several cases the boards did not have to decide which law was applicable because succession under Art. 87(1) EPC was assessed under different national laws for the same set of facts with the same result. See e.g. **T 577/11**, where the board found that none of the appellant's arguments, which were based on the applicability of Italian and Dutch law, led to a finding favourable for the applicant. See also **T 1201/14**.

b) Application of national law to succession in title under Article 87(1) EPC

According to the board in **T 577/11**, where the applicant of the priority application and the applicant of the subsequent application contractually agree that (only) economic ownership ("economische eigendom" under Dutch law) of the priority application and the right to claim its priority is to be transferred to the subsequent applicant, this is not sufficient to consider the latter a successor in title within the meaning of Art. 87(1) EPC 1973. The board recognised the retroactive effect of the transfer of "economic ownership" but not of the legal title. It concluded that at the time of filing of the subsequent application this arrangement only amounted to a limited transfer, insufficient for the purposes of Art. 87(1) EPC 1973. Furthermore, this case was to be distinguished from the situation of equitable assignment under English law, which was the subject of **J 19/87**.

In **T 160/13** the board confirmed that the opposition division had rightly examined the transfer of the priority right on the basis of German law, which called for a bilateral declaration of transfer by both applicants (§§ 398 and 413 in conjunction with §§ 145 et seq. of the German Civil Code). Such declarations were not subject to any particular formal requirements under German law, and no other requirements of a formal nature could be inferred from the decisions cited by the appellant, **T 1056/01** and **T 62/05**. In the board's view the correspondence on file provided ample proof of the transfer.

In **T 205/14**, based on the evidence before it, the board was satisfied both that Israeli law did not require an assignment in writing signed by both parties and that the priority right had been transferred to the patent proprietor before the date of filing of the international application underlying the patent in suit. See also **T 517/14**.

In **T 725/14** A was the applicant for the application from which priority was claimed and also the applicant for the parent application of the patent in suit. However, the appellant (opponent) alleged that the priority right had been transferred from A to F (patent proprietor/respondent) by a declaration of assignment dated 1 March 2007 (D17), some days before the parent application was filed. The board rejected the respondent's argument that the transfer was only effective on the date on which a request for registration of the transfer was sent to the EPO (R. 22 EPC; see, similarly, **T 404/13**). The transfer of the priority right had to be assessed by applying national law (e.g. **T 205/14**, **T 1201/14**). The board saw no reason to deviate from the parties' agreed position that the law of the Netherlands was applicable. Referring to a legal opinion filed by the appellant to explain the requirements for assignment of the priority right under the Dutch Civil Code, the board

concluded that D17 was sufficient to execute the assignment under the law of the Netherlands. The priority claim was invalid. See also parallel case **T 924/15**.

See also **T 1201/14** in this chapter II.D.2.7.4 on nunc pro tunc assignments under US law and in this chapter II.D.2.3.

2.7.3 Burden of proof, standard of proof and suitable evidence of valid transfer

a) Burden of proof

Prior to **G 1/22** and **G 2/22**, the burden of proving a valid transfer of the right of priority lay with the proprietor since it was the one claiming that right (**T 1201/14**, see also **J 19/87**, **T 1008/96**, **T 1056/01**, **T 493/06** and **T 205/14**). This was reversed in **G 1/22** and **G 2/22** (see in this chapter II.D.2.4.3).

b) Standard of proof

In **T 2466/13** the board observed that there was no clear line in the boards' case law on the standard of proof to be met: **T 205/14** and **T 517/14** applied the balance of probabilities, while in **T 1201/14**, a stricter standard was applied (see above). In **T 1786/15**, too, the board applied the standard of proof "beyond reasonable doubt". In doing so, it referred to the boards' case law on cases of prior use (in particular **T 472/92**, OJ 1998, 161) where all the evidence supporting a specific statement of fact was within the power and knowledge of one party (see chapter III.G.4.3.2b). However, according to **T 407/15**, the balance of probabilities was the standard to be applied. See, however, in this chapter II.D.2.4.3.

c) Suitable evidence of valid transfer, formal requirements

In **T 205/14** the board disagreed with the reasoning of the board in **T 62/05** that the transfer had to be proven in a formal way, applying an equally high standard of proof as that required by Art. 72 EPC 1973. Art. 72 EPC 1973 set out formal requirements for a valid assignment of a European patent application and thereby limited the means of giving or obtaining evidence for determining such a transfer. No reason was apparent for applying it by analogy in the context of a transfer of the priority right preceding a subsequent filing. To do so in view of a subsequent European patent application would, in the case of a European first filing, ignore the fact that the priority right is a right independent of the right to the first application and, in the case of a non-European first filing, that Art. 72 EPC 1973 does not govern the relationship between the applicant of a European patent application and a different applicant of a distinct first application. The board came to the same conclusion as the German Federal Supreme Court in its decision of 16 April 2013 that Art. 87 EPC does not require a formal and separate assignment as provided by Art. 72 EPC. See also in this chapter II.D.2.3.

In **T 493/06** it was held that the respondents had provided sufficient proof of the assignment of priority rights. In the board's view, even a copy of an assignment agreement could be sufficient provided that evidence was supplied that the content of the copy was identical to that of the original document.

According to the board in **T 1103/15**, if a party made statements about conclusions to be drawn on the basis of the applicable national law, it had to file suitable evidence, for example by filing as documents adequate copies of such laws and/or as appropriate by filing as expert evidence the opinions of a suitably qualified lawyer in the relevant jurisdiction (**T 74/00**).

2.7.4 Timing of transfer

Concerning succession in title to the right of priority, according to **T 1201/14**, it was clear from the wording of Art. 87(1) EPC 1973 alone that this must have already taken place when the subsequent application is filed. The board in **T 577/11** had already held that a succession in title that occurred after the filing date of the subsequent application was not sufficient to comply with the requirements of Art. 87(1) EPC 1973. The board in **T 1201/14** took the view that, even if a retroactive transfer such as the "nunc pro tunc" assignment under US law invoked by the appellant was allowable under US law, it would not be acceptable under Art. 87(1) EPC 1973.

In **T 1946/21** the board observed that the case law had not been settled on the question of whether the transfer agreement must have been concluded (**T 577/11**), and thus the assignment must have been effective, **before the filing date of the subsequent application** or whether it was sufficient for this to have been done **on the same day but before the actual filing**. The board was not aware of any case before the boards where this question was decisive. Therefore, any reference in the case law to "before the filing" or "before the date of filing" was irrelevant (see e.g. **T 1201/14**). The board concluded that it was sufficient for the applicant or patent proprietor to demonstrate that the assignment of the priority right was effective before the subsequent application was filed. The law did not set forth any other condition. In particular, the assignment need not be effective before the filing date of the subsequent application.

See, however, in this chapter II.D.2.3.

3. Applications giving rise to a right of priority

3.1. Application filed in or for a state which is a party to the Paris Convention or a member of the WTO

Under the EPC 2000 Art. 87(1) EPC was amended to align it with Art. 2 TRIPS, which requires that priority rights also be extended to first filings made in or for any member of the WTO (OJ SE 4/2007, 88). The revised provision governs applications filed on or after 13 December 2007.

Previously, in **G 2/02** and **G 3/02** (OJ 2004, 483) the Enlarged Board decided that the obligations deriving from TRIPS did not bind the EPO directly and did not therefore entitle the applicant for a European patent to claim priority from a first filing in a state which at the relevant dates was not a member of the Paris Convention but was a member of the WTO/TRIPS.

3.2. National deposit of industrial design

In **J 15/80** (OJ 1981, 213) it was held that a priority right based on the deposit of an industrial design was not recognised for a European patent application. As the EPC was a special agreement within the meaning of Art. 19 Paris Convention, a general understanding by the EPC contracting states that the deposit of an industrial design clearly gave a priority right for a national patent application could, by application of Art. 4 Paris Convention, lead to an interpretation of Art. 87(1) EPC 1973 going beyond its terms. However, in the absence of such a general understanding there was no reason to read Art. 87(1) EPC 1973 more broadly than its express terms and scope required. In the board's opinion, a right of priority under the Paris Convention existed if the prior application was for the protection of an invention as such and contained a disclosure of it. The deposit of an industrial design in essence protected aesthetic appearance. Although the deposited design might incorporate an invention, according to national design laws the deposit would not protect the invention as such.

3.3. Exhibition priority

In **T 382/07** it was held that an exhibition priority could not be validly claimed for a European application or patent. The board stated that the possibility of recognising exhibition priorities internationally followed from Art. 11 Paris Convention. Its provisions allowed Paris Union member countries to recognise exhibition priorities in their domestic law under certain conditions but did not oblige them to do so. Entitlement to claim an exhibition priority was to be decided on the basis of the national law of the country where protection and priority were claimed, i.e. for a European application or patent the EPC, and not the law of the country where the exhibition took place or a first application claiming the exhibition priority was filed. Since the EPC did not recognise exhibition priorities, any priority claim based on an invention disclosure at an exhibition must fail in the case in hand.

3.4. Postdating of the previous application

Swiss patent law formerly allowed a patent application to be postdated if it was subsequently amended. In **T 132/90** the patent proprietor had claimed 11 March 1983, the original filing date of the earlier Swiss application, as the priority date for his European application dated 9 March 1984. In 1985 the Swiss Patent Office ordered that the filing date of the Swiss patent application be set at 1 July 1983 following subsequent completion of the technical documentation. The board concluded that the original application should serve as the basis for claiming a priority right and that the priority date was the filing date of the original application. The postdating order did not take effect ab initio, and the subsequent fate of the original application was immaterial as far as the priority date was concerned.

3.5. Multiple exercise of the right of priority for one contracting state

According to the board in **T 998/99** (OJ 2005, 229), Art. 87(1) EPC 1973 made no provision for multiple filings in the same country within the priority period for the same

subject-matter and hence the same invention on the basis of the same priority document. However, in subsequent decisions this strict approach was rejected.

Thus, in **T 15/01** (OJ 2006, 153) the board pointed out that, with respect to the issue of exhaustion of priority, the wording of Art. 87(1) EPC 1973 appeared to be open to different interpretations. Since the EPC constituted a special agreement within the meaning of Art. 19 of the Paris Convention, this provision was not intended to contravene the basic priority principles of this Convention. The Paris Convention in its present version explicitly recognised the possibility of claiming multiple and partial priorities and guaranteed the right to divide patent applications while preserving the benefit of the right of priority for the divisional application as well (principles also recognised in Art. 76(1), second sentence; 88(2) and (3) EPC 1973). The board considered that the priority provisions of the Paris Convention had to be construed in a manner which ensured that the general purpose they served, namely to assist the applicant in obtaining international protection for its invention, was fulfilled as far as possible. The board also examined the circumstances under which the issue of exhaustion might arise (splitting up of the subject-matter of the priority application to avoid non-unity objections; filing of a deficient subsequent application and remedying it by means of a second filing; combination of the originally disclosed subject-matter with further improvements and additional embodiments developed during the priority period) and analysed the interests involved. It concluded that the same priority right might be validly claimed in more than one European patent application; there was no exhaustion of priority rights. In **T 5/05** the board again confirmed that neither the EPC nor the Paris Convention contained any indication that the right of priority constituted an exception which had to be interpreted narrowly and thus allowed the right of priority to be exercised only once for one contracting state. These decisions were followed in **T 1562/06**.

4. Identity of invention

In accordance with Art. 87 EPC a European patent application is only entitled to priority in respect of "the same invention" as was disclosed in the previous application. See also Art. 88(2) to (4) EPC.

4.1. G 2/98 – interpretation of "the same invention"

In **G 2/98** (OJ 2001, 413) the Enlarged Board, ruling on points of law referred by the EPO President regarding the interpretation of Art. 87(1) EPC 1973, addressed the concept of "the same invention" in this provision. It first considered whether interpreting "the same invention" narrowly was consistent with the relevant Paris Convention and EPC 1973 provisions. A narrow interpretation meant that the subject-matter of a claim which defined the invention in a European patent application – i.e. the specific combination of features in that claim – had to be at least implicitly disclosed in the application whose priority was claimed. The Enlarged Board held that a broad interpretation, distinguishing between those technical features which related to the function and effect of the invention and those which did not – with the result that an invention could still be considered "the same" even if a feature were amended, deleted or added – was inappropriate and prejudicial to a proper exercise of priority rights. To ensure a practice fully consistent, inter alia, with equal treatment for applicants and third parties, legal certainty and the principles for assessing

novelty and inventive step, "the same invention" had to be interpreted narrowly and in a manner equating it to "the same subject-matter" in Art. 87(4) EPC 1973. This interpretation was underpinned by the Paris Convention and the EPC 1973, and was entirely consistent with opinion **G 3/93** (OJ 1995, 18).

The Enlarged Board therefore ruled that the requirement for claiming priority of "the same invention", referred to in Art. 87(1) EPC 1973, means that priority of a previous application in respect of a claim in a European patent application in accordance with Art. 88 EPC 1973 is to be acknowledged only if the skilled person can derive the subject-matter of the claim **directly and unambiguously**, using common general knowledge, from the previous application as a whole. The subject-matter of the claim defining the invention in the European application has to be understood as "the specific combination of features present in the claim".

4.2. Disclosure as the basis for the right to priority under Article 87(1) EPC

4.2.1 Generally interpreted in the same way as for Article 123(2) EPC

It may be noted that following **G 2/98** (OJ 2001, 413) the older case law which devised the "**disclosure test**" still applies (see e.g. **T 184/84**, **T 81/87**, OJ 1990, 250, **T 469/92**, **T 269/93**, **T 77/97**). In **T 311/93** and **T 77/97** in particular, the boards applied the criterion of at least implicit disclosure used for the disclosure test under Art. 123(2) EPC 1973. On the other hand, **G 2/98** rejected the approach taken in **T 73/88** ("Snackfood", OJ 1992, 557; see also e.g. **T 16/87**, OJ 1992, 212; **T 582/91**; **T 255/91**, OJ 1993, 318; **T 669/93**; **T 1056/93** and **T 364/95**), according to which adding non-essential and merely scope-limiting features did not invalidate a priority claim; see also CLB, 3rd edn. 1998, p. 228 et seq. and 235 et seq.). The non-applicability of the "essentiality criterion" following **G 2/98** was confirmed in e.g. **T 250/12**, **T 1852/13** (with further references) and **T 2466/13**. See also **T 134/94** rejecting the application of the "novelty test".

As was stated in **G 2/98**, the extent of the right to priority is determined by, and at the same time limited to, what is disclosed in the priority application. Applying **G 2/98**, the board in **T 923/00** found that the application as filed and the priority document were in essence identical. It emphasised that any conclusion in favour of or against the amendments' allowability under Art. 123(2) EPC 1973 would also apply in favour of or against entitlement to the claimed priority, and dealt with both issues jointly.

In its subsequent "disclaimer" decisions **G 1/03** and **G 2/03** (OJ 2004, 413 and 448), the Enlarged Board held that in order to avoid any inconsistencies, the disclosure as the basis for the right to priority under Art. 87(1) EPC 1973 and as the basis for amendments in an application under Art. 123(2) EPC 1973 has to be interpreted in the same way. That meant that a disclaimer, not providing a technical contribution as outlined, which was allowable during the prosecution of a European patent application does not change the identity of the invention within the meaning of Art. 87(1) EPC 1973. Therefore, its introduction is allowable also when drafting and filing the European patent application without affecting the right to priority from the first application, which does not contain the disclaimer (see also **T 175/03** and **T 910/03**). The Enlarged Board reaffirmed the importance of

applying a uniform concept of disclosure in its further "disclaimer" decisions **G 2/10** (OJ 2012, 376) and **G 1/16** (OJ 2018, A70) – see. "gold standard" disclosure test. See also **T 437/14** of 12 March 2019, reported in this chapter II.D.6.3.3, **T 600/16** and **T 1303/18**.

For the application of the disclosure test in the context of Art. 123(2) EPC, see chapter II.E. "Amendments".

4.2.2 Qualification for partial priority – G 1/15

The following qualification was made in **T 282/12**, a case which concerned "partial priority" (see also **G 1/15**, OJ 2017, A82): assessing priority by performing a test under Art. 123(2) EPC could lead to wrong conclusions in certain circumstances because the concept of "partial" validity of an amendment does not exist, whereas "partial priority" does (see also fuller summaries in chapters II.D.5.1. and II.D.6.3.3 below). See also **G 1/15** in this chapter II.D.6.3.2.

4.3. Disclosure in the previous application as a whole

G 2/98 (OJ 2001, 413) stated that pursuant to Art. 4H Paris Convention, priority may not be refused on the ground that certain elements of the invention for which priority is claimed do not appear among the claims formulated in the application whose priority is claimed, provided that the application **as a whole** specifically discloses such elements. Priority for a claim is to be acknowledged if the subject-matter of the claim is specifically disclosed, be it **explicitly or implicitly**, in the application documents relating to the disclosure, in particular, in the form of a claim or of an embodiment or example specified in the description of the application whose priority is claimed. Art. 88(4) EPC corresponds almost literally to Art. 4H Paris Convention.

In earlier decisions it was likewise held that, under Art. 88(4) EPC, it suffices if the features claimed in the later application are disclosed by the earlier application taken as a whole (**T 184/84**, **T 497/91** and **T 359/92**).

If the priority document does not include any claims, this does not mean that the conditions of Art. 88(4) EPC are not fulfilled; Art. 88(4) EPC cannot be construed as meaning that a priority document must comprise claims in order to form a regular national filing within the meaning of Art. 87(3) EPC which can give rise to a right of priority (**T 469/92**). While in such a case it could be more difficult to establish whether the priority document discloses the same invention, the principles of **G 2/98** equally apply (**T 1437/10**). See also e.g. **T 525/13**, in which the right of priority claimed from a US provisional application was held invalid.

T 409/90 (OJ 1993, 40) showed that a broad claim in the previous application was not necessarily a suitable basis for a priority right. When considering what was disclosed in a priority document's claim it was necessary to bear in mind the purpose of the claim, i.e. to define the protection sought. The fact that a claim in a priority document was broad enough to cover specific subject-matter filed for the first time in a later application was not by itself sufficient evidence that such subsequently filed subject-matter had already been disclosed

in the priority document, or that subsequent claims based on the later-filed subject-matter still defined the same invention as that which was the subject of the priority document (see also **T 77/97**, summarised in chapter II.D.4.8 below).

In **T 515/00** the appellant had argued that features pertaining to hardware components relating to the printing process were no longer present in the claim and that there was no basis in the priority document for the deletion of these features. The board referred to **G 2/98** (OJ 2001, 413, point 8.3 of the Reasons), in which the Enlarged Board had warned against an approach whereby a distinction was made between technical features which were related to the function and the effect of the invention and technical features which were not. Priority could not be acknowledged if a feature was modified or deleted, or a further feature was added. The board further noted that a claim passed the priority test if its subject-matter could be derived from the previous application as a whole. It followed that comparing the claim with the corresponding claim of the previous application was not a valid approach to performing the "priority test". The priority test was basically a disclosure test in which the skilled reader could use common general knowledge. If, in the description of the previous application, a distinction was made between features that were essential for the performance of the invention and features which were not, the latter could be deleted from the subject-matter of a claim without losing the right to priority. The omitted hardware components were nowhere presented as essential features in the priority document's description. The skilled reader would not have any reason to assume that they were essential merely because they were present in claim 1 of the priority document. The board concluded that the priority claimed was valid. This decision was followed in **T 321/06**.

Features of the invention may also be disclosed in the drawings (**T 169/83**, OJ 1985, 193; **T 837/13**; also **T 1434/13**, in which the drawings of the priority document were found not to show all the alternatives of claim 1).

In **T 449/04** the board emphasised that the "same invention" considered in Art. 87(1) EPC 1973 did not encompass the comparative example(s) which were clearly and definitely **excluded** from the scope of the invention in an earlier application of the applicant (see also fuller summary in this chapter II.D.5.1.).

4.4. Reference to common general knowledge

The priority of a previous application in respect of a claim in a European patent application in accordance with Art. 88 EPC is to be acknowledged only if the skilled person can derive the subject-matter of the claim directly and unambiguously, using **common general knowledge**, from the previous application as a whole (**G 2/98**, OJ 2001, 413).

According to earlier decision **T 136/95** (OJ 1998, 198), a patent application is a technical document, addressed to the skilled person, not a work intended for the general reader. However, the skilled person is not familiar, unlike in the assessment of inventive step, with all the prior art, but only with those elements of it which form part of his general knowledge, and it is on the basis of this knowledge, or by carrying out simple operations derived from it, that he may infer whether or not there is identity of invention. In the case in question a

structural feature claimed in the European application was supported by a **general functional feature** described in the prior application.

Applying **G 2/98** (OJ 2001, 413), the board in **T 744/99** held that the application of common general knowledge could only serve to interpret the meaning of a technical disclosure and place it in context; it could **not** be used to **complete** an otherwise incomplete technical disclosure. In the case in hand, since the priority document only disclosed a new signal protocol without any disclosure of a suitable receiver, claim 8 of the subsequent application, which was directed to such a receiver, was not entitled to the claimed priority date.

In **T 1312/08** the patent proprietor had submitted that the definition of "PU" was correct in the patent in suit but erroneous in the priority document. The board, referring to the established jurisprudence, stated that the reworking of an example and especially of a method which was not a standardised one and was not reported in encyclopaedias, textbooks, dictionaries and handbooks could not be considered to be the application of common general knowledge. The mere fact that it was necessary to carry out a test, which was not part of common general knowledge, in order to find out whether the definition of PU in the priority document was erroneous made it clear that the different definition of PU used in the patent in suit was not derivable directly and unambiguously, using common general knowledge, from the whole content of the priority document. See also **T 1579/08**.

4.5. Explicit or implicit disclosure in the priority document of the features of the invention

In **G 2/98** (OJ 2001, 413) the Enlarged Board stated that priority for a claim, i.e. an "element of the invention" within the meaning of Art. 4H Paris Convention, is to be acknowledged if the subject-matter of the claim is specifically disclosed, be it **explicitly or implicitly**, in the application documents relating to the disclosure, and priority can be refused if there is no such disclosure.

Already in decision **T 81/87** (OJ 1990, 250), it had been held that, although no identical wording was required, the disclosure of the essential elements, i.e. features of the invention, in the priority document, must either be express, or be directly and unambiguously implied by the text as filed (see also fuller summary of **T 81/87** in chapter II.D.4.6. below; see also **T 184/84**). **T 81/87** has been followed in numerous decisions, both before and after **G 2/98** (e.g. **T 301/87**, OJ 1990, 335; **T 296/93**, **T 479/97**, **T 342/98**).

4.5.1 Example cases – features of the invention all disclosed in the priority document

In **T 289/00** the contested feature of claim 1 was that a channel was enclosed on all sides. The board accepted that the reference in the priority application to the channel as "filled with air" did not in itself mean that it was enclosed. However, the reference had to be seen together with the other information on this matter which the skilled person would derive from the application (see Art. 88(4) EPC 1973). A skilled person considering the priority

application documents as a whole would conclude, without further information, that the channel would be enclosed on all sides.

The patent at issue in **T 578/08** contained only device claims, whereas the previous application contained only process claims (the description and the drawings being largely identical). However, the board found that the wording of the previous application's claim 1 already presupposed structural device components in addition to specifying process steps that could only be performed by suitable – and so structural – technical means. General technical means suitable for performing the specified functions were therefore implicitly disclosed. Besides, the previous application repeatedly explained that the process described and claimed was performed automatically, which likewise called for suitable technical means. Priority was thus validly claimed.

4.5.2 Example cases – features of the invention not all disclosed in the priority document

In **T 1052/93** it was a feature of the wash adjunct products claimed in the European patent that they contained sodium perborate monohydrate in conjunction with a **functionally defined activator**. The priority document only mentioned certain activators complying with the functional definition in the European patent; these specific compounds could not be considered to disclose the broad group of activators functionally defined in claim 1 of the European patent. See also **T 132/09**.

In **T 277/95** the board found that a claim to a method of producing in CHO cells hEPO characterised by the presence of a specific **glycosilation pattern** did not enjoy priority from a priority application which made available the cell line but gave no information on the specific glycosilation pattern. See also **T 479/97**.

In **T 908/09** the board concluded that the priority document did not clearly allocate to one single group the classes of substances which were named in granted claim 1 as components b). Accordingly, the skilled person could not derive directly and unambiguously from the priority document a mixture of at least one substance a) with at least one substance b), as was required by claim 1.

See also **T 379/13** and **T 1487/16**.

In **T 521/10** the enabling disclosure for the embodiment of claim 1 relied on the content of patent applications incorporated by reference. The reference to one of these (D9) was not present in the priority document. Indeed, D9 was not filed until after the claimed priority date. Therefore, as far as the subject-matter of claim 1 was based on the disclosure of D9, the priority was not validly claimed. As D9 was published before the filing date, it was pertinent prior art. See also summary of this decision in chapter II.C.4.2.

In **T 846/10** the US priority application P1 claimed (on Form PTO/SB/01 (12-97)) the benefit under 35 U.S.C. 119(e) of two provisional applications P2 and P3. The board rejected the appellant's claim that their contents were for this reason to be considered incorporated by reference into the disclosure of P1; P1 itself contained no mention of "incorporated by reference" or any equivalent expression.

4.6. Enabling disclosure in the priority document

The decisions below highlight that the priority document must disclose the invention claimed in the subsequent application in such a way that it can be carried out by a person skilled in the art.

In **T 81/87** (OJ 1990, 250) the board took the view that the argument that the skilled person would supplement the disclosure from his common general knowledge to make it work, should any difficulty be encountered, was no excuse when this was a feature of the definition of the invention, and was missing, not envisaged by the inventor and not implied by the description. In order to give rise to priority rights the essential elements, i.e. the features of the invention, in the priority document had to be either expressly disclosed or directly and unambiguously implied in the text as filed; missing elements recognised as essential only later on were not part of the disclosure, and gaps with regard to basic constituents could not be retrospectively filled by relying on knowledge acquired in this manner. It could become a misuse of the priority system if some parties in a competitive situation were allowed to jump ahead of others on the basis of mere expectations and by omitting the critical features of the invention altogether. This decision was followed in e.g. **T 301/87**, OJ 1990, 335, and in **T 296/93**, OJ 1995, 627.

The board in **T 301/87** (OJ 1990, 335) considered that if an entity itself is disclosed to the skilled person, this does not necessarily mean that a component part is also disclosed for the purpose of priority if this cannot be envisaged directly and unambiguously as such, and requires considerable investigation to reveal its identity.

In **T 296/93** (OJ 1995, 627) the board was not convinced by the respondent's (opponent's) argument that the priority document was deficient in respect of relevant technical information necessary for reducing the claimed invention to practice by the person skilled in the art without undue burden. See also **T 207/94** (OJ 1999, 273), **T 767/93**, **T 20/04**.

In **T 919/93** the board found that certain passages in the European application as filed, essential for the application to meet the requirements of Art. 83 EPC 1973, had no counterpart in the priority document, which was thus not enabling for the claimed subject-matter.

In **T 843/03** the board referred to the requirement that the priority document provide an enabling disclosure (**T 81/87**, OJ 1990, 250; **T 193/95**). It had been established in a number of boards of appeal decisions that sufficiency of disclosure presupposes that the skilled person is able to obtain substantially all embodiments falling within the ambit of the claims and that the skilled person, in order to reach this goal, may not be confronted with an undue burden. Based on previous case law on the requirement of Art. 83 EPC 1973 (**T 19/90**, OJ 1990, 476) and on the novelty requirement (**T 464/94**) the board concluded that, when an applicant provided a technical disclosure and **prima facie evidence** as to certain technical elements in an application, **it was the EPO which had the burden of proof** when judging that something was not shown. The board held that the examining division had not taken the legally appropriate approach when deciding to the disadvantage of the applicant with the reason that "[…] no absolute fact can be deduced from figure 7

as to whether it shows correctly formed HPV 16 particles or not". The board did not see full proof of such facts as a requirement within the framework of the EPC and could not see any serious doubts of the examining division substantiated by verifiable facts.

In **T 903/05** the board considered that the claimed selection, made from only one list of entities, was directly and unambiguously derivable from the priority document in the sense of **G 2/98**. Since the enablement of the disclosure of this document had explicitly not been challenged, the board saw no reason to doubt it. Beyond the issue of enablement, the board saw no legal basis for imposing additional criteria such as the presence of experimental data in the priority document (see also **T 1834/09**). In **T 411/19**, however, concerning claim 1, which was directed to a second medical use, the board found that the priority document P1 contained no experimental data or other evidence of any kind that went beyond a mere allegation that the peptides defined therein were indeed suitable for the treatment of the disorders listed. It could therefore not be concluded that P1 provided even an initial plausibility that the claimed compounds were suitable for treating the disorders in question. Thus, P1 did not disclose the invention of claim 1 in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art. For case law on Art. 83 EPC following **G 2/21** (OJ 2023, A85), see chapter II.C.7.2. The Enlarged Board departed from the concept of "plausibility".

According to the board in **T 107/09**, the antibody MR1 was indispensable in order to reproduce the invention of claim 1. The "written" disclosure in the earlier US application from which priority was claimed, even if supplemented by common general knowledge, would not enable the skilled person to carry out the invention. The hybridoma cell line producing the antibody MR1 had been deposited with the American Type Culture Collection (ATCC) only after the filing date of the earlier application. In view of the absence of explicit provisions in the EPC as to when a deposit of biological material had to be made in relation to an earlier application (R. 28 EPC 1973 being concerned with European applications), the board referred in particular to decision **G 1/03**, according to which the requirement of sufficiency of disclosure had to be complied with – in relation to an earlier application from which priority was claimed – at the date of filing of that application. Thus, the board reasoned, if the deposit of biological material was necessary for the requirement of sufficiency of disclosure to be fulfilled for a "priority application", the deposit of this material had to have been made no later than the date of filing of that earlier application. This was not the case here.

4.7. Error margins and definitions of limits

Prior to **G 2/98** (OJ 2001, 413), it was sometimes possible to claim error margins or definitions of limits which differed in the subsequent application from the original one (see **T 212/88**, OJ 1992, 28, **T 957/91**, **T 65/92**, **T 131/92** and CLB, 3rd edn. 1998, p. 231 et seq.). Since the facts are only comparable up to a certain point, it is not possible to say unequivocally to what extent the principles laid down earlier still apply. In the decisions below, **G 2/98** was applied.

In **T 201/99** claim 1 referred to a **mean residence time** of "1-10 minutes", whereas both priority applications disclosed the range "from about 1-6 minutes" (claim 1) or, for all the

examples, a specific residence time of "about 3 minutes". The board found that the features disclosed in the priority applications provided no explicit or implicit disclosure of a process wherein the second step lasted "10 minutes". Therefore, it was apparent that they were insufficient to render directly and unambiguously disclosed therein also the whole range of "1-10 minutes". The board did not accept the appellant's argument that the upper limit of "6 minutes" for the time length of the second step was not disclosed in the priorities as a cut-off value (i.e. as possibly related to the function of the invention and its effect) and thus constituted a feature which might be modified without changing the nature of the invention.

In **T 250/02** the board found that the subject-matter of a claim for a herbal essential oil in which the total amount of carvacrol and thymol was at least 55%, and preferably 70%, by weight of the said essential oil and with exact ratios of carvacrol to thymol could not be derived directly and unambiguously from a priority document only disclosing a herbal oil containing "thymol and carvacrol in levels of 55% to 65%".

Further decisions concerned with differing ranges indicated in a priority document and disputed sets of claims include **T 903/97**, **T 909/97**, **T 13/00**, **T 136/01**, **T 423/01**, **T 788/01**, **T 494/03** **T 537/03** and **T 2930/19**.

4.8. Selection from generic disclosure

A generic disclosure implicitly encompassing two or more alternative embodiments cannot generally give rise to a right of priority in respect of one specific embodiment that is **neither explicitly nor implicitly** disclosed (**T 61/85**; also **T 30/01** below).

In **T 85/87** the priority document disclosed a generic chemical formula, while a dependent claim of the application in suit was directed to a specific compound. Applying the principles which it had previously developed with respect to the novelty of specific (individual) chemical compounds over a generic disclosure of a group of compounds, the board concluded that the specific compound was not disclosed in the priority document. Therefore, the subject-matter of the dependent claim was not entitled to priority and, as a result, was anticipated by the disclosure of the same specific compound in another European patent application within the meaning of Art. 54(3) EPC.

According to the board in **T 77/97**, a chemical compound according to a dependent claim in a European patent application could not be granted priority simply because it fell within the scope of the claims in the priority document, and so was covered by its disclosure, and could be readily prepared on the basis of the information provided there (see **T 409/90**, OJ 1993, 40). Art. 88(4) EPC required, moreover, that the elements for which priority was claimed, i.e. all the features essential for defining the chemical compound, including those distinguishing it from the generic group disclosed and claimed in the priority document, be specifically disclosed in that document. In the case in hand, the board found that each of the compounds according to claims 4 and 5 were part of the "purely conceptual content" of the priority document's claim 3 but not part of its actual teaching. That meant they could not be regarded as "specifically disclosed" by this document, and so the two claims could not be granted the claimed priority. See also **T 295/87** (OJ 1990, 470).

T 30/01 concerned an apparatus for optical imaging and measurement. The board noted that the description of the priority document unmistakably indicated the provision of the light steering means "in the sample arm". This precise disclosure deprived of support the appellant's construction of the disclosure as implicitly disclosing the provision of the light steering means in and outside the probe as two complementary alternative implementations – let alone as disclosing any specific one of these two alternatives by way of "implicit disclosure" by reference to common general knowledge (**T 823/96**, **T 744/99** and **T 818/00**). According to the criterion consistently applied by the boards of appeal, a generic disclosure **implicitly encompassing two or more alternative embodiments** can generally not give rise to a right of priority in respect of a **specific one of the embodiments** that is neither explicitly nor implicitly disclosed (**T 61/85**) the latter criterion being a particular form of the "disclosure test" laid down in **G 2/98** (OJ 2001, 413) and constituting the logical corollary of the established principle – confirmed in **G 2/98** (see also **T 744/99**) – that no right to priority can be acknowledged for an invention that is regarded as novel over the disclosure of the corresponding priority document.

Subsequent decisions **T 788/01**, **T 899/04**, **T 70/05** and **T 971/08** also applied the principle that a generic disclosure cannot provide priority for a specific embodiment not disclosed in the priority document.

4.9. Inventions relating to nucleotide and amino acid sequences

In **T 923/92** (OJ 1996, 564) claim 1, the subject-matter of which was defined by means of a reference to the amino acid sequence of Figure 5, was held not to be entitled to priority from earlier applications P1 and P2, in which that amino acid sequence was not disclosed. The sequence reported in Figure 5 was observed to differ from that of Figure 5 of P1 and P2 in respect of three amino acids. In the board's judgment, the skilled person would consider the reference to the amino acid sequence of a protein as a primary technical feature linked to the character and nature of the product. Evidence from the patentee was restricted to the testing of a limited number of parameters and constituted at most proof of similarity, not of identity of the two polypeptides. These differed in one essential characteristic, i.e. the primary amino acid sequence.

In **T 351/01** a polynucleotide which was the subject-matter of claim 1 was characterised both in structural terms and by its function. Priority documents I and II disclosed a polynucleotide having the same function as that of the polynucleotide of claim 1. However, its structure differed from that of the polynucleotide of claim 1 by five bases, all found in the part of the sequence which does not relate to the function i.e. outside of the coding region. The board, referring to the Enlarged Board's opinion **G 2/98** (OJ 2001, 413), which had rejected an extensive or broad interpretation making a distinction between technical features which are related to the function and effect of the invention and technical features which are not, concluded that the subject-matter of claim 1 could not be seen as the same subject-matter as that disclosed in the priority documents. See also decision **T 1213/05**.

In **T 30/02** the board held that the presence of two additional guanine residues in the nucleotide sequence disclosed in an application cited in this case under Art. 54(3) EPC 1973 resulted in a different molecule that was not directly and

unambiguously derivable from the earlier application from which priority was claimed. It was generally acknowledged in the case law of the boards of appeal that the nucleotide sequence of a nucleic acid represents an essential feature linked to the character and nature of the nucleic acid as such, and, where the nucleotide sequence is a coding sequence, also of the encoded protein (see **T 923/92**, OJ 1996, 564). The skilled person was aware of the fact that even a minimal modification of the nucleotide sequence may result in a different nucleic acid not only from the structural but also from the functional point of view. See also decision **T 70/05**.

In **T 250/06**, claim 1 of the second auxiliary request related to recombinant DNA molecules comprising a nucleotide sequence encoding a murine delta opioid receptor (DOR), characterised as hybridising under conditions of low stringency to the DNA sequence shown in Figure 5. Appellant II pointed out that Figure 5 of the priority document differed by the addition of seven interspersed bases in the 3' untranslated region. The board indicated that conditions of low stringency were developed for screening molecules which differ somewhat from the probe. It was fully expected that the group of molecules obtained by hybridisation to the DNA of Figure 5 of the priority document and of the patent in suit respectively would not be different.

5. First application in respect of the invention

In principle, only the first application filed in a state party to the Paris Convention or a member of the WTO can form the basis of a priority right. In the EPC this is made clear in Art. 87(1) and (4) EPC.

Therefore, if apart from the application whose priority is being claimed in the subsequent European application, an earlier previous application was also filed, in order to check the validity of the priority claim it must be established whether the invention claimed in the subsequent application was already disclosed in the earlier previous application – see in this chapter II.D.5.1. Decisions also focusing on the identity of the applicants are dealt with in this chapter II.D.5.2. Decisions concerning withdrawal of a previous first application are covered in this chapter II.D.5.3.

5.1. Identity of invention

To establish whether the invention claimed in the subsequent European application was already disclosed in the earlier previous application, the same principles have to be applied as when establishing identity of invention between the application forming the basis of priority and the application claiming priority. The question is whether the person skilled in the art could derive the subject-matter of the claim of the subsequent application directly and unambiguously, using common general knowledge, from the earlier previous application or only from the later one (see **G 2/98**, OJ 2001, 413). The principles set out in **G 1/15** (OJ 2017, A82) likewise apply (see **T 282/12** summarised below).

In **T 323/90** the board concluded that the alleged first application disclosed a different invention from that in the European application and the application from which priority had been claimed: the **claimed process** (for increasing the filling power of tobacco lamina

filler) **differed** as regards both the moisture content of the tobacco for processing and the first step in the process.

In **T 400/90** priority had been claimed from a US application in respect of a European application concerning an electromagnetic flowmeter. According to the opponents, an earlier US application filed by the same applicant outside the priority period disclosed all the features contained in the European application with the exception of the use of saddle-shaped coils; however, the latter were already known and used frequently. In the board's opinion, the question to be answered was **whether the use** of saddle-shaped coils **had been disclosed** in the earlier US application, and **not whether it was obvious** to use such coils in place of the magnets disclosed in the earlier application. The board concluded that the inventions claimed in the US applications were different and priority had rightly been claimed from the later application because, according to the teaching of the earlier application, coils of any shape could be used, whereas according to the teaching of the priority document saddle-shaped coils had to be used.

In **T 184/84** the Japanese application from which priority was claimed in the European patent application but also an earlier Japanese application claimed a method of producing a single crystal of ferrite. The starting materials were defined differently in the two Japanese applications. The method disclosed in the later application and the European application was clearly more advantageous than that forming the subject-matter of the earlier one. The board held that the **significant differences in properties** were indicative of the presence of different materials and therefore found that the earlier Japanese application was not the first filing of the invention claimed in the European patent application. It based its finding on **T 205/83** (OJ 1985, 363), which stated that the novelty of products prepared using a modified process could be established by the fact that according to an empirical principle in chemistry, a product's properties were determined by its structure, so that differences in the properties of products indicated a **structural modification**.

The subject-matter of the patent in case **T 107/96** contained the feature "angle of contact greater than 120°", which feature was disclosed in P2, the later of two previous US applications. In P2 a particular advantageous effect was also attributed to the large extent of the said "angle of contact". The earlier previous US application P1 was totally silent about the aforementioned feature "angle of contact" and its advantageous effect. However, the figures of P1 represented diagrammatic and schematic drawings. The board concluded that therefore, and in line with the established jurisprudence of the boards of appeal, they could not serve as a basis for determining the extent of a minimum "angle of contact" because dimensions obtained merely by measuring a **diagrammatic representation** of a document did not form part of the disclosure. Hence, the said feature "angle of contact greater than 120 ", was not disclosed in P1 but only in P2.

In **T 449/04** the board referred to the Enlarged Board's narrow or strict interpretation in **G 2/98** (OJ 2001, 413) of the concept of the "same invention" in Art. 87(1) EPC 1973 and concluded that the invention disclosed in the applicant's earlier application D1 was not the "same invention" as that disclosed in the priority application PR. With regard to a **comparative example** in D1, the composition of which fell within the elemental ranges

claimed in the application in suit as well as in application PR, the board emphasised that the "same invention" considered in Art. 87(1) EPC 1973 did not encompass the comparative example(s), which were clearly and definitely **excluded** from the scope of the invention in D1. Having regard to the strict and narrow interpretation of the term "the same invention", this term was focused on what constituted the elements of the invention.

In **T 1222/11** claim 1 had been amended to include six disclaimers for the purpose of restoring novelty over D4b, an earlier international (Euro-PCT) application of the same applicant, which had been published within the priority interval. The board found that the combination of features defined in positive terms in claim 1 (i.e. without any disclaimer) could not be distinguished from the disclosure of D4b and was not entitled to the claimed priority as far as it concerned the subject-matter already disclosed in D4b (Art. 87(1), (4) EPC). The compositions of D4b were therefore prior art under Art. 54(2) EPC. As the anticipatory disclosure of D4b was not an accidental anticipation (cf. **G 1/03**, OJ 2004, 413), the disclaimers based on it were not allowable under Art. 123(2) EPC. For further mention of this decision see chapter II.D.6.3.1. See also **T 88/21** in chapter II.D.6.3.3.

In **T 282/12** the board held that, for reasons of consistency, the rationale of decision **G 1/15** (OJ 2017, A82 – concept of **partial priority**) must also apply in the context of deciding whether an application from which priority is claimed is the first application within the meaning of Art. 87(1) EPC. Indeed, just as a priority application and a patent claiming priority therefrom may partially relate to the same invention, the priority application and an earlier application filed by the same applicant may also do so. In that case, the priority application would be the first application in respect of only that part of the invention which is not the same as in the earlier application. Here, the board found that the earlier application filed by the applicant disclosed a range which was encompassed within the range of the priority document. Therefore, for that sub-range the priority document was not the first application. See also the summary of this decision and **T 88/21** in chapter II.D.6.3.3.

In **T 1662/14** document D2 was a Euro-PCT application claiming priority from D3, an application of the predecessor in title of the applicant of D2. D3 had the same technical content as D2 and was filed before the date of filing of the patent in suit (which claimed no priority). D11 was also an application of the predecessor in title of the applicant of D2 and had the same technical content as the original application from which the patent in suit was derived. D3 was a continuation-in-part of D11. Hence D11 had left some rights outstanding within the meaning of Art. 87(4) EPC. It followed that D11, and not D3, was the first application in respect of the invention which it disclosed, and D2 could not validly claim priority from D3 for that invention. However, D2 contained more specific elements, i.e. it disclosed a system comprising additional technical features not disclosed in D11. As a consequence, D11 was not the first application for the more specific system, and the priority claim of D2 was valid in respect of such a system, for which D3 was the first application. That specific system belonged to the state of the art according to Art. 54(3) EPC and anticipated the subject-matter of claim 1.

5.2. Identity of applicant

In **T 5/05** the board stressed that priority could be based only on earlier applications **filed by the applicant** of the European application or by the applicant's predecessor in title. Moreover, only such applications could meet the further requirement, derivable from Art. 87(4) EPC 1973, that an application giving rise to the priority right had to be the first application by the applicant or by the applicant's predecessor in title in respect of the invention. The **inventor was not relevant**. Applications filed by various applicants figured alongside one another as state of the art within the meaning of Art. 54(2) or (3) EPC 1973.

In **T 788/05** the proprietor had been co-applicant in a previous European application D1 with an earlier priority date than that of the patent in suit. The board held that the term "a person" in Art. 87(1) EPC 1973 (or "an applicant" in Art. 88(1) EPC 1973) implied that the applicant was the same for "the first application" (or "previous application" in Art. 88(1) EPC 1973) and for the later application for which a priority right was claimed. In the case of D1, the priority right belonged to the two applicants simultaneously, unless one decided to transfer the priority right to the other, who then became the transferor's successor in title and this before the filing of the later application. No evidence of such a transfer had been submitted. Since the application in issue was only filed by one applicant, D1 could not represent the "first application" within the meaning of Art. 87(1) EPC 1973. See also **T 2360/19** in this chapter II.D.2.6.

In **T 1933/12** the application underlying the patent was filed by the patent proprietors A1 and A2 and claimed the priority of D0, also filed by A1 and A2. Prior to D0, however, A2 had filed application D1, whose priority was not claimed but which undisputedly disclosed a gearbox drive in accordance with claim 1 in issue. The patent proprietors argued that D1 could not be considered the first application within the meaning of Art. 87 EPC. Since A2 was the sole applicant for D1 there was no identity of applicant with the patent in suit. The board disagreed. Art. 87(1) EPC did not exclude the (sole) applicant for the first filing sharing his priority right with a third party by filing a subsequent application jointly with the latter, but it did require that the applicant for the first filing, or that applicant's successor in title, be among the applicants for the subsequent, priority-claiming filing. In such a case, if there was only one additional applicant for the subsequent filing, there was no need to provide proof of the transfer of the priority right to that applicant. In the case at issue, sole applicant A2 for D1 was also one of the applicants for the application leading to the patent, so D1 was the first application (Art. 87(1) EPC). Identity of inventor was not relevant for Art. 87 EPC, which, for the purpose of claiming a right of priority, referred to the applicant (**T 5/05**). See also in this chapter II.D.2.5.

In **T 788/05** and **T 1933/12**, which precede **G 1/22** and **G 2/22** (see in this chapter II.D.2), the applicant(s) of the application in suit were **not claiming the priority** of the earlier application which the opponents argued was the "first application" (cf. cases in this chapter II.D.2).

5.3. Previous first application withdrawn

In **T 477/06** the board held first that since Euro-PCT application D8 had been **deemed withdrawn** due to non-payment of the designation fees (R. 23a EPC 1973), it was not prior art under Art. 54(3), (4) EPC 1973 for the application in suit. However, it had been filed by the same applicant and earlier than the priority application. In view of the fact that claimed subject-matter was anticipated by this earlier application, the priority application was not the first application within the terms of Art. 87(1) and (4) EPC 1973 (cf. Art. 8(2)(b) PCT), so that the priority claim was not valid. Hence, the application in suit enjoyed priority only from the date of filing and D8 was prior art under Art. 54(2) EPC 1973. See also **T 1222/11** in chapter II.D.5.1.

For the case of a priority held invalid because it was **not** shown, for the purpose of Art. 87(4) EPC 1973, that at the date of filing of the application from which priority was claimed, a previous first application filed by the applicant in respect of the same invention had been **withdrawn**, see **T 1056/01**.

6. Partial and multiple priorities

In cases where partial or multiple priorities can be validly claimed, the subject-matters of the subsequent application have two or more operative priority dates. In the case of a **partial priority** that part of the subsequent application's subject-matters disclosed in the previous application has the priority date of the previous application; for the remaining part the date of filing of the subsequent application applies. With **multiple priorities**, the priority of two or more previous applications is claimed. In this case, claims in the subsequent application have the priority date of the previous application in which the subject-matter subsequently claimed was disclosed (see also chapter II.D.6.2. below). Multiple priorities may be claimed for any one claim (Art. 88(2), second sentence, EPC), as long as several subject-matters are included (see also chapter II.D.6.3. below, and summary of **G 1/15**, OJ 2017, A82, in chapter II.D.6.3.2).

6.1. Publications during the priority interval – effect on elements of the European patent application not entitled to priority

As noted by the EPO President in the reasons for the referral in **G 3/93** (OJ 1995, 18), on the one hand, it frequently occurs that in subsequent filings new elements and information are added in respect of prior applications of the same applicant and, on the other hand, inventors are often eager to publish the results of their research as soon as possible.

In its ensuing opinion, the Enlarged Board stated that a document published during the priority interval, the technical contents of which correspond to that of the priority document, constitutes prior art citable under Art. 54(2) EPC 1973 against a European patent application claiming that priority, to the extent that such priority is not validly claimed. This also applies if a claim to priority is invalid due to the fact that the priority document and the subsequent European application do not concern the same invention because the European application claims subject-matter not disclosed in the priority document. The Enlarged Board emphasised that the existence of a right of priority depends, inter alia, on

the fulfilment of the requirement that the European patent application claiming the right of priority from an earlier application must be "in respect of the same invention" disclosed in the earlier application. Where priority is claimed but cannot be allowed because the essential condition precedent, that the inventions are the same, is not met, there is no right to priority. Consequently, any publication of the contents of a priority document during the priority interval constitutes prior art **citable against elements** of the European application which are **not entitled to priority**. See the example in **G 3/93**; see also e.g. **T 594/90**, **T 961/90**, as well as the discussion in **T 301/87**, OJ 1990, 335.

T 131/99 stressed that in this regard there is no difference between dependent and independent claims (see also **T 85/87**, and **T 127/92**, which is summarised in the next section).

6.2. Different priorities for different parts of a European patent application

According to Art. 88(3) EPC, if one or more priorities are claimed in respect of a European patent application, the right of priority shall cover only those elements of the European patent application which are included in the application or applications whose priority is claimed. Since, pursuant to Art. 84 EPC, the claims of the European patent application define the matter for which protection is sought and, hence, determine the matter for which priority may be claimed, the term "elements of the invention", referred to in Art. 88(4) EPC, and the term "elements of the European patent application", referred to in Art. 88(3) EPC, are to be considered synonymous. Both an "element of the invention" and an "element of the European patent application" actually constitute subject-matter as defined in a claim of the European patent application (see **G 2/98**, OJ 2001, 413).

In **T 828/93** the board stated that it followed from Art. 88(3) EPC 1973 that different priorities (including no priority, i.e. only the date of the European application) could be conferred on different parts of a European application. It was sufficient to check whether the subject-matter to be compared with the prior art, i.e. the **subject-matter of the independent patent claims**, corresponded to the disclosure of the documents of the priority application as a whole (see Art. 88(4) EPC 1973). Only one (or, as the case may be, no) priority could be conferred on each claimed **subject-matter as a whole**, in so far as the subject-matter was defined by the totality of the given elements. This subject-matter as a whole represented the invention, which either corresponded to the disclosure of a priority application or not.

In **T 127/92** priority had been claimed from two German utility models (D1 and D2), which were published during the priority interval. The board held that priority had been validly claimed from D1 for claim 1 and several dependent claims. However, it found that other **sub-claims**, which also contained **elements not disclosed in D1**, could not claim partial priority from D1 for the subject-matter of claim 1 contained in them. On the basis of the principles developed in **G 3/93** (OJ 1995, 18), the board concluded that D1 and D2 formed part of the state of the art in respect of these claims and that, consequently, their subject-matter did not involve an inventive step. The patent proprietor therefore deleted them.

See also **T 85/87**, **T 594/90** and **T 961/90**.

6.3. Multiple priorities or partial priority for one claim

Article 88(2), second sentence, EPC provides that, where appropriate, multiple priorities may be claimed for any one claim. The Enlarged Board considered the application of this provision in **G 2/98** (OJ 2001, 413) and in **G 1/15** (OJ 2017, A82). Respective summaries are given below.

The following earlier decisions of technical boards are also of interest.

In **T 828/93** (see also chapter II.D.6.2. above) the board confirmed that the possibility mentioned in Art. 88(2) EPC 1973 of multiple priorities for any one patent claim related only to instances where, unlike in the case at issue, the claim contained **alternatives** and could therefore be split into **several subject-matters**.

In **T 620/94** it became apparent that granted claim 1 covered two alternatives A and B of the invention. Only alternative B was disclosed in the priority document; alternative A was contained only in the subsequent European application. Prior art published during the priority interval rendered obvious alternative A. The patent could thus only be maintained in amended form, i.e. limited to alternative B.

In **T 441/93** the patent related to a process for preparing a strain of the yeast Kluyveromyces, which comprised transforming Kluyveromyces yeast cells. The priority document disclosed a process for the transformation of protoplasts of such yeast. The board concluded that the claims could be divided into two groups: Group A, enjoying priority rights from the previous application and comprising claim 1 in so far as directed to a process for the transformation of Kluyveromyces protoplasts, and the related further claims; and Group B, only enjoying the priority of the subsequent European application, and comprising claim 1 in so far as not directed to a process for the transformation of protoplasts, and the related further claims. Consequently, a scientific article published in the priority interval was held to be prior art only as regards the parts of the claimed subject-matter not disclosed in the priority document. See also **T 395/95**.

In **G 2/98** (OJ 2001, 413) the Enlarged Board analysed the legislative intention behind the second sentence of Art. 88(2) EPC 1973 and concluded that a distinction had to be drawn between the two following cases. The legislator did not want several priorities to be claimable for the **"AND" claim** (e.g. a claim to features A and B, with the first priority document disclosing claim feature A alone and only the second priority document disclosing claim feature B). With regard to the **"OR" claim**, the Enlarged Board drew the following conclusion from the historical documentation relating to the EPC 1973: where a first priority document disclosed a feature A, and a second priority document disclosed a feature B for use as an alternative to feature A, then a claim to A or B could enjoy the first priority for part A of the claim and the second priority for part B of the claim. It was further suggested that these two priorities might also be claimed for a claim directed to C, if the **feature C**, either in the form of a generic term or formula, or otherwise, **encompassed feature A as well as feature B**. The use of a generic term or formula in a claim for which multiple priorities were claimed in accordance with Art. 88(2), second sentence, EPC 1973 was perfectly acceptable under Art. 87(1) and 88(3) EPC 1973, provided that it gave rise

to the claiming of a **limited number of clearly defined alternative subject-matters** (see point 6.7 of the Reasons; this proviso was however qualified for partial priorities in **G 1/15**, point 6.3 of the Reasons, see in this chapter II.D.6.3.2.)

6.3.1 Development of the case law after G 2/98 in respect of generically formulated "OR" claims

In the period that followed **G 2/98** (OJ 2001, 413), the above-mentioned proviso of the Enlarged Board in respect of generic "OR" claims gave rise to divergences in the jurisprudence of the boards. These led to a further ruling by the Enlarged Board in **G 1/15** (OJ 2017, A82); see also chapter II.D.6.3.2 below.

In some of those cases, subject-matter disclosed in the priority document and falling within the generically formulated claim of the subsequent European application was denied (partial) priority because the terms of the proviso were found not to be met. Such approach could sometimes lead to a "collision" under Art. 54(3) EPC with another member of the same European patent family (particularly in situations involving what is sometimes referred to as a "toxic priority" or "poisonous divisional" – see also **T 557/13** of 17 July 2015, OJ 2016, A87, summarised in the next section). In **G 1/15** (OJ 2017, A82), the Enlarged Board observed that in a number of decisions the words of the proviso had been understood as a further test to be complied with for a claim to partial priority to be accepted, an interpretation which the Enlarged Board rejected. Accordingly, **G 1/15** has overruled the approach taken in **T 1127/00**, **T 1443/05**, **T 1877/08**, **T 476/09**, and other decisions mentioned in **G 1/15**, point 2.2 of the Reasons.

However, other decisions issued after **G 2/98** acknowledged partial priority in comparable circumstances.

Thus, in **T 665/00**, the board found that the subject-matter of an alleged public prior use within the priority interval was described in the priority document and also fell within the scope of the claims of the disputed patent, but that the priority document did not necessarily describe all the subject-matters claimed. Referring to Art. 88(3) EPC 1973 and **G 2/98** (OJ 2001, 413), the board held that different elements of a patent application could enjoy different priority dates and that this was also applicable to a single claim encompassing alternatives and being, thus, separable into a plurality of subject-matters. Of the different alternatives contained in claim 10 (relating to a powder containing hollow microspheres the specific mass of which was described by the generic term "less than 0.1 g/cm^3"), the non-compacted powders containing "Expancel DE" microspheres were covered by the claimed date of priority. The claimed prior use, which came after the priority date and involved a product containing the same "Expancel DE" microspheres, could therefore not be novelty-destroying. See also **T 135/01**.

The meaning of the proviso of **G 2/98** in relation to the "OR" claim situation was the subject of extensive obiter remarks in **T 1222/11**. According to the board, the condition "provided that it gives rise to the claiming of a limited number of clearly defined alternative subject-matters" should be given a different meaning from that attributed to it in **T 1877/08**, **T 476/09**, **T 1443/05** and **T 1127/00**. This condition could not be meant to set out the

manner in which the subject-matter of the "OR" claim must be defined. This would, at least in relation to generic terms, be at variance with the disclosure test based on the principle of an unambiguous and direct disclosure (cf. **G 3/89**, OJ 1993, 117). For the purpose of the assessment required by Art. 88(3) EPC, the board considered that the wording of the above condition referred to the ability to conceptually identify, by comparison of the claimed subject-matter of the "OR" claim with the disclosure of the multiple priority documents, a limited number of clearly defined alternative subject-matters to which the multiple rights of priority claimed could be attributed or not (cf. examples in the Memorandum drawn up by FICPI (M/48/I, Section C) for the Munich Diplomatic Conference in 1973, as cited in **G 2/98**).

T 571/10 expressly applied the approach of **T 1222/11**. The application in suit, which concerned a pharmaceutical composition, and D9, also a European application, shared the same filing date and claimed priority from the same earlier national application. By comparing the generic subject-matter of claim 1 in issue with the priority document, the board identified two clearly defined alternative subject-matters (a) and (b) as being encompassed by the claim, but not spelt out in it. Only alternative (a) was fully disclosed in the priority document and therefore enjoyed the claimed priority. D9 could belong to the state of the art under Art. 54(3) EPC only in so far as the priority of the application in suit was not validly claimed while the priority of D9 was. For alternative (a) of claim 1, this was not the case, since D9 had no valid earlier effective date. For alternative (b) of claim 1, D9 was state of the art under Art. 54(3) EPC only for the subject-matter for which the priority claimed for D9 was valid, which was that of alternative (a). This subject-matter was not novelty-destroying for the subject-matter of alternative (b) of claim 1, as it had no overlap with the latter.

The decision Headnote states: "In a case in which a single priority is claimed for a given application and a number of features of a claim of said application are generalisations of specific features disclosed in the priority document, a partial priority is to be acknowledged, as long as it is possible to conceptually identify, by a comparison of the claimed subject-matter with the disclosure of the priority document, a limited number of clearly defined alternative subject-matters, including among the alternatives the specific embodiments which are directly and unambiguously derivable from the priority document. In order for this condition to be met, it is not necessary that the clearly defined alternative subject-matters are spelt out as such in the application, nor that the word "or" actually occurs. This condition extends to the case of multiple priorities. In that case, a comparison with the disclosure of each of the priority documents is necessary and for each of the clearly defined alternative subject-matters the earliest priority from which the alternative subject-matter is directly and unambiguously derivable is acknowledged."

6.3.2 Referral case G 1/15 ("Partial priority")

The patent in suit in case **T 557/13** of 17 July 2015 (OJ 2016, A87) had been granted on a divisional application. The opposition division concluded that an intermediate generalisation in granted claim 1 with respect to the disclosure of priority document D16 did not give rise to the claiming of a limited number of clearly defined alternative subject-matters (cf. **G 2/98**, OJ 2001, 413). Hence, although the patent met the requirements of

Art. 76(1) EPC, the subject-matter of claim 1 did not enjoy the priority date of parent application D1. D1 was thus considered to be state of the art under Art. 54(3) EPC, and claim 1 to lack novelty in view of the use of the product of example 1 disclosed identically in D16 and D1. For the board, the question to be resolved was whether claim 1 enjoyed partial priority to the extent that the use of the product of example 1 as disclosed in D16 was encompassed by the more generic definition of claim 1, rather than being spelt out in it. In view of the differing approaches in previous board decisions, the board decided to seek clarification from the Enlarged Board of the law on partial priority for generic "OR" claims and on the proper interpretation of the proviso of **G 2/98** (point 6.7 of the Reasons).

In **G 1/15** (OJ 2017, A82) the Enlarged Board ruled that under the EPC, entitlement to partial priority may not be refused for a claim encompassing alternative subject-matter by virtue of one or more generic expressions or otherwise (generic "OR" claim) provided that said alternative subject-matter has been disclosed for the first time, directly, or at least implicitly, unambiguously and in an enabling manner in the priority document. No other substantive conditions or limitations apply in this respect. The Enlarged Board set out its interpretation of Art. 88(2) and (3) EPC. If a claim in the later application was broader than an element disclosed in the priority document, then priority could be claimed for such element. It did not matter whether partial priority was claimed for one element in one priority document only, for a plurality of elements disclosed in one priority document (first situation addressed in Art. 88(3) EPC), for a plurality of elements disclosed in more than one priority document (second situation addressed in Art. 88(3) EPC) or for a plurality of elements disclosed in a plurality of priority documents (situation addressed in the second sentence of Art. 88(2) EPC). It was also of no relevance whether one claim encompassed only one element disclosed in a priority document or a plurality of elements disclosed in one or more priority documents. The Enlarged Board considered this interpretation to be confirmed by FICPI Memorandum C (M/48/I) of the *travaux préparatoires* to the EPC 1973, which could be said to express its intent (**G 2/98**, point 6.4 of the Reasons; see also Minutes of the Munich Diplomatic Conference of 1973, M/PR/I, "Article 86 (88) Claiming Priority", points 308 to 317), and by the Paris Convention. Thus, the EPC did not contain other requirements for recognising the right of priority beyond the same invention, whether for simple, multiple or partial priority, the last being regarded as a sub-group of multiple priorities. As a consequence, the proviso of **G 2/98** could not be construed as implying a further limitation of the right of priority.

In assessing whether a subject-matter within a generic "OR" claim could enjoy partial priority, the first step was to determine the subject-matter disclosed in the priority document that was relevant, i.e. relevant in respect of prior art disclosed in the priority interval. This was to be done in accordance with the disclosure test laid down in the conclusion of **G 2/98** and on the basis of explanations put forward by the applicant or patent proprietor to support his claim to priority, in order to show what the skilled person would have been able to derive from the priority document. The next step was to examine whether this subject-matter was encompassed by the claim of the application or patent claiming said priority. If the answer was yes, the claim was de facto conceptually divided into two parts, the first corresponding to the invention disclosed directly and unambiguously in the priority document, the second being the remaining part of the subsequent generic "OR"-claim not enjoying this priority but itself giving rise to a right to

priority, as laid down in Art. 88(3) EPC. This also corresponded to the scheme described in the Memorandum. The task of determining the relevant disclosure of the priority document taken as a whole, and whether that subject-matter was encompassed by the claim in the subsequent application, was common practice in the EPO and among practitioners of the European patent system and as such should not pose any additional difficulty. Nor did it create uncertainty for third parties. The decisions reached in **T 665/00**, **T 135/01**, **T 571/10** and **T 1222/11** showed that it could be carried out without any need for additional tests or steps.

6.3.3 Application of G 1/15 in the jurisprudence of the boards

In case **T 260/14** the opposition division had denied priority and found that claim 1 lacked novelty pursuant to Art. 54(3) EPC in view of a working example disclosed in the priority document (D5) itself, which example was also disclosed in the description of the patent in suit. (D5 had been dealt with as a case of "toxic priority".) In accordance with **G 1/15** (OJ 2017, A82), the board first identified the working example as being relevant subject-matter disclosed in the priority document (cf. **G 2/98**, OJ 2001, 413). It then analysed whether claim 1 encompassed the working example, and whether that example was alternative subject-matter by virtue of a generic "OR" claim, by comparing the ambit of the claim with the content of the priority document. The claim was to a dental impression material comprising a base paste and a catalyst paste. Both pastes were described using generic features such as "polyethers" and "copolyether of ethyleneoxide". The working example was one specific embodiment of the claim. Multiple alternative working examples would be possible, with different variants falling within the generic features of the claim. The example was thus alternative subject-matter by virtue of a generic "OR" claim which fell within the ambit of claim 1. Hence, the part of claim 1 concerning that example was entitled to partial priority.

Further decisions applying the approach of **G 1/15** include **T 1526/12** (hair care composition), **T 557/13** of 28 July 2017 (use of a cold flow improver), **T 2466/13** (insulation panel), **T 1399/13** (polymerisation process), **T 88/14** (low-fat confectionary product), **T 1519/15** (sensing circuit comprising sensing capacitors), **T 1728/16** (solid pharmaceutical dosage form), **T 933/18** (method for preparing a biosensor), **T 401/19** (chromatographic purification method), **T 335/20** (progranulin for use in treating dementia), **T 1946/21** (inflatable pool) and **T 307/22** (dishwasher).

In **T 282/12** the board held that, for reasons of consistency, the rationale of decision **G 1/15** (OJ 2017, A82) must also apply in the context of deciding whether an application from which priority is claimed is the **first application** within the meaning of Art. 87(1) EPC (see more detailed summary of this aspect of the decision in chapter II.D.5.1. above). The board also cautioned in this context against assessing priority by performing a test under Art. 123(2) EPC, which approach had led the opposition division to find that D1 was the first application. The assessment of priority and of the requirement of Art. 123(2) EPC were both based on the concept of disclosure. However, applying a test under Art. 123(2) EPC could lead to wrong conclusions in certain circumstances because the concept of "partial" validity of an amendment does not exist, whereas "partial priority" does. Relating this to the facts of the case (gap width of coated tablet), the board agreed that amending a range

from 5% to 33% (i.e. the range in claim 1 and in the priority document D1) to 3% to 33% (i.e. the range in the proprietor's earlier application D22) would result in the addition of subject-matter. However, both of these encompassed an identical part, i.e. the sub-range 5% to 33%, which defined alternative dosage forms that did not change their identity, whether they were claimed as such or as part of a broader group of compositions, including other compositions with a gap width outside the range 5% to 33%. Thus, in the present case, the mere application of an assessment pursuant to Art. 123(2) EPC to the assessment of the validity of the priority claim did not allow the conclusion that D1 and D22 related in part to the same invention and therefore that the priority was not valid over the whole scope of claim 1.

T 437/14 of 12 March 2019 was the board's final decision following its referral of questions on undisclosed disclaimers to the Enlarged Board in case **G 1/16** (OJ 2018, A70; the board's findings on the admissibility of the undisclosed disclaimers are summarised in chapter II.E.1.7.2). In view of the added disclaimers, opponent 3 had argued that claim 1 did not validly claim a priority right and that its subject-matter lacked novelty over D57 and D58, two divisional applications of the application on which the patent was based. According to the board, for this, two conditions would have to be fulfilled: that at least one embodiment of the divisional application/s was encompassed by claim 1, and that claim 1 did not enjoy a priority right or at least a partial priority right for the part/s relating to those embodiment/s. Citing **G 1/03** (OJ 2004, 413), the board was satisfied that the two disclaimers did not provide a technical contribution and fulfilled the requirements of Art. 123(2) EPC. Therefore, the subject-matter of claim 1 enjoyed priority from the earlier application. As far as D57 and D58 disclosed specific compounds falling within claim 1 and validly claimed priority from the earlier application, claim 1 validly claimed a corresponding partial priority right from the earlier application for those compounds. Claim 1 was a generic "OR" claim encompassing alternative subject-matter directly and unambiguously disclosed in the priority document and was thus entitled to a partial priority for that alternative subject-matter within the meaning of **G 1/15** (OJ 2017, A82). Thus, D57 and D58 did not form part of the state of the art under Art. 54(3) EPC for the purpose of assessing novelty.

In **T 88/21** the application in suit and D1 were both filed by the appellant. The application in suit claimed priority from D0. D1 claimed priority from unpublished D1a, which was filed prior to D0. It had not been contested that D0 and D1 belonged to the appellant. Claim 1 had been amended to include an undisclosed disclaimer based on examples 4A-D and 5A of D1. According to the board, the subject-matter of claim 1 of the application in suit before the addition of the undisclosed disclaimer was anticipated by examples 4AD and 5A of D1. The effective date of these examples in D1 was the filing date of D1a, which was before the filing date of D0. Hence, as far as the subject-matter of examples 4A-D and 5A of D1/D1a was concerned, D1a – and not D0 – was the first application within the meaning of Art. 87(1) EPC. Therefore, the application in suit could not validly claim the priority of D0 for the subject-matter of these examples. Since D1 was published prior to the filing date of the application in suit, D1 was prior art under Art. 54(2) EPC for that subject-matter. See also **T 1222/11** and **T 282/12** in chapter II.D.5.1. See also in chapter II.E.1.7.3.

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This chapter concerns the allowability of amendments under Art. 123(2) and Art. 123(3) EPC, as well as corrections of errors in the parts of a patent application or of a patent relating to the disclosure (the description, claims and drawings) under R. 139 EPC. Other aspects related to amendments are dealt with elsewhere; see for example chapters II.D.4.2. in the context of Art. 87(1) EPC; II.F. "Divisional applications", in particular II.F.2.2. "Amendments to divisional applications"; III.I.3.1. "Party's responsibility to define subject-matter by filing appropriate requests"; III.L. "Correction of errors in decisions"; IV.B.1.1., IV.B.2.6.6, IV.B.3.3., IV.B.3.4., IV.B.3.6., IV.B.3.7., IV.B.5. for the admissibility of amendments during the "Examination procedure"; IV.C.5. "Amendments to claims, description and drawings in opposition proceedings" and V.A.4. "New submissions on appeal".

1. Article 123(2) EPC – added subject-matter

1.1. General principles

According to Art. 123(2) EPC the European patent application or the European patent may not be amended in such a way that it contains subject-matter which extends beyond the content of the application as filed. The revision of the EPC introduced a purely editorial change to the wording of Art. 123(2) EPC.

The concept of "content of the application as filed" relates to the parts of the European patent application which determine the disclosure of the invention, namely the description, the claims and the drawings (**G 3/89**, OJ 1993, 117, and **G 11/91**, OJ 1993, 125). See in this chapter at II.E.1.2. "Content of the application as filed: Parts of the application which determine the disclosure of the invention" below.

The **underlying idea** of Art. 123(2) EPC is that an applicant should not be allowed to improve their position by adding subject-matter not disclosed in the application as filed,

which would give them an **unwarranted advantage** and could be damaging to the legal security of third parties relying on the content of the original application (see **G 1/93**, OJ 1994, 541); otherwise, at a later stage the public could be faced with claims extending beyond what was disclosed in the application as filed and published (**T 740/91** and **T 1227/10**). Citing **G 1/93**, in **T 1853/22** the board explained that the purpose of Art. 123(2) EPC is to create a fair balance between the interests of patentees on the one hand and competitors and other third parties on the other. The public may not be confronted with an extent of protection, which could not have been established by a skilled person having studied the whole content of the technical disclosure of the originally filed patent application (**T 157/90**; see also **T 187/91** and **T 2327/18**, which cites **G 2/10**, OJ 2012, 376, point 4.5.5 of the Reasons).

The **"gold standard"** (**G 2/10**, OJ 2012, 376) for assessing compliance with Art. 123(2) EPC is the following: any amendment to the parts of a European patent application or of a European patent relating to the disclosure (the description, claims and drawings) is subject to the mandatory prohibition on extension laid down in Art. 123(2) EPC and can therefore, irrespective of the context of the amendment made, only be made within the limits of what a skilled person would derive directly and unambiguously, using common general knowledge, and seen objectively and relative to the date of filing, from the whole of these documents as filed (**G 3/89**, OJ 1993, 117; **G 11/91**, OJ 1993, 125). **After the amendment the skilled person may not be presented with new technical information** (**G 2/10**; see however **G 1/16** for undisclosed disclaimers). For details, see in this chapter II.E.1.3. "Standard for assessing compliance with Article 123(2) EPC" further below; for more details on **G 1/16**, OJ 2018, A70, see chapter II.E.1.7. "Disclaimer" below.

Article 123(2) EPC **applies to all amendments** to the patent application or patent. These include corrections of the description, claims or drawings under R. 139, second sentence, EPC (for details, see in this chapter II.E.4. "Correction of errors in the description, claims and drawings – Rule 139 EPC").

The Enlarged Board has stressed the importance of applying a **uniform concept of disclosure** (with reference to Art. 54, 87 and 123 EPC; see **G 2/10**, OJ 2012, 376, point 4.6 of the Reasons, citing **G 1/03**, OJ 2004, 413; see also **G 1/15**, OJ 2017, A82, with reference to **G 2/98**, OJ 2001, 413). See also e.g. **T 330/14**, **T 1303/18**, **T 342/20** and **T 1589/21** (on second medical use claims).

In the case of divisional applications, the same principles are to be applied for determining whether subject-matter extends beyond the content of the earlier application as filed (**G 1/05**, OJ 2008, 271, point 5.1 of the Reasons). The decisions dealing with such cases are therefore also reported in this chapter.

The same principles also apply to the ground for opposition under Art. 100(c) EPC.

The ground for opposition under Art. 100(c) EPC and the corresponding requirement of Art. 123(2) EPC in regard to any amendment carried out on the patent in the course of the opposition and opposition appeal proceedings are of equal fundamental importance

compared to other requirements, such as e.g. novelty, inventive step or sufficiency of disclosure, when it comes to deciding whether a patent can be maintained; also, extension of subject-matter in the terms of Art. 123(2) EPC is not a question of "form" of the patent, which might fall under the heading of a "formal requirement", but a substantive one (**T 2171/14**).

1.2. Content of the application as filed: Parts of the application which determine the disclosure of the invention

1.2.1 Description, claims and drawings

Regarding the concept of the content of the application as filed, **G 3/89** (OJ 1993, 117) and **G 11/91** (OJ 1993, 125) laid down that it related to the parts of the European patent application which determined the disclosure of the invention, namely the description, the claims and the drawings. Note however that since the revision of the EPC, when determining the application documents "as filed", account has to be taken of R. 40 and 56 EPC. Since 1 November 2022, R. 56a EPC is relevant too.

Amendments can only be made within the limits of what a skilled person would derive from the **whole** of these documents as filed (**G 2/10**, OJ 2012, 376). In **T 676/90** the board considered that the content of an application was defined not only by features mentioned or shown therein but also by their relationship to each other. Accordingly, it found that a figure could never be interpreted in isolation from the overall content of the application but only in that general context.

In **T 1544/08** the board held that, if the **drawings** of the originally filed application were **in colour**, it was these figures which must be used as the basis for determining whether subsequently filed figures contained added subject-matter within the meaning of Art. 123(2) EPC.

In **T 2166/10** the patent proprietor filed an appeal against the decision of the opposition division revoking the patent, which had been granted on the basis of a Euro-PCT application. Several pages of the description were missing from the original application and the opposition division held that only the originally filed pages were entitled to the international filing date. The subject-matter as granted consequently extended beyond the content of the application as filed. The board held that there was no doubt that the preliminary examination and the patent in suit were partly based on new description pages which had been submitted in the course of the international preliminary examination procedure by way of amendment and which were missing from the application as originally filed. The applicant had never raised the issue of the missing pages or requested a correction of the filing date (see also **J 3/00**). Nor did the applicant subsequently file a request for correction of an error in the decision to grant. The board therefore concluded that the opposition division was correct when it held that the application as filed therefore did not include the missing pages of the description.

1.2.2 Abstracts, titles, priority documents, parallel applications

In **T 246/86** (OJ 1989, 199) the board decided that as the **abstract** was intended solely for documentation purposes and did not form part of the disclosure of the invention, it could not be used to interpret the content of the application for the purposes of Art. 123(2) EPC 1973 (confirmed in **T 735/03**, **T 606/06**, see also **G 3/89**, OJ 1993, 117, **G 11/91**, OJ 1993, 125). The same applies to the **title** on the cover sheet (**T 1437/07**).

For the purpose of Art. 123(2) EPC, "the content of the application as filed" also does not include any **priority documents**, even if they are filed on the same day as the European patent application (see **T 260/85**, OJ 1989, 105; **G 3/89**, OJ 1993, 117; **G 11/91**, OJ 1993, 125; and e.g. **T 1937/17**, **T 1295/19**); the same is true for parallel applications (see, e.g. **J 16/13**, **T 1197/13**, concerning a German utility model application claiming the same priority). Concerning priority documents, see however R. 56(3) EPC and chapter IV.A.5.4. below.

1.2.3 Language issues

Before the EPC 2000, a European patent application could only be filed in one of the official languages of the EPO (Art. 14(1) EPC 1973) or, by persons benefiting from the "language privilege", in an "admissible non-EPO language" with a translation into one of the official languages to be filed (Art. 14(2) EPC 1973). In line with Art. 5 PLT, Art. 14(2) EPC now provides that the application may be filed in one of the official languages or in "any other language". In the latter case a translation has to be provided (see chapter III.F.1. "Language of filing and date of filing of a European patent application").

In **T 382/94** (OJ 1998, 24) the board held that if the drawings were filed in full on the date of filing, they formed part of the application as filed, even if they contained text matter in an official language other than the language of the proceedings.

In **T 605/93** the board held that where the application documents of the European application as filed were a translation of the international application as it was filed, the content of the "application as filed" was that of the **international application as it was filed** (see also **T 1402/09**, **T 923/13** and **T 1981/15**). In all normal circumstances, it ought however to be assumed that the published European application was identical in content with the published international application (**T 605/93**, see also **T 549/09**). Only when there were reasonable grounds to doubt this presumption in a particular case was further investigation and, where necessary, the production of evidence required (**T 1010/07**, **T 1981/15**).

In **T 287/98** the original application in Dutch contained the word "schroot", which means scrap metal. The board decided that the replacement of the word "scrap" (as initial translation of "schroot") by "scrap metal" was allowable under Art. 123(2) EPC 1973 since Art. 70(2) EPC 1973 provided that in a case referred to in Art. 14(2) EPC 1973, i.e. in which the European patent application was filed in a language of a contracting state other than English, French or German, the **original text** had to be taken into account in order to

determine whether the subject-matter of the application extended beyond the content of the application as filed. For further cases under Art. 14(2) EPC and Art. 123(2) and (3) EPC, see e.g. **T 516/12** and **T 1585/12**; see also **T 1312/19**.

In **T 1386/18** the board allowed an amendment of a term in the description, to bring it into line with the original PCT application filed in Chinese. According to the appellant, this amendment was based on the correct translation of the corresponding Chinese term. The board regarded the translation's inaccuracy as a plausible fact and therefore found there was no subject-matter extension.

1.2.4 Cross-references to other documents – incorporation by reference

In **T 6/84** (OJ 1985, 238) the board took the view that structural features of a means for performing a chemical process (here the catalyst "offretite"), which were not mentioned in the application documents themselves but in a document (here a Canadian patent specification) to which they referred, could be incorporated into a patent claim if they unequivocally formed part of the invention for which protection was sought (see also **T 590/94**). However, it was not permissible to single out a particular one of their number (here a silica/alumina ratio) in the absence of evidence that this feature alone was a sufficient characterisation. It was instead necessary to recite fully the other essential components of the structure and the diffraction pattern figures which belonged together, as originally disclosed and defined in that document.

In **T 689/90** (OJ 1993, 616) the board decided that features disclosed only in a cross-referenced document which was identified in the description as filed were prima facie not within "the content of the application as filed". Only under particular conditions would adding them to a claim not be an infringement of Art. 123(2) EPC 1973, namely if the description of the invention as filed left the skilled reader in no doubt that (a) protection was sought for those features; (b) they helped achieve the invention's technical aim and thus formed part of the solution to the technical problem underlying the invention claimed; (c) they implicitly clearly belonged to the description of the invention contained in the application as filed (Art. 78(1)(b) EPC 1973) and thus to the content of the application as filed (Art. 123(2) EPC 1973); and (d) they were precisely defined and identifiable within the total technical information contained in the reference document. In the case at issue these requirements were not fulfilled. See also **T 196/92**, **T 558/03**, **T 1497/06**, **T 1378/08**, **T 664/11**, **T 1451/12**, **T 2498/12**, **T 672/14**; see also **T 474/05** in which the reference in the application to a document was within a specific context, and the amendment went beyond this context and was thus not allowable; see also **T 2477/12**, applying **T 689/90** in the context of Art. 76(1) EPC where the priority application, containing sequence listings, had been "incorporated by reference" in the parent application.

In **T 1125/17** the board emphasised that requirement (a) of **T 689/90** was very stringent. With reference to **T 1415/07**, it highlighted that it had to be unambiguously derivable to the skilled person which features of the application were to be taken from the reference document. A mere mention of a prior art document as an "example" was normally insufficient to identify which features or groups of features were of particular relevance for the citing application.

In **T 1084/22** the board referred to the above conditions developed in the case law for incorporating features from a cross-referenced document (in particular in **T 689/90**). The board viewed these conditions as different applications of the "gold standard". While different tests had been developed, these tests could only assist in determining whether an amendment complied with Art. 123(2) EPC, but did not replace the "gold standard" and should not lead to a different result.

In **T 737/90** the board held that a cross-referenced document could only be taken into account if the relevant addressees of the application containing the reference had ready access to the referenced document (the EPO before publication of the application and the public after it).

On incorporation by reference in the context of novelty, see chapter I.C.4.2. above.

1.3. Standard for assessing compliance with Article 123(2) EPC

1.3.1 Gold standard: directly and unambiguously derivable

Any amendment to the parts of a European patent application or of a European patent relating to the disclosure (the description, claims and drawings) is subject to the mandatory prohibition on extension laid down in Art. 123(2) EPC and can therefore, irrespective of the context of the amendment made, only be made within the limits of what a skilled person would derive directly and unambiguously, using common general knowledge, and seen objectively and relative to the date of filing, from the whole of these documents as filed (**G 3/89**, OJ 1993, 117; **G 11/91**, OJ 1993, 125; **G 2/10**, OJ 2012, 376, referring to this test as "gold standard"; confirmed for disclosed disclaimers in **G 1/16**, OJ 2018, A70; for undisclosed disclaimers, see however chapter II.E.1.7.2c)). After the amendment the skilled person may not be presented with new technical information (**G 2/10**).

In **T 1937/17** the board held that, other than for the purposes envisaged in **G 1/93** (OJ 1994, 541), a "technical contribution" was of no relevance when deciding on the allowability of amendments under Art. 123(2) EPC. Instead, the "gold standard" set out in **G 2/10** was the only criterion that had to be applied.

Similarly, in **T 768/20** the board rejected the argument made by the appellant (proprietor) that the "gold standard" concerned only amendments which provided a technical contribution. On the basis of a detailed analysis of the case law of the Enlarged Board, the board concluded that the "gold standard" developed in opinion **G 3/89** and decision **G 11/91**, and reaffirmed by decision **G 2/10**, was the general rule to be used when examining the compliance of amendments with Art. 123(2) EPC. Undisclosed disclaimers constituted an exception to this rule. As confirmed in **G 1/16**, they were governed by the rules laid down in decision **G 1/03**. Point 2 of the Order of decision **G 1/93** (and point 16 of the Reasons) also appeared to concern undisclosed disclaimers, which decision **G 1/03** examined in greater detail. The board observed that the reasoning in **G 1/03** was mainly based on the purpose of Art. 54(3) EPC and took the view that decision **G 1/03** was best understood as specifying a limited set of exceptions, namely that, for the sake of consistency of the European patent system and similar teleological reasons, the

requirements of Art. 123(2) EPC were deemed to be fulfilled even though the amendment did not meet the "gold standard". The board saw a confirmation for this view in **G 2/10**. To the best knowledge of the board, the case law of the Enlarged Board did not provide for any further exception in the context of Art. 123(2) EPC. This approach was followed in **T 110/20**.

As can be seen from the "gold standard", the assessment of the requirements of Art. 123(2) EPC is to be done from the standpoint of the **skilled person** (see chapter II.E.1.3.2 "Standpoint of the skilled person" below).

The subject-matter must be at least implicitly disclosed (**T 860/00**; see also **G 2/10**, OJ 2012, 376), see in this chapter II.E.1.3.3 "Implicit disclosure" below.

The boards have emphasised with regard to various tests developed for different cases of amendments that they are only meant to provide an indication of whether an amendment complies with Art. 123(2) EPC as interpreted according to the "gold standard". They may assist in determining the allowability of an amendment but do not take the place of the "gold standard" and should not lead to a different result.

1.3.2 Standpoint of the skilled person

Any amendment can only be made within the limits of what a **skilled person** would derive directly and unambiguously, using common general knowledge, and seen objectively and relative to the date of filing, from the whole of the documents as filed (**G 2/10**, "gold standard", see above chapter II.E.1.3.1).

The board in **T 1269/06** held that, for the assessment of whether, contrary to Art. 100(c) EPC 1973, the subject-matter of the patent extends beyond the content of the application as filed, the key question is whether the amendments made in the description, or – as in the case at issue – the claims, did indeed provide the skilled person with additional, technically relevant information which was not contained in the original application documents. This cannot be inferred from the fact alone that terms not present in the application documents were subsequently introduced, or from a purely semantic analysis of the contested passages. Instead, the party or department raising the objection must be able to identify clearly the technical teaching as such which has supposedly been added.

In **T 99/13** the board recalled, in line with the case law (see **T 667/08**, **T 1269/06**, quoted in the decision), that the assessment of the requirements of Art. 123(2) EPC should be done on the same basis as for all other patentability issues (e.g. novelty and inventive step), namely from the standpoint of the skilled person on a technical and reasonable basis **avoiding artificial and semantic constructions**. The skilled person, reading claim 1 as originally filed **from the standpoint of a technician working in the field**, would read the broad condition expressed therein with regard to the viscosity measurement, as a condition to be met at the temperature of use of the claimed formulation and would turn to the description to find further information in this respect. See also **T 2255/12** which guards against an **overly formalistic approach** in which more emphasis is given to the literal

content of the original application rather than the technical information that it conveys. In the same vein, see **T 1690/15**, **T 195/20** or **T 1210/20**.

In **T 532/20** the board held that a skilled person did not read an application as a linguist would, but rather on the basis of their technical understanding. The application clearly taught the skilled person that a severe voltage drop at the generator terminals caused high currents in the generator windings, which could damage the semiconductor switches in the inverter. If this happened, the generator could not remain connected and synchronised. The original application did not contain a single technically useful piece of information as to how a severe voltage drop could be accommodated otherwise than with a protective circuit. It also did not contain a single piece of credible disclosure of conditions under which a low-voltage event would not cause excess currents in the generator. In view of this, a skilled person saw beyond the respondent's strategic choice to represent most parts of the disclosure as optional. In this context, it was simply irrelevant how often the words "in one embodiment" were used correctly or not.

It is established case law that **literal support** for amendments in a patent application is **not required** under Art. 123(2) EPC, insofar as the amended or added features reflect the technical information that the skilled person reading the original disclosure would have derived from its content (description, claims and drawings) considered in its entirety (**T 1728/12** citing decision **T 667/08**; see also **T 1731/07**, **T 45/12**, **T 801/13**, **T 1717/13** and **T 640/14**). See also in this chapter II.E.1.3.3 "Implicit disclosure" below.

Also, the structure of the claims should not be disproportionately considered in detriment of what was really disclosed to the skilled person (**T 1854/22** citing **T 2619/11**; see also **T 342/22**). Rather than to a philologist or logician, an application is directed to a technical audience for which an attempt to derive information from the structure of dependent claims would lead to an artificial result (**T 2619/11**, cited in **T 1194/15**). **T 1363/12** considered that **T 2619/11** did not lay down a new test (namely, of what was "really disclosed" to the skilled person) different from the "gold standard" (see in this chapter II.E.1.3.1) (see also **T 938/11**).

In **T 113/16** the board recalled (with reference to the CLB, 8th edn. 2016, II.A.6.1) that in interpreting claims, in order to determine their content, the skilled person read them with synthetic propensity, building up rather than tearing down – with the aim of making technical sense of their wording and in a way that takes account of the whole disclosure of the patent. Claims are thus read with a **mind willing to understand**, contextually, and using normal reading skills. The same naturally applied to the description and drawings, bearing in mind their purpose to describe or illustrate by detailed examples the basic concept of an invention claimed. Thus, the skilled person approaches claims, description and drawings as integral and connected parts of a whole disclosure. This applied also to determining the contents of the application as filed. See also **T 488/16** and **T 516/18**. However, see **T 916/15**, in which the board took the view that the jurisprudence of the boards of appeal referring to "a mind willing to understand" did not apply for the purpose of assessing the allowability of amendments under Art. 123(2) EPC.

A new definition differing from the standard definition known by the skilled person does not add subject-matter, if there is pertinent disclosure in the application as a whole (**T 1598/18**).

In **T 367/20** the board held that to assess amendments under Art. 123(2) EPC, the claimed subject-matter first had to be determined by interpreting the claim (i.e. establishing the meaning of the claimed features) from the perspective of the person skilled in the art. In a second step, it then had to be assessed whether that subject-matter was disclosed in the application as filed.

1.3.3 Implicit disclosure

Subject-matter which is implicitly disclosed to the skilled person, using common general knowledge, in the application as filed is part of its content (see **G 2/10**, OJ 2012, 376). As pointed out in **T 860/00**, the disclosure implicit in the patent application – i.e. what any person skilled in the art would consider was **necessarily implied** by the patent application as a whole (e.g. in view of basic scientific laws) – is relevant for the requirements of Art. 123(2) EPC 1973 (see also e.g. **T 947/05**, **T 1772/06**, **T 1041/07**, **T 1125/07**, **T 2541/11**, **T 2273/12**, **T 389/13**, **T 2267/14**, **T 1690/15**, **T 1672/21**).

It is essential to identify the actual teaching conveyed by the original disclosure. This approach might lead to the identification of subject-matter which has not been explicitly revealed as such in the application as filed, but nevertheless derives directly and unambiguously from its content. Literal support is not required by Art. 123(2) EPC (see e.g. **T 667/08**, **T 2177/11**, **T 1728/12**, **T 801/13**, **T 640/14**).

In **T 823/96** the board observed that the term "implicit disclosure" should not be construed to mean matter that does not belong to the content of the technical information provided by a document but may be rendered obvious on the basis of that content. The term "implicit disclosure" relates solely to matter which is not explicitly mentioned, but is a **clear and unambiguous consequence of what is explicitly mentioned** (see also e.g. **T 1125/07**, **T 1673/08**, **T 583/09**, **T 2016/11**, **T 49/13**; **T 2842/18** refers to this definition as established jurisprudence; for cases delimiting implicit subject-matter from merely obvious subject-matter, see also in this chapter II.E.1.3.4a)).

In **T 917/94** the board decided that the omission of a feature of a claim did not contravene Art. 123(2) EPC 1973, if this feature was implicitly defined by two other features and, being therefore redundant, its omission created no subject-matter extending beyond that of the application as filed.

1.3.4 Subject-matter not implicitly disclosed

a) Subject-matter merely rendered obvious by the content of the application

In **T 329/99** the board stated that a clear distinction had to be made between the questions whether a particular embodiment was disclosed by an application, be it explicitly or implicitly, or/and whether that embodiment was merely rendered obvious by the

application's disclosure (referring to **T 823/96**; see also **T 1171/08**). A particular technical embodiment might be rendered obvious on the basis of the content of an application as filed without, however, belonging to its explicit or implicit disclosure and therefore without serving as a valid basis for amendments complying with the requirements of Art. 123(2) EPC 1973. See also **T 719/22** and **T 1836/22**.

In **T 598/12** the board had to assess whether the skilled person using his **common general knowledge** would regard the additional technical information encompassed by the claims after the amendment as directly and unambiguously implicitly disclosed in the parent application as filed. The board stressed that it was not to be investigated whether this technical information derived from the prior art knowledge in the field. What had to be assessed was whether the notional skilled person working in the field would consider something as directly and unambiguously disclosed in the light of this common general knowledge. It recalled that the assessment of what information was implicitly disclosed in an application could not go beyond the limits of what the skilled person would objectively understand to be a direct and unambiguous consequence of the explicit disclosure in the particular case. Moreover, when performing this assessment, the common general knowledge could not serve to enlarge or replace, in a subjective or artificial manner, the actual content of the specification. The investigation of the actual disclosure in a patent application as filed could not turn into an investigation of obviousness or a search for obvious alternatives of the actual disclosure in the light of general prior art documents. See also **T 3035/19**, cited and followed in **T 1302/21**.

Referring to **T 598/12**, the board in **T 2489/13** confirmed that the criterion of whether alternatives are well known in the field could not be taken as a valid approach for the investigation of at least an implicit disclosure.

b) Results of reflection and imagination of the skilled person

The board in **T 89/00**, citing **T 260/85** (OJ 1989, 105), **T 64/96** and **T 415/91**, held that, according to the case law of the boards of appeal, a distinction must be made between what the original documents of a patent directly and unambiguously disclosed to a skilled person and what said skilled person on the basis of this disclosure may do upon reflection and using its imagination. The thinking of the skilled person is **not part** of the content of the original documents of the patent. See also **T 553/15**.

In **T 782/16** the board held that for a correct application of the "gold standard", a distinction needed to be made between subject-matter which was disclosed either implicitly or explicitly in the original (or earlier) application and therefore could be directly derived from it, and subject-matter which was the result of an intellectual process, in particular a complex one, carried out on what was disclosed.

c) General open-ended statement in description

In **T 1538/12** the board held that the general statements at the end of the description (e.g. "other variations and modifications of the exemplary embodiments described above may be made" or "other embodiments will be apparent to those skilled in the art") did not

constitute, and thus could not replace, a direct and unambiguous disclosure of the particular generalisation. The general statements at the end of the description were furthermore open-ended and attempted to burden the skilled reader with having to work out which combinations of features from the detailed embodiments might be claimed together, while the applicant was supposedly dispensed from having to present his invention in terms more general than mere detailed description of particular embodiments. See also **T 1365/16**.

1.3.5 Conditions insufficient for compliance with Article 123(2) EPC

a) Consistency with original disclosure

In **T 962/98** the appellant argued that the claimed subject-matter derived from Example 1D and the content of the application as originally filed. In particular, tests carried out on the composition of Example 1D showed that the "four surfactants" could be applied in a more general context, present claim 1 being, furthermore, consistent with the description. Contrary to the appellant's submissions, in order to assess whether an amendment complied with the requirements of Art. 123(2) EPC 1973, the question was neither whether or not a skilled person could design other compositions in the light of the directions given by the tests nor whether or not the amended subject-matter was consistent with the description. On intermediate generalisations, see below in chapter II.E.1.9.

In **T 495/06** the appellant's argument that the amendments were "not inconsistent" with the original disclosure failed to persuade the board, since the applicant thereby invoked a less stringent criterion for compliance with Art. 123(2) EPC than that developed in the jurisprudence of the boards of appeal, namely the question whether the amendment was "directly and unambiguously derivable" from the application documents as originally filed.

In earlier decisions, such as in **T 514/88** (OJ 1992, 570) the boards observed that the relevant question was whether or not the amendment was "consistent with the original disclosure"; the boards clarified that this meant direct and unambiguous derivability from and no contradiction of the totality of the original disclosure (see also **T 527/88** and **T 685/90**).

b) Reasonable plausibility of the included feature

In **T 824/06** the opposition division had rejected the main request because its subject-matter included a temperature maximum for the first *and* the second cooling step whereas the application as originally filed disclosed the requirement that the surface is brought down to this maximum only in relation to the overall cooling treatment. The proprietor had argued that reducing the temperature to this value during the first cooling would be reasonable. The board stated that for an amendment to be allowable under Art. 123(2) EPC its direct and unambiguous disclosure was required; reasonable plausibility was insufficient.

1.3.6 Criteria not relevant for assessing compliance with Article 123(2) EPC

a) Indication in the description that subject-matter is known to the skilled person

In **T 903/16** the examining division had argued that the original disclosure did not indicate or imply that the devices described therein could be new and inventive and had considered the later claiming of such devices as an infringement of Art. 123(2) EPC. The board emphasised that the fact that in the application the disclosed range of devices is stated to be within the means known to the skilled person may be considered when examining other EPC requirements, but it has no bearing on the question of disclosure for the purposes of Art. 123(2) EPC.

b) Enabling disclosure

In **T 1724/08** the board held that the criterion of "direct and unambiguous disclosure" was quite different from the criterion submitted by the appellant, namely whether a person skilled in the art in view of the disclosure was enabled to achieve the envisaged result, i.e. the claimed functionality, without undue difficulty. This latter criterion would allow many different new definitions of subject-matter, none of which would need to be derivable "directly" and "unambiguously" from the earlier application as filed.

In **T 2593/11** the examining division had taken the view that it was not self-evident that devices according to claim 1 could actually be manufactured using a specific fabric and, therefore, the manufacturing of the device using this fabric was not disclosed. The board observed that the requirements of Art. 123(2) EPC differed from those of Art. 83 EPC. Art. 123(2) EPC aimed more particularly to prevent inventors from obtaining protection for inventions they had not thought of at the date of filing, respectively not put into their application as filed. Art. 83 EPC aimed more particularly to prevent them from obtaining protection for "theoretical" inventions which could not be carried out at the date of filing. While in some specific instances there might be a link between the two, in the case at issue, the manufacturing of the device using the specific fabric was clearly disclosed.

c) Limitation of scope of the original claim

In **T 288/92** the appellant (applicant) contended that the amendment resulted in a limitation of the original claim. The board rejected this argument on the grounds that the expression "subject-matter which extends beyond the content of the application as filed" in Art. 123(2) EPC 1973 prohibited the introduction of any technical information which a skilled person would not have objectively derived from the application as filed, so that the examination of the allowability of an amendment according to Art. 123(2) EPC 1973 was directed to the process of "derivation" (see also **T 383/88**), as distinct from a simple comparison of the scopes of amended and unamended subject-matters.

1.3.7 Novelty test

In **T 201/83** (OJ 1984, 481) it was stated that the test for compliance with Art. 123(2) EPC 1973 was basically a novelty test, i.e. no new subject-matter may be

generated by the amendment (see also **T 136/88**). **T 17/86** (OJ 1989, 297, Corr. 415) added that novelty could be found in a limitation, the addition to a claim of a further feature, or even in the absence of one of the elements of a device. In **G 2/10** the Enlarged Board held that after the amendment the skilled person "may not be presented with new technical information" and stressed the importance of applying a uniform concept of disclosure (with reference to Art. 54, 87 and 123 EPC).

The boards have highlighted the limitations of the novelty test (see **T 194/84**, **T 133/85**, **T 177/86**, **T 118/89**, **T 187/91**, **T 288/92** and **T 873/94**; for summaries of these decisions see CLB, 10th edn. 2022, II.E.1.3.7). The boards have seldom expressly applied the novelty test in their recent case law, but it was referred to in e.g. **T 60/03**, **T 1374/07**, **T 2202/08**, **T 1710/09** and **T 2270/09**. According to **T 2537/10**, the novelty test is no longer relevant for the assessment under Art. 123(2) EPC (see also **T 1525/15**). However, reference is still made to this test in the April 2025 version of the Guidelines (H-V, 3.2) for inclusion of additional features: "If the resulting combination is novel over the application as originally filed, the amended claim does not fulfil the requirement of Art. 123(2) [EPC]".

1.3.8 Non-technical subject-matter

In case **T 619/05** the amendment concerned a feature not contributing to the solution of any technical problem by providing a technical effect. It was thus non-technical subject-matter. The term "subject-matter" in Art. 123(2) EPC, without a qualifier, seemed to indicate that this article applied to non-technical as well as technical subject-matter. Thus, any amendments concerning non-technical subject-matter should also be derivable from the patent application as filed. A difficulty in this connection was that a technically skilled person might not have the knowledge necessary in order to determine whether non-technical subject-matter had been added or not. Since the members of a board of appeal were only required to be technically (or legally) qualified under Art. 21 EPC 1973, it would be up to the applicant (or patent proprietor) in such circumstances to provide evidence permitting a board to determine to its satisfaction how a person skilled in the relevant non-technical field would interpret the original patent application and the application (or patent) after amendment. For the case law on non-technical distinguishing features in the framework of novelty, see chapter I.C.5.2.8 above.

1.3.9 Claim interpretation when assessing compliance with Article 123(2) EPC

a) Standpoint of the skilled person

In **T 99/13** the board recalled that, in line with the case law (see **T 667/08**, **T 1269/06**), the assessment of the requirements of Art. 123(2) EPC should be done on the same basis as for all other patentability issues (e.g. novelty and inventive step), namely from the standpoint of the skilled person on a technical and reasonable basis avoiding artificial and semantic constructions. For details see above chapter II.E.1.3.2., which also contains references to decisions confirming or rejecting the application of the jurisprudence referring to "a mind willing to understand" when assessing compliance with Art. 123(2) EPC; on this latter point, see also below in points c) and d) the summaries of

decisions **T 1946/10**, **T 2002/13**, **T 1127/16**, **T 516/18**. Generally on claim interpretation, see also chapter II.A.6.1.

b) Claim feature in itself imparts clear credible teaching

The board in **T 1018/02** stated that although a claim was not to be interpreted in a way which was illogical or did not make sense, the description could not be used to give a different meaning to a claim feature which in itself imparted a clear, credible technical teaching to the skilled reader (**T 876/19**). That also applied if the feature had not initially been disclosed in the form appearing in the claim (see also e.g. **T 1195/01**, **T 474/15**). In the case at issue the claim feature in question would have had to be deleted to achieve consistency with the original disclosure; however this was not possible under Art. 123(3) EPC 1973. See also **T 197/10**, which (in the context of examination of novelty) confirmed the approach that, in the event of a discrepancy between clearly defined claims and the description, those elements of the description not reflected in the claims are not, as a rule, to be taken into account.

In **T 30/17** the board (considering added subject-matter) noted that Art. 69 EPC and its Protocol did not provide a basis for excluding what is literally covered by the terms of the claims, as these provisions related to the patent's (or patent application's) "extent of protection", which was primarily of concern in infringement proceedings. The board emphasised that in examination and opposition proceedings the value of future **legal certainty** was paramount. In the case in hand, the respondent (proprietor) had argued that the expression at issue in claim 1 as granted was linguistically meaningless and that the meaning could only be found by taking into consideration the claim context, the description and the general knowledge of the skilled person in the art. The board, however, considered that the expression was per se not ambiguous and emphasised that a (purported) discrepancy between the claims and the description was not a valid reason to ignore the clear linguistic structure of a claim and to interpret it differently (see e.g. **T 431/03** and **T 197/10**) or to give a different meaning to a claim feature which in itself imparts a clear credible technical teaching to the skilled reader (see e.g. **T 1018/02** and **T 1395/07**). See, however, also **T 195/20** (in which the board underlined that the skilled person would not stop at determining the semantic roles of words in a phrase).

In **T 821/20** the board followed **T 169/20**, in which it was held that where the wording of the claim was clear and technically reasonable within the relevant technical context, the description should not be used to narrow the scope of the claim by excluding interpretations that were both reasonable and technically sound in the technical context of the patent, as this would amount to rewarding the applicant or patent proprietor for wording the claims ambiguously in enabling them to use the description to restrict at will the subject-matter of the claim instead of clarifying the subject-matter of the claim. See also **T 566/20**.

c) Illogical and technically inaccurate claim features may not be disregarded

In **T 2002/13** the board referred to established case law, in particular **T 190/99** (see chapter II.E.2.3.3) according to which the claims must be read with a mind willing to

understand and to make technical sense of them, thereby ruling out illogical or technically meaningless interpretations. The board recalled that the claims were directed to a person skilled in the art. However, the case law did not allow the reader to disregard an illogical or technically inaccurate feature of a claim and hence to interpret such a feature in a correct manner. Thus, if a claim included contradictory features, this contradiction could not be resolved by merely disregarding the technically inaccurate feature and considering only the convenient technically meaningful feature. All the less so when assessing the compliance of these two features with Art. 123(2) EPC. In the board's view, any other approach would provide an unwarranted advantage to the patentee/appellant. See also the summary of **T 81/13** in chapter II.E.1.4.7 "Elimination of inconsistencies and unclear features".

d) Ambiguous features – role of description and drawings

This chapter provides an overview of recent decisions where the boards considered the role of the description and drawings in the interpretation of ambiguous features specifically when assessing compliance with Art. 123(2) EPC. For a general overview, including considerations of the legal basis, see chapter II.A.6.3. "Using description and drawings to interpret the claims".

In **T 23/02** the board said that although the claims as originally filed contained no reference to a **method of measurement** for the average particle diameter, that did not mean that any method could be used to determine that parameter. If anything, the claims raised doubts as to how the average particle diameter had to be determined, in particular because the skilled person would be aware that the measuring method is decisive in particle size analysis. Therefore the skilled person would use the description and drawings when deciding how the average particle diameter was to be measured. They would then conclude that, when properly interpreted in light of the original description, the claims as originally filed contained restrictions as to the measuring method for the average particle diameter. For the case law on the need to include the measuring method of a parameter in the claim, see however chapter II.C.6.6.9 "Analytical measuring methods".

In **T 1946/10** the board held that according to established jurisprudence the skilled person interprets a claim with a mind willing to understand, so as to arrive at an interpretation which is technically sensible and takes into account the whole disclosure of the patent. Though the skilled person strives in principle to understand a claim within the wording and terms of the claim itself, it may, where it encounters ambiguities, need to consult the description and drawings to gain a better understanding. Based on the understanding of the added feature gained by this claim interpretation, the board arrived at the conclusion that adding the feature to claim 1 as originally filed in isolation from its structural and functional context presented a new teaching not originally disclosed. In the same vein, see **T 2350/15** with reference to **T 1592/14**.

In **T 516/18**, in order to be able to compare the claimed subject-matter with the disclosure provided by the application as filed, the board first determined the effective subject-matter resulting from the amendments in the original claims. The board recalled that, the claim must be read and construed by a person skilled in the art with a mind willing to understand,

thereby giving the words the meaning and the scope that they have in the technical field relevant for the invention, including in view of the technical content of the claim. However, according to established case law of the boards of appeal, using the description and the drawings to interpret the claims was considered admissible and even necessary if the person skilled in the art, in an attempt to construe the claim with a mind willing to understand, was confronted with obscure and/or inconsistent features. In the view of the board, this was presently the case.

In **T 1127/16**, however, the board held that the fact that a claim of a patent was to be construed by a mind willing to understand (**T 190/99**) did not mean that the description and the drawings had automatically to be consulted when an "ambiguous" feature (i.e. a feature which at least theoretically allows more than one interpretation) occurred in the claim, or where the claim as a whole included one or more inconsistencies, in order to resolve that unambiguity or inconsistency. Rather, the claim should essentially be read and interpreted **on its own merits** (**T 1018/02**, **T 1279/04**, **T 1404/05**, **T 197/10**). The board underlined that otherwise an applicant (patent proprietor) could arguably dispense with providing a clear and unambiguous formulation of claim features, e.g. during the grant proceedings, in order to be able to fall back on a more description-based interpretation at will during subsequent opposition proceedings. Analysing claim 1 of the main request on a linguistic level, the board decided that the feature at issue would be read in a certain way. On a technical level, the skilled person would also conclude that this interpretation was entirely clear, coherent, and consistent with the other features of claim 1. This interpretation of the feature at issue lead, however, to the infringement of Art. 123(2) EPC, since no such feature was disclosed in the application as filed.

In **T 195/20** the board held that the issue was not how a linguist would construe the meaning of the sentence in question but how the person skilled in the art would. While a linguistic analysis could be helpful in determining how a skilled person would understand a phrase in a claim, the skilled person would not stop at determining the semantic roles of words in a phrase but would interpret the phrase in the context of the claimed subject-matter and the application as a whole.

In **T 1473/19** the board pointed out that although Art. 69(1), second sentence, EPC generally required that the description and drawings be taken into account when interpreting a claim, the primacy of the claims according to Art. 69(1), first sentence, EPC limited the extent to which the meaning of a certain claim feature may be affected by the description and the drawings. The established case law that limiting features which were only present in the description but not in the claim could not be read into a patent claim was thus fully compatible with Art. 69 EPC in conjunction with Art. 1 of the Protocol as a legal basis for determining a patent claim's subject-matter. **T 1473/19** was endorsed in **T 367/20**, where the board explained that the interpretation and determination of the subject-matter of the same claim in the same opposition (appeal) proceedings before the EPO should be uniform and consistent, including for the purpose of Art. 123(2) and Art. 123(3) EPC. See further details regarding claim interpretation in II.A.6.3.

On a related issue, see also chapter II.E.1.4.7 "Elimination of inconsistencies and unclear features" below.

e) Construction with regard to all technically logical interpretations

In **T 1408/04** the board held that while the claims had to be interpreted by a "mind willing to understand" and not by "a mind desirous of misunderstanding", this was understood to mean only that technically illogical interpretations should be excluded (see **T 190/99**). The terms to be interpreted had a wider technical interpretation than envisaged by the appellant. A "mind willing to understand" did not require that a broad term needed to be interpreted more narrowly (even if the narrow interpretation referred to a structure which was very common, but not exclusive, in the technical field concerned), but instead that a broad term should be interpreted with regard to all technically logical interpretations thereof. Based on this understanding of the limiting terms introduced into the claim the board came to the conclusion that the amendment to claim 1 as granted resulted in an intermediate generalisation.

In **T 241/13** the board held that the description did not give a precise definition of the meaning of the expression "minimum intensity level"; the patentee's interpretation of this expression was not clearly excluded. However, that such an ambiguous expression as filed might be interpreted in a particular way was not sufficient to ensure the compliance of an amendment, based on that interpretation, with Art. 100(c) EPC which required a direct and unambiguous disclosure in the application as filed.

In **T 1791/16** the board held that, in the interest of legal certainty, all technically reasonable interpretations of an ambiguous claim had to be considered. If one of those interpretations contained matter that extended beyond the content of the application as originally filed, it had to be concluded that there was added subject-matter (followed e.g. in **T 945/20** and **T 193/22**). A different approach was taken in **T 1345/23** and **T 1886/22**, both citing **T 367/20**, according to which the first step was to interpret the amended claimed subject-matter from the perspective of the skilled person. Whether this subject-matter had been originally disclosed had to be assessed in a second step.

f) Possible but undefined embodiments in dependent claim

According to the board in **T 1688/12**, the mere fact that a dependent claim encompassed a host of possible but undefined embodiments did not mean that the claim on which it depended had to be interpreted as compatible with all those embodiments.

g) Incoherent use of terminology

In **T 1760/21** the board explained that in view of the incoherent use of the terms "forming" "being formed" and "formed product" in the application as originally filed, there was ambiguity as to the intended meaning of "forming". Therefore it was not unambiguous that forming was supposed to be a synonym of shaping. The step of "forming said alloy plate at a temperature in a range of 200°C to 400°C" was thus not directly and unambiguously derivable from the application as originally filed.

This was the approach followed in **T 241/13**, where the board held that the fact that an ambiguous expression as filed may be interpreted in a particular way was not sufficient to

ensure that an amendment based on that interpretation complied with Art. 100(c) EPC, which required a direct and unambiguous disclosure in the application as filed.

h) Role of punctuation

While from a general point of view punctuation may have an influence on claim interpretation and the assessment of Art. 123(2) EPC (as shown by **T 1127/16**, **T 2040/18** or **T 1473/19**), this evaluation is always case specific. In **T 2080/22**, the semicolon did not alter the meaning.

1.4. Removal or replacement of features from a claim

1.4.1 Broadening of claim – permissible within the limits of the original disclosure

The deletion of a feature in a claim as filed may lead to a broadening of the claim. According to **G 1/05** (OJ 2008, 271, referring to **G 1/93**, OJ 1994, 541), the applicant has a right to amend the claims so as to direct them to subject-matter not encompassed by the claims as filed. It is only after grant that the interests of third parties are further protected by Art. 123(3) EPC and the patentee's right to amend the claims is limited by the scope of the granted patent.

In **T 133/85** (OJ 1988, 441) the board held that it was possible to broaden a claim (i.e. to extend the protection conferred by it) without contravening Art. 123(2) EPC, provided that the subject-matter which was within the claims for the first time as a result of the amendment was already disclosed within the content of the original application as filed (confirmed e.g. in **T 732/00**, **T 273/04**, **T 1211/05**).

In **T 66/85** (OJ 1989, 167) it was pointed out that if a technical feature was deleted from a claim in order not to exclude from protection certain embodiments of the invention, the broadening of the claim did not contravene Art. 123(2) EPC 1973 as long as there was a **basis for a claim lacking this feature** in the application as originally filed (see also **T 228/98**).

In **T 1724/08** the board held that the broadening of individual disclosed features, in particular those of an independent claim as filed, was not prohibited by Art. 76(1) EPC 1973; such amendments likewise required a direct and unambiguous disclosure in the earlier application as filed (see also **T 1727/09**).

1.4.2 Basis in the application as originally filed – gold standard

The requirement of Art. 123(2) EPC as applied to the claims means that it is only permissible to delete features from an independent claim if there is a clear and unambiguous basis for a claim lacking these features in the application as originally filed (**T 1726/06**, referring to **T 66/85**, OJ 1989, 167, and **T 558/13**).

The board in **T 755/12** pointed out that, although some tests such as the essentiality test (see in this chapter II.E.1.4.4 below) have been used as an **aid** in assessing the

allowability of amendments, they could not replace the need to answer the question of what a skilled person would objectively have derived from the description, claims and drawings of a European patent application on the date of filing (**G 3/89**, OJ 1993, 117, see in this chapter II.E.1.3.1 "Gold standard: directly and unambiguously derivable" above). For further decisions highlighting that these tests are only tools and do not take the place of the "gold standard", see **T 648/10**, **T 68/21** and the decisions cited in chapter II.E.1.4.4 b) and II.E.1.4.4 c).

1.4.3 Omission of a feature presented as essential

For cases in which the amendment consists of the replacement or removal of a feature from an independent claim, the boards occasionally apply the test of decision **T 260/85** (OJ 1989, 105). In **T 260/85** it was stated that it was **not** permissible to delete from an **independent claim** a feature which the application as originally filed **consistently presented as being an essential feature** of the invention, since this would constitute a breach of Art. 123(2) EPC 1973. See also **T 496/90**, **T 415/91**, **T 628/91**, **T 189/94**, **T 1032/96** (segment length parameters explained as essential), **T 728/98** (OJ 2001, 319; concerning the deletion of the feature "substantially pure"), **T 1040/98** (acoustic waveguide is described in the form of a bladder filled with a suitable material, throughout the description), **T 1390/15** (consistent disclosure of solubility limit on the content of Mg and Cu) and **T 1187/15** (consistent disclosure that heart rate can be derived from the blood pressure measurement). For recent decisions following this approach, see **T 1099/21** and **T 897/20**.

In **T 236/95** the board held that if the problem could not be solved without the features concerned, they could not be considered unimportant.

In **T 784/97** the patent proprietor alleged that a prior art document would have made the skilled person aware that the disputed feature was not essential. The board held that whether or not a feature of an independent claim had to be seen as "essential" could **not be a question of the prior art disclosure**. Rather, what had to be decided was what a skilled person was taught by the originally filed documents.

In **T 1515/11** the board confirmed that a feature could not be deleted from an independent claim if it had been consistently presented as an essential feature of the invention, since this would add subject-matter. In some cases there might be room for debate as to whether the application presents a feature as being essential to the invention or as being optional. However, there were also cases where, on purely formal grounds, the essentiality of a feature could not be doubted. One such case was where the applicant chose to include in an independent claim as filed a feature explicitly mentioning the problem, and affirming that the claimed subject-matter represents a solution to the problem. In particular, where a claim to a method included a feature explicitly defining that the method was carried out in a manner which solved the problem, to argue that this feature was not essential would be tantamount to arguing that in order to solve the problem, it was not essential to carry out the method in a way which solved the problem.

The board in **T 648/10** confirmed the test set out in **T 260/85**. However, it observed that **the EPC does not require the use of any particular tests** when assessing whether subject-matter has been added. Instead, such tests are **tools** which may be helpful, in certain situations, in the assessment of whether subject-matter has been added.

1.4.4 The essentiality or three-point test

a) Decisions setting out the test

In **T 331/87** (OJ 1991, 22) the board, building on **T 260/85** (OJ 1989, 105) set out a three-point test. The board held that the replacement or removal of a feature from a claim might not be in breach of Art. 123(2) EPC 1973 if the skilled person would directly and unambiguously recognise that (1) the feature was not explained as essential in the disclosure, (2) it was not, as such, indispensable for the function of the invention in the light of the technical problem it served to solve, and (3) the replacement or removal required no real modification of other features to compensate for the change (frequently applied until 2012, see e.g. **T 708/07**, **T 775/07**, **T 2359/09**, **T 747/10**, **T 207/10**; now seldom applied, but see **T 1906/12**). This test is sometimes referred to as the essentiality test (see e.g. **T 2359/09**, **T 2599/12**, **T 2489/13**). Note that the Guidelines (H-V, 3.1 – April 2025 version) contain a modified three-point test.

b) Mere aid in assessing the allowability of amendments

The board in **T 1472/15**, citing **T 2311/10** and **T 1852/13**, held that, contrary to how **T 331/87** had often been misinterpreted, the "essentiality test" was not absolute vis-à-vis the "gold standard" and could merely be used as an aid in ascertaining what had been originally disclosed (see also e.g. **T 648/10**, **T 755/12**, **T 2095/12**, **T 2599/12**, **T 46/15**, **T 1420/15**, **T 85/16** and **T 1189/16**). The "essentiality test" cannot take the place of the "gold standard" (**T 172/17** and **T 1134/19**).

c) No longer considered appropriate

According to **T 1365/16**, in the more recent jurisprudence of the boards of appeal, the so-called "essentiality test" (as set out in **T 331/87**, see point a) above) is no longer considered appropriate (see also e.g. **T 1852/13**). In the same vein, **T 2421/18**, **T 1736/18**, **T 1529/19**, **T 2432/19**, **T 435/21**, **T 1441/21**, **T 1638/21**.

As highlighted by numerous decisions, it is the requirements of the "gold standard", which ultimately must be met when assessing **any** amendment for its compliance with Art. 123(2) EPC and by analogy with Art. 76(1) EPC (**T 838/16** with reference to **T 1852/13** and **T 755/12**; see also **T 1462/14**, **T 1869/17**, **T 71/19** and **T 1270/20**). Several decisions have concluded that the essentiality test set out by decision **T 331/87** was moot and should not be applied (**T 2311/10**, regarding intermediate generalisation; **T 2599/12**, **T 830/16**, **T 1365/16**, **T 437/17**; see also the further decisions cited in this chapter in II.E.1.4.4e)).

d) Necessary but not sufficient condition

In **T 437/17** the board, in line with several decisions such as **T 1472/15** and **T 1852/13**, held that fulfilling the three criteria of the "essentiality test" as set out in **T 331/87** (OJ 1991, 22) was a necessary requirement but not a sufficient one for compliance with Art. 123(2) EPC. The board further underlined that, in any case, this test could not replace the "gold standard" and should not lead to a different result than when applying the "gold standard" directly.

e) Decisions criticising the essentiality or three-point test

In **T 910/03** the board criticised the second condition of the essentiality test (omitted feature not, as such, indispensable for the function of the invention in the light of the technical problem it serves to solve). The board criticised this approach in the light of **G 2/98** (OJ 2001, 413) for being tantamount to making a distinction between technical features which were related to the function and the effect of the invention and, on the other hand, technical features which were not.

In case **T 2311/10** which concerned an intermediate generalisation, the board expressed the view that the three-point or essentiality test was unhelpful or even misleading (see also **T 1840/11**, **T 2095/11**, **T 2095/12**). In particular, the board highlighted, with regard to the second criterion, that the test of **T 331/87** necessarily had to relate to the problem derivable from the application as it concerned the disclosure of the application. This was however not always observed.

In **T 1852/13** the board concluded that the three-point essentiality test developed in **T 331/87** should no longer be used (similarly **T 830/16**): in view of that earlier decision's wording ("may not"), logic alone dictated that it could not be congruent with the "gold standard" (**G 2/10**). Indeed, even the board that had developed the test had acknowledged that it might be met, yet Art. 123(2) EPC still infringed. Although the essentiality test could be a useful indicator in certain cases, the "gold standard" was the only test that counted (see **T 755/12**). Moreover the Enlarged Board, in **G 2/98**, ruling on when a priority claim was valid, had rejected the essentiality-based approach taken in **T 73/88** (Snackfood), laying down instead a condition analogous to the "gold standard", and its concern that evaluations of essentiality might be arbitrary applied to amendments too. After considering the reservations expressed in **T 404/03**, the board agreed with **T 910/03** that the conclusion to be drawn from **G 2/98** was that the essentiality test should no longer be applied. Another advantage of the "gold standard" over the essentiality test was that it was a single test for all types of amendment. See also **T 422/16** (agreeing with **T 1852/13** in the context of Art. 76(1) EPC) and **T 833/16**.

1.4.5 Removal of set of features

In **T 211/95** the examining division had refused a divisional application on the grounds that a set of features from the original claim of the parent application was entirely missing from the claim of the divisional application. The board was unable to accept this. It held that the requirements under Art. 76(1) EPC 1973 would be met if it was obvious for the skilled

person that there were **two technically unconnected teachings** which could be claimed separately, and if the skilled person clearly saw that the set of features according to the subject-matter claimed in the parent application was **not essential** to the subject-matter claimed in the divisional application. In the case at hand, the subject-matter of the divisional application was directly and unambiguously disclosed in the parent application. See also **T 341/06** and **T 694/07**.

1.4.6 Removal of a feature indicating the intended purpose

In **T 448/03** the claim as granted referred to an "apparatus for ejecting liquid or powdered medium", whereas claim 1 and the description as originally filed referred to an "apparatus for impulse fire extinguishing". The board observed that according to case law, "for" had to be interpreted as meaning "suitable for" and thus "for" did not limit the use of the apparatus to extinguishing fire exclusively. However, the fact that the apparatus was suitable for a given use or was suitable to contain a specific medium implied specific requirements regarding the material the apparatus was made of and its capacity to contain the volume of medium which was necessary to achieve the expected effect, which was to extinguish fire. See also **T 1143/17** where the board held that the feature "usable in a process of extrusion coating ..." could only be removed without extending the subject-matter if all compositions defined by amended claim 1 could be used in such a process.

In **T 653/03**, the original term "diesel engine" in claim 1 was replaced by the term "combustion engine". Thus, the suitability of the claimed method had been generalised. The board did not share appellant 1's view that the intended purpose of the method did not provide a technical contribution to the invention. The technical contribution was that the amended method had to be suitable for any type of combustion engine. Whether the method steps needed real modification or not was irrelevant when the amendment of the claim was not supported by the original application. See also **T 923/13** concerning the deletion of the words "for paper containers".

For cases where the removal of a use or purpose feature was considered allowable, see however e.g. **T 692/97**, **T 835/97** and **T 235/99**. See also **T 308/13** where the board came to the conclusion that a certain clause in the description addressed the intended purpose rather than a further functional definition of the claimed compounds and therefore did not need to be included in the claim to avoid an intermediate generalisation.

1.4.7 Elimination of inconsistencies and unclear features

a) Amendment allowed

In **T 271/84** (OJ 1987, 405) it was stated that an amendment to a claim to clarify an inconsistency did not contravene Art. 123(2) or Art. 123(3) EPC 1973 if the amended claim had the same meaning as the unamended claim, on its true construction in the context of the specification.

In **T 758/92** the board allowed the deletion of a feature because it was clearly inconsistent with the teaching disclosed in the application as filed, and there was a clear basis in the

original disclosure for its deletion. A skilled reader of the original application documents would have realised that the feature to be deleted was erroneously introduced in the claim because the resulting definition was contradictory to the functioning of the described embodiment of the invention.

In **T 609/95** the board took the position that where a drafting defect or inconsistency in an application would be evident to a reader skilled in the art, the person to whom the application is addressed, it is reasonable to suppose that the skilled person would, in the light of the content of the application, attempt to formulate a notional amendment which would enable them to make sense of what they are reading, and to the extent that the amendment might be said to leap to the mind of the reader, although perhaps only after close study of the document, it can be regarded as implicit in the application and would not contravene Art. 123(2) EPC 1973, if effected in practice (see also **T 887/97** for such amendment during opposition appeal proceedings).

b) Amendment not allowed

In **T 1464/05**, however, the board said that the attempt of the respondent (patent proprietor) to see in the upper ends of range values a removable inconsistency in the application as filed could not, in the context of a wholly consistent and clear disclosure of the application, be accepted.

In **T 1099/21** the board explained that any unclarity that may arise from an ambiguity in an application as filed was to the detriment of a patent proprietor, who was ultimately responsible for the drafting of the application as filed and its claims. The fact that a feature in the application as filed was unclear could not therefore justify or excuse the complete deletion of the unclear feature or its replacement by another feature if this resulted in an extension beyond the content of the application as filed.

c) Article 84 EPC and Article 123(2) EPC – alleged inescapable trap

In **T 81/13** the board refused claim 1 of the main request as it contained a viscosity feature which the board considered not clear (Art. 84 EPC). In claim 1 of the auxiliary request the appellant deleted this viscosity feature and argued that an unclear and unmeasurable viscosity value was not essential and could be omitted for this reason from the claim; this omission should also be possible to escape the Art. 84 EPC and Art. 123(2) EPC "squeeze", which would lead to an "inescapable trap". The board held that this parameter was revealed to be unclear but remained an essential feature since, even unclear, it conferred on the composition a particular aspect and reflected a composition having specific and essential properties. Also, the presence of an unclear essential feature in a claim did not inevitably lead to an "inescapable trap". If the omission of such feature reflecting essential properties of a claimed product was not possible, its replacement by an equivalent feature providing inevitably the same essential property could be considered as normally feasible. This was usually possible through the incorporation of adequate technical features able to provide inevitably said property. As a last resort, the claimed subject-matter could even have taken the form of an exemplified subject-matter. In the

case at issue, the application as originally filed presented a disclosure deficiency and if there was an inescapable trap, it was rather linked to this deficiency.

The case law on the "inescapable trap" between the requirements of Art. 123(2) EPC and Art. 123(3) EPC is reported in chapter II.E.3.

1.5. Ranges of parameters – setting upper and lower limits

1.5.1 Forming a range by combination of end points of disclosed ranges

a) Combination of the preferred narrower range and one of the part-ranges lying within the disclosed overall range

In **T 925/98** the board held that, according to the established case law, in the case of a disclosure of both a general and a preferred range, a combination of the preferred disclosed narrower range and one of the part-ranges lying within the disclosed overall range on either side of the narrower range was unequivocally derivable from the original disclosure of the patent in suit and thus supported by it (see **T 2/81**, OJ 1982, 394; **T 201/83**, OJ 1984, 481; and **T 53/82**, **T 571/89**, **T 656/92**, **T 522/96** and **T 947/96** all referring to **T 2/81**). In the case in point, moreover, graphs indicated that the claimed range was in fact the most efficient one. This frequently cited decision and/or its principles were referred to, for example, in **T 328/10**, **T 2001/10**, **T 227/13**, **T 223/17**, **T 516/18**, **T 476/21**. See also **T 1107/06**, **T 171/21**, **T 630/21** and T 2177/21.

In **T 249/12** the board allowed the amendment to the range of "10-50 mass %", which combined the use of the upper limit of the less preferred broader range (50 mass %) and the lower limit of the most preferred narrower range (10 mass %). Since both end points of the new range were both specifically mentioned in the application as filed, the new range was "unequivocally and immediately apparent to the skilled person" (**T 2/81**), i.e. the range was directly and unambiguously disclosed in the application as filed. See also **T 1143/17** which relates to the combination of the lower-end point of a preferred range with the upper-end point of a more preferred range.

In **T 2514/16**, the board observed that it was allowable to combine thresholds from different levels of preference as long as the new range could be regarded as directly and unambiguously disclosed for the skilled person (**G 2/10**, OJ 2012, 376). This would depend on how the skilled person would construe the amended claim and whether, on the basis of the common general knowledge in the art, they would consider the application to disclose the subject-matter at least implicitly; this would need to be assessed depending on the specific facts of each case. In the case in hand, the disputed amendment had been taken from a passage of the description as originally filed, with the particularly preferred lower value having been combined with the especially preferred higher value. The board found the amendment to be directly and unambiguously derivable from the original application, noting that it amounted to a limitation of a parameter that had been implicitly present in the original claims, not a selection from alternative embodiments set out in the original disclosure.

The board in **T 193/17** distinguished the case from **T 925/98**. It underlined that in **T 925/98** the general and the preferred ranges were disclosed in combination, since independent claim 1 as originally filed disclosed a basic range of 30 to 60%, while claim 2 as originally filed, which depended on claim 1, disclosed a preferred range of 35 to 50%. By contrast, in the case underlying **T 193/17** the end points of the two ranges claimed (regarding thickness of the surface coating and particle size) were disclosed in four different dependent claims as originally filed, which each depended exclusively on claim 1. Moreover, **T 925/98** dealt with the range of a single parameter, whereas present claim 1 related to the introduction of two parameters.

In **T 516/18** the application as filed disclosed two alternative values for each one of the upper and lower limits of the range at stake. The board considered that the person skilled in the art was directly and unambiguously provided with the information that any one of the upper and lower limits proposed could be combined in order to select a suitable range, irrespective of the fact that they were presented as "preferable" or "more preferable" values. The board also noted that, in line with established case law (see e.g. **T 925/98**), when a disclosure of a general and a preferred, narrower range was provided in the originally filed application, a combination of the narrower range with one of the partial ranges lying within the disclosed general range and located on either side of the narrower range would be considered directly and unambiguously derivable from the originally disclosed ranges.

b) Combination of the lower limit of the general range with the lower limit of the preferred range

In **T 1170/02** the board held that the combination of the lower limit of the general range with the lower limit of the preferred range, thus **excluding the preferred range**, did not fall under the principles developed in decision **T 2/81** (OJ 1982, 394). In such a case, it might be useful to ask whether the skilled reader of the parent application would **seriously contemplate** working in the range referred in the divisional application or alternatively whether there was anything in the parent application as filed or his common general knowledge which would cause him to exclude the possibility of working in that range (with reference to **T 187/91**, OJ 1994, 572). To the board, the skilled person would, in view of the data in the parent application, seriously consider working beyond the lower limit of the preferred range as well. Under these circumstances, the range could be directly and unambiguously derived from, and is consistent with, the parent application as originally filed. See also **T 205/13**.

Likewise, in **T 1389/08**, the board considered that the skilled reader would seriously contemplate exploiting the whole disclosed range, including the less suitable range. There was nothing in the parent application as filed or the common general knowledge which would cause the skilled reader to exclude the possibility of working in that range.

In **T 612/09**, however, the board did not agree with the finding of **T 1170/02** that the principles developed in **T 2/81** (OJ 1982, 394) were not applicable to situations where the range resulted from the combination of the lower limit of the general range with the lower limit of the preferred range. The board in **T 612/09** observed that **T 2/81** had established

a two-step approach. In the first step, it had considered that the two part-ranges of the general range (in **T 612/09**: 3 to 75 mg/kg) lying outside the preferred range (in **T 612/09**: 10 to 25 mg/kg) would be unequivocally and immediately apparent to the person skilled in the art. It had then considered that no new matter was introduced by combining the preferred range with the upper part-range. The board in **T 612/09** considered that only the first step of the analysis carried out in decision **T 2/81** was necessary to arrive directly and unambiguously at the claimed range. Indeed, the board held that the two part-ranges lying within the overall range on either side of the narrower range (a dose of 3 to 10 mg/kg and a dose of 25 to 75 mg/kg) were directly and unambiguously disclosed to the person skilled in the art. See also **T 2159/11** and **T 14/19**. In **T 612/09** the board further noted that it could not derive from decision **T 201/83** the requirement that the value on which a sub-range was to be based had necessarily to be disclosed in an example.

In **T 113/19** the board explained that, although the sole example was not covered by the newly claimed range, this did not mean that range could not be directly and unambiguously derived from the application as filed (**T 1389/08**). In its view, a person skilled in the art reading the application as filed in the case in hand would regard a composition as having the required property if it had (for the feature in question) a value that was at least equal to the lower threshold of the general range, but would deem those compositions with values above the upper threshold to be even better. The board concluded that the range as claimed – which was limited to what could be deemed satisfactory and excluded anything considered even better – was directly and unambiguously inferable from the teaching of the application as filed.

Underlining the pivotal role of the "gold standard", in parallel cases **T 2241/22** and **T 2242/22**, the board explained that any test or condition applied by a board in a particular case (such as a the "seriously contemplate" criterion in **T 1170/02**) should simply be considered an aid in assessing the allowability of amendments, and not a substitute for the "gold standard".

c) End points which are not part of a range

In **T 1919/11** the subject-matter of claim 1 of the main request related to silver at a concentration of at least 1µM to less than 200µM. In the description, it was stated in two separate consecutive sentences that "When silver is incorporated in the medium, it will be added at a concentration of less than 900 µM, preferably less than 500 µM, and more preferably less than 200 µM" and "When silver is incorporated in the medium, it will be added at a concentration of at least 10 nM, preferably 100 nM, more preferably 1 µM, and typically at 10 µM". The board observed that the situation in the case at issue was not comparable with that in **T 1107/06** and dealt with in the settled jurisprudence of the boards of appeal. A general range, which means a lower limit which is unequivocally combined with an upper limit, and a preferred disclosed narrower range – equally consisting of a lower limit which is unequivocally combined with an upper limit – were simply missing. Even a kind of parallel structure in indicating the upper and lower limits (less/at least, preferred or more preferred) implied **no unequivocal correlation between a particular upper limit and a particular lower limit** because there was no teaching that such an arrangement was intended. Therefore, one of the upper limits mentioned in the first

sentence in the description of the parent application as originally filed (as cited above) and one of the lower limits mentioned in the second sentence were arbitrarily combined, which did not represent a direct and unambiguous disclosure.

d) Combination of an end point of a range with a value from a list of individually disclosed values

In **T 1320/13** claim 1 defined a specific ratio in the range of "between 0.6 and 1". The appellant argued that the range had a basis in the disclosure of the range "0.1 and about 1" in claim 5 in conjunction with the value "0.6" disclosed in a **list of individual values**, which read: "about 1.0, 0.9, 0.8, 0.7, 0.6, 0.5, 0.4, 0.3, 0.2, 0.1 or even 0, derivable therein". The board held that **T 2/81** did not apply in the case at issue. The skilled person would not regard the list of individually disclosed values of ratios on page 5 of the application as individual end points of ranges. Firstly, a list of individual values – even if disclosed as here in descending order – did not relate to values that lie between them, while a range necessarily encompasses all the values that lie between its two disclosed end points, i.e. a list of individual values is conceptually different from a range. Secondly, the list contained no pointers to a particular combination of ratio values. Accordingly, a specific selection of values also did not clearly and unambiguously emerge for the skilled person from the content of the application.

e) Combination of end points of different levels of preference for several aspects of a composition

In **T 948/13** the subject-matter of claim 1 of auxiliary request 3 had been generated by combining a number of numerical ranges of different levels of preference (general range, most preferred range) for various aspects of the composition. The board held that the selection of these ranges in combination was neither disclosed as such nor otherwise suggested in the application as originally filed.

For a further case in which each of the added features (including ranges of parameters) were, in the board's view, disclosed in the application as filed, though not in combination, see e.g. **T 1853/13** (with regard to claim 1 of auxiliary request 2).

In **T 2514/16**, the board considered it allowable to combine thresholds from different levels of preference (see the summary in chapter II.E.1.5.1a) above). It also found that combining this limitation with a second amendment (limiting the amount of metal cation with end points in line with the most preferred embodiment) was directly and unambiguously derivable from the original application. It noted that the two amendments amounted to a limitation of a feature that had already been present in original claim 2, with both features characterising the salt that was necessarily used in the claimed method (see also the summary in chapter II.E.1.6.1c) below).

1.5.2 Forming a range with isolated value taken from example

a) Principle

In **T 201/83** (OJ 1984, 481) the board came to the conclusion that the amendment of the concentration range for a claimed mixture, such as an alloy, was admissible on the basis of a value described in a specific example, provided that the skilled person could have readily recognised that this value was **not so closely associated with the other features of the example** as to determine the effect of that embodiment of the invention as a whole in a unique manner and to a significant degree. In the case at issue, the new limit could be deduced from the original documents.

As pointed out in **T 1556/16**, limiting an originally disclosed broader range using an isolated value taken from an example may be allowed, if it does not present the skilled person with information that goes beyond the content of the original disclosure. In the case in hand, after a detailed analysis of the application's disclosure, as understood by the skilled person, the board held that the skilled person was not presented, by the particular selection, with new information.

b) Amendment allowed

The board in **T 876/06** applied the principle established in **T 201/83** and came to the conclusion that the skilled person could have recognised in the application as originally filed that the weight ratio of liquid rubber to solid rubber was not so closely associated with the other features of the examples as to determine the effect of the invention as a whole in a unique manner and to a significant degree. Thus, it was permissible to use the particular value used in several examples to limit the range of the weight ratio of liquid rubber to solid rubber. The limitation of the claim represented merely a quantitative reduction of a range to a value already envisaged within the document and not an arbitrary restriction providing a technical contribution to the subject-matter of the claimed invention.

In **T 1188/10** the new range of 0,006% to 0,015% was formed by taking, as end points, single values from examples 2 and 4 relating to the use of LAE as preservative in two different specific food products at different growth temperatures. In order to assess whether this new range complied with Art. 123(2) EPC it had to be considered whether a skilled person, in analogy to **T 201/83**, would generalise these values in the sense that he would recognise them as not only associated with the specific food products and temperatures used in the examples. In the case at issue, this was the case so that the range claimed complied with Art. 123(2) EPC.

For a further decision, where the board considered that the values taken from the examples and used as the end points of the claimed range could not be seen only in the context of all the other parameters given there, see **T 343/90**, in which the relevant amendment complied with Art. 123(2) EPC.

c) Amendment not allowed

In **T 526/92** the board held that if values of a parameter are only given in the examples (as single, punctate values), without the significance of this parameter becoming evident from the original specification, no range must be arbitrarily formed, which is open-ended at one side and has one limit selected from the examples.

Similarly in **T 1004/01**, according to the board, the exemplified laminates and the peel strength thereof were disclosed only in a concrete technical context, without providing any preference for the claimed open-ended range taking the exemplified parameter value as lower limit (peel strength "of at least 24 grams").

Decision **T 526/92** was approved and cited by **T 931/00** – also referring to **T 201/83** (OJ 1984, 481) – which concerned the creation of a new parameter range by defining its upper limit by selecting a single value from an example. The board in **T 931/00** stated that although figures in examples might, under specific conditions, be used to limit a range which was already present in the original application, they could not be used to define an **entirely new relationship between parameters** which had never been linked before. Such arbitrary new links between existing parameters introduced new matter, contrary to the requirements of Art. 123(2) and Art. 100(c) EPC 1973.

The board in **T 1146/01** had to answer the question of whether one measurement of a selected characteristic or property of a sample disclosed only in an individual example could be relevant to the generality of the claimed subject-matter, separately from and irrespectively of the other parameters inherent to the same sample. The board distinguished this case from **T 201/83**. Formulating a new range on the basis of individual values taken from selected examples, which were **not at all directly related to each other**, meant that the reader was confronted with new information not directly derivable from the text of the application as originally filed.

In **T 184/05** the board held that an impurity concentration value of a product obtained under specific process conditions could not be taken in strict isolation from the examples unless it had been demonstrated that this value was not so closely associated via the applied process with specific (undisclosed) maximum values of all other impurities comprised in the product.

In **T 570/05** the proposed amendment was that the coating layer had a "thickness of from 220 to 500 nm", for which the only literal basis in the application as originally filed for the lower value of 220 nm was to be found in three examples; nowhere in the documents as filed did this value form the lower (or indeed any) end point of a range of thicknesses. Recalling the relevant case law namely, **T 201/83**, **T 1067/97** and **T 714/00** (see also in this chapter II.E.1.9. "Intermediate generalisations"), dealing with extracting an isolated feature, the board examined whether or not there existed a **functional or structural relationship** between the coating layer thickness, in particular its lower limit, and the remaining features of the claim. The board concluded that the condition of absence of any clearly recognisable functional or structural relationship was not satisfied in the present case.

In **T 517/07** a newly introduced upper limit had been disclosed in the original application documents only as an isolated value in example 1. The board decided that **singling out** an individual value from a specific embodiment and applying it as a new upper limit in claim 1 created a new – now capped – value range that was not disclosed in the original documents.

1.5.3 Setting new end point with not expressly disclosed value – "less than", "below" and rounding values

T 985/06 concerned amending the upper limit of a range, supported in the description as filed, to a new (lower) value not thus supported, by changing it from "1.05:1 to 1.4:1" to "1.05:1 to less than 1.4:1". The board acknowledged that "1.05:1 to 1.4:1" included all values within the stated range. However, the application as filed disclosed only the range in general; it did not specifically, and thus directly and unambiguously, disclose all values within it. The amendment therefore contravened Art. 123(2) EPC.

In **T 1990/10** the board had to decide whether the application as filed provided a basis for the temperature range "below 35°C" in claim 1. The application as filed disclosed various temperatures, both specific temperature values ("30°C") and temperature ranges, such as open-ended ranges ("below 37°C") and closed ranges with defined upper and lower-end values ("30°C to 35°C"). The board considered that the term "below" was explicitly disclosed only for defining the broadest mentioned temperature range, namely "below 37°C". The board held that "below 35°C" was also not implicitly derivable from the broadest open-ended range "below 37°C" in combination with the upper-end value of the closed range "30°C to 35°C". Applying the criteria of **T 2/81**, the combination of the lower-end and the upper-end values of the closed range with the broadest temperature range would result in the temperature ranges "30°C to below 37°C" and "35°C to below 37°C", not however, in the open-ended temperature range "below 35°C". In addition, the closed temperature range "30°C to 35°C" included the specific temperature "35°C" whereas the open-ended range "below 35°C" in claim 1 explicitly excluded this value.

In **T 83/13** claim 1 as granted included the feature "an amount of less than 15% by weight", whereas the claim as filed and the original description had mentioned amounts of between 5% and 20% and between 8 and 15%. In the board's view, the wording "an amount of less than 15% by weight" included concentration values differing by one or more decimal places from which, depending on the precision of the measurement method or simply by applying rounding rules, the whole value of "15% by weight" could be arrived at. Replacing the concentration value of "15.0% by weight" with "an amount of less than 15% by weight" did not change the technical teaching or constitute a new technical function in relation to the claimed concentration range; from a technical perspective, the scope of protection remained the same even after the amendment (see **T 112/10**). The board added that its decision was consistent with the boards' case law on novelty and rounding values (see **T 234/09** or **T 1186/05**).

In **T 1986/14** claim 6 of the main request was amended by including the features "glycerin in an amount ranging from 50% to 90% by weight of the composition". The appellant argued that the amount of glycerin in claim 6 found a basis in the application as originally

filed, which read "glycerin moisturizer can be present individually in an amount ranging from about 50.00% to about 90.00% by weight". The board held that it was undisputed that 50% and 50.00% differed in their accuracy. For this reason, the values 50.00% and 90.00%, on their own, could not provide a basis for the features 50% or 90%. The applicant argued, however, that the use of the term "about" in the passage mentioned above indicated that it was not intended to restrict the claimed amount to ranges defined by end points with four significant figures. For the board, the feature "about 50.00% to about 90.00%" disclosed a range with two end points, namely 50.00% and 90.00%, and an area of undefined boundaries around them. No other end point, such as 50% or 50.0%, was either implicitly or explicitly disclosed.

In **T 2203/14**, the upper limit of the range relating to the thickness of the corrosion resistant layer in claim 1 as filed "approximately 5 microns" was amended to "approximately 5.0 micrometers" in view of prior art disclosing a value of 5.2. The board recalled that according to case law, when comparing a value from the state of the art with a claimed value, the state of the art value had to be given the same accuracy as the one claimed (citing **T 871/08** of 8 December 2011 and **T 175/97**). Therefore, "approximately 5.0" and "approximately 5" could – in the case at issue – not have the same meaning. The application as filed consistently mentioned only the value of 5 micrometers for the corrosion resistant layer. The fact that the upper limit of another layer in the application as filed was given as 5.0 and 5 had no bearing on the value at issue since the two layers were not linked to such a degree that a certain accuracy for one layer would inevitably imply the same accuracy for the other layer. The board concluded that the amended value "approximately 5.0" was not directly and unambiguously derivable from the application as filed.

1.6. Combination of features pertaining to separate embodiments or lists

According to well-established case law, a single feature may normally be taken from a single list and be incorporated into a claim without contravening Art. 123(2) EPC. If features from more than a single list are combined, there generally needs to be a pointer for each of the selections made such that the combination of selected features can be considered disclosed in the application as filed (**T 1878/19**).

1.6.1 Combination of features pertaining to separate embodiments; application as filed is not a "reservoir"

a) Principles

The content of an application must not be considered to be a reservoir from which features pertaining to separate embodiments of the application could be combined in order to **artificially create a particular embodiment** (**T 296/96**, **T 686/99**, **T 1206/01**, **T 3/06**, **T 1206/07**, **T 1041/07**, **T 1239/08**, **T 1648/11**, **T 1799/12**, **T 1853/13**, **T 1775/14**). In the absence of any **pointer** to that particular combination, this combined selection of features does not, for the person skilled in the art, emerge clearly and unambiguously from the content of the application as filed (**T 686/99**, **T 1853/13**, **T 1252/13**, **T 2680/19**, **T 1133/21**, **T 1809/20**). The fact that features in question have been mentioned in the description as

"preferred" may act as a pointer (**T 68/99**, **T 1869/11**, **T 394/11**, **T 1799/12**, **T 1332/21**; for counter-examples, see however **T 2118/08** and **T 1306/12**). In **T 1728/16** the fact that two of the features introduced in the claim at issue were disclosed as being preferred was seen as a pointer to their combination with the third amendment which introduced generally disclosed percentage ranges. In **T 1199/21**, the board held that passages of the application as originally filed, even if they referred to preferred features, could not be combined at will if the combination was not directly and unambiguously derivable from the application as originally filed.

In **T 524/17** appellant 2 had argued that the features of claim 1 were picked from different embodiments. The board however pointed out that in the application at issue the expression "in one embodiment" referred to general teachings of preferred features which were combinable without going beyond the content of the application as filed. See however also **T 1442/16**.

In **T 3142/19** the examining division considered that in the absence of a positive hint to a combination of features that are otherwise presented as optional, any such combination was new technical information. In the board's view however, this argument was valid only in its positive form: if the description indicated that some combination was desirable, or necessary to solve a technical problem, then a clear pointer to disclosure of the combination was provided. If not, however, it did not automatically mean that the skilled person could not derive the combination from the application as filed. But an excessive number of optional features could have an impact on the assessment of compliance with Art. 123(2) EPC, in that, in a forest of optional features, a singled-out individual combination may not be clearly and unambiguously derivable by the skilled person. Whether this was indeed the case depended on the specifics of the case, e.g. on the level of complexity caused by the optional features.

In **T 2155/19** the board was not persuaded by the respondent's contention that the repeated use of the word "may" in relation to the disclosure of a plurality of features implied they were all optional. The detailed description as filed disclosed nearly every feature therein as possibly being included in the inventive system with wording such as "may be", "may provide", "may include" etc. The result was a reservoir of features in the description which may or may not be part of the invention. The selection of just one of these optionally disclosed features for inclusion with the other features in claim 1 in isolation from related features described with similar emphasis, and even in the same paragraph as the feature taken-up into the claim, was thus not seen to meet the requirement of a direct and unambiguous disclosure of the claimed subject-matter in the application as filed. See also **T 1748/19**.

In **T 1137/21** the board observed that the appellant had not indicated a single passage of the original application that disclosed – in combination – the features of claim 1 of the main request. Claim 1 of the main request was the result of a multiple selection of a very specific combination of features from different dependent claims as originally filed. These selections were made from among numerous possibilities and different degrees of preference. In view of the sheer number of possibilities, the subject-matter of claim 1 was not directly and unambiguously derivable from the dependent claims, even when the

general part of the description was taken into account. It was true that the inventive examples still fell under claim 1 of the main request. However, these examples were not sufficient as a pointer to the specific selection defined in claim 1 since they fell under the most preferred options of the various parameters and ranges. Claim 1 thus corresponded to a multiple selection from a large number of lists and possibilities without a specific pointer.

For examples where the above principles were applied in the case of divisional applications in respect of the earlier application as filed, see **T 2118/08**, **T 961/09**, **T 1581/12**; see also the reference in chapter II.E.1.1. to **G 1/05** (OJ 2008, 271).

b) Examples of cases where the combination was held to be unallowable

In **T 389/13** the composition of claim 1 was defined on filing in a broad manner, its definition including a few structural features as well as two ranges of parametric values, with an indication in the rest of the application of preferences for said structural features and a definition of additional parameters which might be used to characterise the composition, as well as corresponding ranges of values. Subsequently some limits were introduced on the basis of said preferences or on the basis of said additional parameters and corresponding ranges of values. The board emphasised that allowing those various restrictions without there being any – even implicit – indication in the application as filed that the specific combination was envisaged would be unfair to third parties. It would give an applicant who filed a broad speculative claim an unwarranted advantage over other applicants who were the first to attribute any significance to a specific combination of parameters and their ranges of values encompassed by said broad original claim.

In **T 770/90** the board ruled that an **unduly broad claim** not supported by the description as originally filed was not a suitable "reservoir" for amendments.

In **T 296/96** the board stated that, when assessing whether a feature had been disclosed in a document, the relevant question was whether a skilled person would seriously contemplate combining the different features cited in that document. That was not the case in the application as filed.

In **T 2363/10** the board held that the selection of features disclosed in six out of one hundred and forty-three bullet points represented a particular selection which was not disclosed as such. The skilled person had **no hint or incentive** to choose exactly such a combination of features. The **general statement** "any such apparatus, means or method has or may have any of the following features" did not change this conclusion, since for a combination of selected elements to form a disclosure, additional information was required which directed the skilled person to this combination.

For a case where the original independent claim was combined with features from a plurality of dependent claims referring back to the independent claim separately ("US style" dependencies), see **T 1362/15**, summarised below in this chapter II.E.1.6.4.

For further cases concerning an unallowable combination of features see e.g. **T 659/97**, **T 1206/07**, **T 2044/07**, **T 1251/19**, **T 1054/22**.

c) Examples of cases where the combination was held to be allowable

In **T 1241/03** the board came to the conclusion that claims to formulations comprising compounds in specific concentrations did not need to have a literal basis in a single passage of the application as originally filed, as long as the exact concentrations and ranges claimed for the specific substances were disclosed as such in the original application. The claims at issue did not refer to a "patchwork" of parameters disclosed in non-connected parts of the description, nor had specific values been isolated from examples in a non-allowable way.

In **T 330/05** the board considered that the only feature added to the explicit disclosure, namely the concretisation of the polymer material, did not require any "selection" because each of the polymers listed on pages 14 -16 was clearly and unambiguously disclosed as an **appropriate alternative material**.

In **T 2514/16** the board considered whether the two amendments were directly and unambiguously derivable in combination from the original application. In its conclusion, it noted that the two amendments amounted to a limitation of a feature that had already been present in original claim 2, with both features characterising the salt that was necessarily used in the claimed method (contrast with **T 1115/14**). In these circumstances, the amendments were not to be considered a combination of features from different embodiments that had been combined to artificially construct a new embodiment. Instead, they were a limitation of both the definition and the amount of the base salt stated in original claim 2.

In **T 933/18** the board agreed with the opposition division that solely a selection of "10 µg or less" from a single list was required for selecting the disputed feature combination. The disputed feature combination was therefore directly and unambiguously disclosed in the application as filed.

1.6.2 Selections from two lists – singling out a combination of features

a) Principles

In **T 727/00** the board held that the combination – unsupported in the application as filed – of one item from each of **two lists** of features meant that although the application might conceptually comprise the claimed subject-matter, it did not disclose it in that particular individual form. For that reason alone, claim 1 of the main request was not supported by the description and contravened Art. 123(2) EPC. See also **T 714/08**, **T 1267/11** and **T 3035/19**.

According to **T 1621/16** it is established case law that, under certain circumstances, amendments based on multiple arbitrary selections from lists represent an extension of the content of the application as filed under Art. 123(2) EPC. However the board noted

that most decisions following this well-established approach related to amendments based on lists of non-converging alternatives. The board considered that selections from lists of converging alternatives should not be treated in the same way as selections from lists of non-converging alternatives (see the summary of this decision in point d) below). See also **T 1133/21**.

In **T 1937/17** the board held that, other than for the purposes envisaged in **G 1/93** (OJ 1994, 541), a "technical contribution" was of no relevance when deciding on the allowability of amendments under Art. 123(2) EPC. Instead, the "gold standard" set out in **G 2/10** (OJ 2012, 376) was the only criterion that had to be applied. See also **T 795/21**.

The board in **T 1511/07** held that although the selection of explicitly disclosed borderline values defining several (sub)ranges, in order to form a new (narrower) sub-range, was not contestable under Art. 123(2) EPC when the ranges belong to the same list, the combination of an individual range from this list with another individual range emerging from a second list of ranges and relating to a different feature was not considered to be disclosed in the application as filed, unless there was a **clear pointer to such a combination** (**T 1731/18**, **T 1408/21**, **T 1050/22**). According to **T 1149/20** it is established case law that a combination of features originally disclosed separately or selected from several lists may still be directly and unambiguously derivable from the original application in the presence therein of explicit or implicit pointers to said specific combination. For decisions applying this criterion, see in this chapter II.E.1.6.2c) below.

In **T 783/09** the board considered that in the case in hand the skilled person would directly and unambiguously recognise forty-four individual combinations, among them the three "basic" combinations referred to in claim 1. The board referred to the statement in decision **T 12/81** (OJ 1982, 296, in which this criterion was used in the context of novelty; see also above chapter I.C.6.2.) that if "two classes of starting substances are required to prepare end products and examples of individual entities in each class are given in two lists of some length, then a substance resulting from the reaction of a specific pair from the two lists can nevertheless be regarded for patent purposes as a selection and hence as new". The board noted that given the term "can" in this citation, the absence of a direct and unambiguous disclosure for individualised subject-matter was not a mandatory consequence of its presentation as elements of lists. Thus, the "disclosure status" of subject-matter individualised from lists had to be determined according to the **circumstances of each specific case** by ultimately answering the question whether or not the skilled person would clearly and unambiguously derive the subject-matter at issue from the document as a whole.

In **T 1710/09** the board insisted, however, that, in line with established jurisprudence, "can" within the meaning of **T 12/81** was to be a taken as a "is to". In view of the implications of freely interpreting this word "can" as in **T 783/09**, there was deep concern that in this way the uniformity of the disclosure assessment process could not be warranted.

In **T 1255/18**, referring to **T 783/09**, the board emphasised that, while conditions had been developed by the case law, such as the so-called "two-lists principle", they were not meant to be additional or alternative conditions, but only a possible aid in certain cases to verify

whether the "gold standard" was satisfied. The central question to be answered therefore was whether the claimed combination of features could be seen by the skilled person as directly and unambiguously derivable from the content as a whole of the parent application as filed.

In **T 3035/19** the board was of the opinion that, while the notion of selection from two lists was not meant to take the place of the "gold standard", it provided **valuable guidance** and found wide application in case law for the assessment not only of added subject-matter but also of novelty (see **T 12/81**, OJ 1982, 296, and CLB, 9th edn. 2019, I.C.6.2.). Consequently, in view of the importance of applying a uniform concept of disclosure for the purposes of Art. 54 and 123(2) EPC (see **G 2/10**, OJ 2012, 376, referring to **G 1/03**, OJ 2004, 413), and by the same token Art. 76(1) EPC, the board considered that a departure from this established criterion for selection inventions in the assessment of added subject-matter was not appropriate. The board emphasised that the combination of features resulting from selections from two or more lists, or pertaining to separate embodiments, only introduced added subject-matter in the absence of a pointer to that particular combination. In other words, the concept of selection from lists had to be applied with due regard to the whole content of the earlier application as filed.

In **T 2171/21** the board agreed that considerations of a selection from several lists were not meant to replace the "gold standard" (**G 2/10**, point 4.3 of the Reasons). An aspect also addressed in **G 2/10** was that "there would be added matter" where the amendment "would result in singling out any hitherto not specifically mentioned or at least implicitly disclosed individual compound or group of compounds ..." (point 4.5.4 of the Reasons). The board held that the "singling out" of a combination of features was precisely what happened in claim 1 of the case in hand, since the earlier application as filed did not contain a preference for or pointer to any of the combined features or to the chosen combination. The ground for opposition in Art. 100(c) EPC thus prejudiced the maintenance of the patent.

b) Meaning of "selection from two lists"

The board in **T 1374/07**, referring to **T 811/96**, said that a selection of two components (here: fat and enzymes) from one list is in fact equivalent to a twofold selection from two identical lists (see also **T 2375/09**, **T 1506/13**). Thus, the board concluded that the addition of the feature "fat and enzymes" to claim 1 infringed Art. 123(2) EPC.

In **T 197/08** the board observed that the feature "FIE as the sole active ingredient" was not as such mentioned in the original application. The respondent (opponent) had argued that the introduction of "as the sole active ingredient" in combination with FIE, which was selected from a group of compounds in which it was not its most preferred active ingredient, constituted an unallowable selection from two lists. The board considered that FIE was selected from a list of six particularly preferred active ingredients and combined monotherapy (as the sole active ingredient), which constituted de facto the only administration form envisaged in the original application. Under these circumstances, the feature was not the result of two selections from different lists, as basically only one

selection, i.e. the selection of FIE, had to be made in order to arrive at the feature. As a consequence, the requirements of Art. 123(2) EPC were met.

In **T 236/08** the feature "suitable for administration by inhalation" in claim 1 was not present in the claims as originally filed. A basis for this feature could however be found as part of a list in the description, where it was one way among different possible ways of administration. A consequence was however that the combination of the subject-matter of claim 1 with the subject-matter of any dependent claim which also resulted from a selection among different possibilities would constitute an unallowable selection from multiple lists.

According to the board in **T 2134/10**, there was no combination of independent features from two lists. The board found that a specific **degree of sequence identity** (in claim 1(d): "at least 95%") is not a property that, in combination with a particular molecule selected from Table 1 (disclosing 113 open reading frames encoding potentially antigenic peptides of S. pneumoniae), could single out a particular molecule or confer properties to the claimed subject-matter not directly and unambiguously derivable from the application as filed.

In **T 1581/12** claim 1 was directed to a combination of sequences SEQ ID NO 4, 6 with fragment length of "20 or more consecutive amino acids", and a selection of those fragments containing an epitope of these sequences. In the parent application, sequences SEQ ID NO 4, 6 were disclosed as members of a list of several hundred sequences. Likewise, the fragment length indicated in claim 1 was disclosed in the parent application within a long list of lengths to be selected "depending on the particular sequence". Distinguishing its case from **T 583/09** and **T 2134/10** the board observed that the values of the fragment length disclosed in the parent application would be understood by a skilled person to apply to each and every member of the list of disclosed amino acid sequences (SEQ ID NOs), wherein the upper length of these fragments varied "depending on the particular sequence"; the list of fragment lengths was actually **not independent** from the list of amino acid sequences. The combination of the value "20 or more consecutive amino acids" with the amino acid sequences SEQ ID NOs 4, 6, therefore only limited the original disclosure in the parent application. This limitation did not create new subject-matter.

T 119/15 distinguished its case from **T 1511/07** (see the summary in point a) above), as it did not relate to lists within the meaning of **T 1511/07**. Similarly, in **T 2695/16** the board did not accept the argument of the appellant that the combination of amendments resulted from a selection from two lists of compounds.

In **T 1442/19** the board observed that the concept of lists did not require a list to have a particular format. The crucial aspect was the information conveyed to the skilled person. If the skilled person was confronted with an indication of equally preferred items, this indication of items formed an enumeration or list. **T 1442/19** distinguished its case from **T 2635/18**. In **T 2635/18** the board held that starting from the embodiment of a dependent claim of the application as filed did not constitute a selection. However, contrary to **T 1442/19**, with regard to the dependent claim in question, there were no other dependent claims with regard to which a selection would have had to be made. Instead, in **T 1442/19** claims 19 to 21 formed a list. The board held that the mere fact that cobicistat was

individualised in claim 20 could not be understood as a pointer to this compound as argued by the respondent, a view that might possibly have been accepted if cobicistat had been the only compound mentioned in the claims.

With regard to the length of the list, see **T 1442/19**, where the board held that even if lists were regarded as very short, this did not render a selection superfluous, whereas in **T 2037/17** the board held that selecting two independent and individual options from a very short list did not generate any new teaching.

c) Disclosure of combination in an individualised manner – pointers

In **T 1261/21** the board explained that a pointer was an (implicit or explicit) indication or hint towards the combination of features in question. The pointer needed to be suitable for demonstrating that the claimed combination of features was envisaged in the application as filed. Typically, it consisted of an example or embodiment. In the board's view, there was not normally only one pointer towards the most preferred example or embodiment.

(i) Combination not individualised in the application as filed – examples

In the board's view in **T 686/99** the application as filed disclosed in an undifferentiated way different categories of base oils without any pointer regarding the selection of one particular category thereof. Priority was not given to ester oils from the original host of equivalent base oils. Therefore the board came to the conclusion that combining in claim 1 a base oil mandatorily comprising ester oils with the hydrofluorocarbons listed in claim 1 resulted from a multiple selection within two lists of alternative features, namely of ester oils from the list of base oils and of hydrofluorocarbons from the list of refrigerants, thereby generating a fresh particular combination. In the **absence of any pointer to that particular combination**, this combined selection of features did not, for the person skilled in the art, emerge clearly and unambiguously from the content of the application as filed.

In **T 714/08** claim 1 of the main request had been amended so as to limit the first oxidation base to paraphenylenediamine and the list of couplers to 12 compounds, but the specific combination of paraphenylenediamine with each of those couplers could not be derived directly and unambiguously from the application as filed. The board did not accept the argument that the application as filed had already individualised paraphenylenediamine as a preferred first oxidation base. In its view, the cited passage related solely to a specific example. The case differed from those concerning restrictions applied to lists of substituents in Markushtype chemical formulae (see **T 615/95** or **T 50/97**; see the abstracts in this chapter II.E.1.6.3. below); the restrictions there had not resulted in singling out particular combinations but had retained the generic nature of the chemical formula defining the claimed products.

In **T 407/10** the board at first concurred with the appellant that, whereas the combination of e.g. two features only originally disclosed in lists of equivalent alternatives was normally found to violate Art. 123(2) EPC, there might be other combinations of features which although not explicitly disclosed in the application as filed were nevertheless derivable from the presence of an (explicit or implicit) pointer thereto. For instance, the fact that

certain features were disclosed as preferred in the original application acted as a pointer for the skilled person, as the combination of preferred features was obviously the best way of achieving the technical effects that the invention aimed to provide (see e.g. **T 68/99**). However, this jurisprudence did not consider the combination of a feature not originally disclosed as preferred with a plurality of further restrictions based on preferred features as an amendment in accordance with Art. 123(2) EPC.

In **T 775/17**, the board (referring to **T 407/10**) held that under established case law combining a feature that had not originally been disclosed as preferable with a number of other limitations based on preferred features was not an amendment compatible with Art. 123(2) EPC.

In **T 1799/12** the board considered that the jurisprudence and **T 407/10** correctly referred to further circumstances that need to be taken into account, such as pointers to that selection or combination in the description and in the examples, for instance the fact that the features in question have been mentioned in the description as "preferred". By contrast, in the case at issue, no pointer was available towards the choice of a square or rectangular base wall shape, but there was a clear pointer in the opposite direction, namely towards base wall shapes without any corners ("generally circular" or "oval").

In **T 2273/10** the appellant (proprietor) argued that claim 1 was a combination of the invention's most preferred features, and did not involve a selection from various lists. The board disagreed. The application as filed disclosed several possibilities for each of the three features. To arrive at the claimed wording, the skilled person had to make a selection from various lists. In addition these **selections related to preferred and non-preferred features**.

Similarly, in **T 1150/15** the board rejected the proprietor's approach to combine the preferred options for each of the substituents Y, X and Z disclosed on page 75, to disregard the preferred option for R^B disclosed in the same context and to combine it with a definition which has been singled out of the most general list of options for substituent A as arbitrary. The board distinguished its case from the facts underlying **T 615/95** (see chapter II.E.1.6.3. below).

In **T 1259/16** the claimed combination of the features characterising the claimed solution – "free of free bromine" and "less than 100 ppm of metal ion impurities" – was not explicitly disclosed in the application as filed. The board considered that the **lists** relating to free bromine levels and metal ion impurities were **fully independent**. The various levels of free bromine and metal ion impurities represented **equally suitable alternatives**. The skilled person reading the application would not recognise that the lower values were necessarily more preferred, as reducing impurities to as low a level as possible was both impractical and uneconomical. The claimed combination was therefore contrary to Art. 123(2) EPC.

In **T 1476/15** it was held that there was neither an explicit nor an implicit yet direct and unambiguous disclosure in the patent application which indicated that the concentration ranges of the elements in question (polyamines and plant- and yeast-derived protein hydrolysate) had to be read hierarchically and in parallel, where each parallel position in

the sequence of five increasingly preferred embodiments of these two lists was combined. Even taking into account the examples, the board could not identify why the specific concentration ranges mentioned in the claim ought to be combined. This conclusion was in line with the view expressed in **T 1511/07**.

(ii) Combination individualised in application as filed – examples

In **T 45/12** the board considered that the specific combination of pioglitazone with glimepiride was singularised in the root application as filed. All through the description of the root application as filed pioglitazone was disclosed as the most preferred sensitivity enhancer to be used in combination with another antidiabetic agent. Glimepiride was one specific antidiabetic agent disclosed for use as second component in the composition. Thus, even assuming that the composition containing pioglitazone with glimepiride would require a selection (among the specific antidiabetic agents disclosed to be combined with pioglitazone), this **one-dimensional selection** did not introduce added subject-matter.

In **T 1032/12** the board rejected the appellant's argument that the claimed polypeptide was defined by two features selected from two independent lists. The board considered that, in the case at issue, the protein of SEQ ID NO:2 was singled out as the **particularly preferred polypeptide**, and when reference to fragments as the preferred sequences was made, they were always labelled as "particularly preferred fragments". Therefore, the reference in the description to "the preferred polypeptide" was a reference to the polypeptide of SEQ ID NO:2. It was this specific mention of the full-length molecule as the particularly preferred molecule that distinguished the case at issue from the case underlying decision **T 583/09**, referred to by the appellant, where different molecules had been presented as equivalent alternatives.

In **T 1402/14** the board considered that the situation in the case in hand was different from that in **T 1511/07** (see point a) above), where the board had considered that the application as filed did not contain any pointer towards combining two ranges of different level of preference. In the case in hand, the combined ranges were of the **same level of preference** (broadest definition of each range). In the board's view, claim 1 of auxiliary request 1 therefore did not contain any subject-matter extending beyond the content of the application as filed.

In **T 1332/21** the board reasoned that restricting components of a generically defined composition to more specific definitions which the original disclosure presented as being preferred generally did not result in originally undisclosed subject-matter. Even if one considered such amendments as selecting individual values from generic features, as the opponent put forward, in the case in hand these selections were already made in the original disclosure and could not add anything going beyond it.

T 2723/16 is another decision in which the selection was deemed to have already been disclosed as preferable.

d) Lists of converging alternatives

In **T 1621/16** the board observed that it was established case law that, under certain circumstances, amendments based on multiple arbitrary selections from lists represented an extension of the content of the application as filed. However, most decisions following this approach related to amendments based on lists of non-converging alternatives (i.e. mutually exclusive or partially overlapping elements). By contrast, in cases where the amendments were based on selections from lists of converging alternatives (i.e. lists of options ranked from the least to the most preferred, wherein each of the more preferred alternatives is fully encompassed by all the less preferred and broader options in the list), the conclusions had been less consistent (see **T 812/09**, **T 2237/10**, **T 27/16** and **T 615/95**). Moreover, the boards had generally regarded amendments based on multiple deletions of elements from one or several lists of alternatives as an allowable restriction, provided that such amendments did not result in singling out particular combinations of specific meaning (see **T 615/95** and **G 1/93**, OJ 1994, 541). The board considered that selections from lists of converging alternatives should not be treated in the same way as selections from lists of non-converging alternatives for the following reasons: In the case of non-converging alternatives, selecting specific elements from such lists led to a singling out of an invention from among several distinct alternatives, which might provide an unwarranted advantage. On the other hand, when fall-back positions for a feature were described in terms of a list of converging alternatives, each of the narrower elements was fully encompassed by all the preceding less preferred options. Thus, amending a claim by selecting one element from a list of converging alternatives did not lead to a singling out of an invention from among a plurality of distinct options, but simply to a subject-matter based on a more or less restricted version of said feature (see also **T 933/22**). There was thus an analogy to deleting options from a list of non-converging alternatives (as in **T 615/95**). The board emphasised that the above considerations did not allow the conclusion that amendments based on selections from lists of converging alternatives necessarily met the requirements of Art. 123(2) EPC. It needed to be assessed whether the specific combination was supported by the content of the application as filed. For the board, at least the following two conditions needed to be met: i) the combination should not be associated with an undisclosed technical contribution; and ii) the combination should be supported by a pointer in the application as filed. Such pointers could be provided by the example(s) (as in **T 27/16** and **T 615/95**) or by specific embodiment(s) of the application, as this/these generally represented the most detailed and preferred form(s) of the invention.

Again in **T 1482/17**, the same board considered the contested amendments to be compatible with Art. 123(2) EPC because the claim in question was based on combinations of more or less preferred options taken from lists of converging alternatives, the resulting subject-matter was not associated with any non-disclosed technical contribution and the original application contained a pointer towards the feature combinations resulting from the multiple selection. In particular, two of the examples in the application fell within the scope of the claimed subject-matter.

In **T 1937/17** the respondent (proprietor) argued that the parameter value lists and the list of possible structures in the case in hand were lists of converging alternatives of the kind

explained in **T 1621/16**. Furthermore, the description explicitly linked the features disclosed in these lists in terms of their purpose and effects. This provided a disclosed technical contribution and a pointer, as required by **T 1621/16**. The board disagreed. It noted that a distinction had to be made between what was possibly rendered obvious to a skilled person in the light of the disclosure with certain pointers, and what was directly and unambiguously, even if implicitly, derivable from the disclosure for the skilled person using common general knowledge. As regards the requirement stated in **T 1621/16** that the subject-matter resulting from the combination of convergent options from lists "is not associated with an undisclosed technical contribution", the board, citing **G 2/98** (OJ 2001, 413) and **G 2/10** (OJ 2012, 376), explained that the distinction in **G 1/93** (OJ 1994, 541) had been made explicitly for the addition of undisclosed limiting features limiting the scope of protection and did not provide a criterion for establishing whether or not an amendment extended beyond the content of the application as filed. The board concluded that, other than for the purposes envisaged in **G 1/93**, a "technical contribution" was of no relevance when deciding on the allowability of amendments under Art. 123(2) EPC. Instead, the "gold standard" set out in **G 2/10** was the only criterion that had to be applied. See also **T 1465/15**, which, in reply to an argument of the appellant (proprietor) based on **T 1253/07** and **T 1621/16**, likewise highlighted the "gold standard" (**G 2/10**); as well as **T 1261/21** and **T 1824/22**, both of which support **T 1937/17**.

In **T 1133/21** the board recalled that it was established case law that the content of an application must not be used as a reservoir from which features pertaining to separate embodiments could be combined to artificially create an embodiment. In the absence of any pointer to the combination, the combined selection of features did not, for the person skilled in the art, emerge clearly and unambiguously from the content of the application as filed. **T 1621/16** did not provide for an exception to this rule. It required, in fact, that a claim amended on the basis of multiple selections from lists of converging alternatives may only be considered to meet the requirements of Art. 123(2) EPC if the application as filed included a pointer to the combination of features resulting from the multiple selections. This meant that the mere fact that features were described in terms of lists of more or less converging alternatives did not give the proprietor carte blanche to freely combine features selected from a first list with features selected from a second list disclosed in the application as filed. Any such amendment would only be allowable under Art. 123(2) EPC if it complied with the "gold standard". The assessment of whether this standard was complied with was very case specific. It required taking into account the teaching of the application as filed as a whole, avoiding artificial semantic constructions. Factors which might play a role in the assessment were, inter-alia, the number of alternatives disclosed in the application; the length, convergence and any preference in the lists of enumerated features; and the presence of examples pointing to a combination of features. For instance, if the values in a number of examples were clustered within specific ranges, this might provide a pointer to those ranges. In the current case, the application for the opposed patent was drafted to provide a large reservoir of options and alternatives to be selected and combined to create a vast number of embodiments. **T 1133/21** was cited and followed in **T 1261/21**.

In **T 1261/21**, the board highlighted the "gold standard" and agreed with **T 1937/17** that the first criterion in point 2 of the Catchword of **T 1621/16** ("the subject-matter resulting

from the multiple selections is not associated with an undisclosed technical contribution") should not be taken into account when establishing whether there was a direct and unambiguous disclosure for the combination of features resulting from a multiple selection. Otherwise, the present board agreed with the conclusion in point 1 of the Catchword of **T 1621/16** that the choice of a more or less preferred element from a list of converging alternatives should not be treated as an arbitrary selection because this choice did not lead to a "singling out"; and that in general a pointer to the combination of features resulting from multiple selections was necessary to comply with Art. 123(2) EPC (see second criterion in point 2 of the Catchword of **T 1621/16**). In this context, the present board preferred the term "converging elements" to "converging alternatives", as "alternatives" seemed to imply that there were real alternatives that did not overlap. Furthermore, the board considered that whether the claimed combination of features merely resulted from the combination of claims having an appropriate back-reference to each other (see **T 2237/10**) played a role in the assessment of compliance with Art. 123(2) EPC and, in particular, whether there was a pointer to the claimed combination of features.

1.6.3 Deletion of elements from lists – shrinking the lists without singling out a combination of features

According to the boards' consistent case law, the guiding principle is that deleting meanings of residues in a generic chemical formula must not lead to the selection, in the respective lists, of a particular combination of single, specific but originally undisclosed meanings of residues (see **T 615/95** and **T 859/94**).

In **T 615/95** there were three independent lists of sizeable length specifying distinct meanings for three residues in a generic chemical formula in a claim. One originally disclosed meaning was deleted from each of the three independent lists. The board stated that the present deletions did not result in singling out a particular combination of specific meanings, i.e. any hitherto not specifically mentioned individual compound or group of compounds, but maintained the remaining subject-matter as a generic group of compounds differing from the original group only by its smaller size. Such a **shrinking of the generic group** of chemical compounds was not objectionable under Art. 123(2) EPC 1973, since these deletions did not lead to a particular combination of specific meanings of the respective residues which was not disclosed originally or, in other words, did not generate another invention. (See also **T 948/02**, which refers in detail to this case law and which did not allow the amendment of a generic chemical formula. For another decision distinguishing its case from **T 615/95**, see **T 1150/15**). For further decisions applying the teaching of **T 615/95**, see **T 888/08** and **T 2865/19**.

In **T 50/97** the board explained that in the case at issue the shrinking of the lists of alternative definitions disclosed in the application as filed was not objectionable as that limitation did not result in singling out a particular combination of specific definitions, i.e. a hitherto not specifically mentioned sub-class of compounds, but maintained the remaining subject-matter of claim 1 as generic lists of alternative definitions differing from the original lists only by their smaller size (with reference to **T 615/95** and **T 859/94**).

In **T 942/98** the board held that, through the **deletion of all other meanings**, residues X1, X2 and R5 had been narrowed down to a single meaning, leading to a combination of specific meanings of residues not disclosed in the application as filed. Consequently, claim 1 as filed did not in itself provide adequate support for claim 1 as amended (cited by **T 2013/08** in connection with the established case law concerning **"singling out"**).

In **T 1506/13** the board, referring to **T 948/02**, summarised that a deletion of genes from a **list of specific genes** was allowable if it fulfils **two conditions**: First, the deletion must not result in singling out any hitherto not specifically mentioned individual compound or group of compounds, but maintains the remaining subject-matter as a generic group of compounds differing from the original group only by its smaller size. Second, the deletion does not lead to a particular combination of a specific meaning which was not disclosed originally, i.e. it does not generate another invention, or in other words it merely restricts the required protection but does not provide any technical contribution to the originally disclosed subject-matter. See **T 2744/16**.

In **T 98/09**, which concerned the "singling out" of combinations of active ingredients not originally disclosed from lists, the board held that, contrary to the appellant's view, a deletion from a list could also constitute an inadmissible extension if the singling out of one individual ingredient led to a selection of combinations which, even if conceivably covered by the application as filed, had not been specifically disclosed. It was the boards' settled case law that such a selection is to be regarded as an inadmissible extension and so as an infringement of Art. 123(2) EPC (see e.g. **T 727/00** and **T 686/99**). The case at issue concerned two lists (six elements and 47 elements). The applicant sought to individualise one of the lists to one element. The board held that this selection was contrary to Art. 123(2) EPC. For a similar case, in which the board found that the deletion of elements of two lists led to an unallowable selection, see **T 1808/08**.

In **T 10/97** not all the compounds listed in the original claim were included in amended claim 1. However, since the claimed group of compounds was obtained not by restricting an originally disclosed generic definition of a substituent in a generic formula to a specific one selected from worked examples, but by **deleting some members from a list** of individualised equally useful compounds in order to improve the chances of patentability over the available prior art, the board found that such deletions must be considered admissible in accordance with the case law of the boards of appeal (see **T 393/91**). For the remaining compounds, no particular technical effect was either disclosed or alleged.

In **T 783/09** the board referred to **T 10/97**. All forty-four combinations resulting from the combination of the elements of the two lists (one list with two elements, the other list with 22 elements) were directly and unambiguously disclosed. However, a further issue was whether or not the claiming of only three of the forty-four combinations disclosed extended the content of the application as filed in an unallowable way. The forty-four combinations were referred to as "very preferred embodiments"; by this statement the skilled person was taught that each of the forty-four combinations had the same quality, i.e. they were all very preferred combinations in the context of the invention. Nothing else was derivable from the remainder of the application, i.e. a particular quality, for example a particular technical effect, was attributed neither to the three combinations of claim 1 nor

to the remaining forty-one. Hence, the group of claim 1 was to be considered as the result of the **deletion of forty-one elements from a list of forty-four qualitatively equal elements** (see **T 10/97**). In summary, the subject-matter of claim 1 complied with the requirements of Art. 123(2) EPC.

In **T 1075/12** the patent proprietor restricted the definitions of groups to lists of specific substituents. The board held that the more precise definitions of the groups did not result in a particular combination of specific meanings of the respective groups being singled out, namely no particular structural feature of the compounds concerned was now claimed which was not disclosed originally. The board distinguished its case from **T 859/94** and **T 801/02**, in which more than one variable in the respective chemical formulae had been individualised.

1.6.4 Combination of original independent claim with features from a plurality of dependent claims referring back to the independent claim separately – "US style" dependencies

In **T 1362/15** the board had to decide whether Art. 123(2) EPC allowed incorporating the features of a plurality of dependent claims into an independent claim in a situation in which the application as originally filed included a claims set with a "US-style" dependency (i.e. with the relevant dependent claims separately referring back to the independent claim) and an embodiment in which the features of the independent claim and the dependent claims were shown in combination – albeit together with even more features. The appellant had asked for a referral of questions relating to this situation to the Enlarged Board and had pointed to allegedly diverging case law. The board did not consider this referral to be justified for, inter alia, the following reason: the Enlarged Board had already clearly defined the necessary and sufficient criteria to assess the requirements of Art. 123(2) EPC in, inter alia, **G 2/98** (OJ 2001, 413) and **G 2/10** (OJ 2012, 376), i.e. that the skilled person must be able to derive the claimed subject-matter directly and unambiguously, using common general knowledge, and, seen objectively and relative to the date of filing, from the original application as a whole. These applied irrespective of the particular dependency structure of the originally filed claims. The board analysed the allegedly diverging decisions **T 2619/11** and **T 1414/11** and came to the conclusion that both decisions relied on the same criteria and did not contradict each other. Regarding the "US-style" claim dependency, the board noted that there was no insurmountable limitation regarding the possible combinations of features in the claims of a US application under 35 U.S.C 112. The board refused the request for referral and decided that the subject-matter at issue extended beyond the content of the application as originally filed.

In **T 895/18** the appellant (patentee) argued that the application was typical of many applications relating to new and inventive compositions which were drafted in the "USA style" and should therefore be read accordingly as disclosing also combinations of features of dependent claims that were not dependent on each other. The board rejected this approach, because there was no legal basis in the EPC for applying the requirements of Art. 123(2) EPC differently in view of a deliberately selected drafting style.

In **T 2405/19** the board was not persuaded by the appellant's argument that, when construing the content of the application as filed, the skilled person would consider the

specific drafting style for US applications and come to a different conclusion. Different origins of application documents could not lead to a different understanding when applying the "gold standard" according to which, after an amendment, the skilled person should not be presented with new technical information.

1.7. Disclaimers

1.7.1 Definition

The term "disclaimer" is used in the decisions **G 1/03** (identical to **G 2/03**) (OJ 2004, 413, 448), **G 2/10** (OJ 2012, 376) and **G 1/16** (OJ 2018, A70) as meaning an amendment to a claim resulting in the incorporation therein of a "negative" technical feature, typically excluding from a general feature specific embodiments or areas.

Furthermore **G 1/16** concurred with decision **T 1870/08**, that a disclaimer is only a proper disclaimer if the remaining legal subject-matter is **less** than that of the unamended claim. If any subject-matter can be identified which falls within the scope of the claim after amendment by the proposed disclaimer, but which did not do so before the amendment, the disclaimer is improper and, as a consequence of this, unallowable under Art. 123(2) EPC.

The board in **T 1870/08** provided the example of a negative formulation removing a restricting feature: While this formulation may look like a disclaimer, it may in fact extend the legal scope of protection.

The term **"undisclosed disclaimer"** relates to the situation in which neither the disclaimer itself nor the subject-matter excluded by it have been disclosed in the application as filed. The term **"disclosed disclaimer"** relates to the situation in which the disclaimer itself might not have been disclosed in the application as filed, but the subject-matter excluded by it has a basis in the application as filed, e.g. in an embodiment. Thus, undisclosed disclaimers and disclosed disclaimers can be distinguished according to whether the subject-matter on which the respective disclaimer is based is explicitly or implicitly, directly and unambiguously, disclosed to the skilled person using common general knowledge, in the application as filed (**G 1/16**).

1.7.2 Standards for examining disclosed and undisclosed disclaimers

In **G 1/16** (OJ 2018, A70) the Enlarged Board considered that the choice of the proper test for assessing the allowability of any disclaimer is determined by the fundamental distinction, in terms of their legal nature, between disclosed disclaimers and undisclosed disclaimers. That distinction necessitates providing **for each of the two classes of disclaimer a single specific test** for assessing whether the introduction of a given disclaimer is in compliance with Art. 123(2) EPC. Therefore, for undisclosed disclaimers the proper test is whether the criteria of **G 1/03** (OJ 2004, 413) are fulfilled, and for disclosed disclaimers the proper test is the "gold standard" disclosure test of **G 2/10** (OJ 2012, 376).

In **T 768/20**, cited and followed in **T 110/20**, the board held that the only exception to the "gold standard" (**G 2/10**) were undisclosed disclaimers, governed by the rules laid down in **G 1/03** (**G 1/16**). Point 2 of the Order of **G 1/93** did not provide for a further exception.

With regard to the admissibility of disclaimers, reference should also be made to chapter II.D.4.2.

a) Principles established in G 1/03 and G 2/03 for undisclosed disclaimers

The Enlarged Board held in **G 1/03** and **G 2/03** (OJ 2004, 413 and 448) concerning **undisclosed** disclaimers that an amendment to a claim by the introduction of a disclaimer may not be refused under Art. 123(2) EPC 1973 for the sole reason that neither the disclaimer nor the subject-matter excluded by it from the scope of the claim have a basis in the application as filed. It considered that the following criteria were to be applied for assessing the allowability of a disclaimer which was not disclosed in the application as filed:

A disclaimer may be allowable in order to:

- restore novelty by delimiting a claim against state of the art under Art. 54(3) and (4) EPC 1973;

- restore novelty by delimiting a claim against an accidental anticipation under Art. 54(2) EPC 1973; an anticipation is accidental if it is so unrelated to and remote from the claimed invention that the person skilled in the art would never have taken it into consideration when making the invention; and

- disclaim subject-matter which, under Art. 52 to 57 EPC 1973, is excluded from patentability for non-technical reasons.

In addition, a disclaimer should not remove more than is necessary either to restore novelty or to disclaim subject-matter excluded from patentability for non-technical reasons. On the other hand, a disclaimer which is or becomes relevant for the assessment of inventive step or sufficiency of disclosure adds subject-matter contrary to Art. 123(2) EPC 1973. And a claim containing a disclaimer must meet the requirements of clarity and conciseness of Art. 84 EPC 1973.

In **G 1/03** (and **G 2/03**), the Enlarged Board, having regard to the law established by it in relation to disclaimers, expressly identified those board decisions which should no longer be applied. Thus, the Enlarged Board stated that the isolated decisions **T 170/87** and **T 313/86** were not to be followed, whilst also criticising **T 323/97** in the light of the new law applicable.

b) Principles established in G 2/10 for disclosed disclaimers

The Enlarged Board in **G 2/10** found that, subsequent to decision **G 1/03** (and **G 2/03**), different opinions had been expressed in the jurisprudence of the boards on whether

decision **G 1/03** related to the disclaiming of embodiments which were **disclosed** as part of the invention in the application as filed or whether in that situation the jurisprudence as previously established following decision **T 4/80** (OJ 1982, 149) continued to apply (see **G 1/07**, OJ 2011, 134, point 4.2.3 of the Reasons). In **G 2/10** the Enlarged Board reformulated the question referred to it, stating that the question was construed as intending to ask whether an amendment to a claim by the introduction of a disclaimer infringes Art. 123(2) EPC if the subject-matter of the disclaimer was disclosed as an embodiment of the invention in the application as filed.

The Enlarged Board in **G 2/10** stressed that decision **G 1/03** did not support the conclusion drawn by **T 1050/99** that **G 1/03** also related to disclaimers for disclosed subject-matter. Further, in **G 1/03** it was not decided that an undisclosed disclaimer would be always allowable under Art. 123(2) EPC. The wording of its answer, reading "a disclaimer may be allowable", indicated that with the criteria established in this answer the Enlarged Board in **G 1/03** did indeed not intend to give a complete definition of when a disclaimer violates Art. 123(2) EPC.

The Enlarged Board stated that neither decision **G 1/93** nor decision **G 1/03** intended to modify the general definition of the requirements of Art. 123(2) EPC established in opinion **G 3/89** (OJ 1993, 117) and decision **G 11/91** (OJ 1993, 125), which has become the generally accepted or "gold standard" for assessing any amendment for its compliance with Art. 123(2) EPC. As to the criteria to be applied, the principle that any amendment to an application or a patent, and in particular to a claim, must fulfil the requirements of Art. 123(2) EPC also applies to an amendment limiting the claim by disclaiming disclosed subject-matter. Therefore, as is the case for any other amendment, the test for an amendment to a claim by disclaiming subject-matter disclosed as part of the invention in the application as filed must be that after the amendment **the skilled person may not be presented with new technical information**. Hence, disclaiming subject-matter disclosed in the application as filed can also infringe Art. 123(2) EPC if it results in the skilled person being presented with technical information which he would not derive directly and unambiguously, using common general knowledge, from the application as filed.

The point of reference for assessing an amended claim for its compatibility with Art. 123(2) EPC is the subject-matter which the claim contains after the amendment. In other words, it is the subject-matter remaining in the claim after the amendment. The test to be applied is whether the skilled person would, using common general knowledge, regard the **remaining claimed subject-matter as explicitly or implicitly, but directly and unambiguously, disclosed in the application as filed**. This test is the same as that applied when the allowability of a limitation of a claim by a positively defined feature is to be determined. The Enlarged Board found that no convincing reason had been advanced for not applying the principles developed in the context of Art. 123(2) EPC for the assessment of amendments to claims by the introduction of positive limiting features in the same manner to limitations of claims by disclaimers which disclaim subject-matter disclosed in the application as filed. The Enlarged Board stressed in its decision **the importance of applying a uniform concept of disclosure** (with reference to Art. 54, 87 and 123 EPC; see **G 2/10**, point 4.6 of the Reasons, citing **G 1/03**, OJ 2012, 436).

The Enlarged Board in **G 2/10** (OJ 2012, 376) answered the two questions referred to it by interlocutory decision in **T 1068/07** (OJ 2011, 256) as follows:

(1) An amendment to a claim by the introduction of a disclaimer disclaiming from it subject-matter disclosed in the application as filed infringes Art. 123(2) EPC if the subject-matter remaining in the claim after the introduction of the disclaimer is not, be it explicitly or implicitly, directly and unambiguously disclosed to the skilled person using common general knowledge, in the application as filed.

(2) Determining whether or not that is the case requires a technical assessment of the overall technical circumstances of the individual case under consideration, taking into account the nature and extent of the disclosure in the application as filed, the nature and extent of the disclaimed subject-matter and its relationship with the subject-matter remaining in the claim after the amendment.

According to **T 1676/08**, the principles set out in decision **G 2/10** with regard to the requirements to be met in order for amendments by the introduction of disclaimers for disclosed subject-matter to be allowable under Art. 123(2) EPC also apply with regard to the requirements for **divisional applications** under Art. 76(1) EPC; they also apply to the examination under Art. 100(c) EPC.

As in **G 1/03** (and **G 2/03**), the Enlarged Board in **G 2/10** identified board decisions which should no longer be applied. Thus, it criticised the approach taken in **T 1050/99** and **T 1102/00**.

c) Explanations in G 1/16

In the case law that followed these decisions of the Enlarged Board there was no uniformity of approach regarding the application of **G 2/10** to "undisclosed disclaimers" (see CLB, 8th edn. 2016, II.E.1.5.2b) and the summary in **G 1/16**, point 24 of the Reasons). This led to the referring decision **T 437/14** of 17 October 2016 (OJ 2017, A50) asking in particular whether the standard referred to in **G 2/10** for the allowability of disclosed disclaimers under Art. 123(2) EPC, i.e. whether the skilled person would, using common general knowledge, regard the subject-matter remaining in the claim after the introduction of the disclaimer as explicitly or implicitly, but directly and unambiguously, disclosed in the application as filed, was also to be applied to claims containing undisclosed disclaimers.

In **G 1/16** (OJ 2018, A70) the Enlarged Board considered that the choice of the proper test for assessing the allowability of any disclaimer is determined by the fundamental distinction, in terms of their legal nature, between disclosed disclaimers and undisclosed disclaimers. That distinction necessitates providing **for each of the two classes of disclaimer a single specific test** for assessing whether the introduction of a given disclaimer is in compliance with Art. 123(2) EPC. Therefore, for undisclosed disclaimers the proper test is whether the criteria of **G 1/03** (OJ 2004, 413) are fulfilled, and for disclosed disclaimers the proper test is the "gold standard" disclosure test of **G 2/10** (OJ 2012, 376).

The assessment of the allowability of a claim amendment by an undisclosed disclaimer is governed exclusively by the criteria laid down in **G 1/03**. No modifications are to be made to, nor any conditions added which go beyond, the criteria of **G 1/03**.

The Enlarged Board confirmed that an amendment by an undisclosed disclaimer may be allowable in the three situations mentioned in **G 1/03** (point 2.1 of the Order), i.e. in order to (1) restore novelty by delimiting a claim against state of the art under Art. 54(3) EPC; (2) restore novelty by delimiting a claim against an accidental anticipation under Art. 54(2) EPC; or (3) disclaim subject-matter which, under Art. 52 to 57 EPC, is excluded from patentability for non-technical reasons.

In addition, the undisclosed disclaimer must not be related to the teaching of the invention, as already held in **G 1/03** (point 2.3 of the Order; point 2.6 of the Reasons). In endorsing this concept, the Enlarged Board provided the following explanations:

The question to be asked in this context is not whether an undisclosed disclaimer quantitatively reduces the original technical teaching – this is inevitably the case – but rather whether it **qualitatively changes** it in the sense that the applicant's or patent proprietor's **position with regard to other requirements for patentability** is improved. If that is the case, then the original technical teaching has been changed by the introduction of the disclaimer in an unallowable way. And as a consequence, the technical teaching based on the amended claim, i.e. on the remaining subject-matter without the disclaimer, can no longer be considered as belonging to the invention as presented in the application as originally filed.

For the sake of completeness, the Enlarged Board added that the prohibition of a qualitative change in the original teaching applies in an absolute way, i.e. not only with regard to the prior art which provides the basis for the undisclosed disclaimer, but also to the entire prior art relevant for the assessment of inventive step. In practical terms, this means that the evaluation of inventive step has to be carried out disregarding the undisclosed disclaimer, as proposed in **T 710/92**. In this way, any unallowable modification of the original technical teaching in the assessment of inventive step is avoided.

The Enlarged Board concluded that the introduction of an undisclosed disclaimer must fulfil one of the criteria laid down in point 2.1 of the Order of decision **G 1/03**, but may not provide a technical contribution to the claimed subject-matter of the application as filed; in other words, the identity of the invention as originally filed must remain unchanged by the subject-matter remaining in the claim after the introduction of the undisclosed disclaimer.

The Enlarged Board answered the questions referred to it as follows:

For the purpose of considering whether a claim amended by the introduction of an undisclosed disclaimer is allowable under Art. 123(2) EPC, the disclaimer must fulfil one of the criteria set out in point 2.1 of the Order of decision **G 1/03**.

The introduction of such a disclaimer may not provide a technical contribution to the subject-matter disclosed in the application as filed. In particular, it may not be or become

relevant for the assessment of inventive step or for the question of sufficiency of disclosure. The disclaimer may not remove more than necessary either to restore novelty or to disclaim subject-matter excluded from patentability for non-technical reasons.

1.7.3 Decisions applying the criteria established by the Enlarged Board in G 1/03 and G 1/16

a) Accidental anticipation

In **G 1/16** (OJ 2018, A70, point 45 of the Reasons) the Enlarged Board held with reference to **G 1/03** (OJ 2004, 413, point 2.1 of the Order and point 2.2 and sub-points of the Reasons) that an anticipation is accidental if it is so unrelated to and remote from the claimed invention that the person skilled in the art would never have taken it into consideration when making the invention.

In **T 500/00** the amendment was an undisclosed disclaimer introduced by the appellant into claim 1 during the examining proceedings in response to an objection of lack of novelty based on prior art document D1. The question that arose was whether or not the disclosure of D1 was accidental. D1 and the application in suit concerned the same technical field, had, except for the disclaimed component, identical compositions and related to the same purpose of sufficient curing. Moreover, the same technical problem underlay both the patent in suit and D1. Since the skilled person would consider D1 as suitable prior art to make the invention, confirmed by the reference to D1 in the original application, the disclosure of D1 could not be considered as being accidental within the meaning of **G 1/03**. Furthermore, since D1 related to the same technical effect as the patent in suit, and since its starting polymers to be cured were structurally identical to those used in the claimed process, D1 could be considered as a suitable starting point for assessing inventive step.

The decision in **T 14/01** concerned the allowability of a disclaimer aimed at removing an overlap with prior art in view of **G 1/03**. According to the board in this case, the allegation that a teaching extracted from prior art led away from the invention implied that the skilled person had taken this prior art into consideration. Yet for an anticipation to be accidental it was necessary that the skilled person would have never taken it into consideration. The board then decided that the prior art in question was not accidental in the sense of **G 1/03**, and that the disclaimer was not admissible.

In **T 1297/12** document D3 itself was not unrelated and remote since it related to the same field as the patent in suit. However the appellant (proprietor) argued that the specific novelty-destroying disclosures in D3 were "unrelated and remote". The board cited **T 14/01** and held that the fractions were disclosed **in a relevant document**, D3, and so could not be considered to represent an "accidental" disclosure.

In **T 1049/99** the board concluded that, contrary to what the respondent (patent proprietor) claimed, the skilled person would have taken the teaching of document D21 into consideration when working on the invention in search of a solution to the technical problem defined by the respondent, using appropriate and relevant means to resolve his problem **in the same technical field** as that of the patent in suit. Moreover, contrary to

the respondent's conclusions at the hearing, the board stressed that the fact that a document was difficult to find in published prior art or was difficult for the skilled person to access was not sufficient to justify the conclusion that it constituted an accidental anticipation.

In **T 217/03**, on the issue of whether document D1 was an accidental anticipation, the board stated that D1 did not deal explicitly with the technical problem underlying the claimed invention. However, that was not decisive for accepting D1 as an accidental anticipation. The board concluded that D1 related to the same general technical field as that of the subject-matter of claim 10 and was not from a technical point of view so unrelated and remote that the person skilled in the art would never have taken it into consideration when working on the invention (see **G 1/03**, OJ 2004, 413). Thus the disclosure of D1 could not be considered to constitute an accidental anticipation.

In **T 1146/01** the board held that comparative examples of D1, although teaching what not to do, nevertheless served to elucidate the teaching of the document as a whole and were closely related to the other experiments disclosed in the document. Although it could be said that a comparative example had a "negative relevance", it was neither remote from nor unconnected from the disclosure in the document. Thus, although the comparative examples of D1 provided a teaching not to be followed, this did not mean that their information was not part of the disclosure of D1 or would not be considered by an inventor working on his invention.

In **T 1218/14** the board clarified the meaning of the criterion mentioned in **G 1/03** (OJ 2004, 413) that an accidentally novelty-destroying disclosure had to be completely irrelevant for inventive step. The finding that the claimed subject-matter was inventive in view of D1 as a secondary document did not mean that D1 was irrelevant to inventive step within the meaning of this criterion. This criterion had to be understood not as an alternative, or additional criterion, but as a consequence of the criterion in **G 1/03** and **G 1/16** (OJ 2018, A70) that, from a technical point of view, said disclosure was so unrelated and remote that the person skilled in the art would never have taken it into consideration when making or working the invention.

Other decisions too have had to establish whether or not the anticipation was accidental. In the following decisions, the boards ruled that the anticipation was **not** accidental and that the disclaimers were therefore inadmissible: **T 1086/99**, **T 584/01**, **T 506/02**, **T 285/00**, **T 134/01** (field of pharmaceuticals, same illness; findings summarised by the board in **T 1911/08**, in which account was also taken of **T 739/01**, **T 580/01** and **T 639/01**), **T 351/12**, **T 632/12**, **T 88/21**. For decisions in which the boards found that the anticipation was accidental, see e.g. **T 717/99** and **T 3077/19** (technical field of E4, namely car blankets, considered remote from therapeutic treatment).

b) Drafting of disclaimers – disclaimer to remove no more than necessary

Regarding the drafting of disclaimers, the Enlarged Board stated in **G 1/03** and **G 2/03** (OJ 2004, 413 and 448) and confirmed in **G 1/16** (OJ 2018, A70) that the disclaimer should not remove more than was necessary to restore novelty or to disclaim subject-

matter excluded from patentability for non-technical reasons. The need for a disclaimer was not an opportunity for the applicant to reshape his claims arbitrarily. In **G 2/10** (OJ 2012, 396) the Enlarged Board held that the requirement that "the disclaimer should not remove more than is necessary to restore novelty" was not suitable for the disclaiming of disclosed subject-matter, since in that case the wording of the disclaimer must be configured in accordance with the disclosure of the disclaimed subject-matter in the application as filed.

As to the relationship between the requirement that "the disclaimer should not remove more than is necessary to restore novelty" and the requirement of clarity and conciseness, see also **T 2130/11** (summarised in chapter II.E.1.7.3e) "Drafting of disclaimers – clarity" below).

(i) Disclosure of the interfering document not novelty destroying

In **T 747/00** the board concluded that since, in the absence of a novelty-destroying disclosure in document (5), the disclaimer removed subject-matter without any need to do so, that disclaimer necessarily removed more than was necessary to restore novelty, which was not allowable (see also **T 201/99**).

The board in **T 1224/14** found that a disclaimer was no longer needed to restore novelty over the prior-art example 5A of D1 because the example had become irrelevant for novelty purposes following a limitation of the claimed subject-matter. The disclaimer thus removed more than was necessary to restore novelty and was therefore at odds with the decision in **G 1/03**.

(ii) Uncertainty about anticipation by prior art document

In **T 1532/16** the disclaimer at issue was held unallowable by the opposition division on the grounds that it could not be concluded with certainty that D5 actually disclosed the subject-matter as defined by the positive features of the claim. The board agreed that the disclaimed examples of D5 could not be seen as providing an unambiguous disclosure of compositions within the terms of the positive features of operative claim 1. However, this did not necessarily mean that the requirements of Art. 123(2) EPC were not met. As the wording of the **examples** was **carefully repeated**, nothing more than what these examples disclosed was potentially removed from the claims; but to the extent that the examples were not novelty destroying, indeed nothing was in fact removed.

(iii) Disclaimer covered more than what was disclosed in the prior art

In **T 1050/99** the board concluded that the disclaimer covered more than was disclosed in the prior art and thus removed from the claim more than was necessary to restore novelty. See also **T 285/00** which concerned a disclaimer largely not based on the disclosure of a prior art document cited under Art. 54(3) EPC 1973, thereby rendering the remaining claimed subject-matter more distant from a relevant prior art document cited under Art. 54(2) EPC 1973.

In **T 10/01** the scope of the disclaimer was broader than was necessary to restore novelty. The board nevertheless referred to point 3 of the Reasons for **G 1/03**, saying that it could also be inferred from that decision that a disclaimer that was broader than strictly necessary to restore novelty might be allowed, depending on the circumstances of the case, if that proved necessary to prevent any lack of clarity in the claim that might otherwise result. However, in the case at issue there was no apparent justification for the disclaimer being broader than the disclosure in document (1).

In **T 8/07**, however, the board observed that **G 1/03** had stated that a disclaimer may serve exclusively the purpose for which it is intended. Further, the necessity for a disclaimer was not an opportunity for the applicant to reshape his claims arbitrarily (**G 1/03**, point 3 of the Reasons). Therefore, the disclaimer should not remove more than was necessary to restore novelty or to disclaim subject-matter excluded from patentability for non-technical reasons. From that the board found that it could not be derived from the reasoning of **G 1/03** that a patent proprietor was permitted a degree of **discretion or latitude** concerning the "border" within which the disclaimer should be drafted with respect to the subject-matter to be excised. On the contrary, the existence of any discretion regarding the extent of the disclaimer as compared to the subject-matter to be excluded would inevitably introduce a degree of arbitrariness in the drafting of the disclaimer. This would conflict with the express findings of **G 1/03**. See also **T 2277/18** (with reference to **T 8/07** and **T 795/05**).

In **T 477/09** claim 1 was modified by addition of an undisclosed disclaimer with a view to restoring its novelty over document D1. The board observed that two conditions relating to the wording of disclaimers had been established in points 2.2 (disclaimer should not remove more than is necessary) and 2.4 (clarity and conciseness) of the Order made in **G 1/03** and that those two conditions were equally applicable. In the case at hand, the board found that the scope of the disclaimer was greater than the actually novelty-destroying disclosure in D1.

In **T 2130/11** the board dealt again with these two conditions and held that the condition that the disclaimer should not remove more than is necessary to restore novelty (**G 1/03**) should be applied while taking into consideration its purpose, namely that the "necessity for a disclaimer is not an opportunity for the applicant to reshape his claims arbitrarily" (**G 1/03**). A disclaimer removing more than was strictly necessary to restore novelty would not contradict the spirit of **G 1/03**, if it were required to satisfy Art. 84 EPC and it did not lead to an arbitrary reshaping of the claims (for more details see chapter II.E.1.7.3e) below).

In **T 1354/15** the appellant had argued that, since the disclaimer at issue specified not merely the specific L-dsRNA sequence disclosed in D7, but also the C18 linker group between the two strands, it removed more than was necessary to restore novelty. In the board's view however, the RNA described in D7 was characterised also by the C18 linker. The fact that the application as filed did not contemplate such linkers did not result in the skilled person being presented with new technical information. Excluding the specific RNA having a C18 linker did not provide any technical contribution to the subject-matter disclosed in the application as filed.

(iv) Reference to a comparative example in prior art

In **T 1843/09** (OJ 2013, 508) the opponent argued that the disclaimer contravened Art. 123(2) EPC because the wording of the disclaimer that the claimed film "is other than a film of comparative example 4 of EP-A 0546184" did not represent a technical feature. The board did not accept this argument. Although it was true that technical information could not directly be extracted from the wording of the disclaimer as such, it should be noted that the disclaimer did not merely cite a published patent document, but clearly referred to a specific disclosure in D15, namely a single film described in comparative example 4. Table 4 of D15 characterised this film unambiguously by a number of technical features. The skilled person was therefore able to determine simply by reading the comparative example in D15 which technical embodiment should be excluded from the scope of the claim.

(v) Disclaimed subject-matter not comprised by the claim

In **T 1836/10** the examination division had based its refusal of the application on Art. 53(a) in conjunction with R. 28(c) EPC. The applicant attempted to disclaim the relevant subject-matter. The board considered that an applicant could not amend its claims at will, and that any disclaimer needed should not exclude any more than was necessary to disclaim subject-matter excluded from patentability for non-technical reasons. The same applied to a disclaimer which served to disclaim subject-matter that was not comprised by the claim in the first place (since the subsequent use of the stem cells had not been claimed as a method step).

c) Drafting of disclaimers – disclaimer shall not remove less than is necessary

In case **T 440/04** the question was whether disclaiming example 1 of C63 was sufficient to restore novelty. Whereas on the one hand a disclaimer should not remove more than was necessary to restore novelty, it cannot, on the other hand, be considered to serve its intended purpose when it excises less than what is necessary to restore novelty. The disclosure in C63 of fibres having compositions and properties as required by the present claims 1 according to all requests was not limited to the fibres described in example 1 of C63. "Cutting out" the latter fibres was thus not sufficient to exclude from the said claims 1 all those fibres disclosed in C63 having a composition and the inherent properties according to said claims.

d) Drafting of disclaimers – delimitation against any potential prior art

In **T 285/03** the board found that the interpretation offered by the appellant amounted to a disclaimer although it was not phrased in the usual form. However, that disclaimer was not based on a particular prior art disclosure, whether accidental or not, but tried to delimit the claim against any potential prior art disclosure, contrary to the principles set out in **G 1/03**.

e) Drafting of disclaimers – clarity

The Enlarged Board stated in **G 1/03** and **G 2/03** (OJ 2004, 413 and 448) that the requirements of conciseness and clarity of Art. 84 EPC 1973 were also applicable to claims containing disclaimers. This meant that a disclaimer was not allowable if the necessary limitation could be expressed in simpler terms in positive, originally disclosed features in accordance with R. 29(1), first sentence, EPC 1973 (R. 43(1) EPC). In addition, a plurality of disclaimers might lead to a claim drafting which put an unreasonable burden on the public to find out what was protected and what was not protected. A balance had to be struck between the interest of the applicant in obtaining adequate protection and the interest of the public in determining the scope of protection with reasonable effort.

In the interest of transparency of the patent, it should be clear from the specification that there was an undisclosed disclaimer and why it had been introduced. The excluded prior art should be indicated in the description in accordance with R. 27(1)(b) EPC 1973 (R. 42(1)(b) EPC) and the relation between the prior art and the disclaimer should be shown.

The following rulings on the clarity of claims including a disclaimer were handed down after the decisions in **G 1/03** and **G 2/03**:

(i) Combination of features taken from different documents

In **T 161/02** the board pointed out that the second disclaimer combined features which arose from two different documents of prior art, the combination of these features resulting in a disclaimer that corresponded to neither the disclosure of the first nor that of the second document, and which did not make any technical sense. The board held that such a disclaimer rendered the claim unclear within the meaning of Art. 84 EPC 1973, as it did not allow the public to find out what was protected and what was not protected.

(ii) Disclaimer excluding treatment by surgery or therapy

To justify the exclusion expressed by the formulation "non-therapeutic use" at the beginning of the disputed claim, the appellant in **T 67/02** had cited **G 1/03** and **G 2/03** (OJ 2004, 413 and 448), which had ruled that disclaimers were admissible for subject-matter not patentable under Art. 52 to 57 EPC 1973. However, the board found that in the present case it was not possible to identify a clear distinction between cosmetic use and therapeutic treatment. The board therefore took the view that the exclusion rendered the claimed subject-matter unclear.

In **T 1695/07**, claims 1 to 8 of the main request were found by the board to be directed to a method for treatment of the human body by surgery which is excepted from patentability under Art. 53(c) EPC. Claim 1 of auxiliary request 2 included the feature "wherein the process is not a method for treatment of the human or animal body by surgery". Concerning the admissibility of a disclaimer excluding subject-matter not eligible for patent protection, the board in this case first stressed with reference to **G 1/03** (OJ 2004, 413) that the requirements of Art. 84 EPC are also applicable to claims containing disclaimers.

A clear delimitation and distinction between excepted surgical applications and possibly allowable non-surgical applications of the claimed process requires that the two methods be distinct, i.e. **separable**, which means that they must be of a different nature and may be carried out in different ways. In the board's view, it could not be seen how the claimed process would work without the surgical steps involved.

In **T 1487/09** the board observed that the uses excluded (namely, uses that "comprise or encompass an invasive step representing a substantial physical intervention on the body of a human or an animal which requires professional medical expertise to be carried out and which entail a substantial health risk even when carried out with the required professional care and expertise") were not explicitly defined, but rather must be derived from a condition which was to be fulfilled. Whether this condition was fulfilled or not would have to be established by the reader of the claim. Leaving room for such an assessment by the reader inevitably introduced uncertainty as to the matter for which protection was sought. Hence a lack of clarity arose, which was in breach of Art. 84 EPC. Further, the fact that the wording chosen for the disclaimer was the same as the one used in decision **G 1/07** for describing a surgical method did not mean that the claim fulfilled the clarity requirements of Art. 84 EPC. This had to be handled on a case-by-case basis.

In **T 1916/19**, which related to a non-therapeutic method of providing an anti-microbial effect to skin, the board considered that the claim was clear since such non-therapeutic methods existed and could be identified. In particular the claims were not self-contradictory and the claimed scope was not rendered void by the disclaimer, unlike in **T 1635/09**, **T 767/12** or **T 2074/22**.

(iii) Hiding a disclaimer

In the claim at issue in **T 201/99** the appellants (proprietors) replaced the range of treatment times "1-10 minutes" by "1-6 minutes". They argued that the range of 1 to 6 minutes should be regarded as disclaiming a sub-range of more than 6 to 10. The board, however, emphasised that **G 1/03** and **G 2/03** (point 3 of the Reasons) explicitly ruled out the possibility of hiding a disclaimer by using an undisclosed positive feature defining the difference between the original claim and the anticipation, since this would affect the transparency of the patent (Art. 84 EPC 1973).

(iv) Interpretation of terms

In **T 286/06** the board held that it derived from the purpose of Art. 84 EPC 1973 to ensure legal certainty, that the wording of a claim could not be interpreted by taking into consideration the teaching of further publications not referred to explicitly in the original documents of the application as being relevant for the interpretation of terms used in the description or in the claims. This applied also in the case of a disclaimer, as the only justification for its introduction in a claim was to exclude a novelty-destroying disclosure and it did not represent an opportunity for the applicant or patent proprietor to reshape its claims arbitrarily (see **G 1/03**, OJ 2004, 413). The board evaluated the clarity of claim 1, considering what the skilled person would have understood in reading the claim only,

taking into consideration common general knowledge. The board concluded that the wording of claim 1 was unclear.

(v) Reference to a trade mark

In **T 447/10**, the board stated that according to the established case law of the boards, the characterisation of a product in a claim by reference to a trade mark lacked clarity because the product's composition could change over the term of the patent (see **T 762/90**, **T 270/11**, **T 2030/13**). In the case at issue, the disclaimer excluding a composition sold under a trade mark was of an uncertain scope, such that the subject-matter of claim 1 in the requests in question lacked clarity.

(vi) Disclaimer removing more than strictly necessary to restore novelty for clarity reasons

In **T 477/09** board observed that two conditions relating to the wording of disclaimers had been established in points 2.2 (disclaimer should not remove more than is necessary) and 2.4 (clarity and conciseness) of the Order made in **G 1/03** and that those two conditions were equally applicable. The patent proprietor therefore could **not** be considered to have any **room for manoeuvre** in wording the disclaimer and thereby defining its scope: to satisfy the conditions set out in **G 1/03**, a disclaimer could not remove more than was necessary to restore novelty.

In **T 2130/11** the board held that the requirements of Art. 84 EPC must apply for a disclaimer as for any other feature of a patent claim. However, the condition that the disclaimer should not remove more than is necessary to restore novelty (**G 1/03**) should be applied while taking into consideration its purpose, namely that the "necessity for a disclaimer is not an opportunity for the applicant to reshape his claims arbitrarily" (**G 1/03**). In this respect situations could be foreseen, in which, while fulfilment of the condition taken in a strictly literal way would not be possible, a definition of the disclaimed subject-matter, which satisfied the requirements of Art. 84 EPC and fulfilled the purpose of the condition (i.e. to avoid an arbitrary reshaping of the claims), might be achievable. In other words, a disclaimer removing more than was strictly necessary to restore novelty would not contradict the spirit of **G 1/03**, if it were required to satisfy Art. 84 EPC and it did not lead to an arbitrary reshaping of the claims. In **T 1399/13** the board concurred with the approach taken in **T 2130/11**.

f) Undisclosed disclaimer must not be related to the teaching of the invention

According to **G 1/03** (OJ 2004, 413), a disclaimer which makes a technical contribution, in particular which is or becomes relevant for the assessment of inventive step or sufficiency of disclosure, adds subject-matter contrary to Art. 123(2) EPC (point 2.3 of the Order; point 2.6 of the Reasons). In **G 1/16** (OJ 2018, A70) the Enlarged Board endorsed the concept that the undisclosed disclaimer may not be related to the teaching of the invention and provided the following clarifications: Introducing any disclaimer into a claim necessarily changes the technical information. The question to be asked in this context is not whether an undisclosed disclaimer quantitatively reduces the original technical teaching – this is inevitably the case – but rather whether it **qualitatively changes** it in the

sense that the applicant's or patent proprietor's **position with regard to other requirements for patentability** is improved. If that is the case, then the original technical teaching has been changed by the introduction of the disclaimer in an unallowable way.

In **T 788/05** the undisclosed disclaimer was introduced by the appellant during the examination procedure with the purpose of establishing the novelty of the claimed subject-matter with respect to D1, which was then considered as a prior art document relevant under Art. 54(3) EPC 1973. In the case at issue, the relevant prior art was represented by documents D1 and D5. To be allowable the disclaimer had to fulfil the conditions in relation to both documents. As far as D1 was concerned, the disclaimer appeared to be appropriate. D5 represented the state of the art under Art. 54(2) EPC 1973. As D5 was not state of the art under Art. 54(3) and (4) EPC 1973 and was not an accidental disclosure, the disclaimer would only be allowable if it did not add subject-matter within the meaning of Art. 123(2) EPC 1973, i.e. if the disclaimer did not become relevant for the assessment of inventive step. Going into details, the board concluded that the subject-matter of claim 1 of the main and the first auxiliary requests was not acceptable under Art. 123(2) EPC 1973 (see also **T 761/08**).

In **T 660/14** claim 1 of auxiliary request 4 contained two additional features according to which the operating and control members of the claimed bicycle control device were pivotable about non-common offset axes and were not pivotable commonly about either of the offset axes. The board, applying the criterion of **G 1/03** (OJ 2004, 413) as interpreted by **G 1/16** (OJ 2018, A70), considered that the disclaimers provided a technical contribution to the subject-matter disclosed. The pivotable arrangement of the operating and control members about the axes was of a technical nature, not least through the disclosure of the ergonomic benefits; the board concluded the disclaiming of this arrangement would have to be as well. By disclaiming both common offset axes and common pivoting about either of the offset axes, the ergonomic considerations identified in the application as filed had been modified, resulting in a **qualitative change** to the originally disclosed technical teaching in the sense that the proprietor's position with regard to inventive step would be changed. See also **T 2000/14**, in which the board also found that the disclaimer lead to a qualitative change to the originally disclosed technical teaching.

In **T 437/14** of 12 March 2019, taking into account the answers to the questions on undisclosed disclaimers which it had referred to the Enlarged Board in case **G 1/16** (OJ 2018, A70), the board considered that there was no evidence that the limitation of the genus of compounds covered by the formula in claim 1, which resulted from the excision of the seven specific compounds defined in the disclaimer, became relevant for establishing inventive step or sufficiency of disclosure.

In **T 1984/15** the board pointed out that under decision **G 1/03** a disclaimer that would be allowable solely on the basis of a conflicting application could not render the invention novel or inventive over state of the art under Art. 54(2) EPC. Since the new disclaimer in this case had, as asserted by the patent proprietor itself, rendered the subject-matter of the claim inventive over the closest prior art D10 (a document as per Art. 54(2) EPC),

precisely that was the scenario here. The disclaimer was therefore an unallowable amendment under Art. 123(2) EPC.

g) Positive features – G 1/03 not applicable

In **T 2502/13** the applicant sought to apply **G 1/03** to a positive feature in order to restore novelty over a document under Art. 54(3) EPC. The board held, however, that **G 1/03** did not apply in this situation.

h) Negative feature implicitly disclosed in original application – G 1/03 not applicable

In **T 1525/15** the appellant's objection related to a negative feature (or disclaimer) of both independent claims ("free of a micro-embossing design"). The board observed that there was no verbatim disclosure of this feature in the original application. The feature was added during the grant proceedings to establish novelty over document D1, which was state of the art according to Art. 54(3) EPC. The board emphasised that such an amendment was allowable: (i) if the negative feature was implicitly disclosed as such in the original application; or (ii) if the disclaimer was undisclosed in the original application but complied with the requirements formulated in decision **G 1/03** (OJ 2004, 413) of the Enlarged Board. In the case in hand the board came to the conclusion that the negative feature was implicitly but nevertheless directly and unambiguously disclosed in the original application. As the negative feature was disclosed as such in the original application, it was not necessary to examine whether the conditions set out in decision **G 1/03** (and confirmed in **G 1/16**, OJ 2018, A70) were fulfilled.

In **T 273/22**, the board's view on disclaimers was that there existed a fundamental difference between (i) an implicit disclosure in an (earlier) application as filed of the absence of certain features derivable from the comparison of the invention with the prior art and (ii) a claim wording that specified the mandatory absence of certain features as an explicit negative technical feature from the specific subject-matter defined in the claim under consideration (i.e. a disclaimer in a claim). In the case in hand, in view of the uncertainties caused by the absence of any explicit disclosure of the (alleged) preferable absence of fully human antibodies, the board considered that the disclaimer concerned was in fact an undisclosed disclaimer. The findings of **G 1/03**, **G 2/03** and **G 1/16** thus applied. The fact that the disclaimer did not fall into any of the categories established in these decisions meant that, for this reason alone, it was not allowable.

1.7.4 Decisions applying the criteria established by the Enlarged Board in G 2/10 – remaining subject-matter test

The board in **T 1224/14** found that an amendment designed to exclude a specific value from a range described as particularly preferred in the application as filed did not meet the **G 2/10** criteria for an allowable disclaimer.

In **T 2130/11** the disclaimer in the third auxiliary request excluded a disclosed embodiment **from a generic class**. The board considered that the remaining subject-matter was still generic and could not be considered as a non-disclosed subgroup which had been singled

out by means of the disclaimer, so that the remaining general teaching could not be seen as being modified by the disclaimer. Whether the invention worked for the claimed subject-matter and what problem was credibly solved by it were questions which were not relevant for assessing whether this subject-matter extended beyond the content of the application as filed. See however also **T 1441/13** and **T 1808/13** according to which it had to be established whether the subject-matter of the invention remaining in the claim was available at the filing date.

In **T 1577/21**, the subject-matter of claim 1 of the main request resulted from the deletion of the proviso present in original claim 1. The deletion of a proviso/disclaimer explicitly disclosed in an application as originally filed as "not forming part" of the invention might not be admissible if the deletion resulted in the "non-part" being still partially claimed or if there was no disclosure in the original application as a whole which rendered the remaining claimed subject-matter directly and unambiguously derivable therefrom. In the present case, the omission of the proviso "provided that such pamoic acid or pharmaceutically acceptable salt thereof is not an active pharmaceutical ingredient" did not extend beyond the content of the application as filed. The main request thus met the requirements of Art. 123(2) EPC.

In **T 1660/22** the subject-matter of claim 1 in auxiliary request 5 contained a disclosed disclaimer. The board therefore considered whether the remaining claimed subject-matter was directly and unambiguously disclosed in the application as filed (**G 2/10**). The original disclosure also included the method for producing HFSI without a catalyst, as it was apparent from the several paragraphs and an example of the description that a catalyst was optional. Therefore, the remaining subject-matter, i.e. the method without a catalyst, met the "gold standard".

1.7.5 Applicability of the decisions of the Enlarged Board to cases already pending

The board in **T 500/00** and **T 740/98** ruled that the principle of good faith could not be invoked against the application of the principles concerning the allowability of disclaimers laid down in **G 1/03** to pending cases (see also **T 1045/09** and chapter III.A.6.1. "Case law deviating from or overruling the practice").

1.7.6 No analogy with G 1/03 where a disclaimer already in the application as filed is deleted

In **T 2327/18** the respondent (patent proprietor) submitted that the disclaimer at issue had been included in the original application for legal reasons only (namely to establish novelty over an Art. 54(3) EPC document cited in relation to the parent application). The board refused to draw the analogy with **G 1/03** (OJ 2004, 413) which the appellant had sought to establish, holding that a disclaimer expressly disclosed in the application as filed as not forming part of the invention could not permissibly be deleted if that would mean that some of that "non-part" was claimed after all.

1.8. Generalisations

1.8.1 Replacing specific feature with more general term – no inclusion of undisclosed equivalents

With reference to **T 416/86** (OJ 1989, 308), **T 265/88** and **T 118/89**, the board in **T 284/94** (OJ 1999, 464) confirmed that an amendment which replaced a disclosed specific feature either by its function or by a more general term and thus incorporated undisclosed equivalents into the content of the application as filed, was not allowable under Art. 123(2) EPC 1973.

In **T 685/90** the board stated that specific equivalents of explicitly disclosed features did not automatically belong to the content of a European patent application as filed, when this content was used as state of the art according to Art. 54(3) and (4) EPC 1973 against a more recent application. It therefore concluded that such equivalents could not belong to the content of a European patent application either, when this content was assessed to determine whether an amendment was admissible under Art. 123(2) EPC 1973. See also **T 946/13** and **T 2087/17**, citing **T 685/90** and applying this principle in the context of Art. 87(1) EPC. On the prohibition of including equivalents, see also **T 673/89**.

In **T 40/97** the board considered that in a case where a number of generally similar embodiments were discussed in equivalent terms, the person skilled in the art would, in normal circumstances and when nothing pointed to the contrary, notionally associate the characteristics of an element of one embodiment described in some detail with the comparable element of another embodiment described in lesser detail.

In **T 653/03** the original term "diesel engine" in claim 1 was replaced by the term "combustion engine". The board decided that the treatment of exhaust gas in the original application was always related to a diesel engine, and it could not be inferred by the skilled person that the subject-matter of the granted patent extended to a method which was suitable for any type of combustion engine. The generalisation was not admissible.

In **T 2537/10** the board found that decision **T 416/86** (OJ 1989, 308), holding that replacing a disclosed special feature by a broad general expression was to be considered an unallowable amendment under Art. 123(2) EPC if that general expression implicitly combined special features other than the disclosed one with the subject-matter of the application for the first time, was irrelevant since a specifically disclosed feature had not been replaced by its function. Instead, a general claim had been limited using a feature that the skilled person would, on the basis of common general knowledge in the art, directly and unambiguously derive from the originally filed version of the application.

1.8.2 Generalisation and claim category

In **T 784/89** (OJ 1992, 438) the patent application as filed explicitly disclosed a computer-controlled method for producing a particular effect. By reference to another patent application an apparatus was implicitly disclosed comprising a programmable component which, when suitably programmed, was used for the claimed method. The board

considered that only this specific combination had been disclosed. To claim an apparatus for carrying out that method was considered an inadmissible extension of the application because the claim covered apparatus which could also be used in other methods and to achieve other effects. The only allowable claim was for an apparatus for carrying out a method comprising a programmable component which could be suitably programmed to carry out the method.

1.8.3 No generalisation of an effect obtained for particular embodiments

In **T 3/03** the board decided that an amendment consisting in the generalisation of an effect obtained for particular embodiments was not admissible. In the case in point, the results obtained for particular embodiments could not be generalised since the particular circumstances of use, including the type of additive used, determined whether or not filterability was improved.

1.8.4 Amendments to preamble of claim by substituting general term for specific term

According to **T 52/82** (OJ 1983, 416), an amended claim does not contain subject-matter which extends beyond the content of the application as filed if the preamble to the claim has been amended by substituting an appropriate more general term, which is apt to define a feature common to both the closest prior art described in the application as filed and the invention which is the subject of the application, for a specific term which is not apt to define that feature of the prior art (see also **T 285/07**).

1.9. Intermediate generalisations

1.9.1 Principles

According to established case law (as summarised e.g., in **T 219/09**, **T 1944/10** or **T 3069/19**), it will normally not be allowable to base an amended claim on the extraction of isolated features from a set of features originally disclosed only in combination, e.g. a specific embodiment in the description or drawings of the original application (**T 1067/97**, **T 714/00**, **T 25/03**, **T 2095/12**, **T 1365/16**).

Amended subject-matter that amounts to a generalisation of a particular embodiment disclosed in the original application but is still more specific than the original definition of the invention in general terms is often called an "intermediate generalisation" (see e.g. **T 461/05**, **T 191/04**; see also **T 2311/10**) and sometimes an "intermediate restriction" (see **T 461/05**, **T 879/09**, **T 2537/10**). Other decisions understand "intermediate generalisation" to refer to an undisclosed – and thus unallowable – combination of selected features lying somewhere between an originally broad disclosure and a more limited specific disclosure (**T 1408/04**). An intermediate generalisation is different from a simple generalisation (as e.g. in **T 910/03**, **T 404/03**), since in the former case a definition of the invention in general terms forms part of the original disclosure (**T 461/05**).

In **T 1238/08** the board observed that it would be contrary to the purpose of Art. 123(2) EPC to allow undisclosed intermediate generalisations only because the

application as originally filed had not been drafted to contain appropriate fall-back positions.

An intermediate generalisation is justified only **in the absence of any clearly recognisable functional or structural relationship** among the features of the specific combination (see e.g. **T 1067/97**, **T 25/03**, **T 876/05**, **T 1587/12**, **T 1561/14**, **T 2003/14**, **T 879/18**) or if the extracted feature is **not inextricably linked with those features** (see e.g. **T 714/00**, **T 2154/11**, **T 2287/11**, **T 775/17**). See also e.g. **T 1397/09**, **T 2172/11**, **T 2095/12**, **T 2489/13**, **T 2313/13**, **T 1469/15**, **T 152/16** and **T 1365/16**, which refer to both criteria; see also the abstracts on **T 1500/07** and **T 500/11** below.

The board in **T 962/98** held that an intermediate generalisation was admissible only if the skilled person could recognise without any doubt from the application as filed that those characteristics were **not closely related** to the other characteristics of the working example and applied directly and unambiguously to the more general context (often cited, see e.g. **T 1144/08**, **T 313/09**, **T 879/09**, **T 2185/10**, **T 500/11**, **T 2489/13**, **T 1002/14**, **T 978/15**). In other words, in order to be acceptable, this intermediate generalisation had to be the result of unambiguous information that a skilled person would draw from a review of the example and the content of the application as filed.

In **T 461/05** the board found that claim 4 as amended defined subject-matter which was less general than that defined by claim 1 in the original version but more general than the particular embodiment corresponding to case 2a as disclosed in the description and the subject-matter of claim 6 as originally filed. The amendment comprised the omission of certain characteristics of the combination of features of the particular embodiment. The board held that the provisions of Art. 123(2) EPC 1973 precluded such an amendment only where the amendment presented the skilled person with new information which did not follow directly and unambiguously from the application as originally filed. A restriction of a claim by adding a number of features from a particular embodiment originally disclosed did not in itself introduce such new information. By contrast, the omission of the remaining features of the embodiment would introduce new information if the **omitted features** were **necessary to carry out the particular embodiment** of the invention. In the case in hand, the board saw no reasons why these omitted features would be necessary to carry out the invention. Therefore, claim 4 as amended was in conformity with Art. 123(2) EPC. See also **T 273/10**.

In **T 1906/11** the board emphasised that classifying an amendment as an "intermediate generalisation" or otherwise, for example as an "omission of an originally claimed feature" or a "multiple selection from two groups of alternative features" did not permit, as such, the drawing of any conclusion about the allowability of this amendment under Art. 123(2) EPC. According to that decision, the only relevant question would be whether a skilled person faced with the amended version of the application or patent, as compared to a skilled person having seen only the version originally disclosed, would derive from that amended version any **additional technically relevant information**. Only if such additional information was derivable can there be an infringement of Art. 123(2) EPC (cited in **T 802/13**). In **T 248/12** the board stated that in respect of the "technical relevance" of the added information, case **T 1906/11** could not be understood to define a new standard

for judging amendments with respect to Art. 123(2) EPC since this would be at odds with the "gold standard" in **G 2/10** (OJ 2012, 376). See also **T 1791/12** where the board considered that no divergent interpretations of the principles contained in **G 2/10** for judging amendments were apparent in **T 1906/11**. The board in **T 1471/10** considered that the **ultimate standard for assessing compliance with the requirements of Art. 123(2) EPC in the case of an intermediate generalisation remains the "gold standard"** (as set out in chapter II.E.1.3.1; see also **T 2392/10**, **T 1791/12**, **T 1762/21**). This approach was followed in **T 321/23** where the board observed that, also in the context of intermediate generalisations, the various tests developed for different cases of amendments might be an aid but they could not take the place of the "gold standard" and should not lead to a different result.

In **T 2311/10** the board held that, in the case of an intermediate generalisation, the three-point or essentiality test was unhelpful or even misleading. See also **T 1840/11**, **T 2095/12** and **T 2489/13**. On the three-point or essentiality test in general see in this chapter II.E.1.4.4 above. Also, in **T 9/19**, the board held that the degree of relevance or essentiality of a feature was not the relevant test for assessing whether an amendment introduced added subject-matter.

In **T 1387/05** the board noted that the same principles were to be applied for both Art. 76(1) EPC and Art. 123(2) EPC 1973. It followed that it was normally not allowable under Art. 76(1) EPC 1973 to extract features from a set of features which were originally disclosed only in combination in a parent application and to claim such extracted features in a divisional application isolated from their context, namely the combination disclosed in the parent application. See also the abstract for the consolidated cases **T 1500/07**, **T 1501/07** and **T 1502/07** in chapter II.E.1.9.2 below.

1.9.2 Examples regarding the requirement "no clearly recognisable functional or structural relationship"

In **T 25/03** the board stated that extracting isolated features from a set of features which had originally been disclosed in combination would only be justified in the absence of any clearly recognisable functional or structural relationship among said features (see e.g. **T 1067/97**). The board concluded that since claim 1 at issue resulted from the extraction of isolated steps from the specific combination (here a sequence of steps) disclosed as **essential for obtaining the desired result in the embodiment** of Figure 4, and since the appellant had not referred to other parts of the application as filed that could support the proposed amendment, and no such parts had been identified by the board, claim 1 as amended in accordance with the first auxiliary request did not meet the requirements of Art. 123(2) EPC 1973. An example with the opposite conclusion, that is, in which the board held that the skilled person would consider the omitted features to be non-essential for the identified technical effects, can be found in **T 1601/16** (albeit without reference to the criterion stipulated in **T 1067/97**).

In **T 582/91**, the respondent (opponent) was of the opinion that when restricting a granted claim by introducing subject-matter from the dependent claims all the **features of the dependent claims** in question should be incorporated in the new independent claim.

Contrary to this opinion the board considered that one feature of a dependent claim could be readily combined with a preceding independent claim as long as the skilled person recognised that there was clearly no close functional or structural relationship between the one feature of that dependent claim and its other features, or between that one feature and the teaching of other dependent claims referred to in that dependent claim (see also **T 3240/19**). If this was the case, no objections under Art. 123(2) EPC 1973 arose (see also **T 938/95**).

In the consolidated cases **T 1500/07**, **T 1501/07** and **T 1502/07**, the board applied the established case law of the boards of appeal concerning Art. 123(2) EPC to the case of Art. 76(1) EPC 1973. The board stressed that where newly claimed subject-matter was based on the extraction of features in isolation from a set of features originally disclosed in combination (e.g. in a specific embodiment in the description) the criterion that this subject-matter had to be directly and unambiguously derivable by the skilled person from the original disclosure was met if there was no clearly recognisable functional or structural relationship between the features, i.e. when they were not inextricably linked. What was decisive was determining which specific combinations of features were originally taught by the parent, and whether the skilled person recognised immediately and unequivocally from the totality of the disclosure when read contextually and using common general knowledge that, and which, certain features were **incidental to the proper functioning of these specific embodiments**, and that these could be dispensed with without consequence for the remaining features. In the case before the board, the fact that the claimed features were not given any special prominence, and that they were functionally and structurally bound to the other remaining features indicated that these criteria were not met.

A further example of a clearly recognisable functional or structural relationship between the isolated feature(s) and the other features of a set of features originally disclosed in combination can be found in **T 833/16**. In this case the features in question were the two characteristics defining a type of magnetic signal generated by the coil disclosed in the application. There was no disclosure, explicit or implicit, that the omitted feature was merely optional or preferred.

In **T 886/15** the board examined whether the embodiments disclosed in certain figures could constitute, on their own, a sufficient basis for the features added in claim 1 of the main request. The board recalled that the selection of some features from a group of features originally disclosed in combination is allowable under Art. 123(2) EPC if the selected and omitted features are neither structurally nor functionally linked. The board held that, in the case in hand, in the absence of any indication, in the drawing and the corresponding portion of the description, as to the **effects resulting from the relevant feature**, it was impossible to recognise whether the above conditions for selecting a feature from its context were fulfilled. According to the board, a further consequence was that it was impossible for the skilled person to recognise what purpose was meant to be achieved by the selected features in the context of the invention. They thus could not be considered to be the deliberate result of technical considerations directed to the solution of the technical problem involved (see also **T 398/00**, see chapter II.E.1.13.2 "Schematic drawings" below). However, in **T 2027/18** the board explained that the approach of

T 398/00 and **T 886/15** de facto made a distinction between features in the drawings which were related to the solution of the technical problem and features which were not. In the board's view, such a distinction was problematic in the context of Art. 123(2) EPC as it introduced a degree of legal uncertainty considering that technical problems often completely changed in the course of the proceedings, for example if new prior art was considered (see **G 2/98**, reasons 8.3; **T 2311/10**; **T 910/03**).

In **T 1762/21**, the board explained that the skilled person was presented with subject-matter extending beyond the application as filed when an amended claim included only some features of an originally disclosed combination and the features left out of the claim were understood by the skilled person to be inextricably linked to the claimed ones. This was the case if the skilled person would have considered the omitted features as **necessary to achieve the effect** associated with the added features. In such a situation, the amended claim conveyed the technical teaching that the effect could be obtained with the claimed features alone. This was in contradiction with the original disclosure, according to which the whole combination of features was needed.

1.9.3 Further examples of unallowable intermediate generalisations

In **T 1408/04** a specific selection had been made in amended claim 1 from the broad range of topsheet/backsheet structures within the scope of claim 1 as granted. The board considered that, to avoid an intermediate generalisation (i.e. an undisclosed combination of selected features lying somewhere between an originally broad disclosure and a more limited specific disclosure), all the necessary features of the specific selection must be included in the claim. The selection in this case came from the drawings, which, however, also showed a particular (albeit commonly used) type of topsheet/backsheet connection. This particular connection was lacking in the claim. Thus an intermediate generalisation was present. Cited e.g. in **T 163/13**.

In **T 448/16** the board emphasised that the idea of added feature f had to be at least implicitly disclosed in the parent application as a teaching that the skilled person would immediately recognise **as distinct and separable** for it to be introduced in isolation into claim 1. The board did not consider that the skilled person, **without foreknowledge** of what they are looking for, would immediately identify the feature in question as a distinct and separable aspect of the embodiment from which it was isolated.

In **T 1365/16** the board held that whether and how the skilled person would generalise the embodiment of Figure 8 was neither inherent nor implicit from the disclosure as filed, but concerned matters (if any) related to obviousness (see also **T 2745/19**). This was however not a sufficient basis to comply with Art. 123(2) EPC (**G 2/10**, OJ 2012, 376). In the boards view, in particular the considerations of **T 1538/12** (regarding general statements at the end of the description burdening the skilled reader with having to work out which combinations of features from the detailed embodiments might be claimed together) applied mutatis mutandis to the general statement that "the invention ... may equally be utilized on symmetric key agreement protocols".

For further examples of unallowable intermediate generalisations, see **T 1004/01** (summarised above in this chapter II.E.1.5.2 "Forming a range with isolated value taken from example"), **T 166/04** (feature omitted although its function was presented as being essential to achieving the desired result), **T 191/04** (no hint for skilled reader that the claimed robot could be associated with a milking box without having a further feature), **T 200/04** (nothing in the description indicating that the features omitted in the claim, as compared to the examples, were not essential), **T 1164/04** (isolated feature disclosed only in combination with other features), **T 911/06** (omission of a feature that is consistently presented in the application as necessary for a certain function), **T 273/10** (no indication in the application as filed that the omitted features served no purpose, were optional or could be replaced by other technically equivalent means), **T 775/17** (isolated feature was inextricably linked to the other features defined in the relevant example), **T 1748/19** (systematic use of "may" in front of a verb, thereby emptying it of its conventional meaning of introducing an optional verb).

1.9.4 Further examples of allowable extractions of isolated features from a set of features

In the above-mentioned decision **T 1408/04**, the board considered, with regard to the third auxiliary request, that the skilled person would immediately realise that the specific topsheet/backsheet sealed configuration as shown in Figures 1 to 3 was generally applicable also to other aspects of the invention and was not limited only to the set of features shown in these Figures. The other elements present in these Figures were not inextricably linked to the topsheet/backsheet sealed configuration, as also confirmed by the description, which categorised these features as optional.

In **T 500/11** the amendment in claim 1 at issue corresponded to the restriction of the range "between 50 to 10000 ppm of chromium" by the lower end-value of 550 ppm. It was uncontested that there was a literal basis for this specific value in example 3 of the patent, however not in combination with the other features of amended claim 1. The question to be answered was whether the feature "550 ppm Cr" was **inextricably linked** to the other features defined in the relevant example of the patent. The board observed that all the features were parameters which might be varied individually and each of these variations would necessarily lead to a different result on the selectivity to TCS. The aim of the invention – namely increasing the selectivity to TCS – was merely achieved by the addition of selected amounts of chromium to silicon and thus this feature was not "closely related to the other characteristics of the working example and applies directly and unambiguously to the more general context" as required in **T 962/98**. The current decision was also in line with **T 273/10**. It followed that the picking out of the value 550 ppm was plainly acceptable in the case at issue, with the consequence that the requirements of Art. 123(2) EPC were fulfilled. For further cases when a **range** is formed by taking an isolated value from an example, see also chapter II.E.1.5.2.

In **T 916/19** each of the layers constituting the stack of layers of the superconductive segments of the specific embodiments had a particular function that was explicitly disclosed in the original application. The skilled person would therefore have directly and unambiguously derived the consequences of a missing buffer layer or a missing capping layer from the original application. In addition, neither the buffer layer nor the capping layer

contributed to the solution of the problem primarily addressed by the original application. The board thus established that the buffer layer and the capping layer could not be seen as being inextricably linked to the other features of claim 1.

For further examples where the board considered that the extraction of isolated features from a set of features was not an unallowable intermediate generalisation, see e. g. **T 266/12**, **T 717/15**, **T 2047/20** and **T 507/22**.

1.10. Specific derived from generic

1.10.1 Specific term or embodiment derived from generic disclosure

It is a generally established principle in the case law of the boards of appeal that a generic term or embodiment does not disclose a specific term or embodiment unless the application teaches otherwise (**T 88/12**). In the case in hand in **T 88/12** the generic term "a laundry machine" did not disclose the specific term "a drying machine".

In **T 367/92** the board rejected an amendment because it contained a specific term which could not be considered to be clearly and unambiguously derivable from the originally disclosed generic term. In this case the issue boiled down to the question whether the generic term "polyester" could be equated with the specific term "polyethylene terephthalate". The sole document added by the appellant (proprietor) in support of this interpretation proved only that polyethylene terephthalate was a polyester (which was never under discussion), but did not show that "polyester" could be interpreted as implicitly meaning "polyethylene terephthalate".

In **T 187/91** the invention and its preferred embodiments had been described throughout the application as filed as having more than one light source. However, there was an indication in the description that although the preferred embodiment of the invention was shown as having three light sources, "it will be understood that more or less sources [...] may be utilized". The board held that a specific example (one light source) within a generic disclosure (more or less than three light sources) forming part of the description of the invention in an application as filed is part of the content of the application as filed if the skilled reader would **seriously contemplate** such specific example as a possible practical embodiment of the described invention, having regard to its context in the remainder of the application as filed, and subject to any understanding of the skilled reader to the contrary. In the case at issue the board held that the skilled reader of the application would seriously contemplate the use of only one light source. See also **T 1170/02**, regarding ranges of parameters, summarised in chapter II.E.1.5.1b).

For cases where the boards came to the contrary conclusion that the skilled person would not seriously contemplate the respective specific choice which was claimed, see e.g. **T 725/99**, **T 1038/01** and **T 1477/21**.

1.10.2 Component of entity derived from entity

In **T 1228/01** the appellant (applicant) inferred that the reference to a deposited phage in a claim, whose correct deposit was mentioned in the application as originally filed, was an implicit disclosure of a part of a nucleotide sequence contained in the phage, although the sequence was not disclosed per se. The board made reference to **T 301/87** (OJ 1990, 335), in which it had been decided that if an entity itself was disclosed to the skilled person, this did not necessarily mean that a component part was also disclosed for the purpose of priority if this could not be envisaged directly and unambiguously as such and required considerable investigation to reveal its identity. The board in **T 1228/01** held that these findings were also applicable to amendments. It stated that the disclosure in the application as originally filed of the deposition of the recombinant bacteriophage Lgt11-P3 was not considered to be a basis within the requirements of Art. 123(2) EPC 1973 for the disclosure of a DNA sequence designated as "the P3 coding sequence" which was allegedly contained in that bacteriophage, but which as such was not disclosed in the application as originally filed. Thus, the requirements of Art. 123(2) EPC 1973 were not met.

1.10.3 Restricting a generic definition of a substituent to a specific (individual) one

In **T 288/92** the board held that it was not permissible to amend a generic formula defining a class of chemical compounds by restricting an originally disclosed generic definition of a substituent to a specific (individual) one which was arbitrarily selected from chemical entities, such as in the examples, without some support for such restriction in the general part of the description (see also **T 1537/14**).

1.10.4 Multiple arbitrary selection

In **T 1919/11** the board considered that the subject-matter of amended claim 1 of the main request (method for producing taxanes) resulted from a **multiple arbitrary selection** of three features (selection of one particular species and of a specific range of silver concentration and a restriction of "auxin-related growth regulator" to "auxin" for the enhancement agent). The board concluded that the skilled person was not in a position to derive in a direct and unambiguous way, from the parent application as originally filed, that these features were present in the particular combination now claimed. The selections were arbitrary and their present combination represented added subject-matter.

On unallowable multiple selection, see also above in this chapter II.E.1.6. "Combination of features pertaining to separate embodiments or lists".

1.11. Additions

1.11.1 Addition to the claim of a feature taken from drawings

For examples concerning the insertion of additional features to the claim taken from **drawings**, see below in this chapter II.E.1.13. "Disclosure in drawings".

1.11.2 Addition to the claim of an isolated feature taken from description

For examples concerning the insertion of an **isolated** feature to the claim taken from the **description**, see above in this chapter II.E.1.9. "Intermediate generalisations".

1.11.3 Addition to the claim of features originally presented as prior art

In **T 912/08** the board held that an amendment that resulted in features originally presented as part of the prior art, being then presented as the invention could be damaging to the legal security of third parties relying on the content of the original application and added subject-matter contrary to Art. 123(2) EPC.

In **T 1652/06** the board drew a distinction as to whether in the application as originally filed the feature in question was disclosed as part of the background art or as part of the invention. In the case at issue, the feature was taken from the background art and could not serve as basis for the amendment (see also **T 626/11**).

However, in **T 293/12** the board distinguished its case from **T 1652/06** and underlined that a case-by-case analysis of the structure and content of the description was necessary in order to come to a conclusion for a particular case. In the case in hand, a sentence under the heading "State of the art" was clearly intended to provide the skilled person with a definition of the disease to be treated and therefore related to the teaching of the invention.

1.11.4 Addition to the claim of features previously described as non-essential

In **T 583/93** (OJ 1996, 496) the board held that any attempt to interpret Art. 123(2) EPC 1973 such that the introduction into a claim of features previously described as non-essential would not be permissible, had to fail. The EPC contained no requirement that forbade the redefinition of an invention provided that Art. 123(2) EPC 1973 and Art. 123(3) EPC 1973 were complied with. Such a redefinition was often necessary in order to take into account prior art not known to the applicant at the priority date. It was therefore possible that features described as optional at the priority date later became essential in the sense that they were necessary to delimit the invention from the prior art. The introduction of such features was permissible provided that, first, the application as originally filed contained an adequate basis for such limitations and, second, the resulting combination of features was still in line with the teaching of the application as originally filed.

1.11.5 Adding prior art citations to the description

a) General

In **T 2321/08** the board came to the conclusion that R. 27(1)(b) EPC 1973, or equivalent R. 42(1)(b) EPC, does not put a stringent obligation on the applicant to acknowledge prior art known to him, and to cite documents known to him reflecting this prior art, already at the time of filing the application. Furthermore, no requirement of the EPC prohibits amending an application in order to meet the provisions set out in R. 27(1)(b) EPC 1973

or R. 42(1)(b) EPC (endorsed by **T 1123/09**; see also **T 2450/17**, summarised in chapter IV.C.5.1.2b)).

In **T 11/82** (OJ 1983, 479) it was pointed out that the mere addition to the description of a reference to prior art could not reasonably be interpreted as the addition of "subject-matter", contrary to Art. 123(2) EPC 1973. Whether it did so would clearly depend on the actual language used and the circumstances of the case.

In **T 450/97** (OJ 1999, 67) the board confirmed that the mere addition of a reference to prior art did not contravene Art. 123(2) EPC 1973. It added that after limitation of the claims, also at the opposition stage, a document which subsequently proved not only to be the closest state of the art, but also to be essential for understanding the invention within the meaning of R. 27(1)(b) EPC 1973 was to be introduced in the amended description. See also **T 276/07**.

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

In **T 471/20** the board had to decide whether, in the case in hand, the insertion into the description of a new paragraph acknowledging a prior art document resulted in subject-matter extending beyond the content of the application as filed. The board held that the paragraph in question did not provide a definition to be used when interpreting the claims and that its insertion therefore did not provide the person skilled with any new technical information. For another recent example where the insertion of a reference to relevant prior art did not add new technical information see **T 857/20**.

See also **T 725/05** (addition of a discussion of a prior art document which went far beyond that document's disclosure) and **T 452/08** (added reference to prior art redefined a feature) and chapters II.E.1.14.3 and II.E.1.14.4.

b) Erroneous delimitations from the relevant prior art

In the above-mentioned decision **T 11/82** (OJ 1983, 479), the board also held that the (added) delimitations from the relevant prior art should not be incorrect or misleading, otherwise they could indeed alter the subject-matter of the patent. In **T 2450/17**, the board cited **T 11/82**, concluding (with reference to **T 889/93** and **T 1039/93**) that remedying this kind of error therefore did not contravene Art. 123(2) EPC.

1.11.6 Addition of advantages and effects to the description

In **T 11/82** (OJ 1983, 479) the board stated that the addition of a discussion of the advantages of the invention with reference to the prior art did not necessarily constitute a contravention of Art. 123(2) EPC 1973. Whether Art. 123(2) EPC was infringed depended

on the actual language used and on the circumstances of the individual case. See also **T 725/05** where the addition of an analysis and discussion of a prior art document which went far beyond the disclosure of said document was considered contrary to Art. 123(2) EPC).

In **T 37/82** (OJ 1984, 71), for example, a technical feature was clearly disclosed in the original application but its effect was not mentioned or not mentioned fully. It could however be deduced from the original application on the basis of normal expert considerations. **T 434/97** stated that when introducing features not explicitly disclosed, it was necessary that such features could be unmistakably and fully derived from the original text (in this case the parent application); this corresponded to the opinion in **T 37/82**. In the case at issue the added effect could not be derived from the original text.

1.11.7 Addition/change of claim category

In **T 243/89** the applicant had originally claimed a catheter only for medical use; during examination proceedings he filed a further claim for its manufacture. The board saw no reason to refuse the filing of an additional method claim for forming the apparatus, in view of the similar wording and thus of the close interrelationship between both independent claims. Since the result of the activity was in itself patentable, such methods were also patentable unless the disclosure was insufficient.

In **T 49/11** the board found that it is well-established that subject-matter is not added by a change of claim category per se. The relevant question to be answered was whether there was a basis for the new claim category. In the case in issue the originally filed product claims were changed to claims to a method of treatment. The board, after analysing the disclosure of the application as filed, concluded that this change of category complied with Art. 123(2) EPC. The reasoning in **T 49/11** was supported in **T 959/20**.

1.11.8 Insertion of an ambiguous feature in the claim

In **T 792/94** the board ruled that since the teaching of claim 1 as amended was ambiguous (Art. 84 EPC 1973), allowing scope for an interpretation which extended beyond the overall teaching of the initial application, the amendment contravened Art. 123(2) EPC 1973.

In **T 1067/02** the board came to the conclusion that the **unclear** nature of the amendment introduced upon grant in claim 1 as filed, i.e. the introduction of the term "complete", allowed two different interpretations and, although they were both technically sensible, neither of them was directly and unambiguously derivable from the general disclosure of the application as filed. Consequently, claim 1 of the main request extended beyond the overall teaching of the application as originally filed.

In **T 2298/09** the board held that, although the alternatives g2 and g3 remained **without a clearly derivable meaning**, it was not disputed that their introduction into claim 1 added information to the teaching of this claim. The group of features (g) encompassing these

alternatives could not be ignored when examining these amendments under Art. 123(2) EPC.

See also the related topic "Claim interpretation when assessing compliance with Article 123(2) EPC" in chapter II.E.1.3.9 above.

1.11.9 Characteristic described for intermediate product added to the claimed end product

In **T 314/07** the question arose whether the amendment of the claim directed to the absorbent material was directly and unambiguously derivable from a passage of the application as filed not describing the final absorbent material as such but the preparation of the intermediate film used therefor. The particular characteristics of the intermediate film described in the application as filed could be automatically transferred to the final absorbent material only if these characteristics would remain unchanged throughout the process of preparing the absorbent material (see also **T 320/10**). The board concluded that Art. 123(2) EPC was infringed.

1.12. Errors in the disclosure

1.12.1 Calculation errors

In **T 13/83** (OJ 1984, 428), a case decided prior to **G 3/89** (OJ 1993, 117) and **G 11/91** (OJ 1993, 125) (see chapter II.E.4. "Correction of errors in the description, claims and drawings – Rule 139 EPC" below), the board held that a correction of an erroneous technical calculation was allowable under Art. 123(2) EPC 1973 if the amendment would be regarded by the skilled reader as clearly implied by the disclosure of the application as filed. If more than one arithmetical possibility of correction could be envisaged, the correction chosen had to be the one which the application as a whole clearly implied (see also **T 784/96**, which cites **T 13/83**). See also **T 1242/07** in which the board found that the correction of an obvious calculation error satisfied the requirements of Art. 123(2) EPC.

1.12.2 Incorrect structural formula

In **T 552/91** (OJ 1995, 100) the question arose as to whether and in what form protection could be obtained for groups of chemical substances and individual compounds whose originally disclosed structural formula proved incorrect. The applicant's main request was aimed at securing such protection by a further substance claim for the group of compounds with the structural formula subsequently found to be correct. This request was refused on the grounds that it would violate Art. 123(2) EPC 1973. The board held that the subsequently amended general formula gave the skilled person for the first time crucial information about the true chemical structure of the group of substances. This led to conclusions regarding properties that could be put to use. The information added to the application through the amendment of the general formula and relating to the true composition of the group of substances could not have been obtained from the application as originally filed (for decisions referring to **T 552/91**, see **T 1074/97** and **T 2003/07**; for a further example of the correction of an error in a formula, see **T 1728/07**).

1.12.3 Amendment based on erroneous figure in the disclosure

In **T 740/91** the board allowed a change in the upper limit of a range from 5 % to 0.6 %. The value of 0.6 % was explicitly disclosed in example IV. However, the patentee conceded that this figure had been inserted in error in place of the true figure of 0.49 %. The board concluded that the fact that the figure was wrong did not alter the fact that it was actually and credibly disclosed in the application as filed. It could thus be relied on as the basis for the new upper limit. This interpretation was consistent with the underlying intention of Art. 123(2) EPC 1973, which was to protect the public from being faced at a later stage with claims which were wider in their scope than what had been disclosed in the application as filed, and published for the information of the public, including the applicant's competitors.

1.12.4 Incorrect information in earlier application as filed but correct information directly and unambiguously derivable

In **T 1088/06** an appeal was filed against the decision of the examining division refusing the European patent application, which had been filed as a divisional application, on the ground that the application extended beyond the content of the earlier application as filed. Both the expression "10^{-4} to 10^{-9}" and the expression "10^{4} to 10^{9}" had occurred several times in the earlier application; the divisional application referred to a range between about 10^{4} to 10^{9} Ohm/cm^{2}. The examining division held that the correct range could not be directly and unambiguously derived from the parent application as originally disclosed. The board could not agree. If information in the earlier application was **objectively recognisable** by the person skilled in the art as information that was **incorrect**, and if the person skilled in the art would derive the correct information directly and unambiguously, using common general knowledge, and seen objectively and relative to the date of filing, from the whole of the documents of the earlier application as filed, then the correct information belonged to the content of the earlier application and might be used to decide whether a divisional application extends beyond the content of the earlier application as filed (Art. 76(1) EPC). In the case before it, the board concluded that the range mentioned in the divisional application did not introduce subject-matter extending beyond the earlier application as filed.

1.13. Disclosure in drawings

1.13.1 General

When examining whether there is support for a feature in a drawing the exact same standards must be applied as for the description: the crucial point is what the skilled person would derive directly and unambiguously from the drawing using common general knowledge (**T 2537/10**, supported by **T 2027/18**). See also **T 730/19**.

The case law according to **T 169/83** (OJ 1985, 193) - which has been frequently cited -, **T 523/88** and **T 818/93** shows that the EPC does not prohibit the amendment of claims to include **features from drawings**, provided the structure and the function of such features

were clearly, unmistakably and fully derivable from the drawings by the skilled person and not at odds with the other parts of the disclosure. Nor could any element be dropped.

Indeed, in **T 169/83** (OJ 1985, 193), **T 465/88** and **T 308/90** it was pointed out that where drawings existed they were to be regarded as an integral part of the documents disclosing the invention. Drawings were to be **treated on an equal footing with the other parts of the application** (see also chapter II.E.1.2.1 "Description, claims and drawings"). Further, the fact that features were disclosed solely in the drawings did not preclude these features from becoming essential in the course of the proceedings (**T 818/93**). The features for which a skilled person could clearly derive the structure and function from the drawings could be used to define more precisely the subject-matter for which protection was sought (**T 372/90**).

In **T 676/90** the board underlined that a drawing could never be interpreted in isolation from the overall content of the application but only in that general context. The content of an application was defined not only by features mentioned or shown therein but also by their relationship to each other. **T 676/90** was recently supported in **T 571/22**.

In **T 191/93** amendments were based exclusively on the original drawings and introduced only some of the features disclosed in the drawings. The board held that the subject-matter of the patent had been extended compared to the application as filed because it was not derivable from the drawings that the two newly introduced features could be **isolated from the other features** shown in the drawings. For further cases where the isolation of features from a drawing amounted to an unallowable intermediate generalisation, see **T 1408/04**, **T 983/12** and **T 324/21**.

In **T 324/21** the board explained that the description of a drawing might be inextricably linked to the specific disclosure of this drawing. If a feature in the description of the drawing was extracted from the very specific context of the drawing in order to be included in a claim, the specific disclosure of the drawing had to be taken into account. If there was no literal support for this specific disclosure in the application as filed that could be used to supplement the feature used to amend the claim, it may not be possible to avoid an unallowable intermediate generalisation. This could in particular occur if a feature from a specific and detailed embodiment was included in the context of a schematic drawing.

In **T 398/92** the patent claims as amended contained features that had not been expressly mentioned in the written part of the original application but had been derived from the figures for the application as filed. The drawings in question illustrated the curves in a system of Cartesian co-ordinates with a precise, defined scale. The curves therefore could not be compared to the schematised representation of an invention given by a graph. The board recognised that the points of these curves were not purely intellectual graphic constructions but, on the contrary, corresponded to real experimental values, representing the percentages of a particular drug released in solution. Although these percentages were not expressly mentioned in the original document, the board was of the opinion that for a skilled person they would have been clearly and unambiguously derivable from the scale given on the Y-axis, since the figures were sufficiently precise for the ordinate values to be read exactly and thus for the same numerical features as introduced in the claims to be

derived from them. The incorporation into the text of the claims of the numerical features derived from the curves therefore did not contravene Art. 123(2) EPC 1973 (as far as a graph representing a mathematical equation is concerned, see **T 145/87**).

In **T 1544/08** the board observed that, if drawings were originally filed **in colour** at the date of filing of an application, then the technical content of these original colour drawings should be determined when establishing the content of the application as filed, for the purpose of examining compliance of amendments with Art. 123(2) EPC.

1.13.2 Schematic drawings

In **T 748/91** the board, agreeing with the appellant, held that schematic drawings depicted all the essential features. The board reached the conclusion that size ratios could be inferred even from a schematic drawing as long as the delineation provided the relevant skilled person with discernible and reproducible technical teaching (with reference to **T 451/88**). In the case at issue the description provided the skilled person a sufficient teaching for an unambiguous interpretation of the drawing.

In **T 497/97** the board noted that, since drawings were often approximate and therefore unreliable, they could only be used in interpreting amended claims if the description did not contain a more precise indication of what was meant.

Likewise, in **T 906/97** the board held that the parent application as filed failed to disclose unambiguously the position of a door. The only indication of this position could be found in some figures, and in the board's view there was no suggestion whatsoever in the description itself that this detail of the schematic representation was actually meant to correspond to a technical feature of the apparatus shown in the figures, rather than being merely an expression of the draughtsman's artistic freedom.

In the same vein, in **T 2481/18** the board explained that schematic representations of an invention or of elements of an invention did not normally on their own constitute a sufficient basis for amending the claims. This general assessment relied, first, on the findings that such schematic representations were not to be construed in isolation. Instead, they had to be construed in the light of the accompanying description. In effect, the embodiment referred to by reference to drawings would incorporate much more information than could be derived from the drawings alone. Second, such schematic representations might also contain further limitations which were not the result of deliberate technical considerations but merely reflected the choices made by the draughtsperson without any bearing on the technical content of the application.

In **T 1148/12** the board distinguished the case at hand from the one in **T 748/91**. In the case at issue in **T 1148/12**, the schematic nature of the figures did not allow the skilled person to clearly and unmistakably derive the feature in question (parallel arrangement of electrodes), nor did the description of the original application allow him to clearly and unmistakably derive anything related to the function of the purported parallel arrangement.

In **T 614/12** the board found that the drawing did not show any measurements or scale or give any other indication that it was an exact engineering drawing reproducing the construction elements to scale. It was thus no more than a schematic illustration of the kind commonly found in patent documentation. The imprecision of such an illustration made it impossible to measure angle sizes.

In **T 398/00** the appellant sought to derive a feature (concerning the positioning of an engine) from the drawings. Referring to **T 169/83** (OJ 1985, 193) the board explained that what would be required was that the person skilled in the art would clearly unmistakeably recognise from the drawings, in the context of the description as a whole, that locating the engine according to this feature was the deliberate result of technical considerations directed to the solution of the technical problem involved. Given in particular the schematic nature of the illustration of the engine, this was however not the case. Cited in **T 886/15**.

In **T 324/21** the amendment comprised some of the features illustrated in two schematic drawings as well additional features originally disclosed only in the description of two detailed drawings of the application as filed. The board explained that the description of a drawing may be inextricably linked to the specific disclosure of this drawing. If a feature in the description of the drawing was extracted from the very specific context of the drawing in order to be included in a claim, the specific disclosure of the drawing had to be taken into account. If there was no literal support for this specific disclosure in the application as filed which could be used to supplement the feature used to amend the claim, it may not be possible to avoid an unallowable intermediate generalisation. This could in particular occur if a feature from a specific and detailed embodiment was included in the context of a schematic drawing.

1.13.3 Negative features

In **T 170/87** (OJ 1989, 441) the board held that a figure which served only to give a schematic explanation of the principle of the subject-matter of the patent and not to represent it in every detail did not allow the sure conclusion to be drawn that the disclosed teaching purposively excluded a feature not represented. Such a "negative" feature (in this case, "with no internal fittings") could not subsequently be incorporated into the claim (see also **T 410/91**, **T 1120/05**, **T 474/15** and **T 621/15**). Regarding the absence of a feature in a figure which served only to give a schematic explanation of the principle of the invention, see also **T 264/99**, in which the board found the circumstances to be different from those in **T 170/87**.

T 1120/05 also followed the conclusion in **T 170/87** that negative features could not be deduced from a schematic drawing alone. In **T 1120/05** the invention concerned an "arrangement for and a method of managing a herd of freely walking animals" and the amendment introduced a negative feature namely "but not to the milking station". This negative feature was not expressly disclosed in the description and in the claims of the patent application as filed. Features could be taken from the drawings if their structure and function were clearly, unmistakably and fully derivable from the drawings (**T 169/83**). It was not possible to derive a negative or missing feature on its own, i.e. without the context of the other, existing features of the claim. Moreover, **arbitrarily** choosing one of many

possible negative features was not permitted (see also **T 777/07**), because the skilled person not only had to realise the possible negative features, but – because they were derived from the drawings – he also had to establish which one of the features was essential to the invention and which ones were not. The board found that in the absence of a teaching from the description, the skilled person would be unable to establish the essential nature of a single negative feature, seen against a background of a multitude of potentially essential features, even if this selected single negative feature in the drawings could be recognised by the skilled person in the drawings.

1.14. Amending the description

1.14.1 Amendment to provide support for unsupported claim

T 133/85 (OJ 1988, 441) concerned a case where a feature was described as an essential feature of the invention but was not contained in the claim. The claim was therefore not supported by the description (Art. 84 EPC 1973). An amendment to the description to provide support for the claim was, however, not allowable under Art. 123(2) EPC 1973, because the amended description would contain subject-matter which extended beyond the content of the application as filed – namely information that such feature was not an essential feature of the invention.

On the requirement that the claims must be supported by the description, see the general principles discussed in chapter II.A.5.1.

1.14.2 Impact on the claimed subject-matter

The board in **T 835/11** held (in relation to a divisional application) that an amendment to the description could result in an inadmissible extension only if it changed the subject-matter. That might be the case, for instance, if the description initially defined a feature in the claims more narrowly than its usual meaning; deleting the definition from the description could then result in an inadmissible extension of the patent's subject-matter. Removing or adding examples might also affect how the claims were understood and so also change the patent's subject-matter (see e.g. **T 1239/03** and **T 1227/10**, in chapter II.E.1.14.4 below). The boards had also repeatedly held that reformulating the problem to be solved could inadmissibly extend the patent's subject-matter (see e.g. **T 13/84**, OJ 1986, 253, in chapter II.E.1.14.6). By contrast amendments to the description which had no effect on the claimed subject-matter were not open to objection. In the case in hand, Art. 100(c) EPC had not been infringed.

1.14.3 Adding prior art citations to the description – removing the wrong label "prior art"

For cases concerning the addition of prior art citations to the description, see above in this chapter II.E.1.11.5.

In **T 1039/93** certain figures of the application **as filed** had been erroneously labelled as prior art while in fact representing in-house technical knowledge of the appellant that had not been made available to the public. The board did not object to the deletion of the labels

"prior art" from the relevant figures since such deletion neither infringed Art. 123(2) EPC 1973 nor affected the disclosure of the state of the art; on the contrary such amendment was necessary to avoid giving an inaccurate representation of the state of the art. After the amendment the description correctly indicated the prior art as required by R. 27(1)(b) EPC 1973.

1.14.4 Amendment of definitions or removal of examples

In **T 500/01** the board stated that a claim, the wording of which was essentially identical to a claim as originally filed, could nevertheless contravene the requirements of Art. 123(2) EPC 1973 if it contained a **feature whose definition was amended in the description** in a non-allowable way. The specific definition of a feature which according to the description was an overriding requirement of the claimed invention was applied by a skilled reader to interpret that feature whenever it was mentioned in the patent. Since in this case the definition had no basis in the application as filed, claim 1 did not meet the requirements of Art. 123(2) EPC 1973. See also **T 471/20**, in which the facts of the case were found to be different from **T 500/01**.

In **T 1239/03** it was not in dispute between the parties that no part of the patent contained a definition of the ethylene content of the elastomeric copolymer in terms of weight percent. Prior to the amendment, preference was given to the interpretation "mol percent", which, with the deletion of example 3, had shifted towards "weight percent". In such a case, where it was certain that a shift in the interpretation of the claims had occurred, but uncertain if this would lead to an addition of subject-matter, the board took the view that it should be incumbent upon the patent proprietor or applicant as the author of such amendment(s) to demonstrate that the requirements of Art. 123(2) EPC 1973 were complied with in making them. In the case at issue, the patent proprietor was unable to do so.

In **T 1227/10** the claim as granted was similar to the claim as originally filed. However, other than in the patent as granted, the original application also contained a figure 1 labelled as prior art and a corresponding passage of the description. The board found that the original application did not include the possibility of using a filter as gas solid separator for a certain purpose, whilst the patent as granted encompassed such a possibility. Hence, the deletion of original figure 1 and of the related passage of the description had modified the application in such a way that the granted claim 1 included subject-matter which was excluded from the originally filed invention.

1.14.5 Shift in the information provided by the examples after amendment of claims

T 97/05 concerned an amendment of a claim resulting in a shift in the information provided by examples. During the opposition proceedings, claim 1 was modified by replacing the term "chemically" with "covalently" in order to specify the nature of the bond between the anionic groups and the core. The information provided by the description was that the bonding between the core and the anionic group was "chemical" and that one type or species of "chemical" bonding was "covalent". In the board's view a consequence of the amendment of the claims by replacement of the generic term "chemically bonded" by the specific term "covalently bonded" was that the examples of the patent acquired by

association information, i.e. that the anionic groups were covalently bonded to the core, which was not – even implicitly – contained by the same examples in the application as filed. Thus there was a shift in the information provided by the examples in the patent as amended according to the main request compared to that provided by the same examples in the application as filed, even though the examples themselves had not been modified (by analogy with **T 1239/03**). Therefore the main request did not meet the requirements of Art. 123(2) EPC 1973.

On bringing the description into line with amended claims, see chapter II.A.5.3.

1.14.6 Reformulation of the technical problem

Expanding on **T 13/84** (OJ 1986, 253), it was stated in **T 547/90** and **T 530/90** that reformulating the technical problem was not in breach of Art. 123(2) EPC 1973 provided the problem as clarified and the solution proposed could have been deduced from the application as a whole in the form originally filed (see **T 871/08** of 8 December 2011, **T 2076/09**). In **T 969/19** the board made it clear that Art. 123(2) EPC was not concerned with the issue of whether or not an objectively reformulated technical problem could be used in the course of the problem- solution approach. It could only come into play if an amended technical problem was incorporated into the description itself (see **T 564/89**, **T 284/98** and **T 276/06**).

On the reformulation of the technical problem, see also chapters I.D.4.4. and I.D.4.5.

1.14.7 Replacement of complete description

In **G 2/95** (OJ 1996, 555) the Enlarged Board observed that a correction affecting the content of the application could only be effected within the limits of Art. 123(2) EPC (as defined in **G 3/89**, OJ 1993, 117). The complete documents forming a European patent application, that is the description, claims and drawings, could not be replaced by way of a correction under R. 88 EPC 1973 (R. 139 EPC) by other documents which the applicants had intended to file with their request for grant.

In **J 16/13** the board held that the ratio decidendi of **G 2/95** (and also of **J 5/06**) was also applicable to all cases where at least a complete description was sought to be exchanged.

In **J 3/21** the Legal Board observed that the ban on the replacement of the description by way of correction, established in **G 2/95** on the basis of Art. 123(2) EPC and further developed in e.g. **J 5/06** and **J 16/13**, was categorical and followed from the principle reflected in R. 40(1)(c) EPC that the accorded filing date was inseparable from the description as originally filed. An exchange of the description by way of correction would directly result in the separation of the filing date from the description in contravention of Art. 123(2) EPC.

1.14.8 Deletion from the description of expressions making features optional

In **T 2466/13** the appellant (opponent) had raised an objection under Art. 123(2) EPC, contending that the way the patent description had been adapted, in particular the deletion of expressions showing that features included in the main claim were optional, was liable to give the proprietor an undue advantage in any infringement action, especially one alleging infringement by equivalent means. The board disagreed, observing that, since the original application had been published, the defendant in any such action would still be able to cite the amendments made during the EPO proceedings by producing it alongside the patent as granted and/or amended.

1.15. "Comprises", "consists of", "consists essentially of", "contains"

In **T 759/10** it had to be examined whether there was a clear and unambiguous implicit disclosure in the application as filed providing a basis for the amendment from "comprises" to "consists essentially of". The appellant argued that the **term "comprising"** encompassed three alternatives, namely (i) "comprising", (ii) "consisting of" and (iii) "consisting essentially of", and that each of these alternatives would immediately come to the skilled person's mind when reading the term "comprising". The term "comprises" was therefore in itself already a sufficient basis for the term "consists essentially of". The board could not accept this argument as each term had a different technical meaning, namely (i) that any further component can be present ("comprises"), (ii) no further component can be present ("consists of") and (iii) specific further components can be present, namely those not materially affecting the essential characteristics of the texturizing agent ("consists essentially of"). Therefore the skilled person was not at liberty to choose whichever of the three terms he wished when reading the term "comprises". The board further refused the request for referral of questions to the Enlarged Board. Although the board agreed with the appellant that the two boards in decisions **T 472/88** and **T 975/94** appeared to have considered the term "comprises" in itself to be a sufficient basis for the term "consists essentially of", the jurisprudence of the boards had further developed since these two decisions, in particular by way of the two later decisions of the Enlarged Board in **G 2/98** (OJ 2001, 413) and **G 1/03** (OJ 2004, 413).

In line with these decisions of the Enlarged Board, more recent decisions of the boards of appeal, e.g. **T 868/04**, **T 725/08** and **T 903/09**, have applied the criterion of clear and unambiguous disclosure to decide on the allowability of the amendment of the term "comprises" to "consists essentially of". These decisions considered that this criterion is not automatically fulfilled by the term "comprising" alone. The board in **T 725/08** found that, where the term "consisting of" was not disclosed explicitly, replacing "mixture comprising" with "mixture consisting of" was permitted, provided that the original application had not envisaged any ingredients other than those mentioned in the mixture. In **T 1594/21** the board applied the principle set out in decision **T 725/08** and concluded that, since the initial application had disclosed at least one other ingredient (triethanolamine) not present in claim 1, the application as filed had not directly and unambiguously disclosed the composition as defined in claim 1.

In **T 44/20** the board agreed with the observation in **T 759/10** that the terms "comprising" and "consisting of" had different technical meanings, the former allowing the presence of further components and the latter excluding such further components, and that the skilled person was not at liberty to attribute whichever of these meanings they desired when reading the term "comprises". As further pointed out in **T 759/10**, an amended feature must be directly and unambiguously derivable from the application as filed, which could only be assessed by reference to the application in question. The same standard was also applied in **T 1634/13** and in **T 957/22**.

According to **T 1271/13** it is today settled that the term "comprising" is not generally accepted as direct and unambiguous basis for an amendment to "consisting essentially of".

In **T 56/08** the board rejected the respondent's argument that the verb **"to contain"** had a more restrictive meaning than the verb "to comprise"; the board pointed out that the general meaning of the verb "to contain" was "to have in it", "to hold", "to include", "to encompass" or "to comprise".

In **T 1170/07** "consisting essentially of" was substituted for "comprising". Before evaluating whether the original disclosure in its entirety specifically disclosed the claimed unit dosage form consisting essentially of tetrahydrolipstatin, it had to be established what the term "consisting essentially of", which could not be found in the original application, meant in the context. The board recalled on this occasion that claims should be read in a technically reasonable way. In the case at issue, the expression "consisting essentially of" excluded the presence of further active agents useful in the treatment of the specific disease concerned but allowed the presence of additional compounds forming the carrier for the active agent. The board concluded in this case that the substitution of "consisting essentially of" for "comprising" was allowable under Art. 123(2) EPC.

In **T 108/14** the board distinguished the case at issue from the one in **T 1170/07** because it was not directly and unambiguously derivable from the application as filed, which "active agents" were useful. Furthermore, the board referred to a line of jurisprudence (e.g. **T 147/22**, **T 1095/09**, **T 759/91**, **T 522/91**, **T 472/88**) according to which the expression "consisting essentially of" was found to be clear and to allow the presence of other components in addition to the components mandatory in the claimed composition, provided that the essential characteristics of the claimed composition were not materially affected by their presence. However, in the case at issue, the application as filed was silent as regards the components which, in addition to those defined in claim 1 at issue, could be allowed in the claimed refractory without affecting its essential characteristics.

In **T 107/14** the appellant (opponent) argued that claim 1 extended beyond the content of the application as filed because it was directed to an alloy **"consisting of"** the given elements, whereas claim 1 as originally filed related to an alloy "comprising" the given elements. The board held that, since the originally filed claim 1 already disclosed that the rest of the composition consisted of Ni, not allowing for the presence of further elements, and thus was already directed to closed compositions, the composition stipulated by

claim 1, "consisting of" the given elements, was already disclosed in the application as originally filed.

In **T 1634/13** the claim as granted combined the subject-matter of various claims as filed, with the terms "comprising" and "containing" being replaced by the terms "consisting in" or "consisting of". The board held that specific examples in the application taught that the terms "comprising"/"containing" included the term "consisting" as a particular, originally disclosed meaning. While it was true that the change in wording restricted the subject-matter with respect to the original wording, such a restriction was not objectionable under Art. 123(2) EPC. In particular, there had been **no singling out** within the meaning of **G 2/10**.

In **T 1173/17** "comprising" was replaced by "consisting of" in claim 1 of auxiliary request 2. The board distinguished its case from **T 107/14** and **T 725/08** and considered that the subject-matter of claim 1 was not directly and unambiguously derivable from the original application.

Regarding the interpretation of "comprising (substantially)", "consisting (essentially) of", "containing", see chapter II.A.6.2.

1.16. Different sets of claims for different contracting states

In **T 658/03** the board stated that any change of attribution of claimed subject-matter in an application or patent having different (sets of) claims for different contracting states, to a contracting state under which that subject-matter was not previously included, amounted to an amendment within the meaning of Art. 123 EPC 1973. Such an amendment was subject, in principle, to full examination as to its conformity with the requirements of the EPC.

2. Article 123(3) EPC – extension of the protection conferred

According to Art. 123(3) EPC the European patent may not be amended in such a way as to extend the protection it confers. This refers to the patent as a whole.

The wording of Art. 123(3) EPC 1973 had referred only to the claims of the patent; however, already under the EPC 1973, the boards had held that amendments to the description and the drawings could also extend the protection conferred within the meaning of Art. 123(3) EPC 1973 (see **G 2/88**, point 4 of the Reasons; **G 1/93**, point 11 of the Reasons; **T 1149/97**, OJ 2000, 259; and **T 142/05**). The board observed in **T 953/22** that, for this reason, the basic principles analysed in the case law on Art. 123(3) EPC 1973 were also applicable to Art. 123(3) EPC. In particular, in **T 142/05**, the board held that amendments to the description and drawings could modify the content of the claims and possibly extend the scope of protection under Art. 69(1) EPC 1973, even where the wording of the claims was clear and remained unamended.

Article 123(2) EPC and Art. 123(3) EPC are mutually independent of each other (**G 1/93**, OJ 1994, 541); the same is true for Art. 76(1) EPC and Art. 123(3) EPC (**T 1736/09**).

2.1. Purpose of Article 123(3) EPC

Article 123(3) EPC is examined in post-grant proceedings, i.e. opposition and limitation proceedings (Art. 105a EPC); as regards nullity proceedings before national courts, see Art. 138(1)(d) EPC (corresponding to Art. 123(3) EPC).

Article 123(3) EPC is directly aimed at protecting the interests of third parties by prohibiting any broadening of the claims of a granted patent, even if there should be a basis for such broadening in the application as filed (**G 1/93**, OJ 1994, 541) (**T 2461/17**). In accordance with the general intention of Art. 123(3) EPC, there should be legal certainty for the activities of third parties trusting that the protection conferred by a patent can only be restricted, but not extended (**T 1149/97**, **T 2450/22**).

The object of Art. 123(3) EPC is to prevent any procedural situation where an act which does not infringe the patent as granted becomes an infringing act as a result of an amendment after grant (see **T 1149/97**, **T 1898/07** referring to **T 59/87**, OJ 1988, 347 and **T 604/01**).

2.2. Totality of claims

In accordance with the established case law of the boards of appeal, the legal notion "protection conferred" in Art. 123(3) EPC refers to the **totality** of protection established by the claims as granted and not necessarily to the scope of protection within the wording of each single claim as granted (**T 579/01**, **T 1456/06**, **T 1544/07**, **T 1207/21**, see also **T 49/89**, **T 402/89**). According to **G 2/88** (OJ 1990, 93), it is the totality of the claims before amendment in comparison with the totality of the claims after the proposed amendment that has to be considered (**T 2461/17**).

Under Art. 123(3) EPC, the patentee is generally allowed to redraft, amend or delete the features of some or all claims and is not bound to specific terms used in the claims as granted as long as the new wording of the claims does not extend the scope of protection conferred as a whole by the patent as granted. Thus, in order to assess any amendment under Art. 123(3) EPC after grant, it is necessary to decide whether or not the totality of the claims before amendment in comparison with the totality of the claims after amendment extends the protection conferred (see e.g. **T 579/01**, **T 1898/07**, **T 1830/14**, **T 1207/21**).

2.3. Extent of protection

2.3.1 Article 123(3) EPC and Article 69 EPC

a) Principles

Article 69 EPC and its Protocol are to be applied in proceedings before the EPO whenever it is necessary to determine the protection conferred. In this context, the national laws of the contracting states relating to infringement should not be considered. Rather the protection conferred by a patent is determined by the terms of the claims, and in particular

by the categories of the claims and their technical features, in accordance with Art. 69(1) EPC and its Protocol (**G 2/88**, OJ 1990, 93; see also e.g. **T 81/03**, **T 547/08**, **T 1832/17** and **T 970/17**, all with reference to **G 2/88**, and in this chapter II.E.2.3.1b)).

b) Protection conferred within the meaning of Article 123(3) EPC not determined by subject-matter at issue in national infringement proceedings

As stressed in numerous decisions with reference to **G 2/88** (OJ 1990, 93), it is unnecessary when deciding on admissibility of an amendment under Art. 123(3) EPC to consider the national laws of the contracting states relating to infringement and this issue is not relevant (see e.g. **T 81/03**, **T 547/08**, **T 970/17** and **T 321/21**).

In **T 81/03** the board stressed that the general, abstract concern that the addition of a feature to a claim after grant led to an extended scope of protection because the resulting combination of features might give rise to a different evaluation of **equivalents** in infringement proceedings was not in itself a sufficient reason for not allowing the addition of limiting features under Art. 123(3) EPC 1973.

In **T 547/08** the board stated that the appellant's (opponent's) arguments relating to the rights of the patent proprietor to sue for **indirect or contributory infringement** were not relevant to the issue of extension of the scope of protection under Art. 123(3) EPC. With respect to the question of an extension of the scope of protection under Art. 123(3) EPC, it was, rather, appropriate to take into account the fact that the protection conferred by a patent was determined by the terms of the claims, and in particular by the categories of the claims and their technical features, in accordance with Art. 69(1) EPC and its Protocol (**G 2/88**, OJ 1990, 93). See also **T 970/17** (which highlighted the difference between the "extent of the protection conferred" by a patent under Art. 69 EPC and the "rights conferred" by a patent under Art. 64 EPC).

The board in **T 1832/17** likewise stressed that the scope of protection conferred by a patent within the meaning of Art. 123(3) EPC was not established by reference to the subject-matter that would be at issue in any national infringement proceedings. Art. 69(1) EPC and its Protocol stipulated that the protection conferred was determined by the terms of the claims, and in particular by the categories and technical features of those claims. Ascertaining whether an amendment extended the scope of protection thus meant comparing the granted claims with the amended ones (see also this chapter II.E.2.2.).

c) Generally accepted meaning of a term in the claims versus definition in the description

In **T 177/08**, with reference to Art. 123(3) EPC, the board referred to Art. 69(1), second sentence, EPC, which provides that the description and the drawings are to be used to interpret the claims. The board said that it had therefore to be decided whether said interpretation of the claims by the content of the description was limited to cases where the claims were in need of interpretation, e.g. because of functional or unclear features, or whether it also applied to the case at issue, where a **well-known and generally accepted meaning of a term** was overthrown and replaced by a new definition given in the

description. The board was of the opinion that the second sentence of Art. 69 EPC did not apply to cases where an unambiguous and generally accepted definition of a term figuring in the claims was to be superseded by a different definition found in the description (approach followed in **T 2461/17**). If it was intended that a term which was in no need of any interpretation be given a new meaning, then the definition for this new meaning had to be put into the claims. Third parties could not be expected to check every single term of the claims for a potentially different meaning that might be hidden somewhere in the description.

In **T 1172/08** the board stated that claim 1 as granted and claim 1 of the main request, when read on their own, provided protection for different subject-matter. The patent proprietor agreed that normally such a shift in the extent of protection would not be allowable. It argued, however, that the case at issue was very particular because the claims as granted did not embrace the subject-matter of the only example of the patent specification. The board had no doubts and the parties did not dispute that dendritic cells and monocytes were different cell types characterised by different features. Reading the patent proprietor's interpretation into claim 1 would require the skilled reader to completely ignore the wording of granted claim 1, which per se was not technically meaningless, with the consequence that the wording of claim 1 would merely serve as an empty shell. This was clearly not in the sense of Art. 69 EPC nor in the sense of the Protocol on its interpretation. Moreover, the interest of third parties in legal certainty would be completely ignored, if the patent proprietor's interpretation were found to be acceptable. This approach was also followed in **T 111/22**.

In **T 2284/09** the appellant (patent proprietor) had relied upon decision **T 108/91** (OJ 1994, 228), according to which, in the case of inconsistency between the claim and the totality of the disclosure, it was permissible to refer to the description and, pursuant to Art. 69(1) EPC, to rely on the disclosure of the description to amend the claim. **T 108/91** was however not applicable in the case at issue, since there was no inconsistency between the claim of the granted patent and the description. Furthermore decision **G 1/93** (OJ 1994, 541) ruled that in the case of a non-disclosed limitation being introduced during examination proceedings (as was the case here), it was not permissible to remove it when so doing would extend the scope of protection. In **G 1/93** the role of Art. 69(1) EPC was also considered and it was concluded that the description was to be used for assessing in particular sufficiency of disclosure and in determining the scope of protection conferred by the claims. However, there was no finding in **G 1/93** that supported the position of the appellant that the description might be used as a repository from which amendments to the claims could be derived even if such amendments would contravene Art. 123(3) EPC. See also **T 195/09**, in which the board stated that **T 108/91** had been overruled in this regard by **G 1/93**.

In **T 1736/09** the board emphasised that, for the purpose of examination under Art. 123(3) EPC it was irrelevant whether the granted patent met the requirements of Art. 123(2) EPC or Art. 76(1) EPC. See also **T 2186/12**.

In **T 1896/11** the appellant submitted that, taking Art. 69 EPC into account, the description had to be used to interpret the claims; since the protection conferred by claim 5 of the

patent as granted necessarily extended to what was stated in the description, claim 5 could be corrected to reflect the description without infringing Art. 123(3) EPC. However, the board held that, in the case at issue, the description could not be used to give a different meaning to a claimed method step which **in itself imparted a clear and credible technical teaching** to the skilled reader. Otherwise third parties could not rely on what the claim actually stated. In order to determine whether the claimed method step in itself imparted a clear, credible technical teaching, it was necessary to examine "whether (a) the step as claimed was in itself meaningful and plausible from a technical point of view, and (b) whether there was, prima facie, any inherent incompatibility with the remaining features of the claim" (see **T 1202/07**). In the case in hand, the relevant feature was meaningful and plausible from a technical point of view. This approach was confirmed e.g. in **T 626/16**.

In **T 131/15**, however, the board highlighted that, in determining whether the requirements of Art. 123(3) EPC 1973 were met, it was not sufficient to look only at the claims in isolation. The approach to be followed was set out in **G 2/88** (OJ 1990, 93) with reference to Art. 69(1) EPC 1973 and its Protocol. In the light of these principles, the board came to the following conclusion: Where an expression in a granted claim, taken literally and in isolation, would have the effect of excluding all of the disclosed embodiments from the scope of protection, but where a definition of the expression may be derived from the patent itself which would locate (at least some of) the disclosed embodiments within the ambit of the claim, and provided this definition was **not manifestly unreasonable**, having regard to the normal meaning of the words used in the expression, then in judging compliance with the requirements of Art. 123(3) EPC, the scope of protection should normally be considered to include at least that which would fall within the terms of the claim understood according to this definition.

2.3.2 Cut-off point

The decisions reported below address the question of whether the grant of the patent constitutes a cut-off point for making amendments to the application documents. As summarised in **T 1481/14**, the grant of a patent is not necessarily an automatic and final cut-off point ruling out any reinsertion of deleted subject-matter whatsoever. At best, the restrictions on further amendments to a patent under R. 80 and 138 **EPC** and Art. 123(3) EPC can be regarded as having such a cut-off effect.

The extent to which amendments may be admissible in opposition proceedings was discussed in **T 1149/97** (OJ 2000, 259). Once a decision to grant has been issued, the European examination procedure is closed and its results become binding on the applicant and the EPO in that no further amendments may be made. However, if an opposition is filed, the patent in suit may be amended. Such amendments are not left to the general discretion of the patent proprietor, since opposition proceedings are not a continuation of the examination proceedings (**G 1/84**, OJ 1985, 299). However, the patent proprietor may, pursuant to R. 80 EPC (R. 57a EPC 1973) – without prejudice to R. 138 EPC (R. 87 EPC 1973) – react to the opponent's objections by amending the description, claims and drawings, provided that the amendments are occasioned by the grounds for opposition specified in Art. 100 EPC, even if the respective ground has not been invoked

by the opponent (see also chapter IV.C.5.1.2.). In addition, amendments occasioned by national rights of earlier date are admissible pursuant to R. 138 EPC (see also chapter IV.C.5.1.3.).

In **T 1149/97** (OJ 2000, 259) the board decided that, without opposition, issue of a decision to grant a European patent normally constituted a cut-off point for making amendments to the application documents in the European proceedings. If an opposition has been filed, cutoff effects due to the grant of a patent might be seen in the restrictions which R. 57a EPC 1973, R. 87 EPC 1973 and Art. 123(3) EPC 1973 impose on further amendment of the patent specification. Although Art. 123(3) EPC 1973 addressed only the claims of the European patent, amendments to the description and the drawings might also extend the protection conferred in accordance with Art. 69(1) EPC 1973. If, in view of Art. 84 and Art. 69 EPC 1973, the application documents were adapted to amended claims before grant, thereby deleting part of the subject-matter originally disclosed in order to avoid inconsistencies in the patent specification, as a rule subject-matter deleted for this reason could not be reinserted either into the patent specification or into the claims as granted without infringing Art. 123(3) EPC 1973. An analogous finding applied to subject-matter retained in the patent specification during such adaptation for reasons of comprehensibility, but indicated as not relating to the claimed invention. See also **T 37/99** and **T 684/02**.

In **T 1481/05** the board distinguished the facts of its case from those underlying **T 1149/97**. It agreed with **T 1149/97** that the "cut-off effect" finds its basis in Art. 123(3) EPC and that the test to be applied to determine whether this provision was infringed was the following: Is it possible to identify some subject-matter which did not fall under the scope of protection in the granted version of the patent, but would do so if the amendment in question (the reintroduction of the deleted features) was allowed? Applying this test the board was unable to identify abandonment of subject-matter.

Likewise in **T 81/03**, the board detailed why it considered that the facts of the case dealt with in **T 1149/97** (OJ 2000, 259) differed from those of the case in point. The board also held that amendments to a European patent could be based on the whole reservoir of features originally disclosed in the corresponding application, provided that Art. 123(3) EPC 1973 was not infringed by such amendments, due account being taken of the provisions of Art. 69(1) EPC 1973.

In **T 241/02** in the board's view neither the fact that the appellant (proprietor) approved the text of the patent in suit nor considerations with respect to legal certainty added to the requirements relating to amendments in R. 57a or Art. 123(2) EPC 1973. The grant of a patent therefore did not necessarily constitute a final and automatic cut-off point ruling out any reinsertion of deleted subject-matter (in the case at issue, reinsertion of portions of the description relating to the process claimed). The opposition division had concluded on the basis of **T 1149/97** (OJ 2000, 259) that reinsertion would not be possible, but without referring to any specific parts or making any connection between parts to be reinstated and any concrete conclusion as to how the product claims would be extended in contravention of Art. 123(3) EPC 1973. The board decided that, by contrast with the situation in **T 1149/97**, in the case in point the appellant had deleted too much of the

description, overlooking the relevance of parts of it to these remaining claims. According to the board, **T 1149/97** did not lay down a strict rule. It required that an examination of a request for reinsertion be carried out with a view to establishing whether or not Art. 123(3) EPC 1973, on the facts of each case, was indeed infringed.

In **T 975/03** the appellants (opponents) referred to decisions **T 420/86** and **T 61/85** in support of their argument, regarding the reintroduction of the feature of claim 1 deleted before the grant of the patent, that the appellant (patent proprietor) could not reinsert into the patent a feature it had deleted during the examination procedure, as such deletion was equivalent to abandonment. In the board's view, however, no legal grounds for the latter assertion were indicated in **T 420/86** (or in **T 61/85**). This decision had also preceded the ruling in **G 7/93** (see point 2.1 of the Reasons). The board held that the grant of a patent did not necessarily establish an automatic and final cut-off point which ruled out any reintroduction of deleted subject-matter. The amendment in the case at issue was therefore allowable, provided that it did not breach the requirements of R. 57a and Art. 123(2) and Art. 123(3) EPC 1973. In the case at issue these requirements were met.

2.3.3 General claim interpretation

This section deals with general claim interpretation for the purposes of Art. 123(3) EPC. See chapter II.A.6.1. for the general principles for the interpretation of claims.

Decision **T 190/99** gives guidance on how to interpret a claim as granted for the purpose of Art. 123(3) EPC. The skilled person, when considering a claim, should rule out interpretations which are illogical or which do not make technical sense. He should try, with synthetical propensity, i.e. building up rather than tearing down, to arrive at an interpretation of the claim which is technically sensible and takes into account the whole disclosure of the patent (Art. 69 EPC). The patent must be construed by a mind willing to understand, not a mind desirous of misunderstanding (this frequently cited decision was more recently referred to in the context of Art. 123(3) EPC, for example, in **T 1084/10**, **T 1009/12**, **T 916/15**, **T 2450/22**).

The approach of **T 190/99** was followed in **T 111/22**, where the board added that the extent to which the meaning of a claimed feature may be affected by the description and/or the drawings was limited. In view of the primacy of the claims in claim interpretation, in case of a clear conflict between the claims and the description, the claims took precedence. In other words, if a person skilled in the art understood a claim in a certain manner without doubt, taking into account the rules of grammar, the ordinary meaning of the terms used and common general knowledge, this understanding would usually take precedence over an incidental and conflicting statement in the description, in particular if that statement was only made in the context of an alleged embodiment.

In **T 953/22** the board was not convinced by the appellant's counter-argument that a discrepancy between the claims and the description was not a valid reason to ignore the clear linguistic structure of a claim and to interpret it differently or to give a different meaning to a claim feature which in itself imparted a clear credible technical teaching to the skilled reader. The board explained that the description and drawings were also taken

into account for the purposes of Art. 123(3) EPC if the claims were clear and unambiguous,they were not only consulted to fill gaps. Citing Art. 1 of the Protocol on the Interpretation of Art. 69 EPC and **G 2/88** (point 4 of the Reasons), the board, while also recognising the primacy of the claims under Art. 69(1) EPC, explained that it would not in the case in hand go so far as to say that the disclosure of the description and the figures could not be read into the patent claim. The board also relied on **G 1/93** (point 11 of the Reasons), according to which: "In principle, it does not matter whether the addition concerns the claims, the description or the drawings, since the protection conferred by the patent has to be determined by all these elements in accordance with Art. 69 EPC and the Protocol on the interpretation of this provision. However, the claims are no doubt the most important element in this respect."

In **T 287/11** the question to be answered was whether the claims of the main request covered any compositions or methods which were not covered by the claims as granted. The board considered decision **T 999/10**, which had been cited by the appellant, where it was stated that in view of the sequential ("cascade") formulation of the claim, there was no doubt as to the "intention" of the patent proprietor that no block copolymers other than the specific SIS-type might be present in the adhesive. The approach described in **T 999/10** was followed in **T 262/13**, **T 1063/15** and **T 2215/18**. However, in **T 287/11** the board held that the scope of protection should **not be interpreted in the light of the intention of the drafter of a claim**, since this was a subjective criterion, but rather on the basis of the meaning generally accepted by the person skilled in the art to the technical features defined in said claim. **T 287/11** was followed in **T 881/11**, **T 52/13**, **T 865/13, T 514/14**, and **T 664/20**.

In **T 2174/16** the board recalled that the principle of legal certainty for third parties was of utmost importance when determining the scope of protection conferred by the patent as granted.

2.4. Deletions and replacements

2.4.1 Deletion of a limiting feature in a claim – inescapable trap

A granted claim cannot be amended by deleting limiting subject-matter from the claims, because such amendment would extend the protection conferred, which is prohibited by Art. 123(3) EPC; if the limiting subject-matter had been added in contravention of Art. 123(2) EPC, the applicant is caught in an "inescapable trap", see **G 1/93** and chapter II.E.3.1.

In **T 1407/05** the board considered that claim feature A described essential technical characteristics of the claims as granted. Feature A was removed from the wording of the claims in all pending requests; all other claim features remained essentially the same. The board held that the removal of a positive technical feature from an independent claim prima facie resulted in a broadening of the scope of protection afforded by it and therefore contravened Art. 123(3) EPC.

In **T 1983/14** the applicant had added a limiting feature to the claim during examination. The opposition division found that, as a consequence of adding this feature, the patent proprietor had lost its right to priority and its own use of the invention during the priority period had been prejudicial to novelty. The board agreed and held in addition that the problem of the added feature could not have been overcome by amendment. This was because Art. 123(3) EPC prevented the removal, after grant, of a problematic, limiting feature.

In **T 666/97** the product claim of the auxiliary request no longer included a process feature which was included in the product claim as granted. In the board's view, it followed from the fact that the subject-matter for which protection was claimed in the auxiliary request was a product that it could only be characterised by features manifest in/on the product itself. That meant that manipulations taking place during product manufacture but not resulting in product features were of no relevance to the definition of the claimed product and hence to the scope of protection of the claim. That was an unavoidable implication of the established case law of the boards of appeal, under which the subject-matter of a **product-by-process claim** derives its novelty not from new procedural steps but purely from structural features (see **T 205/83**, OJ 1985, 363). Thus, to resolve the issue of compliance with the requirements of Art. 123(3) EPC 1973, what had to be decided was whether the omitted product-by-process feature was technically significant for the definition of the claimed product, i.e. whether it was a product feature. The board found that in the present case the omitted feature was not a product feature. Thus the claim had not been extended within the meaning of Art. 123(3) EPC 1973.

In **T 1191/15** a feature present in the claims as granted had been deleted from the new main request so that this request now encompassed embodiments that were not encompassed by the claims as granted (namely embodiments wherein the control means of the claimed dialysis apparatus was programmed in a certain way). This was contrary to Art. 123(3) EPC.

2.4.2 Deletion of feature from description where claim remains unchanged

In **T 142/05** the board found that, even where the wording of the granted claims was unamended and clear, the mere deletion from the description of an important desired property of the patented subject-matter led to an extension of the scope of protection which contravened Art. 123(3) EPC 1973 (this is different in the case of an optional, hence not important feature, see **T 71/10**). The board explained that, although the claims were the most important element in determining the extent of protection, **the wording of the claims** should **not be seen as the sole relevant factor**; instead, the description and drawings were to be used in interpreting the claims. From this, it followed that even if the wording of a claim was clear and unambiguous, i.e. where the scope of its literal meaning was clear, reference was still to be made to the description and claims. This could lead to a different interpretation of the claim, diverging from that obtained by considering only its literal meaning. Amendments to the description and drawings could modify the content of the claims and thereby extend the scope of protection according to Art. 69(1) EPC 1973, even where the wording of the claims was clear and remained unamended. In the board's view,

the deletion in the case at issue had the effect of generalising the teaching of the patent. Art. 123(3) EPC 1973 had therefore been contravened.

This approach was confirmed in **T 1360/13** as well as in **T 953/22**, which related to the deletion of drawings (see below chapter II.E.2.4.5).

2.4.3 Deletion of examples for a general feature in a claim

The board in **T 1052/01** took the view that deleting examples given in claim 1 as granted (here "valve, restrictor, etc.") for a general feature (here "hydraulic functional unit") did not extend the protection conferred, as these examples were embraced by the general feature which determined the extent of the protection conferred.

2.4.4 Deletion of disclaimer

In **T 532/08** the board held that, in the case at issue, the disclaimer could only be omitted without extending the scope of protection if it was beyond doubt that the components (of the disclaimed suspension) identified by trade names did not comprise any of the claimed tensides. However, it could not be unequivocally established what was excluded by a disclaimer referring to trade names, as a product designated by a trade name may change over time while keeping its name.

In **T 136/12** the amended disclaimer was narrower than the disclaimer in claim 1 of the patent as granted, whereas the positive features of that claim had remained the same. The board found that the amended claim extended the scope of protection and observed in this context that the case law of the boards had consistently taken disclaimers into account when examining whether a claim amended by introducing, modifying or deleting a disclaimer fulfilled the requirements of Art. 123(3) EPC.

2.4.5 Deletion or replacement of drawings

In **T 2259/09**, whilst the patent as granted comprised a set of Figures, in the amended patent according to the main request all drawings were deleted to comply with the requirements of Art. 123(2) EPC, and the description was correspondingly adapted. Concerning the examination of Art. 123(3) EPC, with the deletion of the drawings from the patent specification, technical information was undoubtedly lost. Whilst this loss of information might also introduce some uncertainties about certain details of the preferred embodiments depicted in the drawings, it could not be concluded, as in the impugned decision, that it automatically broadened the protection conferred. In the case at issue, the claims were not limited to any of the details, dimensions or features specifically depicted in the (deleted) drawings. Moreover, under Art. 69(1) EPC, reference to the drawings of a patent specification may be helpful or even necessary if an ambiguity exists in the granted claim. However, in the case at issue, the impugned decision did not identify any such ambiguity; nor could the board see any. Therefore, the deletion of the drawings did not extend the scope of the protection conferred by the main request.

In **T 236/12** the drawings published in the patent specification had been replaced by those originally filed. Although the published drawings had disclosed technical information not derivable from those originals, their replacement did not broaden the scope of the patent. The technical features of the claims were explained in sufficient detail in the description, as read together with the originals, so the skilled person could still get a clear idea of the protected subject-matter and how it should look.

In **T 1360/13** the board considered that, in view of Art. 69(1) EPC, after grant, any information in the description and/or drawings of a patent directly related to a feature of a claim and **potentially restricting its interpretation** cannot be removed from the patent without infringing Art. 123(3) EPC. Referring to **G 2/88** (OJ 1990, 93) and Art. 69 EPC, the board held that even if, after the claims have been read taken alone, no clarification seemed necessary, it could not be excluded that the description and drawings were necessary to interpret the claims, i.e. to determine the extent of the protection conferred. As a rule, the vocabulary used in a patent was unitary and dependent on the technical field of the invention and on the writer's own preferences. The description and drawings generally included explicit or implicit definitions of terms used in the claims, e.g. explanations as to the functions of the claimed features, the aims to be achieved by the invention, etc. Concentrating exclusively on the wording of the claim would mean that from the point of view of the extent of protection, the whole description and the drawings of the patent could be deleted, in which case, the intentions of the inventor would be completely ignored. In the present case, the deletion of the drawings and any references to them in the description led not only to a generalisation of the teaching of the patent but also to a more general interpretation of the claim. The board distinguished its case from **T 2259/09** and **T 236/12**.

In auxiliary request 1 ("AR 1") of **T 953/22**, claim 1 and the description remained unamended. Considering amended Figure 4 ("Fig. 4"), the board established that the protection conferred by the patent as amended according to AR 1 was extended (Art. 123(3) EPC; **G 2/88**, point 4.1 of the Reasons). The features of claim 1 as granted did not define how the length of the overlay welds was to be understood. It was only by using the description and the drawings, in particular L2 in Fig. 4 as granted (or as amended in AR 1), that the extent of protection could be determined. Fig. 4 as granted (or as amended in AR 1) was thus not used to read limiting features into claim 1 that were not present in this claim but to determine the extent of the protection conferred.

2.4.6 Deletion of feature in a claim mentioned "in particular"

In **T 260/10** the feature "having at least one optical display unit and in particular at least one operating unit ..." in claim 1 as granted had been replaced and the words "and in particular at least one operating unit" thereby deleted. The board found that it generally **depended on the specific context** whether a feature following the expression "in particular" had to be regarded as optional. As a rule, an optional feature in the main claim was one which was not essential to the claimed teaching but instead served as an example illustrating other features. The wording used in claim 1 as granted meant that the claimed domestic appliance included not only an optical display unit but also an operating unit, the expression "in particular" having to be construed in the sense of "above all" or "especially".

The operating unit was specified not as an example of a possible component, but rather as an essential part of the domestic appliance. In this case, "in particular" gave special emphasis to the operating unit as part of the appliance. The scope of protection was limited by this non-optional feature and its deletion therefore infringed Art. 123(3) EPC (see also **T 916/08**).

2.4.7 Deletion of a "preferred" feature in a claim

In **T 795/95** the board did not share the appellant's view that deleting the feature "preferably polyvinyl or polyethylene" from the preamble of granted Claim 1 extended the protection conferred. The formulation "preferably polyvinyl or polyethylene" had no bearing on the scope of protection, which was determined by the more general term "plastic" and not the specific preferred substances polyvinyl or polyethylene. Deleting a "preferred" feature did not extend the scope of protection if such feature was encompassed by an earlier and general one (in this case, "plastic") which determined the protection conferred.

2.4.8 Replacement of a restrictive term by a less restrictive term

In **T 371/88** (OJ 1992, 157) the board held that Art. 123(3) EPC 1973 was not contravened if a restrictive term in a granted claim which in its strict literal sense did not embrace an embodiment set out in the description was replaced by a less restrictive term clearly embracing also this embodiment, provided two conditions were fulfilled: The restrictive term should not be so clear in its technical meaning in the given context that it could be used to determine the extent of protection without interpretation by reference to the description and drawings. Moreover, it had to be quite clear from the description and drawings and also from the examination procedure up to grant that the further embodiment belonged to the invention and that it was never intended to be excluded from the protection conferred by the patent (see also **T 673/89** confirming **T 371/88**; **T 738/95** distinguishing its case from **T 371/88**; **T 750/02**, which held that the first condition set out in **T 371/88** was not fulfilled; **T 749/03**, which held that both conditions were met and which is summarised in chapter II.E.2.4.9 below).

In **T 824/08** the board observed that the rationale of **T 371/88** could not be applied in the case at issue since the limiting feature was clear in itself and did not pose any problems when determining the extent of protection conferred by the claim.

2.4.9 Replacement of an inaccurate technical statement in a claim

In **T 190/99** the board stated with reference to **T 108/91** (OJ 1994, 228) and **T 214/91** that the amendment of a granted claim to replace an inaccurate technical statement, which was evidently inconsistent with the totality of the disclosure of the patent, with an accurate statement of the technical features did not infringe Art. 123(3) EPC 1973. The board added that the skilled person, when considering a claim, should rule out interpretations which were illogical or did not make technical sense.

In **T 749/03** the respondent (patent proprietor) argued that a situation similar to the one in **T 190/99** arose as claim 5 as originally filed would, if taken alone, not make technical

sense, and even the simple addition of its features to the features of claim 1 would result in an inadequately defined apparatus. However, by taking into account the whole disclosure of the patent the skilled person might arrive at a technically sensible interpretation of the claim. The board based its reasoning on the approach taken in decision **T 371/88** (OJ 1992, 157, summarised in chapter II.E.2.4.8 above), which concerned the admissibility of amending a granted claim to replace a restrictive term with a less restrictive term and defined two conditions: (a) the restrictive term in the granted claim was not so clear in its technical meaning in the given context that it could be used to determine the extent of protection without interpretation by reference to the description and the drawings of the patent; (b) it was quite clear from the description and the drawings of the patent and also from the examination procedure up to grant that the further embodiment belonged to the invention and that it had never been intended to exclude it from the protection conferred by the patent. In the case at hand (**T 749/03**), having regard to claim 1 alone, the features relating to the second (transmission) grating were perfectly clear in their technical meaning. However, in combination with claim 5 they would only make sense if reference were made to the description and drawings. Therefore requirement (a) was met. Further, there could be no doubt that the applicant had not waived that embodiment. Hence requirement (b) was also met.

In **T 1896/11** the appellant had replaced the parameter to be monitored in claim 5 of the patent as granted by a different parameter. According to the appellant, this was done because claim 5 of the granted patent contained an inaccurate technical statement and, since from the description it was clear what was obviously intended, claim 5 could be corrected to reflect this intention (with reference **T 108/91**), without violating Art. 123(3) EPC. The board disagreed and held that the skilled person would understand claim 5 of the granted patent as it stood and would not have any reason to suspect that it contained an inaccurate technical statement. Moreover, in accordance with **G 1/93** (OJ 1994, 541), it was not allowable to replace a technical feature of a patent claim with another technical feature which caused the claim to extend to subject-matter which was not encompassed by the granted claim. As pointed out in **T 195/09**, in this respect decision **T 108/91** had been clearly overruled by **G 1/93**.

2.4.10 Replacement of "cell of a plant" by "plant"

In **T 579/01** independent claim 1 and dependent claims 2 to 6 of the new main request were directed to a "vegetable plant", while the respective claims as granted were directed to a "cell in a vegetable plant". The board decided that, considering the totality of protection established by the claims as granted, any plant as subject-matter of claim 1 of the new main request fell within the protection conferred by a claim to "a cell of a plant", and finally that the "plant" now claimed was characterised by the same genetic features as recited in the granted claim to "a cell of a plant". Also taking account of legislative developments in Europe in respect of the legal protection of biotechnological inventions (i.e. Art. 8.1 and 9 of the Biotech Directive), the board concluded that the amendment of the "cell of a plant" claim to a "plant" claim was not contrary to the requirements of Art. 123(3) EPC 1973. For a summary of the findings in **T 579/01** see also **T 1898/07**.

2.4.11 Replacement of substance by device containing substance or substance with mechanical device

In **T 352/04**, claim 1 as granted had been directed to a haircare composition defined only by its components, whereas claim 1 of the main request pending on appeal included a variant that additionally characterised it as "present in the form of a nonaerosol hairspray with a mechanical spray device". Observing that the dependent claims as granted had similarly made no reference to any device features, the board held that the addition of this mechanical spray device extended the protection conferred in breach of Art. 123(3) EPC 1973. Its inclusion as a separate element also changed the category of the claim, as it now encompassed a device containing the cosmetic composition too. See also in this chapter II.E.2.7. "Change of claim category". See also **T 681/15**.

In **T 1898/07** the appellant (patent proprietor) argued that a claim referring to a packaged kit containing the liquid composition of claim 1 as granted was in fact narrower in scope than a claim referring to the liquid composition, as this claim encompassed the liquid formulation in any possible container, vessel, package or reservoir. The board agreed with the appellant in so far as the scope of protection covered by a claim referring to a physical entity should be considered to encompass the physical entity in any possible package or container. However, it was self-evident that "a packaged kit" was a different physical entity than "a liquid composition". In the board's view the content of a package is not a characterising feature of the package per se. Thus, a procedural situation was created where an act, for instance the production of the box, package or other container, which did not infringe the patent as granted, became an infringing act as a result of an amendment after grant. It is precisely this situation which should be prevented by the requirements of Art. 123(3) EPC. A referral under Art. 112(1)(a) EPC was not justified since the board, which examined the teaching of cases **T 579/01** and **T 352/04** (amendment from cosmetic agent to combination of the agent with a mechanical device) referred to by the appellant, concluded that they did not apply in this case.

2.4.12 Replacement by aliud

In **T 867/05**, the product claims as granted defined a composition of matter (membrane material of claims 1 to 9 and permselective material for use in dialysis of claim 12), whereas the amended product claims defined an apparatus (artificial kidney). The board considered that there had been a shift of the definition of the invention from a physical entity to a more complex physical entity which was not encompassed by the terms of the claims as granted. That shift implied that further components of an apparatus were encompassed by the terms of the present claims. This extended the protection conferred by claim 1 as granted to subject-matter which was foreign to that as granted (aliud), and so violated Art. 123(3) EPC. Likewise in **T 1321/05** the board saw the combination of two physical entities ("graphic marking film bonded to a vehicle") as a new physical entity different from the previously claimed entity ("graphic marking film"), considered this subject-matter as an aliud and the amended claim thus contrary to Art. 123(3) EPC.

In **T 547/08** the granted claim was directed to a user interface and screen display apparatus for a dialysis machine, the claim as maintained by the opposition division to a

dialysis machine comprising user interface and screen display apparatus. In the board's view the scope of the claim as maintained had been **restricted** vis-à-vis that of the claim as granted since the subject-matter upheld explicitly comprised the dialysis machine as an additional feature. The board did not accept the appellant's arguments relating to the rights of the patent proprietor to sue for indirect or contributory infringement. In **G 2/88** (OJ 1990, 93) it was clearly ruled that it was not necessary to consider the national laws of the contracting states in relation to infringement and that this issue was not relevant when deciding upon admissibility of an amendment under Art. 123(3) EPC. With respect to this question, it was rather appropriate to take into account that the protection conferred by a patent is determined by the terms of the claims, and in particular by the categories of the claims and their technical features, in accordance with Art. 69(1) EPC and its Protocol (**G 2/88**). The board distinguished its case from those of **T 352/04** (change from a substance to a combination of the substance and a device) and **T 867/05** (change from a substance A for use in a method X to a combination of a device B and the substance A) and rejected the appellant's argument that the scope of protection had been shifted to an "aliud" in breach of Art. 123(3) EPC.

The board in **T 1296/11** held that – in contrast to, for example, **T 352/04**, **T 867/05** and **T 321/07** – there had been no change of claim category because the same electro-mechanical device was claimed after the amendment as before. Citing the conclusion reached in **T 547/08**, which had likewise involved the replacement of a specified purpose in the granted claim by a mandatory combination, it held that the protection conferred had not been extended within the meaning of Art. 123(3) EPC; on the contrary, the added features limited the protection.

For further cases, where the boards considered the amended claim to define an aliud, see e.g. **T 1675/08**, **T 1779/09**, **T 1701/10**, **T 1578/13**, **T 2181/13** and **T 2194/21**; conversely for cases where the boards saw no shift to an aliud, see e.g. **T 820/98**, **T 1818/11** and **T 1646/12**.

2.4.13 Narrowing down a generic class or list of chemical compounds; open claims ("comprising"); sequential drafting ("cascade")

As summarised in e.g. **T 1384/16**, the problem underlying the Art. 123(3) EPC objection dealt with in the following decisions arises when a granted claim directed to a composition defined in an open manner and specifying the presence of a component belonging to a class or list of compounds in a quantity defined by a range is amended by limiting the definition of the class or list of compounds. In such a case, in spite of the apparent limitation, the result of the amendment is that the deleted compounds, which according to the granted claim had to be present in an amount within a specific range, can still be present, but in an unspecified manner. The protection conferred by the amended claim then extends beyond that of the granted claim, contrary to the requirement of Art. 123(3) EPC.

In **T 2017/07** the board stated that a composition which is specified in a claim to comprise a component in an amount which is defined by a numerical range of values is characterised by the feature which requires the presence of the component within that range, as well as

by the **implicit proviso** which excludes the presence of that component in an amount outside of that range. Consequently, the amount of that component present in the composition must not exceed the upper limit of the numerical range indicated. An amendment restricting the breadth of that component, for instance by narrowing down a generic class or a list of chemical compounds defining that component, has the consequence of no longer requiring the presence within that numerical range of those chemical compounds no longer encompassed by the restricted definition of that component and, thus, of limiting the scope of this implicit proviso. A composition which is defined as comprising the components indicated in the claim is open to the presence of any further components, unless otherwise specified. Thus, in a claim directed to an openly defined composition, the restriction of the breadth of a component present therein may have the effect of broadening the scope of protection of that claim, with the consequence that in opposition/appeal proceedings such amended claim may extend the protection conferred by the granted patent (Art. 123(3) EPC). The considerations in **T 2017/07** were confirmed in e.g. **T 9/10** and **T 2430/17** (in which a list of three families of polymers as defined in claim 1 as granted was limited by the deletion of two alternatives, thus removing the implicit proviso for these two alternatives).

In **T 999/10** the board considered that sequential drafting (formulation "en cascade") in an open claim ("comprising"), i.e. retaining in an amended claim the broad definition of claim 1 and adding, by means of the expression "and in which ...", an additional limitation, avoided the situation contemplated in **T 2017/07**, where an amendment initially made with a view to limiting a claim in fact extended the scope of protection it conferred (Art. 123(3) EPC). The approach described in **T 999/10** was followed in **T 262/13**, **T 1063/15** and **T 2215/18**. However, in **T 287/11** the board held that the scope of protection should **not be interpreted in the light of the intention of the drafter of a claim**, since this was a subjective criterion, but rather on the basis of the meaning generally accepted by the person skilled in the art to the technical features defined in said claim, and established that the requirements of Art. 123(3) EPC were not met. **T 287/11** was followed in **T 881/11**, **T 52/13**, **T 865/13**, **T 514/14**, and **T 664/20**.

In **T 1360/11** the board confirmed that in a case where a granted claim, directed to a composition defined in an open manner and including the presence of a component belonging to a class or list of compounds in a quantity defined by a range, was later amended by limiting the definition of the class or list of compounds, in spite of the apparent limitation, the wording of the granted and amended claims might be such that the amendment results in an extension of the protection conferred. The problem was well known in the case law, see e.g. **T 172/07**, **T 2017/07**, **T 832/08**, **T 1312/08**, **T 869/10**, **T 287/11**. The board observed that by means of inserting a **double condition** the claim may not extend the protection conferred by the patent. A possible infringement of the requirements of Art. 123(3) EPC might be avoided by including in the amended claim a **quantitative condition on the limited class or list of compounds** and an **additional constraint** on the total amount of compounds belonging to the broader class or list. See also **T 514/14**, **T 1063/15** and **T 2215/18**.

In **T 306/14** the board considered that possible ways out of the situation were a sequential drafting of the claim (formulation "en cascade" as in **T 999/10**) or a "double condition" (as

in **T 1360/11**). In the case in hand, the appellant had chosen the second possibility and amended the claim by including a further limitation of the total amount of the milled filler. The board agreed with the respondent/opponent that the claims were not identical to the claims in decision **T 1360/11**, wherein the added condition also specified the amount of the specific components, but the idea was exactly the same. Adding the second condition ensured that the total amount of milled filler remained within the scope of the granted claims.

However, see also **T 2447/18**, which illustrates that such claim formulations may contravene Art. 123(2) EPC.

2.5. Additions

2.5.1 Addition of technical features defining the invention more narrowly

In the case of a change in the technical features of the invention, if the technical features of the claimed invention after amendment are more narrowly defined, the extent of the protection conferred is less (**G 2/88**, OJ 1990, 93, point 4.1 of the Reasons).

In **T 970/17** claim 1 of the third auxiliary request included all the features of claim 1 as granted but also several additional technical features. Both claims were product claims. The board concluded that claim 1 of the third auxiliary request had a narrower scope of protection than claim 1 as granted (see **G 2/88**, point 4.1 of the Reasons). The opponent had argued that it was not allowable under Art. 123(3) EPC to claim a physical entity which was different from the physical entity claimed in the patent as granted (here: claim 1 of the third auxiliary request was directed to a vascular access port comprising the septum according to claim 1 as granted). The board, however, held that what mattered was not what the first technical feature in a claim was, but rather what technical features the claims included in their totality. In the board's view, the opponent's arguments relating to possible differences in the German patent law on contributory infringement did not change the above assessment. There was a difference between the "extent of the protection conferred" by a patent under Art. 69 EPC and the "rights conferred" by a patent under Art. 64 EPC.

2.5.2 Reducing scope of claim by adding embodiments to a negative feature

In **T 363/11** the board considered that the feature concerned was a negative feature, in the sense that it defined embodiments which were excluded from the claim. Since after the amendment more embodiments were excluded from claim 1 of the request than from claim 1 as granted, its scope was reduced vis-à-vis granted claim 1 and the requirements of Art. 123(3) EPC were satisfied.

2.6. Transposition of features within claims

In **T 16/86** the board pointed out that it was the subject-matter of the claim as a whole which embodied the invention. Therefore, in so far as a change in the position of a feature inside a claim did not alter its meaning, the extent of protection conferred remained

unchanged and such an amendment contravened neither Art. 123(2) nor Art. 123(3) EPC 1973.

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

In **T 96/89** the board again allowed the transposition of features from the preamble of a claim to its characterising portion. This did not alter the subject-matter claimed, and thus did not extend the scope of protection. Nor was it in breach of Art. 123(3) EPC 1973 if terms were first generalised in the preamble, then trimmed back in the characterising portion to the subject-matter originally disclosed. R. 29(1) EPC 1973 required that claims be delimited against the nearest prior art; before the preamble to an independent claim could be drafted at all it was often necessary to select from two restrictive terms (the subject-matter claimed and the closest prior art) a general term covering both.

In **T 49/89** the subject-matter of granted claim 1 had been limited during opposition proceedings to a special embodiment according to granted dependent claim 2. The board held that the protection had not been extended because new claim 1 indicated all the features in granted claim 1 and the newly incorporated features were merely elaborations on those contained in granted claim 1. The extent of protection conferred by a European patent was determined by the content of all claims, not that of one or several only. Thus, for example, even though an independent claim lacked novelty a claim dependent on it could still be valid and the patent proprietor could restrict himself to that claim. It was, moreover, irrelevant when determining the extent of protection whether features were referred to in the prior art portion or characterising portion. The transposition of information from one to the other did not therefore contravene Art. 123(3) EPC 1973 (**T 579/01**, **T 411/02**, **T 250/02**, **T 1898/07**).

2.7. Change of claim category

In **G 2/88** (OJ 1990, 93) the Enlarged Board stated that a change of category of granted claims in opposition proceedings was not open to objection under Art. 123(3) EPC 1973, if it did not result in extension of the protection conferred by the claims as a whole, when they were interpreted in accordance with Art. 69 EPC 1973 and its Protocol. In this context, the national laws of the contracting states relating to infringement should not be considered, for there was a clear distinction between the protection which was conferred and the rights which were conferred by a European patent. The **protection conferred by a patent** was determined by the terms of the claims (Art. 69(1) EPC 1973), and in particular **by the categories of such claims and their technical features**. In contrast, the rights conferred on the proprietor of a European patent (Art. 64(1) EPC 1973) were the legal rights which the law of a designated contracting state might confer upon the proprietor. In other words, in general terms, determination of the "extent of the protection conferred" by a patent was a determination of what was protected, in terms of category plus technical features; whereas the "rights conferred" by a patent were related to how such subject-matter was protected. When deciding upon the allowability of an amendment involving a change of category, the considerations were, in principle, the same as when

deciding upon the allowability of any other proposed amendment under Art. 123(3) EPC 1973.

2.7.1 From product claim to a claim directed to the use of the product

a) Different categories of use claims

Enlarged Board decision **G 2/88** (OJ 1990, 93) related to a change of claim category in opposition proceedings, and in particular to the change from a product claim to a claim directed to the use of the product for a particular purpose, which the Enlarged Board allowed for the use of a particular physical entity to achieve an effect. The **protection conferred by a patent** was determined by the terms of the claims (Art. 69(1) EPC 1973), and in particular **by the categories of such claims and their technical features**. An amendment of granted claims directed to "a compound" and to "a composition including such compound", so that the amended claims were directed to "the use of that compound in a composition" for a particular purpose, was not open to objection under Art. 123(3) EPC 1973. For it was generally accepted as a principle underlying the EPC that a patent which claimed a physical entity per se, conferred absolute protection upon such physical entity, for all uses of such physical entity, whether known or unknown. It followed that if it could be shown that such physical entity (e.g. a compound) was already part of the state of the art, then a claim to the physical entity per se lacked novelty. It also followed that a claim to a particular use of a compound was in effect a claim to the physical entity (the compound) only when it was being used in the course of the particular physical activity (the use), this being an additional technical feature of the claim. Such a claim therefore conferred less protection than a claim to the physical entity per se.

However, the Enlarged Board distinguished between use claims, which define the use of a particular physical entity **to achieve an "effect"**, and claims which define such a use **to produce a "product"**. The latter type of claim was a process claim within the meaning of Art. 64(2) EPC 1973.

In **T 401/95** the board, with reference to **G 2/88** (OJ 1990, 93), identified two different categories of use claim, namely

(i) the use of a physical entity to achieve an effect, and

(ii) the use of a physical entity to produce a product.

A use claim of the latter category (ii) is to be considered as a process claim comprising physical steps for producing the product using the physical entity with the consequence that this type of use claim is a process claim within the meaning of **Art. 64(2) EPC 1973**. Pursuant to that article, the product insofar as it is **directly obtained** by that process, is also protected. Hence, the product, when obtained by that process, is within the scope of protection conferred by that type of use claim. Consequently, the use claim as amended conferred protection to the claimed use and to the product directly obtained by the claimed process, which, in the case at issue, extended the protection conferred (for a case where the issue of Art. 64(2) EPC 1973 was not considered, see however **T 879/91**).

b) From product claim to a claim directed to using a product to achieve an effect

In **T 134/95** a patent had been granted in respect of a "container for medical use", designed for the separate storage and the mixing of compounds. The protection conferred therefore related to the apparatus and, necessarily, to its use at least for the purposes of storage and mixing. After amendment, the claim became a use claim, covering only the use of the container and no longer protecting the apparatus as such. Having pointed out that inventions of this kind were designed with a particular object in mind and could not normally be used for other purposes, the board noted that in this case, the change of category, replacing the granted claim with a claim for the use of the container, had the effect of limiting the scope of protection. The two stages of the process therefore in no way had the effect of modifying the starting solutions with a view to obtaining or manufacturing a product. This use therefore fell into the category "use of a physical entity to obtain an effect or result" (see **G 2/88**, OJ 1990, 93), and on this basis the change of category was allowable.

A change from a product claim to a claim for the use of the product to produce an effect was also allowed in **T 568/94**, **T 78/97**, **T 977/02**.

c) From product claim to a claim directed to using a product for producing another product – Article 64(2) EPC

In **T 912/91** the board held that the change of claim category from the granted product claims for composite bodies to use of graphite for obtaining a sintered composite ceramic body having certain characteristics did not broaden the scope of protection of the granted claims. Even if it were considered that the use claim was notionally equivalent to a claim to a process including the step of using the graphite in the sintered body and that the effect of Art. 64(2) EPC 1973 was to confer protection on the product resulting from this process as well, this would not represent an extension of protection within the meaning of Art. 123(3) EPC 1973, since the sintered composite body was defined in the use claim in a more restricted way than the composite body of the granted claim (narrower range of the graphite content, etc.).

In **T 282/09** the claims of the main request as amended comprised only use claims, which had replaced the product claims directed to a physical entity of the patent as granted. The board held that according to EPO practice (see **T 401/95**) a claim directed to "the use of a physical entity to produce a product" was to be considered as a process claim comprising physical steps for producing the product using the physical entity, with the consequence that this type of use claim was a process claim within the meaning of Art. 64(2) EPC. Pursuant to that article of the EPC, the product, insofar as it was directly obtained by that process, was also protected. Hence, the product, when obtained by that process, was within the scope of protection conferred by that type of use claim (see decision **G 2/88**, OJ 1990, 93, point 5.1 of the Reasons). In the case at issue, the protection conferred after amendment extended beyond that conferred before, contrary to the requirements of Art. 123(3) EPC, because the product obtained using the physical entity was not protected before the amendment of the claims, but was now protected as a result of the amendment. See also **T 1471/14**.

In **T 1954/12** claim 3 as granted was to a cell characterised by the presence of a recombinant nucleic acid encoding VKOR. Claims 2 and 3 of the main request were directed to the use of the cell of granted claim 3 for making a VKD protein. The board observed that a distinction had been made in **G 2/88** (OJ 1990, 93) between "a patent whose claimed subject-matter is the use of a product to achieve an effect ... [and] ... a patent whose claimed technical subject-matter is a process of manufacture of a product". For this latter case, it was stated with reference to Art. 64(2) EPC that "protection is conferred not only upon the claimed process of manufacture, but also upon the product resulting directly from the manufacture". The board noted that the methods of claims 2 and 3 were directed to the manufacture of a particular product, namely a VKD protein, and thus, the protection conferred by these claims was not limited to the claimed process of manufacture but extended also to this product. The protection conferred by granted claim 3 did not extend to this product and, in this regard, the protection conferred by claims 2 and 3 went beyond the protection conferred by granted claim 3. However, decision **G 2/88** required **comparing the totality of the claims before and after the amendment**. In the case at issue, the protection conferred by granted claims 4-7 extended, in accordance to Art. 64(2) EPC, to the product obtained, i.e. a VKD protein. The board came to the conclusion that granted claims 4-7 provided protection for the product obtained by the methods of claims 2 and 3 of the main request, namely a VKD protein. The requirements of Art. 123(3) EPC were fulfilled.

2.7.2 From device claim to a method claim directed to using the device to carry out a work method

In **T 653/16** the appellant (opponent) took the view that changing the category of claim 1 as granted from one directed to a device (floatable harbour power supply) to a method claim for carrying out a work method (method for supplying external power to a ship in the harbour) using the device extended the scope of protection. The board disagreed. In the case in hand, the patent as granted had solely contained claims directed to a physical entity per se. The Enlarged Board had acknowledged that it was a fundamental principle of the EPC that any patent which claimed a physical entity per se conferred absolute protection upon that entity, i.e. for all uses of the entity, whether known or unknown (**G 2/88**, OJ 1990, 93). Contrary to the appellant's opinion, the scope of protection conferred by the patent as amended in line with auxiliary request 2 did not extend to cover the ship since that request was no longer directed to physical entities – for want of any device claims.

2.7.3 From product or product-by-process claim to a claim directed to a process for manufacturing/preparing the product, and vice versa

According to established case law, a product claim confers protection to all processes for making that product, such that the replacement of a claim directed to a product by a claim directed to a specific process or method for making that product does not extend the protection conferred thereby (**T 674/02** with reference to **T 54/90**, **T 28/92**, **T 468/97**, **T 554/98**; see also **T 37/90**, **T 191/90**, **T 762/90**, **T 153/91**, **T 601/92**, **T 646/98**, **T 425/02**, **T 1139/06**, **T 425/23**).

In **T 423/89** the change in category from a product-by-process claim to a manufacturing process claim was admissible. In **T 402/89**, however, the board pointed out, in passing, certain difficulties in interpreting the term "protection conferred".

In **T 5/90** the patent was granted with a claim in the form "a product having product features x and product-by-process features characteristic of process steps y". This claim, however, turned out not to be novel. The patentee finally claimed "a process of making a product having product features x by using process steps y and process steps z". The board interpreted such a claim as covering the process steps only in so far as a product having product features x actually resulted. This was called a **process-limited-by-product claim** by the board. The direct product of this process would also be protected under the provisions of Art. 64(2) EPC 1973, but such product inevitably fell within the scope of the product claim originally granted. The board regarded a process-limited-by-product claim of this type as clearly complying with the requirements of Art. 123(3) EPC 1973 because it would only be infringed if the product fell within the originally granted product claim and in addition the particular form of manufacture using process steps z was used (see also **T 562/04**).

In **T 20/94** the patent as granted exclusively comprised process claims for preparing a product. In the form as amended it comprised a product claim relating to the product per se. The board stated that the protection conferred by a claim directed to a process for preparing a product covered a product directly obtained by that process (Art. 64(2) EPC 1973), but it was not protected when obtained by any other process. However, the protection conferred by a claim directed to a product per se was absolute upon that product. The product claim thus conferred protection on that product regardless of the process by which it was prepared. The appellant attempted to overcome this objection by formulating the product claim as amended in the form of a product-by-process claim using the term "directly obtained". The board did not agree with this line of argument, stating that a product-by-process claim was interpreted as a claim directed to the product per se, since the only purpose of referring to a process for its preparation was to define the subject-matter for which protection was sought, which was a product. Thus amended claim 1 in the case in question contravened Art. 123(3) EPC 1973.

In **T 1206/01** the board pointed out that according to the established case law of the boards of appeal a product claim conferred protection on the claimed product, regardless of the process or method by which it was prepared. Therefore a change of category from a granted product claim to a process claim restricted to one or more methods of preparing the product did not extend the protection thereby conferred (see also **T 276/11**).

2.7.4 From a product claim to a product-by-process claim

In **T 794/03** claim 1 as granted had been a substance claim for a plain-bearing composite material, preferably for manufacturing bearing bushes, whereas claim 1 according to the main request pending on appeal was for a plain-bearing bush made of the (in the meantime, limited) composite material. The board found that this amended claim amounted to a kind of "product-by-process" claim, which meant that, in order to determine

the extent of protection it conferred, it had to establish what features the process lent the end product. It concluded that the scope of protection had indeed been extended.

2.7.5 From method of operating a device claim to product claim

In **T 426/89** (OJ 1992, 172) claim 1 as granted and claim 1 of the main request related to a process for operating a pacemaker. The board noted that an actual operating method for a pacemaker for arresting a tachycardia would necessarily be a method for treating the human (or animal) body by therapy, and would not be patentable. However, the board agreed with the patentee that the claim referred to the steps in a technical method which did not define a method of treatment but rather, in functional terms, the structural features of a pacemaker. However, the board found the claim to be contrary to Art. 84 EPC 1973. The differences between the claim 1 according to the auxiliary request and the granted version were that in claim 1 the terms "Method for the operation of a pacemaker", had been replaced by "Pacemaker". The board held that claim 1 as granted was already a product claim containing a functional definition of a pacemaker. So the seeming change of category did not alter the content of the claim but simply served to clarify it (see also **T 378/86**, OJ 1988, 386).

In **T 82/93** (OJ 1996, 274) claim 1 as granted related to a method of operating a pacer. The board found that this claim defined a method for treatment of the human body by therapy and therefore was not allowable under Art. 52(4) EPC 1973. It held that the device claim of the auxiliary request was not allowable under Art. 123(3) EPC 1973. The subject-matter protected by the granted claim was a pacer, **when in use**; in contrast, the claim of the auxiliary request only included technical features which defined physical characteristics of the pacer device itself. The board explained that in general terms, if a patent as granted only included claims defining the operation of a device and therefore **containing both "device features" and "method features"**, and the proposals to amend the patent during opposition proceedings included claims which only contained "device features", the proposed amendment was not allowable having regard to Art. 123(3) EPC 1973, because the patent as granted conferred protection upon the device only when it was in use so as to carry out the method, whereas the proposed amended patent would confer protection upon the device whether or not it was in use, and would therefore confer additional protection compared to the patent as granted. In contrast to the findings in **T 426/89**, in the case at issue the board held that claim 1 as granted was clear, defined the use of a device to carry out a method of treatment of the human body by therapy and was not a pure "device claim" since it also included method steps. Thus, under such circumstances, Art. 52(4) and Art. 123(3) EPC 1973 might operate in combination as an "inescapable trap".

T 1830/14, too, concerned the conversion of a granted method claim to a device claim. The board recalled that a claim directed to an apparatus provided absolute protection of the defined apparatus and, hence, its scope of protection was broader than the scope defined by a claim directed to a method of production or use of the same apparatus. In the case at issue, compared to the cooling apparatus defined in claim 1 as granted, in the apparatus claim 1 of the main request a feature had been deleted. The appellant argued that granted independent method claim 9 defined a cooling apparatus without the deleted

feature and that, therefore, deleting this feature from the apparatus claim did not broaden the scope of protection. However, referring to the principles stated in **T 82/93** (OJ 1996, 274), the board observed that in the case in hand two features defining the operation of the cooling apparatus in claim 9 as granted were missing from claim 1 of the main request. The protection conferred by granted claim 9 to the defined cooling apparatus was limited to the apparatus when it was transferring heat according to the missing features, i.e. only when it was in operation. Claim 1 at issue defined the same cooling apparatus as granted claim 9, but conferred absolute protection to it, irrespectively of whether it was in operation or not. Hence, its scope of protection was broader than that of granted claim 9 and the main request did not fulfil the requirements of Art. 123(3) EPC. The board accepted auxiliary request IV, as the apparatus claim also contained the features defining the operation of the apparatus.

2.7.6 From use claim to process claim, and vice versa

In **T 279/93** the board found that a claim to the use of a compound A in a process for preparing compound B had no broader scope than a claim to a process for preparing compound B from compound A. It had already been stated in **G 2/88** (point 2.5 of the Reasons) that the technical features of a claim to an activity were the physical steps which defined such activity. In this case, the board considered that process claim 1 as filed, process claim 1 as granted and use claim 1 filed on appeal all related to the same physical steps, and that the claims were therefore of the same scope. On this view, the scope of protection conferred by this use claim was not broader than that conferred by the granted process claim (see also **T 619/88**).

In **T 420/86** a change from a claim for a process for treating soil, in which X was used, to a claim for the use of X for treating soil was allowed. In **T 98/85** on the other hand, a change from a "process for the preparation of a ... composition" to the "use of this ... composition as a ..." was seen as a breach of Art. 123(3) EPC 1973.

In **T 276/96** the board decided in view of **G 5/83** (OJ 1985, 64) that the change of claim of the type "Method of fabricating item A using item B providing effect C" to a claim of the type "Use of item B in a method of fabricating item A to provide effect C" did not extend the protection conferred, since with both formulations the same activity would be forbidden to competitors.

In **T 22/09** of 5 February 2016 the board held that since claim 1 as granted concerned a method of pre-treating a catalyst support, which by virtue of Art. 64(2) EPC extended the protection conferred to the pre-treated catalyst support directly obtained by the claimed method, and since instead claim 1 according to the new request concerned the use of a modifying component for suppressing the solubility of a catalyst support, i.e. defined the use of a chemical compound to obtain a particular effect on the catalyst support, the protection conferred by the patent as granted had not been extended.

2.7.7 From use claim to Swiss-type claim

In **T 1635/09** (OJ 2011, 542) claim 1 in the 23rd auxiliary request differed from claim 1 in the granted text in that the originally granted use claim was converted to the so-called Swiss form of claim, i.e. a claim for the use of a substance or mixture of substances for manufacturing a medicament for a specific therapeutic use. Under the established jurisprudence of the boards of appeal, when establishing whether the scope of protection was extended by this amendment all the granted claims must be taken into consideration. It was therefore necessary to determine whether the reformulation of a claim for the "use of an oral dosing form comprising ... for contraception ..." into a claim for the "use of a composition comprising ... for manufacturing an oral ... dosing form for contraception ..." complied with the requirements of Art. 123(3) EPC. A crucially important question here was whether the Swiss-type claim was to be regarded as for (a) the use of a substance or mixture of substances for a specific purpose or (b) the manufacture of a medicament. Citing **G 5/83** (OJ 1985, 64) and **G 2/88** (OJ 1990, 93), the board in **T 1635/09** ruled that the conversion of a claim for the use of a substance or mixture of substances for a specific purpose into a Swiss-type claim or a product claim limited to a specific use in accordance with Art. 54(5) EPC results in an extension of the scope of protection.

2.7.8 From Swiss-type claim to purpose related product claim under Article 54(5) EPC

In **T 250/05** the board held that, apart from the fact that Art. 54(5) EPC (entry into force 13 December 2007) did not apply to a patent granted in 2001, Art. 123(3) EPC would not allow the change of category of a granted use claim into a product claim, even if drafted as a purpose-related product claim. Therefore, in the case at issue, the amended claims had to remain in the "Swiss form" in order not to contravene Art. 123(3) EPC.

In **T 1780/12**, in the context of double patenting, the board understood that the board in **T 250/05** had considered that the scope of protection conferred by a purpose-related product claim was in fact larger than the scope of protection conferred by a Swiss-type claim. See also **T 879/12**.

In **T 1673/11** claim 1 of the main request was drafted in the format of a purpose-limited product claim as provided for by Art. 54(5) EPC, whereas all claims as granted had been in the so-called "Swiss-type" form. For the respondent, the protection conferred by both types of claims was the same. The board disagreed. The purpose-limited product claim conferred protection on the product, whenever it was being used for the treatment of infantile Pompe's disease. Since the claim did not refer to a step of manufacture of a medicament, the product claimed was not limited to a manufactured medicament, packaged and/or with instructions for use in the treatment of infantile Pompe's disease. Even if by virtue of Art. 64(2) EPC the protection conferred by granted claim 1 extended to the product directly obtained by the manufacturing process referred to in said claim, the protection conferred by claim 1 of the main request was broader. Nor could the board follow the appellant's argument that since the use limitation of the claims of the main request and of the granted claims was the same, their scope of protection was identical. For example, once the patent was amended, a medicament containing the product, packaged and provided with instructions for the use in a treatment other than that of

infantile Pompe's disease was encompassed by the scope of claim 1 of the main request when said medicament was being used for the treatment of infantile Pompe's disease. The protection conferred by granted claim 1 did not encompass such use. The board concluded that the amendment of the contested patent in such a way extended the protection it conferred, contrary to Art. 123(3) EPC.

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

This chapter concerns the "inescapable trap" of Art. 123(2) EPC in combination with Art. 123(3) EPC when the applicant inadmissibly adds a limiting feature to the claim. A similar trap may exist in the situation in which there is no violation of Art. 123(2) EPC but a lack of novelty due to loss of priority, see **T 1983/14** summarised in chapter II.E.2.4.1 above. For the situation in which an unclear feature (Art. 84 EPC) is deleted from the claim and the argument that this also might lead to an "inescapable trap", see **T 81/13** summarised in chapter II.E.1.4.7 above.

3.1. Inescapable trap

In **T 384/91** (OJ 1994, 169) the question was referred to the Enlarged Board whether, given the requirements of Art. 123(2) and Art. 123(3) EPC 1973, a patent could be maintained in opposition proceedings if its subject-matter extended beyond the content of the application as filed, whilst at the same time the added feature limited its scope of protection. The conflict here was that the "limiting extension" had to be deleted as a breach of Art. 123(2) EPC 1973, but to do so would broaden the scope of the patent and thus contravene Art. 123(3) EPC 1973 (see **G 1/93**, OJ 1994, 541).

This problem had been extensively discussed for the first time in **T 231/89** (OJ 1993, 13), where the board held it to be inappropriate to take Art. 123(2) and 123(3) EPC 1973 as independent of each other while applying them in conjunction to revoke the patent.

In **G 1/93** (OJ 1994, 541) the Enlarged Board ruled as follows:

If a European patent as granted contained subject-matter which extended beyond the content of the application as filed within the meaning of Art. 123(2) EPC 1973 and which also limited the scope of protection conferred by the patent, such patent could not be maintained in opposition proceedings unamended, because the ground for opposition under Art. 100(c) EPC 1973 prejudiced the maintenance of the patent. Nor could it be amended by deleting such limiting subject-matter from the claims, because such amendment would extend the protection conferred, which was prohibited by Art. 123(3) EPC 1973. Therefore, in principle, if the European patent as granted contained a "limiting extension", it had to be revoked. Art. 123(2) and 123(3) EPC 1973 were mutually independent of each other (**T 1736/09**: by analogy, Art. 76(1) EPC and Art. 123(3) EPC must also be regarded as mutually independent of each other). In this sense, it had to be admitted that Art. 123(2) EPC 1973 in combination with Art. 123(3) EPC 1973 could operate rather harshly against an applicant, who ran the risk of being caught in an **inescapable trap** and losing everything by amending his application, even if the amendment was limiting the scope of protection. However, this hardship was

not per se a sufficient justification for not applying Art. 123(2) EPC 1973 as it stood in order to duly protect the interests of the public. Nor did it, in principle, matter, that such amendment had been approved by the examining division. The ultimate responsibility for any amendment of a patent application (or a patent) always remained that of the applicant (or the patentee).

3.2. Attempts to resolve the conflict

3.2.1 General

The Enlarged Board in **G 1/93** (OJ 1994, 541) mentioned three instances where the patent could be maintained:

- If the added undisclosed feature could be **replaced** by another feature disclosed in the application as filed without breaching Art. 123(3) EPC 1973, the patent could be maintained in amended form (**G 1/93**, Headnote 1). See below in this chapter II.E.3.2.2.

- An added undisclosed feature **without any technical meaning** could be **deleted** from a claim without violating Art. 123(3) EPC 1973 (**G 1/93**, point 4 of the Reasons, citing **T 231/89**). See below in this chapter II.E.3.2.3.

- An added undisclosed feature, which **did not provide a technical contribution** to the subject-matter of the claimed invention but merely limited the protection conferred by the patent as granted by excluding protection for part of the subject-matter of the claimed invention as covered by the application as filed, was not considered as subject-matter which extended beyond the content of the application as filed within the meaning of Art. 123(2) EPC 1973. In this case also the patent could be maintained (**G 1/93**, Headnote 2). See below in this chapter II.E.3.2.4.

In **T 1180/05** the board, on the basis of decisions **G 1/93** and **G 1/03** (OJ 2004, 413) dealing with Art. 123(2) and Art. 123(3) EPC 1973 and with disclaimers, came to the conclusion that the deletion of a feature in a granted claim, which feature extended beyond the content of the application as filed, and its reintroduction in the form of a disclaimer, so that the subject-matter of the claim remained the same, was not suitable to overcome the potential conflict between Art. 123(2) and Art. 123(3) EPC 1973. The decision of the opposition division maintaining the patent in amended form was set aside and the patent revoked.

Further circumstances in which boards have found that the conflict could be solved were mentioned in **T 1127/16**:

- The added undisclosed, limiting feature in contravention of Art. 123(2) EPC 1973 could be maintained in the claim without violating Art. 123(2) EPC 1973 provided that a further limiting feature was added to the claim which further feature was properly disclosed in the application as filed, and deprived the undisclosed feature of all technical contribution to the subject-matter of the claimed invention (**T 553/99**).

- The added undisclosed feature **could effectively be ignored** if it did not add anything over the other features of the respective claim, such that it had to be considered **redundant** (**T 310/13**).

- If the added undisclosed feature – in **T 131/15** an expression – taken literally and in isolation, had the effect of excluding all of the disclosed embodiments from the scope of protection, but a definition of this feature could be derived from the patent itself which would locate (at least some of) the disclosed embodiments within the ambit of the claim, and if this definition was not manifestly unreasonable, having regard to the normal meaning of the words used in the expression, then in judging compliance with the requirements of Art. 123(3) EPC, the scope of protection should normally be considered to include at least that which would fall within the terms of the claim understood according to this definition (**T 131/15**). The board in **T 1127/16** expressed doubts about this test and distinguished its case from the facts underlying **T 131/15**. On these two decisions and on earlier decisions regarding inconsistencies and the inescapable trap between the requirements of Art. 123(2) EPC and Art. 123(3) EPC, see below in this chapter II.E.3.2.5.

- One further circumstance referred to in **T 1127/16** (replacement of the added undisclosed feature by a broader feature) is presented below in chapter II.E.3.2.2 as a sub-case of the instance set out in **G 1/93**, Headnote 1.

The board noted in **T 335/03** that, according to **G 1/93**, there was no basis in the Convention for providing a claim with a footnote to the following effect; "This feature is the subject of an inadmissible extension. No rights may be derived from this feature"; in other words, in cases of conflict between Art. 123(2) and (3) EPC 1973 the **footnote solution** is **inadmissible** (see also **T 307/05**, **T 614/12** and **T 474/15**).

3.2.2 Replacement of an added undisclosed feature by another feature disclosed in the application as filed without violating Article 123(3) EPC

In **T 166/90** (decided before **G 1/93**, OJ 1994, 541, was issued) the board allowed an inadmissible feature in a granted claim to be replaced by other disclosed features, since this did not extend the scope of protection. The invention concerned an opaque plastic film. The product claim as granted contained a feature stating that the density of the film was less than the arithmetical density from the type and proportion of the individual components. In opposition proceedings the patent proprietor claimed a process for manufacturing the film, but without including in his process claim the density-related feature. The board examined whether this would broaden the scope of the patent, asking if the process claim features which replaced the deleted feature necessarily limited the claim to films – like that in the granted product claim – with a density less than the arithmetical one. The board concluded that, with a probability bordering on certainty, the process now claimed would produce an opaque film of a density less than that arithmetically derivable from the type and proportion of its individual components.

In **T 250/05** the board, following the principles set out in **G 1/93**, came to the conclusion that the patent could not be maintained unamended and that the patent could only be

maintained if there was a basis in the application as filed for replacing such subject-matter without violating Art. 123(3) EPC. The sixth auxiliary request met both prerequisites.

As noted in **T 1127/16** (in which the board summarised "workarounds" for resolving the inescapable trap between the requirements of Art. 123(2) and Art. 123(3) EPC), an added undisclosed feature, embracing one embodiment of the description, can be **replaced by a broader feature**, also covering an additional embodiment of the description, if the undisclosed feature is not so clear in its technical meaning in the given context that it could be used to determine the extent of protection without interpretation by reference to the patent's description and the drawings and it is quite clear from the description and the drawings and also from the preceding examination proceedings that the further embodiment belongs to the invention (**T 371/88**).

In the following cases the exception set out in **G 1/93**, Headnote 1, was invoked by the patent proprietor, but the board found that the requested replacement was not allowable under Art. 123(3) EPC: **T 729/11**, **T 108/12**, **T 1833/13** and **T 469/14**.

3.2.3 Deletion of added undisclosed feature, which has no technical meaning, without violating Article 123(3) EPC

In **G 1/93** (OJ 1994, 541), point 4 of the Reasons, the Enlarged Board noted with regard to previous decisions of the boards that it did not seem to be disputed that an added undisclosed feature without any technical meaning may be deleted from a claim without violating Art. 123(3) EPC, as held in case **T 231/89**. For recent decisions, see **T 1779/09** and **T 2624/22**.

In **T 2151/14** the board had to deal with the omission from claim 1 as granted of the term "publishing" used in connection with the server to which the claimed method claim related. The board noted that in the application as filed, the term "published" appeared to be used as a synonym for "made available", which, however, was an implicit function of a server. Beyond this, in its broadest interpretation, the term "publishing" in claim 1 as granted had no technical significance. It could therefore be omitted without infringing Art. 123(3) EPC (see **G 1/93**, OJ 1994, 541, point 4 of the Reasons). See also **T 958/15** and **T 270/22**.

In **T 2461/17**, the board established that the disputed feature of claim 1 as granted had a clear technical meaning. Consequently, the exception provided for in **G 1/93** did not apply.

3.2.4 Added undisclosed feature, which does not provide a technical contribution and does not contravene Article 123(2) EPC

G 1/93 (OJ 1994, 541) stated that the underlying idea of Art. 123(2) EPC 1973 was clearly that an applicant should not be allowed to improve his position by adding subject-matter not disclosed in the application as filed, which would give him an unwarranted advantage and could be damaging to the legal security of third parties relying on the content of the original application. If, however, an added feature merely excluded protection for part of the subject-matter of the claimed invention as covered by the application as filed, the adding of such a feature could not reasonably be considered to give any unwarranted

advantage to the applicant. Nor did it adversely affect the interests of third parties. Therefore, a feature which had not been disclosed in the application as filed but which had been added to the application during examination was not to be considered as subject-matter which extended beyond the content of the application as filed within the meaning of Art. 123(2) EPC 1973, if it **merely limited the protection conferred** by the patent as granted by excluding protection for part of the subject-matter of the claimed invention as covered by the application as filed, **without providing a technical contribution** to the subject-matter of the claimed invention (see also **T 112/95**).

These principles were in general confirmed in **G 2/10** (OJ 2012, 376), see also **G 2/98** (OJ 2001, 413). Pursuant to **G 2/10** it was, however, evident from the context that by introducing the "technical contribution" criterion in **G 1/93** the Enlarged Board had not intended to amend the definition concerning when an amendment was allowable under Art. 123(2) EPC generally, but that it only had sought a way of avoiding the potentially fatal consequences of the patentee being caught in the "inescapable trap" between the requirements of Art. 123(2) and (3) EPC. See also **T 1937/17** and **T 768/20**.

The question of whether an added feature made a technical contribution has been discussed in numerous decisions.

In **T 384/91** (OJ 1995, 745) it was held that the added feature did make a technical contribution. This decision was based on the following considerations: the example mentioned by the Enlarged Board illustrated a case where the feature was clearly not merely a limitation. However, the borderline beyond which a feature was no longer to be considered as making a technical contribution to the subject-matter of the claimed invention and was merely limiting the protection conferred, was not co-terminous with this example but lay between it and the limit of complete technical irrelevance. According to the board this view was consistent with the fact that the Enlarged Board had rejected relevance as a criterion for novelty and inventive step, which would also have implied a comparison with the cited prior art documents. The board explained that the term "invention" did not necessarily imply the presence of novelty and inventive step, as was apparent from the wording of Art. 52, 54 and 56 EPC 1973. The board concluded that there was no need to take into account the prior art documents, but that the assessment of whether the exception for mere limitations applied in a particular case should depend only on the **technical relationship** of the added feature to the content of the application as originally filed, as understood by a skilled reader. At the least, a feature went beyond providing a mere limitation not involving a technical contribution to the invention if it interacted with the way in which the other features of the claim solved the technical problem, as it was understood from the application as originally filed.

In case **T 64/96**, a patent relating to a cover for automobile sun visor mirrors comprising rectangular plates overlapping and connected together in chain-like succession was revoked by the opposition division. The third auxiliary request of claim 1 was amended in that it was included as an additional feature that lugs were "integrally formed in said plates". The board came to the conclusion that applying the criterion, as set out in **G 1/93** (OJ 1994, 541) and **T 384/91** (OJ 1995, 745), to the case at issue, it could be seen that the feature in question did indeed make a technical contribution to the subject-matter of

the claim since forming the lugs integrally with the plates led to a simpler and cheaper construction of cover which, at least by implication, was the technical problem which the invention set out to solve.

In **T 518/99** the board held that the technical significance of a feature in a claim was not governed by its relevance for the assessment of novelty and inventive step vis-à-vis the available prior art, as had been argued by the appellant, but by its **contribution to the technical definition** of the claimed subject-matter, to be assessed by the skilled person in the light of the original disclosure. Otherwise, the decision about the technical significance of a feature would be subject to different interpretations dependent on the respectively available prior art. The board also rejected the appellant's argument that the disputed feature was technically meaningless because it was unrelated to the essence of the claimed invention. In this context the board referred to **G 2/98** (OJ 2001, 413) where the Enlarged Board had found it problematic to try to distinguish between technical features which were related to the function and effect of an invention and technical features which were not, because there were no clear and objective criteria for making such a distinction, which could thus give rise to arbitrariness.

In **T 1779/09** the board considered that a limiting feature which generally would not be allowable under Art. 123(2) EPC could, under certain conditions, nevertheless be maintained in the claim of an opposed patent in the particular situation addressed in decision **G 1/93**. It then complied with Art. 123(2) EPC by way of a legal fiction. In the case at issue, the term "only" was introduced during the examination proceedings and successfully objected to under Art. 100(c) EPC in proceedings before the opposition division by the former respondent. Since the board considered the term to be truly limiting, its deletion would extend the protection conferred and thereby infringe Art. 123(3) EPC. However, the board held that the exclusive limitation did not influence the solution of the technical problem as understood from the application as originally filed, and hence provided no technical contribution to the claimed invention (see also **T 384/91**). It merely excluded protection of part of the invention described in the application, thus not giving any unwarranted advantage to the applicant.

In **T 592/99** the board observed that in the case of a product claim concerning a composition defined by its components and their relative amounts given in terms of ranges, it could not be accepted that such ranges, which constituted essential features, did not provide a technical contribution to the subject-matter of the claimed invention, as suggested by the appellant. Any amendment to the ranges had to have the effect of modifying the claimed subject-matter, and thus also provided a technical contribution. If the newly claimed limited range were allowed even though unsupported, any subsequent selection invention based on the new range would have to be refused as not novel, which would otherwise not necessarily be the case. To allow this would, of course, give an unwarranted advantage to the patentee, contrary to the purpose of Art. 123(2) EPC 1973. In the board's view, that was exactly what was meant in the "typical example" given in point 16 of **G 1/93**, "where the limiting feature is creating an inventive selection not disclosed in the application as filed or otherwise derivable therefrom". Therefore the new feature constituted added subject-matter.

The invention in **T 2230/08** concerned a method of regenerating a catalyst/absorber. The undisclosed modification contained in claim 1 as granted and still present in claim 1 of the auxiliary request would be prejudicial to third parties relying on the invention as described in the application as originally filed, as that undisclosed modification which was technically sensible might possibly be the basis for a valuable invention. Claim 1 of the auxiliary request was not restricted to any specific method which would deprive the definition of the temperature of the regenerating gas of all technical contribution within the context of that claim. In the absence of any additional disclosed restricting feature to that effect, the temperature of the incoming regenerating gas was therefore considered to interact with the remaining features of the claim in such terms that it influenced the solution of the technical problem which could be understood from the application as originally filed. It followed that the condition that missing technical contribution be provided, set out in decision **G 1/93** (OJ 1994, 541), was not met in the case at issue.

In **T 287/14** the board held that the disclaimer "wherein the composition does not contain a beta-nucleating agent" added to the claim was a feature providing a technical contribution to the claimed subject-matter. The disclaimer, by modifying the technical characteristics of the matrix phase of the polyolefin composition of claim 1, gave the appellant an unwarranted advantage by restricting the claimed subject-matter to a group of polyolefin compositions having specific technical characteristics and properties.

For further cases which did not fall under the exception of **G 1/93**, Headnote 2, because the added feature provided a technical contribution to the claimed invention, see e.g. **T 913/15**, **T 958/15**, **T 312/16**.

3.2.5 Resolving the conflict in cases of clerical errors or incompatibility between the claims as granted and the description

Decision **T 438/98**, which concerned the correction of an obvious clerical error, followed **T 271/84** (OJ 1987, 405), **T 371/88** (OJ 1992, 157), **T 673/89** and **T 214/91**, in ruling that amending a claim to remove an inconsistency did not contravene Art. 123(2) or Art. 123(3) EPC 1973 if the claim as corrected had the same meaning as the correct interpretation of the uncorrected claim in the light of the description.

However, in **T 1018/02** the board held that the description could not be used to give a different meaning to a claim feature which in itself imparted a clear, credible technical teaching to the skilled reader. The feature would thus have had to be deleted to achieve consistency with the original disclosure (Art. 123(2) EPC). But this would have contravened Art. 123(3) EPC and therefore the patent was revoked. See also **T 1202/07**.

In **T 195/09**, on the conflict between Art. 123(2) and Art. 123(3) EPC, the appellant referred to **T 108/91** in which it had been decided that an inaccurate technical statement in a granted claim, which statement was evidently inconsistent with the totality of the disclosure of the patent and would contravene the requirements of Art. 123(2) EPC, could be replaced with an accurate statement of the technical features involved without infringing Art. 123(3) EPC. The board in **T 195/09** pointed out that this decision had been clearly overruled by **G 1/93** (see also **T 1746/10**, **T 1896/11**).

In **T 131/15** the interpretation of the expression "opposite direction" in claim 1 as granted in a precise geometrical sense would have excluded all of the described embodiments from protection and would have resulted in amended claim 1 of the sole request contravening Art. 123(3) EPC. However, in the light of the principles set out in **G 2/88** (OJ 1990, 93) with reference to Art. 69(1) EPC 1973 and its Protocol, the board came to the following conclusion: Where an expression in a granted claim, taken literally and in isolation, would have the effect of excluding all of the disclosed embodiments from the scope of protection, but where a definition of the expression may be derived from the patent itself which would locate (at least some of) the disclosed embodiments within the ambit of the claim, and provided this definition was not manifestly unreasonable, having regard to the normal meaning of the words used in the expression, then in judging compliance with the requirements of Art. 123(3) EPC, the scope of protection should normally be considered to include at least that which would fall within the terms of the claim understood according to this definition. Since the description provided a basis for interpreting the expression "opposite direction" less restrictively, the board considered that Art. 123(3) EPC was not infringed by reinstating in claim 1 of the sole request an originally disclosed part of the feature concerned, which had been omitted in the granted claim.

In **T 1127/16**, contrary to the appellant's (patent proprietor's) view, the board held that **T 131/15** concerned a situation entirely different from the case in hand. The board observed that, irrespective of the fact that such a comprehensive and intricate test as suggested in **T 131/15** could arguably place an undue burden on third parties when trying to establish the "true" (i.e. intended) scope of protection conferred by a granted patent, in **T 131/15** the issue was that if the expression in question was read literally, there would be no compatibility at all between the description and the claim as granted. This was not comparable to the case in hand because the feature at issue, as interpreted by the board – although undisclosed – provided a clear and credible technical teaching compatible with both, the claim as granted and the described embodiment, which was therefore not entirely excluded from the scope of protection. Consequently, claim 1 of the 2nd auxiliary request did not comply with Art. 123(3) EPC, which led to an inescapable trap.

For case law on bringing the description into line with amended claims, see chapter II.A.5.3.

4. Correction of errors in the description, claims and drawings – Rule 139 EPC

According to R. 139 EPC, linguistic errors, errors of transcription and mistakes in any document filed with the EPO may be corrected on request; however, if the request for such correction concerns the description, claims or drawings, the correction must be obvious in the sense that it is immediately evident that nothing else would have been intended than what is offered as the correction. This wording does not differ in substance from the former R. 88 EPC 1973; only some editorial changes have been made in the three languages. Hence, the jurisprudence with regard to R. 88 EPC 1973 is applicable to R. 139 EPC (**T 1460/10**).

Relevant for the present chapter on amendments is R. 139, **second sentence**, EPC, which concerns corrections to the parts of a European patent application or of a European patent relating to the disclosure (the description, claims and drawings).

Other aspects related to corrections can be found under chapters II.F.4.3. "Correction of errors in a divisional application"; IV.A.5.2.2 "Correction of designation of applicant (Rule 139 EPC)"; IV.A.5.5. "Corrections under Rule 139 EPC"; IV.A.7.3. "Correction of designation of states (Rule 139 EPC)"; IV.B.3.8.3 "Correction of the withdrawal of the application". As to the corrections under the **first sentence** of R. 139 EPC, the boards, in particular the Legal Board, have developed a large body of case law on corrections, namely that the correction must introduce what was originally intended; where the original intention is not immediately apparent, the requester bears the burden of proof, which must be a heavy one; the error to be remedied may be an incorrect statement or an omission; and the request for correction must be filed without delay (see **G 1/12**, point 37 of the Reasons).

4.1. Relationship of Rule 139 EPC with Article 123(2) and (3) EPC

In opinion **G 3/89** (OJ 1993, 117) and decision **G 11/91** (OJ 1993, 125) the Enlarged Board held that corrections under R. 88, second sentence, EPC 1973 (now R. 139, second sentence, EPC) were special cases of an amendment within the meaning of Art. 123 EPC and fell under the prohibition of extension laid down in Art. 123(2) EPC.

The parts of a European application or patent relating to the disclosure (description, claims and drawings) can be corrected only within the limits of what the skilled person would derive directly and unambiguously, using common knowledge and seen objectively and relative to the date of filing, from the whole of these documents as originally filed (recently supported e.g. in **T 232/23**). Such a correction was **of a strictly declaratory nature** and thus did not infringe the prohibition of extension under Art. 123(2) EPC 1973.

For case law on these issues prior to **G 3/89** and **G 11/91**, see the summary of facts and submissions of those decisions, and CLB, 7th edn. 2013, II.E.4.1. For a summary of the findings in **G 3/89** and **G 11/91**, see also **G 2/95** (OJ 1996, 555, point 2 of the Reasons).

In **T 1946/16** the board recalled that a correction under R. 139, second sentence, EPC was a special case of an amendment within the meaning of Art. 123 EPC and that the requested correction would have to meet the requirements of Art. 123(3) EPC. The board in **T 2058/18** likewise noted that Art. 123(2) EPC applied to all amendments to the patent application or the patent; these included corrections of the description, claims or drawings under R. 139, second sentence, EPC. In the same vein, see also **T 2461/17**, **T 1435/20** and **T 1515/20**.

4.2. Obviousness of the error and the correction

In order for a correction in the description, the claims or the drawings to be allowable under R. 139, second sentence, EPC, the boards apply a two-step approach. It must be established (i) that it is obvious that an error is in fact present in the document filed with

the EPO, the incorrect information having to be objectively recognisable by the skilled person using common general knowledge (**G 3/89**, OJ 1993, 117 and **G 11/91**, OJ 1993, 125, point 5 of the Reasons), and (ii) that the correction of the error is obvious in the sense that it is immediately evident that nothing else would have been intended than what is offered as the correction (**G 3/89** and **G 11/91**, point 6 of the Reasons). For recent decisions applying this two step approach, see e.g. **T 923/13**, **T 1626/16**, **T 2058/18**, **T 953/22**, **T 1435/20** and **T 1515/20**.

Since the prohibition of extension under Art. 123(2) EPC also applies to a correction under R. 139, second sentence, EPC (**G 3/89** and **G 11/91**, point 1.4 of the Reasons), the parts of a European patent application or of a European patent relating to the disclosure (the description, claims and drawings) may be corrected under R. 139, second sentence, EPC only within the limits of what a skilled person would derive directly and unambiguously, using common general knowledge and seen objectively and relative to the date of filing, from the whole of these documents as filed (**G 3/89** and **G 11/91**, point 3 of the Reasons).

4.2.1 Documents to be taken into account for the assessment of obvious error and correction

Before a correction can be made under R. 139, second sentence, EPC it has to be established what a skilled person would derive, on the date of filing, from the parts of the European patent application relating to the disclosure. As a result of the prohibition of extension under Art. 123(2) EPC, documents other than the description, claims and drawings may only be used insofar as they are used for proving the common general knowledge on the date of filing. On the other hand, documents even if they were filed together with the European patent application, such as priority documents and the abstract may not be used. Documents not belonging to the parts of a European patent application relating to the disclosure could, under certain circumstances, be included partially or wholly in the disclosure by means of reference. Evidence of what constituted common general knowledge on that date could be furnished in any suitable form (**G 3/89** and **G 11/91**).

In **T 1008/99** the board held that, for the purposes of R. 88 EPC 1973, the error had to be **apparent from the divisional application itself**, and the parent application could not be used to demonstrate that the error was obvious. Even if it was apparent from the filed description, claims and drawings that they did not belong together, it was not immediately clear from the divisional application itself which of these parts was incorrect.

In **T 2058/18** the board held that the disclosure of a family member of a document cited in an application could not be used to dispel doubts as to the meaning of an ambiguous part of the application.

The board observed that, in **T 158/21**, the request for correction was aimed at the replacement of a document, i.e. the set of claims filed as a pdf-file, by another set of claims filed as a zip-file. The board noted that the set of claims contained in the zip-file was submitted as a "pre-conversion" file. The board held that a pre-conversion file was taken into account only to solve problems caused by the conversion of document formats.

4.2.2 Obvious error – incorrect information objectively recognisable

In **G 3/89** (OJ 1993, 117) and **G 11/91** (OJ 1993, 125) the Enlarged Board specified that, for a correction under R. 88, second sentence, EPC 1973 to be allowed, the respective part of the European patent application or patent had to contain such an obvious error that a skilled person was in no doubt that the information was not correct and could not be meant to read as such. The skilled person must be in a position objectively and unambiguously to recognise the incorrect information using common general knowledge. If, on the other hand, it was **doubtful** whether any information at all was incorrect, then a correction was ruled out. The same applies if incorrect information only becomes apparent in the light of the proposed correction.

In **T 664/03** the board held that the feature concerned was comprehensible in its literal sense and a different interpretation did not impose itself in view of the description and/or the common general knowledge. Hence it was at least doubtful that the skilled person would come to the conclusion that the feature in question was incorrectly defined in that claim.

In **T 829/05** the board held that, even if the skilled person were aware of an inconsistency between the claim and the drawing, he would have no cause to believe that the claim was incorrect. The drawing was stated to be diagrammatic and, in the absence of any evident technical reason to suspect that the claim was incorrect, the skilled person would simply accept the inconsistency as being characteristic of a schematic drawing.

In **T 1702/12** the board held that the skilled person had no reason to doubt the value of 500 when reading granted claim 1 at face value, since this value **made technical sense**. Even when taking the description and dependent claims of the granted patent into account, the skilled person could not be sure that the value of 500 was erroneous, or whether an error occurred in the description or said dependent claims. The board rejected the argument that any relevant evidence must be taken into account. Rather, if it was necessary to study the **prosecution history** of the case in order to determine whether an error had been made and what the correction should be, then the criterion of immediacy in R. 139 EPC was not met.

Likewise in **T 2523/11** the error itself was not obvious, since the wording of claim 1 was clear and understandable, no inconsistency with regard to the description existed, the range fell within the range as originally disclosed and it made perfect technical sense. Hence, the skilled person would not have any reason to doubt that it was anything but the limited range which was intended to be pursued.

For further examples of cases in which it was considered doubtful that the skilled person would have thought that the feature concerned was incorrectly defined, see **T 2230/08**, **T 1946/16** and **T 1558/21**.

In **T 2058/18** the board held that features the applicant had presented as essential features distinguishing the invention from the closest prior art could not later be said to be obvious errors.

4.2.3 Obvious correction – immediately evident that nothing else would have been intended than what is offered as the correction

In **G 3/89** and **G 11/91** the Enlarged Board held that the parts of a European patent application as filed which relate to the disclosure must further allow a skilled person – using the common general knowledge on the date of filing – directly and unequivocally to ascertain the precise content of the information the person making the request actually meant to give, instead of the incorrect particulars, on the date of filing or when making an amendment under Art. 123 EPC, so that, for said skilled person, "it is immediately evident that nothing else would have been intended than what is offered as the correction" (R. 139, second sentence, EPC). However, if there is any doubt that nothing else would have been intended than what is offered as the correction, a correction cannot be made.

a) Decisions where it was not immediately evident that nothing else would have been intended than what was offered as the correction

In **J 5/06** the Legal Board, referring to **T 158/89** (which had not accepted correction in case of two equally plausible alternatives for a percentage range of a component), held that establishing that a suggested set of documents was a probable and suitable replacement did not amount to establishing that nothing else would have been intended. This latter threshold implied that there was only one **single plausible** replacement – the one which the skilled person would have deduced from those parts of the application which made up the disclosure of the invention. For the case in hand the Legal Board concluded that, to the contrary, a complete exchange of the application documents would quite obviously open the door to a plethora of plausible replacements. See also **J 16/13**, also relating to replacement of application documents; **T 15/09** and **T 846/16**, both relating to correction of a feature in the claims at issue.

In **T 955/92** the reasons given by the appellant to show that only the requested correction could have been intended were not based on the level of general knowledge on the date of filing. In order to arrive at the conclusion that the requested correction was the only physically meaningful one, **experiments** had had to be performed which needed more than common general knowledge, and the results thereof would not have been available on the date of filing. The request for correction was therefore refused.

In **T 438/99** the board held that the fact that a term or phrase could not be interpreted or construed because it was unresolvably ambiguous did not necessarily mean that its deletion was a permissible amendment under Art. 123(2) EPC 1973. There remained a residual clear meaning in the ambiguous term, e.g., as in this case, that a specific direction was taught, and suppressing that fact resulted in a different technical teaching. Therefore, the second condition of R. 88 EPC 1973 (immediately evident that nothing else would have been intended than what is offered as the correction) was not met by the offered correction of deleting the feature without replacement.

T 1728/07 concerns the correction of an error in a structural formula representing oxazoline derivatives. The board recalled that according to R. 139, second sentence, EPC it must be immediately apparent to the skilled person that (i) an error has occurred and (ii)

how it should be corrected. With respect to requirement (ii), it must be decided whether the corrected feature is directly and unambiguously derivable from the content of the application as originally filed taken as a whole. This requirement was found by the board to be fulfilled.

In **T 1508/08**, the board concluded that the second condition for allowability of a correction under R. 139 EPC was not met. In its view, not only did the correction fail to solve the existing problems of a lack of clarity, but it actually made things **even less clear**. That was one reason why the skilled person would not have contemplated the correction made by the appellant proprietor. Even if it were assumed in the appellant's favour that the skilled person would have contemplated this correction, it was not the only one possible, but rather one of at least three conceivable corrections.

In **T 455/09** the board held that in the case at issue the skilled person could not exclude one of two options with certainty, so that it was not directly and unambiguously evident that nothing else could have been intended other than the proposed correction. For another case where other corrections were equally possible, see **T 923/13**.

In **T 141/14** the board held that the amendment of the feature "vanadium" to "vanadium oxide" did not meet the requirements of R. 139 EPC because the proposed correction was only **one of several options** which would occur to the skilled person. As long as there was at least one further possibility of correction, the criterion within R. 139 EPC that "the correction must be obvious in the sense that nothing else would have been intended than what is offered as the correction" was not fulfilled.

In **T 244/19** the appellant (patent proprietor) had argued that it was obviously an error that original claim 6 referred back to just one of the two independent product claims. The board, however, did not consider it immediately evident that nothing other than a reference to both could have been intended.

b) Decisions where it was immediately evident that nothing else would have been intended than what was offered as the correction

In **T 2303/10** the board held that it would be obvious to the skilled person that the first of the two alternative corrections mentioned by the examining division was totally incompatible with what was disclosed in the application as originally filed, whereas the second was technically feasible and entirely consistent with the disclosure and therefore allowable.

T 163/13 concerned the correction of "72EF" to "72°F". The board held that the only possible correction having a technical meaning in the present context was the temperature, as it was an essential parameter for the test in question. Consequently, the skilled person would immediately consider that "F" meant "Fahrenheit" and make the correction accordingly.

In **T 657/11** the board held that the requested correction was obvious. It could not accept the argument of the respondent that the correction was not obvious because the wrong

wording of the claim was also to be found in one passage of the description as filed. In fact, apart from this one passage, the rest of the description, the working examples and the figures were in line with the perceived correction. The board also excluded another possible correction because, although theoretically and technically possible, the skilled person would immediately reject it.

For more examples where the error and the correction were obvious to the skilled person, see **T 1436/19** and **T 1597/22**.

4.3. No replacement of the description under Rule 139 EPC

Decision **G 2/95** (OJ 1996, 555) decided that the complete documents forming a European patent application could not be replaced under R. 88 EPC 1973 (R. 139 EPC). The interpretation of R. 88 EPC 1973 (R. 139 EPC) had to be in accord with Art. 123(2) EPC 1973. See **G 3/89** (OJ 1993, 117) and **G 11/91** (OJ 1993, 125). See also IV.A.5.5.2.

In **J 5/06** and **J 16/13** the Legal Board held that this equally applied to the exchange of a description. This followed from the principle that the filing date is inseparable from the description, since it is obvious that allowing an exchange of "only" the description by way of correction would directly result in the separation of the filing date from the description.

In **J 3/21**, the Legal Board observed that the ban on the replacement of the description by way of correction, established in **G 2/95** on the basis of Art. 123(2) EPC and further developed in e.g. **J 5/06** and **J 16/13**, was categorical and followed from the principle reflected in R. 40(1)(c) EPC that the accorded filing date is inseparable from the description as originally filed. An exchange of the description by way of correction would directly result in the separation of the filing date from the description in contravention of Art. 123(2) EPC.

According to **T 1963/17**, the reason for this is simply that in light of the infinite possibilities of drafting a description, it is not obvious to a skilled person how an amended description should look like. The board observed that in the case in hand, in which the originally filed description did not match the claims and applicant requested to substitute the originally filed description, it may not even have been obvious to a skilled person which invention the applicant intended to pursue. Moreover, the board agreed with **J 27/10** that an interpretation of R. 56 EPC that some, or all, of the description that was originally filed in order to obtain a filing date could be amended, replaced or deleted is incorrect. See also chapter IV.A.5.4.2.

4.4. Request for correction to be filed without delay

In **T 2058/18** the board noted that a request for correction must be filed without delay (**G 1/12**, OJ 2014, A114, point 37 of the Reasons). The appellant's (applicant's) representative pointed out that he was not an expert in the field of the invention and that it was only when consulting an expert that could qualify as a skilled person in this case, that the representative was made aware that there was a mistake in the description and claims

as originally filed. He had reacted during examination proceedings as soon as he was made aware of the mistake. However, the board observed that the applicant had previously based its arguments on the erroneous features as essential distinguishing features of the invention over the closest prior art. The board underlined that it was the responsibility of the appellant to cooperate in the drafting and filing of amendments and to give clear instructions to the representative. Thus the correction could not be considered as having been filed without delay.

4.5. Correction of errors in the description, claims and drawings after grant, and in opposition proceedings

In **J 42/92** the Legal Board had to decide whether a request under R. 88, second sentence, EPC 1973 could be made after grant. It came to the conclusion that a request under R. 88 EPC 1973 for amendments to the description or claims could only be filed **during the pendency of application or opposition proceedings**. Under Art. 97(4) EPC 1973, the decision to grant a European patent took effect on the date on which the European Patent Bulletin mentioned the grant. After this date, R. 88 EPC 1973 could only be applied while opposition proceedings were pending. In the case at issue, the decision to grant the patent had already taken effect, and no opposition had been filed. The appeal was therefore dismissed, since the EPO had ceased to have jurisdiction to consider a request under R. 88 EPC 1973 at the time when the request was filed (see also **J 23/03**, **T 493/08** and **T 423/21**).

Note that **G 1/10** (OJ 2013, 194) deals with the different fields of application of various provisions as compared with R. 140 EPC (formerly R. 89 EPC 1973), in particular R. 139 EPC (points 9 and 11 of the Reasons) and Art. 123 EPC (see point 13 of the Reasons).

In **T 657/11** the board observed that according to **G 1/10** R. 140 EPC was not available to correct the text of a granted patent and a request for such a correction was inadmissible whenever made, including after the initiation of opposition proceedings (likewise **T 2051/10**, **T 164/14**, **T 1578/13**). However, in the case at issue, the amendments went beyond the mere removal of an error; namely by limiting the claims to those granted as (process) claims 6-11. Hence the basis for the decision on the appeal (and, thereby, on the opposition) was no longer that for the **decision to grant** the patent in suit, which decision would **definitely lose its effect** and be replaced by a new decision. In such a situation any (further) amendment of the claims, even if it aimed at the removal of an obvious mistake in the claims as granted, did not constitute a correction of an error or a mistake in a decision of the EPO within the meaning of R. 140 EPC. The board held that in opposition proceedings mistakes or errors concerning the claims, the description or the drawings of the patent as granted could be removed either by an amendment occasioned by a ground of opposition under Art. 100 EPC (see R. 80 EPC) or, insofar as the mistakes or errors concerned texts or drawings which remained unamended, by way of a correction pursuant to R. 139 EPC (which applied independently of R. 80 EPC; see also **T 556/13** and **T 1966/17**). See also **T 164/14** and **T 1578/13**, in which, however, the boards ultimately did not decide whether corrections could be made under R. 139 EPC in the

conditions set out in **T 657/11**, because, in any event, the mistakes at issue in those cases were not obvious.

In **T 1111/19**, the board concluded that, in line with the reasoning in **T 657/11**, the provisions and specific requirements of R. 139 and 80 EPC were to be applied independently. The mere correction of errors in the claims according to the main request did not meet the requirement under R. 80 EPC since it was not aimed at overcoming a ground for opposition under Art. 100 EPC.

5. Evidence and standard of proof for allowing amendments and corrections

In accordance with the established case law of the boards of appeal, in the case of a proposed amendment under Art. 123(2) EPC or of a correction under R. 139 EPC, the factual disclosure of a European patent application as originally filed has to be established to a rigorous standard, namely the standard of certainty "beyond reasonable doubt". In **T 1248/08** the board recalled this case law, in particular as established in **T 113/86**, **T 383/88**, **T 581/91**, **T 723/02** and **T 1239/03**; for further recent decisions confirming this standard, see e.g. **T 831/11**, **T 1710/13**, **T 2418/13**, **T 1224/14**, **T 19/20**, **J 3/21**, **T 1435/20** and **T 1515/20**. In particular, the board observed in **T 768/20** that the very requirement of an unambiguous disclosure under the "gold standard" indicated that a strict standard had to be applied and that the actual existence of a disclosure was not a matter of probabilities.

According to **T 307/05** and **T 370/10**, the same standard of "beyond reasonable doubt" applies when assessing the allowability of amendments under Art. 123(3) EPC. For further decisions confirming this standard, see e.g. **T 2275/17**.

The burden of proof that amendments comply with Art. 123(2) EPC rests with the party making the amendment (**T 910/06** with reference to **T 1239/03**; see also **T 222/05** and **T 1497/08**). See **T 2275/17** in the context of Art. 123(3) EPC.

In **T 383/88** the board held that the normal standard of proof in proceedings before the boards, namely "the balance of probability", was inappropriate for determining the allowability of an amendment under Art. 123(2) EPC 1973. Instead, a rigorous standard, i.e. one equivalent to "beyond reasonable doubt" was considered by the board to be the right one to apply in such a case, since applying a lower standard could easily lead to undetected abuse by allowing amendments on the basis of ostensibly proven common general knowledge. **T 383/88** also considered that the issue of the allowability of an amendment under Art. 123(2) EPC 1973 had to be decided by reference to what could be derived from the patent application as filed in the light of common general knowledge and not vice versa. Moreover, it was notoriously difficult to prove common general knowledge. For example, information might be generally disseminated, and therefore known within the community of skilled addressees, but it might well, at the same time, not be commonly accepted.

The board in **T 307/05** stated that, as indicated in the decision **T 64/03**, it was established case law that a **very rigorous standard**, namely that of "beyond reasonable doubt", was to be applied when checking the allowability of amendments under Art. 123(2)

and 123(3) EPC. A similar rigorous standard was also expressed in the decision **T 581/91** relied on by the board in its communication by reference to the decision **T 113/86**, in which it was stated that the **slightest doubt** that the unamended patent could be construed differently to the patent as amended would preclude the allowability of the amendment (see also **T 370/10**, **T 2285/09**, **T 2418/13**).

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1. Introduction

A divisional application is a new application which is separate and independent from the earlier application. Therefore, divisional applications are to be treated in the same manner as ordinary applications and are subject to the same requirements, unless specific provisions of the EPC require something different (see **G 1/05**, OJ 2008, 271). The most important provisions on European divisional applications are Art. 76 EPC and R. 36 EPC (R. 25 EPC 1973).

According to Art. 76(1), second sentence, EPC, the divisional application may be filed only in respect of subject-matter which does not extend beyond the content of the earlier application as filed. The divisional application is accorded the same filing date as the parent (earlier) application and benefits from any right of priority of the parent (earlier) application in respect of the subject-matter contained in the divisional application. When determining whether the subject-matter of a divisional application extends beyond the

content of the earlier application as filed (Art. 76(1), second sentence, EPC) exactly the same principles are to be applied as for extension of subject-matter under Art. 123(2) EPC (**G 1/05**; see in this chapter II.F.2.1.).

Divisional applications may be amended like any other application. If a divisional application is amended, it must meet the requirements of both Art. 76(1) EPC and Art. 123(2) EPC, so as to preclude the introduction of new subject-matter into the proceedings (see in this chapter II.F.2.2.).

A divisional application (of whatever generation) can be the "earlier application" within the meaning of Art. 76(1) EPC for a further divisional (**G 1/06**, OJ 2008, 307). According to R. 36(1) EPC the earlier application must still be pending (see in this chapter II.F.3.5.).

It is a ground of opposition and a ground of revocation if the subject-matter of a patent granted on a divisional application extends beyond the content of the earlier application as filed, see Art. 100(c), 138(1)(c) EPC.

The question whether a European divisional application may anticipate its parent ("poisonous divisional") is treated in the context of partial priority in **T 557/13** (OJ 2016, A87; referral **G 1/15**). For a summary of **G 1/15** (OJ 2017, A82), see in chapter II.D.6.3. "Multiple priorities or partial priority for one claim".

2. Subject-matter of a divisional application

2.1. Subject-matter extending beyond content of the earlier application

2.1.1 Principles

The wording of Art. 76(1) EPC and the wording of Art. 123(2) EPC is so similar (in all three languages) that it is clear that **exactly the same principles** are to be applied for both types of cases when determining what extends beyond the content of the earlier application (**G 1/05**, OJ 2008, 271). The mere fact that the wording of the French version differs (Art. 76(1), second sentence, EPC: "éléments"; Art. 123(2) EPC: "objet") does not justify a different interpretation (**T 276/97**). The case law on added subject-matter is summarised in chapter II.E.1.

Article 76(1) and Art. 123(2) EPC have the **same purpose**, i.e. to create a fair balance between the interests of applicants and patentees, on the one hand, and competitors and other third parties on the other. The idea underlying these provisions is that an applicant should not be allowed to improve their position by adding subject-matter not disclosed in the application as filed, which would give them an unwarranted advantage and could be damaging to the legal security of third parties relying on the content of the original application (**G 1/93**, OJ 1994, 541; **T 873/94**, OJ 1997, 456; **T 276/97**, **T 701/97**). Both Art. 76(1) EPC 1973 and Art. 123(2) EPC 1973 enshrine the principle that before grant the legal security of third parties is sufficiently protected by the prohibition of extending the content of the application by amendment beyond what was originally disclosed (**T 1387/05**). Since the underlying requirements of Art. 123(2) and 76(1) EPC are the

same, there is no harm done if the examining division incorrectly refers to Art. 123(2) EPC (instead of Art. 76(1) EPC) when refusing a divisional application on the grounds that its subject-matter extended beyond the parent application (**T 542/94**).

2.1.2 Directly and unambiguously derivable from content of earlier application as filed

The subject-matter of a divisional application must be **directly and unambiguously derivable** from the earlier application as filed (see **G 1/06**, OJ 2008, 307). More specifically, subject-matter of the divisional must be directly and unambiguously derivable by the skilled person from the disclosure of the earlier application as filed, as determined by the totality of its claims, description and figures when read in context (see consolidated cases **T 1500/07**, **T 1501/07**, **T 1502/07**; see also **T 961/09**).

Subject-matter claimed in the divisional application has to be compared with the content of the earlier (parent) application as filed, whereby the content of an application comprises the whole disclosure, express or implied, that is directly and unambiguously derivable from the application including information which is implicit and immediately and unambiguously apparent to a person skilled in the art reading the application (**T 423/03**). In other words, it has to be established whether technical information has been introduced into the divisional application which a skilled person would not have objectively and unambiguously derived from the earlier application as filed (**T 402/00**).

The "content" within the meaning of Art. 76 EPC is to be interpreted as the **whole technical content** of the earlier application (**G 1/05**, OJ 2008, 271, point 9.2 of the Reasons). Art. 76 EPC does not require that the content be disclosed in the claims of the earlier application. It only requires that the subject-matter be disclosed as such anywhere in the whole disclosure of the earlier application (**T 211/95**, **T 1026/03**, **T 314/06**).

In **T 1134/19** the board referred to **G 1/05** and recalled that the "gold standard" had to be applied by analogy when assessing compliance with Art. 76(1) EPC, second sentence. The "essentiality test" (see chapter II.E.1.4.4) could not replace the "gold standard", which ultimately meant that the "gold standard" requirements always had to be met.

The case law on the question of when subject-matter is directly and unambiguously derivable (including decisions applying Art. 76 EPC) is summarised in chapter II.E.1.

2.1.3 Sequence of divisionals – derivable from each of the preceding applications as filed

In **G 1/06** (OJ 2008, 307) the Enlarged Board ruled that Art. 76 EPC 1973 also applied to divisionals from divisionals, because – if not specifically provided otherwise – divisionals must be treated just like any other application. Therefore, a divisional (of whatever generation) could be the "earlier application" within the meaning of Art. 76(1) EPC 1973 for a further divisional. In the case of a sequence of applications consisting of a root (originating) application followed by divisional applications, each divided from its predecessor, it was a necessary and sufficient condition for a divisional application of that sequence to comply with Art. 76(1), second sentence, EPC 1973 that anything disclosed

in that divisional application be directly and unambiguously derivable from what is disclosed in **each of the preceding applications as filed** (see **G 1/06**).

The subject-matter has to be still present (i.e. it was not unequivocally and definitively abandoned by that time, see **J 2/01**, OJ 2005, 88; **J 15/85**, OJ 1986, 395) in each earlier predecessor application at the time the – further – divisional application was filed so that it was thereby existing at all times throughout after its disclosure in the root application as filed up to and including the date of filing the divisional application under consideration. Content which had been omitted on filing a member higher up the sequence could not be re-introduced into that member or in divisional applications lower down the sequence from it. Conversely, content which has been added on filing of a divisional application a sequence higher up could not be claimed in a divisional application down the sequence because according to Art. 76(1) EPC such added matter did not benefit from the filing date of the root application in which it was not disclosed (see **G 1/06**).

In **T 2175/09** the appellant argued that an infringement of Art. 76(1) EPC 1973 in the case of an intermediate higher-generation divisional application (here the grandparent application) did not constitute a ground for opposition under Art. 100(c) EPC 1973. The board held that Art. 100(c) EPC 1973 gave the public the possibility of opposing a patent on the ground that its subject-matter extended beyond the content of the earlier application as filed if an infringement of Art. 76(1) EPC 1973 had been overlooked in examination proceedings. This also applied in the particular case of an infringement of Art. 76(1) EPC 1973 in an intermediate higher-generation divisional application. The grandparent application too is "the earlier application" within the meaning of Art. 100(c) EPC.

2.1.4 Language issues

In **T 1076/12** the board held that it was the text of the application as originally filed, even if the text was not in an official language of the EPO, that had to be used, together with any other non-text portions of the application as filed, in order to determine the "content of the earlier application as filed" as referred to in Art. 76(1) EPC.

In **T 1312/19** this led to an "inescapable trap", as the amendments necessary to overcome an objection under Art. 76(1) EPC extended beyond the content of the divisional application as originally filed. Indeed, a term used in claim 1 of the patent as granted on the divisional application was broader than the term used in the earlier application as originally filed in Italian. Claim 1 of the seventh auxiliary request filed in appeal replaced this term by a term which the opposition division had accepted as a correction under Art. 14(2) EPC. The board, however, pointed out that, since the appellant had chosen to file the divisional application directly in English, there was no application filed in "any other language" and Art. 14(2), second sentence, EPC therefore did not apply.

See also chapter II.E.1.2.3.

2.2. Amendments to divisional applications

Divisional applications are new applications which are separate and independent from the earlier applications. Amendments to a divisional application are thus allowed under Art. 123(2) EPC to the **same extent as amendments of any other non-divisional application** (**G 1/05**, OJ 2008, 271).

Amendments may be allowed even if the divisional application as filed contains – contrary to Art. 76(1), second sentence, first half sentence, EPC – subject-matter extending beyond the earlier application as filed. Such a divisional application is **not** to be considered **"invalid"** (**G 1/05**, OJ 2008, 271). It may still be amended during examination proceedings so that it complies with the requirements of Art. 76(1) EPC, provided always, however, that the amendment complies with the other requirements of the EPC (see **G 1/05**, OJ 2008, 271). Even if the **earlier application is no longer pending**, it remains possible to amend a divisional application to bring it in line with the requirements of Art. 76(1) EPC (**G 1/05**, OJ 2008, 271).

If a divisional application is amended, it must meet **both the requirements of Art. 76(1) EPC and those of Art. 123(2) EPC**, so as to preclude the introduction of new subject-matter into the examination proceedings (see, among many others, **G 1/05**, OJ 2008, 271; **T 284/85**; **T 441/92**; **T 873/94**, OJ 1997, 456; **T 1221/97**; **T 1008/99**; **T 561/00**; **T 402/00**; **T 423/03**).

In **T 2327/18** the board rejected the argument made by the respondent (patent proprietor) that, in accordance with **G 1/05** and **G 1/06** (OJ 2008, 271 and 307), bringing the application into line with the requirements of Art. 76(1) EPC had to be given priority over compliance with Art. 123(2) EPC. What those decisions had in fact made clear was that Art. 123(2) EPC was equally applicable to amendments to a divisional application as to amendments to any other application. In the case at issue, this meant that deleting a disclaimer which was not in the parent application as originally filed but was in the divisional application as originally filed was not allowable (because it was incompatible with Art. 123(2) EPC; see chapter II.E.1.).

2.3. Subject-matter of a patent granted on a divisional application

2.3.1 Findings of G 1/05 and G 1/06 also applicable to granted patents

The findings of the Enlarged Board in **G 1/05** (OJ 2008, 271) and **G 1/06** (OJ 2008, 307), although made in regard to patent applications, are also valid for granted patents. This can be derived from the fact that the Enlarged Board of Appeal relied on a direct correspondence between Art. 76(1) and 123(2) EPC, both articles enshrining the same principles, and that Art. 123(2) EPC applied to both patent applications and patents (**T 265/05**). Thus, in order to meet the requirements of Art. 100(c) EPC 1973, it was a necessary and sufficient condition that anything disclosed in the granted patent had to be directly and unambiguously derivable not only from the application on which the patent had been granted, but also from what was disclosed in each of the preceding applications as filed (**T 687/05**, **T 549/09**, **T 2175/09**, **T 1283/12**).

2.3.2 Two distinct grounds for opposition under Article 100(c) EPC

In **T 475/02** the board had to decide whether the patent fulfilled the requirements of Art. 100(c) EPC. Since the opposed patent was granted on a divisional application, for the subject-matter of any claim as granted to be allowable, it had to pass both of the **two tests** of this provision: (i) the subject-matter must not extend beyond the content of the divisional application as filed; and, (ii) it must not extend beyond the content of the earlier application as filed. Whether the first test was passed depended only on the particular claim and on the content of the divisional application as filed. That the subject-matter of a claim passed the second test did not necessarily mean that it passed the first, and vice versa. The two tests needed separate consideration, in particular where the divisional application as filed did not include the complete text (both description and claims) of the parent application.

In **T 806/03** the opposition division had applied the first test of Art. 100(c) EPC to "the application as originally filed, which is the parent application" and decided that Art. 123(2) EPC had not been complied with. The board held that the reference to the wrong provision made no difference with regard to the substance of the opposition division's decision, since the descriptions of the parent application and of the divisional application as filed were identical.

In **T 2233/09** the board held that Art. 100(c) EPC contained two distinct legal grounds: Art. 76(1) EPC and Art. 123(2) EPC. Since no objections with respect to Art. 76(1) EPC had been raised during the opposition proceedings, such a **new legal ground** could be introduced in the appeal proceedings only with the consent of the patent proprietor.

2.3.3 Ground raised against amended claims in opposition proceedings

In **T 1975/09** the board held that Art. 100(c) EPC – and not Art. 76(1) EPC – would have been the correct provision to cite in the decision of the opposition division when the claims of the granted patent were considered. With respect to amendments made to the claims in the course of the opposition proceedings, Art. 101(3)(a) and (b) EPC required the opposition division to form an opinion on whether or not the patent and the invention to which it related met the requirements of the Convention. Art. 76(1) EPC related to a requirement for filing a divisional application, which was not a requirement under the Convention for an (amended) patent. Therefore, the requirement of Art. 123(2) EPC, although not explicitly referring to the content of the "earlier application(s)", was the corresponding requirement of the Convention within the meaning of Art. 101(3) EPC, to be met by the patent in relation to amendments made thereto, with respect to the content of the earlier and of the divisional application(s) as filed. See however e.g. **T 2371/18**, **T 2490/18**, **T 3272/19** of 11 February 2021, which apply Art. 76(1) EPC to claims amended in opposition (appeal) proceedings.

2.4. Link between subject-matter of earlier application and divisional application

2.4.1 No abandonment of subject-matter in earlier application if divisional is filed

In **T 118/91** the respondent argued that since a divisional application was filed, the subject-matter of the divisional must be considered to have been abandoned in the parent application. The board held that there was nothing in Art. 76 EPC 1973 or any other provision of the EPC to support that contention: the content of the application as filed cannot, as a matter of logic, be reduced by the subsequent filing of a divisional application.

2.4.2 No effect on content of divisional application if earlier application was refused

In **T 441/92** the parent application was refused by a decision of the examining division (which became final after the appeal was held inadmissible) after the divisional application had been filed. The board held that the lapse of the parent application cannot have the effect of reducing the content of a previously filed divisional application.

2.4.3 Final decision on subject-matter in the parent application or a sibling application – res judicata

a) Decisions affirming "cross-procedural" res judicata effect

In **T 51/08** the appellant submitted amended claims corresponding to the second auxiliary request of the parent application which had already been refused on appeal. The board held that subject-matter on which a final decision had been taken by a board of appeal in the parent application became res judicata and could not be pursued in the divisional application (see also **T 790/10**, see however also **T 2145/11**, in which the board distinguishes its case from **T 51/08** as the claims at issue were not identical to those in the proceedings related to the parent patent).

In **T 1155/13** an objection of lack of sufficiency was raised by the appellant against the patent based on a divisional application. The board considered, however, that **T 468/09** had dealt with an insufficiency objection in relation to the patent granted on the basis of the parent application. Since decision **T 468/09** was res judicata and dealt with insufficiency of disclosure in relation to the same embodiments, and the facts were the same, the current board had no power to examine this objection again (with reference to **T 51/08**).

b) Decisions leaving open the question of "cross-procedural" res judicata effect

In **T 1643/10** the board left open the question of whether, or to what extent, decisions regarding a parent or a sibling application represent res judicata for a divisional application. For the board in **T 1666/14** too, there was ultimately no need to answer this question because the claims at issue in the examination appeal proceedings brought before it in relation to the divisional application differed from those decided on in the earlier opposition appeal proceedings concerning the parent application. It nevertheless took the view that, where decisions had been taken on a parent application in both examination appeal and

opposition appeal proceedings, only the latter decision could, if at all, have binding effect on the relation between the parent and divisional application. See also **T 2145/11**, **T 1870/16** and **T 1270/20**, in which the boards similarly held there could be no res judicata because the claims were not identical.

c) Decisions doubting "cross-procedural" res judicata effect

In **T 2084/11** the appellant (opponent) had argued that the invention's reproducibility was res judicata, a final decision having already been taken on the parent application. The board noted that the EPC did not mention res judicata, let alone regulate its applicability in the context of separate proceedings on parent and divisional applications or any resulting patents. EPO proceedings on a divisional were essentially independent of those on its parent (see **T 1254/06**). The board therefore doubted that a final decision taken in opposition appeal proceedings (here revocation of the patent) could have any "cross-procedural" res judicata effect at all on separate opposition (or opposition appeal) proceedings concerning a patent granted on a divisional. **T 167/93** had already said that res judicata, whilst a generally recognised principle, was of extremely narrow scope and would only "involve something" where (amongst other criteria) "the issues of fact are the same". But it had said nothing about any "cross-procedural" application. In the case in point, the board anyway took the view that the above criterion from **T 167/93** was clearly not fulfilled, because the subject-matter (the "something" in the sense of **T 167/93**) requiring the division's or board's decision was not the patent granted for the parent application; rather, it was the divisional-derived patent and whether the requests submitted were legally sustainable in view of the objections raised, and – in contrast to **T 51/08** – the requests (sets of claims) for decision in the two sets of proceedings were also not identical. Moreover, the underlying facts were different since further evidence had been submitted. The board's conclusion was that in the case in hand the appeal decision on the parent patent could have no res judicata effect in the opposition (or opposition appeal) proceedings as regards the reproducibility of the divisional-derived patent in suit.

The principle of a "cross-procedural" res judicata effect was also doubted in **T 1266/19** (citing **T 2084/11** and **T 1666/14**).

2.4.4 Re-filing of same subject-matter

In **T 1287/07** the appellant had submitted before the board that re-filing the same subject-matter comprised in an earlier divisional application which had been withdrawn and converted into a national right was an abuse of procedure. The board clarified that this re-filing did not fall within the grounds for opposition exhaustively listed in Art. 100 EPC, and there was no legal basis for revoking the patent in suit on this basis. Therefore, the alleged re-filing of the same subject-matter could not result in the revocation of the patent in suit.

In **T 1437/10** the appellant filed new requests during oral proceedings which claimed subject-matter essentially identical to the scope of protection of the granted European patent for which the appellant was the proprietor and for which the application at issue was the earlier application in accordance with Art. 76(1) EPC. Consequently, the subject-matter of the new requests had already been decided in favour of the appellant and a

second decision on the same subject-matter was superfluous. The board therefore exercised its discretion under Art. 13(1) RPBA 2007 so as not to admit the new requests into the procedure.

On the related issue of "double patenting" see chapter II.G. "Prohibition of double patenting"

3. Filing a divisional application

3.1. Right to file a divisional application

3.1.1 Applicant of earlier application entitled to file divisional application

In **J 20/05** the Legal Board held that only the applicant of the earlier (parent) application was entitled to file the divisional application. It stated that, fundamentally, it is the entitlement acquired by virtue of the parent application that gives the right to file a divisional application. This means that the rights in respect of the divisional application derivable from the parent application extend to, but are also limited to, the rights existing in the parent application at the filing date of the divisional application. The entitlement to file a divisional application under Art. 76 and R. 25 EPC 1973 (now R. 36 EPC) was a procedural right that derived from the applicant's status as applicant in the earlier application (with reference to **J 2/01**).

In **J 2/01** (OJ 2005, 88) the Legal Board held that **joint applicants** could not acquire a procedural status different from that of a single applicant, because otherwise each of them could perform different and contradictory procedural acts, including the filing of different versions of the patent to be granted. Therefore, where an application (the "earlier application") had been filed jointly by two or more applicants and the requirements of Art. 61 or R. 20(3) EPC 1973 (now R. 22(3) EPC) had not been met, the right to file a divisional application in respect of the earlier application under Art. 76 EPC 1973 was only available to the registered applicants for the earlier application jointly and not to one of them alone or to fewer than all of them. In **J 7/21** the application at issue was filed as a divisional application from an earlier application which had not been filed by the same co-applicants. However, the co-applicants could prove to the board's satisfaction that the second applicant had acquired applicant status for the earlier application by universal succession. The Legal Board confirmed previous case law according to which there was no need to meet the requirements under R. 22 EPC, as this provision did not apply. Indeed, the notion of "transfer" in R. 22(3) EPC should be interpreted as not covering universal successions. Therefore, the application in suit was filed by the same co-applicants as the parent application and met the requirements of R. 36(1) EPC.

In **J 34/86** the Legal Board allowed an application to be filed as a divisional application by a party **other than the registered applicant** for the parent application. This case concerned, however, a particular set of circumstances. The applicant for the parent application had been ordered by a US court to assign all property rights in the invention to the person who became the applicant for the divisional application, and the applicant for the parent application had already signed an assignment to that effect.

3.1.2 Filing of divisional application during stay of proceedings

In **J 20/05** application proceedings had been suspended under R. 13 EPC 1973 (now R. 14 EPC) because of pending national entitlement proceedings. The Legal Board decided that the applicant was not entitled to file a divisional application relating to that application while the proceedings remained suspended (confirmed in **G 1/09**, OJ 2011, 336).

In **J 9/12** the Legal Board added that to allow the filing of a divisional application by an applicant whose entitlement was challenged would be inconsistent with and contrary to the fundamental objective of R. 14(1) EPC, which was to preserve any potential rights a third party might have to the grant of a patent for the earlier application in dispute.

3.1.3 No obligation to postpone a decision to allow the filing of a divisional application

In **T 1184/03** the appellant requested during the oral proceedings before the board that the delivery of the decision be postponed with a view to filing a divisional application. Since the case was ready to be decided at the oral proceedings, the board held that postponing the decision of the board to allow the filing of a divisional application would run counter to the public interest in having the matter decided as expeditiously as possible, because the matter ready to be finally decided by this board would be pending again. See also **T 592/15**, in which the board observed that requests forcing a board to examine questions outside of the framework of the given appeal were not admissible (**T 502/02**). Thus, the board refused the applicant's request that the "application be maintained pending until [a] divisional application has been filed".

In **T 591/05** the applicant had declared during the examination proceedings that it reserved the right to file a divisional application. The board found that this declaration created no obligation for the examining division to check the status of any possible divisional application or to postpone the grant of the patent. It was incumbent on the applicant to undertake the appropriate measures to ensure that any possible divisional application was filed in due time before the grant procedure was closed.

3.2. Filing date attributed to divisional application

According to Art. 76(1), second sentence, EPC, in so far as the subject-matter of the divisional application does not extend beyond the content of the earlier application as filed, the divisional application shall be deemed to have been filed on the date of filing of the earlier application.

The characterising feature of a sequence of divisional applications each divided out from its predecessor is that each member of the sequence claims as filing date the date of the originating or root application in which the subject-matter divided out in sequences of divisional applications was first disclosed. The filing date of the root application is the **only filing date** which can be attributed to a divisional application, by way of the legal fiction contained in Art. 76(1), second sentence, second half sentence, EPC 1973, irrespective

of whether the divisional application is a first divisional or a divisional further down in a sequence of divisionals (**G 1/06**).

In **T 600/08** the Receiving Section had granted the request that the applicant's name in the divisional application be corrected (under R. 88 EPC 1973) on the ground that the wrong firm had been named as applicant by mistake. Before the board, the appellant (opponent) asserted that the request for correction under R. 88 EPC 1973 ought not to have been granted and that the divisional application was therefore invalid. As a result, the filing date relevant for the patent at issue was the date of receipt of the application on which it was based. The board found that there were only two alternatives for a European patent application filed as a divisional application: either it was not treated as a divisional application, in which case the grant procedure would not even start, or it was treated as a divisional application, in which case it could only be accorded the filing date of its parent application. Since the application on which the patent was based had been filed as a divisional application and then treated as such, there was no choice but to accord it the filing date of the parent application. The EPC does not provide for reviewing in opposition proceedings whether the correction of an applicant's name carried out by the Receiving Section was lawful (Art. 100 EPC 1973). See also **T 196/10**.

3.3. Language for filing divisional application

According to R. 36(2), first sentence, EPC, a divisional application shall be filed in the language of the proceedings of the earlier application. According to R. 36(2), second sentence, EPC, if the latter was not in an official language of the European Patent Office, the divisional application may be filed in the language of the earlier application; in such a case, a translation into the language of the proceedings for the earlier application shall be filed within two months of the filing of the divisional application.

In **J 13/14** the Legal Board observed that a divisional application of an earlier application, which had been filed in an EPO official language, had also to be filed in the EPO official language of the earlier application. A correction of the language deficiency by means of a translation into the language of the proceedings for the earlier application was neither required under R. 36(2), second sentence, EPC nor was it even admissible in view of the wording of that provision and of **G 4/08** (OJ 2010, 572). A correction under R. 139, first sentence, EPC or Art. 123(2) EPC was also not possible. The legal consequence of the non-compliance with the language requirements was that the divisional application could not be treated as a valid divisional application by analogous application of Art. 90(2) EPC.

3.4. Divisional application to be filed with EPO

Divisional applications must be filed with the EPO in Munich, the Hague, or Berlin (R. 36(2), third sentence, EPC). If a divisional application is sent to a national authority, the latter does not have to transmit it to the EPO. However, if it does, this application will have as date of receipt the date on which it reaches the EPO (**T 196/10**).

3.5. Requirement of pending earlier application

Rule 36 EPC (former R. 25 EPC 1973) requires that a divisional application only be filed if it is in relation to any **pending** earlier patent application. In **G 1/09** (OJ 2011, 336) the Enlarged Board of Appeal decided that a "pending (earlier) European patent application" in the specific context of R. 25 EPC 1973 (R. 36(1) EPC) was a patent application in a status in which substantive rights deriving therefrom under the EPC were (still) in existence.

An application is pending up to (but not including, see **J 7/04**, **J 24/10**) the date on which the European Patent Bulletin mentions the grant of the European patent or up to the date on which the application is refused, withdrawn or deemed withdrawn (**J 28/03**; for a case where the mention of grant was deleted following an appeal, see however **J 1/24**). For details on pendency in case of grant of the earlier application, see chapter II.F.3.5.3 and 3.5.4; for details on the situations of refusal and (deemed) withdrawal of the earlier application, see in this chapter II.F.3.5.5 to 3.5.9.

Note however that a divisional application cannot be validly filed during proceedings that have been stayed, see in this chapter II.F.3.1.2.

3.5.1 Requirement of pending earlier application sets no time limit

The wording "to any pending earlier European patent application" in R. 36(1) EPC does **not set a period/time limit**, but rather sets a condition (**J 29/10**, referring to **J 10/01**; **J 24/03**, OJ 2004, 544; **J 18/04**, OJ 2006, 560; **J 7/05**, **G 1/09**, OJ 2011, 336, **J 10/12**). Therefore, the provision on the re-establishment of rights does not apply to the filing of a divisional application (**J 24/03**, see also **J 21/96** and **J 10/01**). Rule 134(2) EPC, concerning the effects on periods of a general dislocation in the delivery of mail, does also not apply (**J 29/10**).

In **J 18/04** (OJ 2006, 560) the board explained that the term "pending ... patent application" in R. 25(1) EPC 1973 established a **substantive requirement** which had to be fulfilled at the point when a divisional application was filed. A board had no power to exempt an applicant from compliance with this substantive requirement. No substantive rights were established in a divisional application before the actual filing date of the divisional application. Substantive rights which were lost in the parent application could not be re-established in the divisional application by applying Art. 122 EPC 1973.

3.5.2 Pendency of a Euro-PCT application before the EPO acting as patent-granting authority according to the EPC

In **J 18/09** (OJ 2011, 480) the Legal Board of Appeal decided that an international application which did not fulfil the requirements according to Art. 22 PCT for entering the European phase was not pending before the EPO and therefore could not be considered a pending earlier European patent application pursuant to R. 36(1) EPC. The term "pending earlier European patent application" under R. 36(1) EPC included the requirement that the application must be pending **before the European Patent Office**

acting as patent-granting authority according to the EPC. On the basis of the provisions of the PCT and the EPC, a Euro-PCT application not having entered the European phase was not a pending earlier European application within the meaning of R. 36(1) EPC. See also **G 1/09**, point 3.2.5 of the Reasons.

In **T 1316/20** the divisional application for the patent in suit was filed the day before the expiry of the 31-month period for the parent international application's entry into the European phase. The request for examination was made on the same day, along with the payment of the related fees. However, since apparently no request for early processing of the application had been filed, the processing of the parent application could not be permissibly processed until the expiry of the 31-month period, and so it could not be considered a pending European application until the end of this period. The divisional application filed before its entry into the European phase was therefore inadmissible under R. 36(1) EPC. However, the board was of the opinion that the lack of a pending parent application was not a ground for objection in opposition or appeal proceedings. While the notice of opposition might indicate that the divisional application went beyond the content of the parent application, this would concern the technical content of the parent application, not its pendency.

3.5.3 Pendency in case of grant of earlier application against which no appeal was filed

An application is pending up to (but not including, see **J 7/04**, **J 24/10**) the date on which the European Patent Bulletin mentions the grant of the European patent. By way of an obiter dictum, the Enlarged Board held in **G 1/09** (OJ 2011, 336) that, in the case of a decision to grant, the pending status of the European patent application normally ceased on the **day before the mention of its grant was published** since from that point in time **substantive rights** under the EPC were no longer derived from the patent application, but now derived from the granted patent.

In **J 8/19** the board confirmed that there is no overlap between the phases of a pending patent application and a granted European patent.

3.5.4 Pendency in case of grant of earlier application against which an appeal was filed

In **J 5/08** the Legal Board had to decide whether the parent application was pending at the date of filing of the divisional application which took place after the appeal in the parent application had been filed but **before the interlocutory revision decision** by which the examining division revised the appealed decision (decision to grant referring to uncorrected text of claim 1). According to the Legal Board, a revision decision pursuant to Art. 109 EPC 1973 as such opened up the possibility that the patentability of the claimed subject-matter would be completely re-assessed. In the case at issue, the grant proceedings which had been terminated by the revision decision were still pending up to that date of the revision decision. The Legal Board concluded that in general where a decision is taken on the **allowability of an appeal**, an application was pending within the meaning of R. 25 EPC 1973 (now R. 36(1) EPC) at least up to the point in time when the decision was taken.

The Legal Board in **J 5/08** further noted that there appeared to be diverging case law on the question of whether the suspensive effect of an appeal always had the consequence that the grant proceedings remained pending within the meaning of R. 25 EPC 1973 (R. 36(1) EPC) during the appeal proceedings. One line of decisions appeared to say that this was indeed the case (**J 28/94**, OJ 1995, 742 and **J 3/04**). However, a different view was taken in **J 28/03**, where the Legal Board had decided that the grant proceedings were to be considered as not having been pending during the appeal proceedings if the appeal was dismissed as **inadmissible**; the status of a divisional application filed while an appeal against the decision to grant a patent on the parent application was pending **depended on the outcome of that appeal**.

In **J 23/13** (albeit regarding an appeal against a refusal of the earlier application), the Legal Board referred to **G 1/09** (OJ 2011, 336) and considered that the fact that the appeal was later rejected as inadmissible could not change the fact that, on the point in time when the divisional was filed, substantive rights were still in existence.

In **J 1/24**, the Legal Board recalled that, according to an obiter dictum in **G 1/09**, the pending status of the European patent application normally ceases on the day before the mention of its grant is published. It distinguished the case from **J 28/03** where the earlier patent application was no longer "pending" as the date of publication of the mention of the grant had not been deleted, so that the grant of the patent became effective. On the contrary in the present case, the date of publication of the mention of the grant had been deleted as a consequence of the appeal filed. Therefore, the parent application was still pending. The Legal Board was not convinced by the principle stated in **J 28/03** that whether the parent application was still "pending" depended on the outcome of the appeal against the grant of the parent application. According to Art. 106(1), second sentence, EPC, an appeal had suspensive effect. This provision did not distinguish between an appeal against the refusal or against the grant of a patent. The board also considered it inconsistent to view an appeal in two different ways: on the one hand, for the mention of the grant to be deleted, the appeal only needed to be admissible, on the other hand the application of the suspensive effect depended on the outcome of the appeal proceedings. Since the EPC had no provision restricting appeals of the applicant against the grant of a patent, such an appeal could not be seen as clearly inadmissible (as opposed to an appeal filed by a third party).

3.5.5 Pendency in case of refusal of earlier application against which no appeal was filed

In **G 1/09** (OJ 2011, 336) the Enlarged Board decided that, in the case where no appeal is filed, a European patent application which has been refused by a decision of the examining division is thereafter pending within the meaning of R. 25 EPC 1973 (R. 36(1) EPC) until the **expiry of the time limit for filing a notice of appeal**. It stated that a "pending (earlier) European patent application" in the specific context of R. 25 EPC 1973 (R. 36(1) EPC) was a patent application in a status in which substantive rights deriving therefrom under the EPC were (still) in existence. A patent application which had been refused by the examining division was thereafter still pending within the meaning of R. 25 EPC 1973 (R. 36(1) EPC) until the expiry of the period for filing an appeal and, on the day after, was no longer pending if no appeal was filed.

3.5.6 Pendency in case of refusal of earlier application against which an appeal was filed

In **J 23/13** the applicant had filed the divisional application after the filing of the notice of appeal against the decision refusing the parent application, but before the **time limit for filing the statement of grounds of appeal** had expired; since no statement of grounds was filed, the board rejected the appeal against the refusal of the parent application as **inadmissible**. The board in **J 23/13** observed that the divisional application had been filed while the time limit for filing the grounds of appeal was still running. The fact that the appeal was later rejected as inadmissible could not change the fact that, on the date when the divisional was filed, substantive rights were still in existence (**G 1/09**, OJ 2011, 336).

In **J 22/13** the applicant had filed the divisional application, in contrast to the situation in **J 23/13**, **after expiry of the time limit for filing the statement of grounds of appeal**. The application could thus not be treated as a divisional application.

3.5.7 Pendency in case of deemed withdrawal of earlier application and request for re-establishment

In **J 4/11** (OJ 2012, 516) the Legal Board held that an application which had been deemed to be withdrawn for **non-payment of a renewal fee** was not pending within the meaning of R. 25(1) EPC 1973 in the period for filing a request for re-establishment of rights under Art. 122 EPC 1973 in respect of such non-payment, or in the period after which such a request was filed in the event of such request being refused. The mere existence of the right to file a request for re-establishment of rights in respect of a deemed withdrawn application did not mean that the application was still pending while the period for filing such a request was running. Likewise, the fact that a request for re-establishment of rights was actually filed could not make the application become pending again. The board stated that the point in time when the application was deemed to be withdrawn was the point when the due time for payment of the renewal fee expired; the loss of rights occurred on the expiry of the time limit that had not been observed and, as such, was final in itself. Filing a request for re-establishment did not provisionally revive a deemed withdrawn application. As to whether the applicant enjoyed substantive rights in respect of the earlier application which were (still) subsisting when the later application was filed (see **G 1/09**, OJ 2011, 336), the Legal Board held that in the case at issue the substantive rights under Art. 64 EPC were no longer subsisting. As to other possible rights, the right of the inventor under Art. 60 EPC was held to be no longer subsisting when the divisional application was filed, since the right ceased to exist if and when the application was finally refused or was withdrawn or deemed to be withdrawn.

3.5.8 Pendency in case of deemed withdrawal of earlier application and no reaction to loss of rights communication under Rule 112(1) EPC

In **J 10/16** the Legal Board found that a divisional application could not be filed from the point in time at which the parent application was deemed to have been withdrawn (here: after expiry of the six-month period under R. 161(1) EPC) and if the applicant did not act on the communication noting this loss of rights under R. 112(1) EPC. Where, after receiving such a communication, the applicant did not apply for a decision under

R. 112(2) EPC, the rights were lost on expiry of the original unobserved time limit (see e.g. **J 4/86**, OJ 1988, 119; **G 1/90**, OJ 1991, 275; **G 4/98**, OJ 2001, 131; **J 19/01**; **J 9/02**); the communication became final; and the proceedings came to an end also **on expiry of the original time limit** – unless the legal effect in question was set aside by either further processing or re-establishment of rights. Communications under R. 112(1) EPC and decisions under R. 112(2) EPC were purely declaratory findings of a loss of rights already having arisen by operation of law (see **J 1/05**).

3.5.9 Pendency in case of withdrawal of earlier application

The case underlying **J 20/12** concerned a parent application which had been unconditionally withdrawn but the appellant had filed a **request to correct this withdrawal**. This request was ultimately refused by the Legal Board of Appeal (in decision **J 1/11**). After the request for correction, the appellant had filed a divisional application, which the Receiving Section decided not to process because the parent application had been withdrawn and, according to R. 36(1) EPC, an applicant could only file a divisional application relating to any pending earlier European patent application. The Legal Board saw no difference between the case of an application deemed to be withdrawn due to the non-payment of fees (which had been dealt with in **J 4/11**, OJ 2012, 516) and an application that had been voluntarily withdrawn by a communication from the applicant. In neither case was the withdrawal the result of a decision taken by the EPO. From the wording of Art. 67(4) EPC ("withdrawn" in contrast to "finally refused"), and the further clarification given in decision **J 4/11**, it could be concluded that an application was no longer pending as from the moment it had been withdrawn. This was not altered by the possibility of filing a request for correction of a withdrawal under R. 139 EPC, nor by the actual filing of such a request.

3.6. Time limits under Rule 36(1)(a) and (b) EPC in the version in force between 1 April 2010 and 31 March 2014

In the original version of R. 25 EPC 1973 of 1 October 1988, a divisional application could be filed only up to the date on which the applicant approved the text in which the patent was to be granted under R. 51(4) EPC 1973 (in the version which entered into force on 1 September 1987). For a brief overview of the case law in respect of the version of 1 October 1988, see CLB, 6th edn. 2010, p. 389-390. Under R. 25(1) EPC 1973 in the amended version of 2 January 2002, the applicant could file a divisional application in respect of any pending earlier European patent application (see CLB, 6th edn. 2010, p. 390-391). This requirement of pendency was adopted into R. 36(1) EPC.

Between 1 April 2010 and 31 March 2014, R. 36(1) EPC additionally required that the divisional application must be filed within the time limits laid down in R. 36(1)(a) and (b) EPC. The nature of the communication starting the time limit for voluntary division (R. 36(1)(a) EPC) was specified with effect from 26 October 2010. The requirements under R. 36(1)(a) and (b) EPC were removed in the amended version of R. 36(1) EPC which entered into force on 1 April 2014. On the interpretation of R. 36(1)(a) and (b) EPC see **J 13/13**, summarised in CLB, 9th edn. 2019, II.F.3.6.2.

4. Procedural questions

4.1. Procedural independence of divisional application

4.1.1 Principles

The procedure defined in the EPC for the filing of divisional applications is self-contained and complete (see e.g. **T 587/98**, OJ 2000, 497). The procedure concerning the divisional application is, in principle, independent from the procedure concerning the parent application. Although there are some connections between the two procedures (e.g. concerning time limits), actions (or omissions) occurring in the procedure concerning the parent application after the filing of the divisional application should not influence the procedure concerning the latter (**G 4/98**, OJ 2001, 131). The parent application also does not have any procedural priority over the divisional application, which is like any other application and in particular does not have subordinate procedural status (**T 1177/00**, **T 1176/00**).

In **J 12/18** the Legal Board recalled that only after the filing of a divisional application is its fate separated from changes concerning the earlier application. The nature of a divisional application, which is derived from a parent application thereby benefiting from the parent's date of filing and priority rights, implies that the divisional cannot be broader than the parent application, neither its subject-matter (Art. 76(1) EPC) nor its geographical coverage. Hence, in the case in hand, designated states forfeited in the parent application at the time of filing the divisional could not be revived in the divisional.

4.1.2 No preclusive effect of a decision with respect to identical requests in the other procedure

The consequence of the procedural independence of the divisional application can be seen in **T 1254/06**. In this case, the examining division had refused the divisional application and the applicant did not appeal. In the appeal proceedings concerning the parent application (in which the applicant had made the same requests as in the proceedings concerning the divisional application) the question arose whether the legal force of a **refusal decision** in respect of the divisional application also affected the parent application procedure to the extent that it could prevent the EPO (including the boards of appeal) from dealing with the substance of identical requests. The board stated that the principle that both proceedings were independent meant that a refusal decision in one procedure did not have a preclusive effect with respect to identical requests in the other procedure. This applied in particular when, as in this case, the refusal decision was made not by the board of appeal but by the examining division, because the first-instance administrative decision did not have true res judicata effect.

In **T 1266/19** the board recalled that it was established case law that proceedings against a parent and a divisional application were separate independent proceedings. Thus, the facts, evidence, and submissions made or filed in these proceedings were not automatically part of the parent procedure and vice versa. No exceptional circumstances in the sense of Art. 13(2) RPBA could be inferred from decisions relating to a different

case, or arguments submitted therein. Whether, as an effect of res judicata, subject-matter on which a final decision is taken by a board for a parent or divisional application cannot be pursued in another application or patent could be left open, as the facts were in any case not identical.

For decisions dealing with the issue of a cross-procedural res judicata effect, see chapter II.F.2.4.3 above.

4.1.3 Filing a divisional application not a response to a communication under Article 94(3) EPC

In case **J 5/07** the appellant had failed to file observations according to Art. 96(2) EPC 1973 (Art. 94(3) EPC). The appellant's request for further processing was rejected on the ground that the omitted act was not completed in due time (Art. 121(2) EPC 1973; R. 135(1) EPC). The appellant filed an appeal against this decision, arguing that the omitted act was in fact completed because in response to the communication a divisional application was filed by the appellant. The Legal Board held that, as a consequence of the principle that a divisional application was legally and administratively separate and independent from the grant proceedings concerning the parent application, the filing of a divisional application could not constitute a response to the invitation by the examining division in the parent application within the meaning of Art. 96(3) EPC 1973 (now Art. 94(4) EPC).

4.1.4 Intention to file divisional application immaterial to admissibility of appeal against grant of the parent

The board in **T 591/05** could not see how the filing and the status of a divisional application might have had any bearing on the admissibility of the appeal against the parent (i.e. on the question of whether the appellant was adversely affected). In particular, any allegation relating to the circumstances under which the divisional application had been filed (here: appellant had expressed the intention to file a divisional application) might have been pertinent to the legal status of the divisional application, but was irrelevant to the issue of the admissibility of the appeal.

4.1.5 Submissions made in the parent proceedings

In **T 1705/11** the board held that facts, evidence and requests or submissions made or filed in the parent proceedings were not automatically part of the divisional proceedings. A general citation or a mere reference to facts and/or evidence, such as to prior art documents, filed in the parent proceedings but not physically filed or incorporated into the divisional application proceedings did not constitute a reservoir upon which a party might draw at its convenience and at any time in the divisional application proceedings.

4.2. Designation of contracting states in a divisional application

4.2.1 Deemed designation of all states designated in earlier application at the date of filing of divisional

According to Art. 76(2) EPC 1973, the European divisional application shall not designate contracting states which were not designated in the earlier application. Pursuant to Art. 76(2) EPC all the contracting states designated in the earlier application at the time of filing of a divisional application are deemed to be designated in the divisional application. For divisional applications filed after 1 April 2009, only one designation fee has to be paid (Art. 2(1), item 3 RFees); if this designation fee is not paid in due time, the application is deemed to be withdrawn (R. 36(4) EPC, R. 39(2) EPC).

4.2.2 Designated state forfeited in the parent application at the time of filing the divisional

In **J 12/18**, interpreting Art. 76(2) EPC in accordance with the recognised rules of interpretation, the Legal Board confirmed that under this provision only those states that had been designated in the earlier application at the time of filing the divisional could be designated in the divisional. A designated state forfeited in the parent application at the time of filing the divisional could not be revived in the divisional one. The fact that the application was referred to as a "divisional" application under Art. 76(2) EPC implied by definition that it was divided from the earlier application and thus at the time of filing it could not be broader than the earlier application it derived from. Only after the filing of the divisional application was its fate separated from changes concerning the earlier application. Likewise, in the context of the required systematic interpretation of Art. 76(2) EPC the Legal Board noted that the nature of a divisional application, which was derived from a parent application, thereby benefiting from the parent's date of filing and priority rights, implied that the divisional could not be broader than the parent application, neither as to its subject-matter (Art. 76(1) EPC) nor its geographical cover. Thus Art. 79 EPC had to be considered. According to Art. 79(3) EPC the applicant could withdraw the designation of a Contracting State at any time up to the grant of the European patent. However, further possibilities, in particular the addition of a Contracting State, which had previously been excluded by withdrawal, were not foreseen in Art. 79 EPC. A revival of the withdrawn designation could only be achieved under particular circumstances if the requirements for a correction under R. 139 EPC were fulfilled. This, for reasons of consistency, had to apply also to a divisional derived from the earlier application. See also the parallel decisions **J 13/18**, **J 14/18** and **J 3/20**, which contain identical reasoning on this point.

4.2.3 Full effect of designation up to the due date for payment

In **G 4/98** (OJ 2001, 131) the Enlarged Board found that the wording of Art. 78(2) and Art. 79(2) EPC 1973 and the European patent system clearly indicated that up to the due date for payment of the designation fees, the designations had full effect. Only if the designation fees were not paid in due time would the designations not have any effect with respect to acts to be performed after that date, such as the filing of a divisional application. Retroactivity of the effects of non-payment of designation fees would occur only where

the EPC explicitly provided for it, i.e. in the case of provisional protection (Art. 67(4) EPC 1973).

4.2.4 Payment of fee for each designated State – case law concerning situation prior to 1 April 2009

For case law concerning the situation regarding divisional applications filed before 1 April 2009, where designation fees had to be paid for each designation of a contracting state, see CLB 9th edn. 2019, II.F.4.2.2.

4.3. Correction of errors in a divisional application

In **J 17/97** and **J 18/97** the representative had filed the divisional application under a different name than the parent application. The Receiving Section had thus refused to treat the application as a divisional application. The representative filed a request for correction of errors pursuant to R. 88 EPC 1973 (now R. 139 EPC) to replace the name of the applicant of the divisional application with the name of the applicant of the parent application. The Legal Board rejected the request as the appellant had not proved that the divisional application had been filed in error under the wrong name. Rule 88 EPC 1973 may not be used to enable a person to give effect to a change of mind or to a subsequent development of plans.

In **T 1008/99**, the request for correction of errors concerned a divisional application which had been filed with a wrong description unrelated to the earlier (parent) application. The wrongly filed description was therefore to be replaced by the description of the parent application. The board rejected the request and held that, for the purposes of R. 88 EPC 1973, the error had to be **apparent from the divisional application itself**, and the parent application could not be used to demonstrate that the error was obvious. Even if it was apparent from the filed description, claims and drawings that they did not belong together, it was not immediately clear from the divisional application itself which of these parts was incorrect.

4.4. Search fee for a divisional application

It was confirmed in **J 7/13** that the relevant provisions for determining the amount of the search fee to be paid for a European divisional application are R. 36(3) EPC and Art. 2(1), item 2, RFees. The time limit for payment in R. 36(3) EPC can only refer to the actual date on which the divisional application documents were received at the EPO. The amount payable does not depend, as contended by the appellant, on the fictitious date of filing accorded to the application under Art. 76(1) EPC, which is conditional on the fulfilment of substantive requirements and likewise has substantive effects.

G. Prohibition of double patenting

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4. Double patenting objection in opposition 755

1. Introduction

According to the Enlarged Board, a European patent application can be refused under Art. 97(2) and 125 EPC if it claims the same subject-matter as a European patent which has been granted to the same applicant and does not form part of the state of the art pursuant to Art. 54(2) and (3) EPC. The application can be refused on that legal basis, irrespective of whether it: a) was filed on the same date as, or b) is an earlier application or a divisional application (Art. 76(1) EPC) in respect of, or c) claims the same priority (Art. 88 EPC) as the European patent application leading to the European patent already granted (**G 4/19**, OJ 2022, A24, Order 1 and 2.1).

In **G 4/19** the Enlarged Board endorsed the **narrow reading of the term "double patenting"** given by the referring board (**T 318/14**, OJ 2020, A104, points 17 to 23 of the Reasons). Double patenting in this narrow sense may arise in situations in which two or more European patent applications with **overlapping territorial scope**, directed to the **same subject-matter** and having the **same effective date** are filed by the **same applicant**. Because such applications do not form part of the state of the art according to Art. 54(2) or (3) EPC, their prosecution could lead to the same applicant being granted two or more patents directed to the same subject-matter and having an identical or at least overlapping territorial scope.

There are three situations in which such European patent applications could have the same effective date: (i) a European patent application is filed on the same date as another European patent application of the same applicant (**parallel filings**); (ii) a European patent

application is filed as a European divisional application (Art. 76(1) EPC) in respect of an earlier European patent application (**divisional application**); (iii) a European patent application is filed claiming the priority (Art. 88 EPC) of an earlier European patent application (**internal priority**) or both claim priority from the same national application (see **G 4/19**, point 9 of the Reasons).

The Enlarged Board did not address in **G 4/19** what "the same subject-matter" or "the same applicant" meant in the context of double patenting, as these questions were not considered to be covered by the referral (**G 4/19**, point 16 of the Reasons). The technical boards have several times considered the notion of the "same subject-matter" (see in this chapter II.G.3).

2. Legal basis for the prohibition of double patenting

In **G 1/05** (OJ 2008, 271) and **G 1/06** (OJ 2008, 307) the Enlarged Board dealt with the issue of compliance with Art. 76(1) EPC. In this context the Enlarged Board stated that it accepted that the principle of prohibition of double patenting existed on the basis that an applicant had **no legitimate interest** in proceedings leading to the grant of a second patent for the same subject-matter if that applicant already possesses one granted patent therefor. Hence, the Enlarged Board found nothing objectionable in the established practice of the EPO that amendments to a divisional application were objected to and refused when the amended divisional application claimed the same subject-matter as a pending parent application or a granted parent patent.

Some technical boards had sought to identify the **legal basis** for this prohibition in the EPC and had suggested Art. 125 EPC (see **T 2461/10** highlighting that the "legitimate interest" was one of the principles of procedural law generally recognised in the contracting states; see also **T 2563/11**; but see also **T 307/03**, OJ 2009, 422 and **T 1423/07**), or Art. 60 EPC (**T 307/03**; but see also **T 1423/07** and **T 2461/10**). As noted in **T 2461/10**, the EPC only contains a provision relevant to the prohibition on double patenting in the context of European and national applications and patents (see Art. 139(3) EPC). For an overview of relevant decisions predating **G 4/19** discussing the legal basis for the prohibition of double patenting, see CLB, 10th edn. 2022, II.F.5.2.

In view of divergent case law on the legal basis for the prohibition of double patenting and the doubts raised as to whether the EPC contained any provision at all which could serve as legal basis, in **T 318/14** (OJ 2020, A104) the board referred points of law regarding the legal basis for the prohibition of double patenting, and the corresponding conditions for a refusal on this basis, to the Enlarged Board in accordance with Art. 112(1)(a) EPC.

In **G 4/19** (OJ 2022, A24) the Enlarged Board decided that a European patent application can be refused under Art. 97(2) and 125 EPC if it claims the same subject-matter as a European patent which has been granted to the same applicant and does not form part of the state of the art pursuant to Art. 54(2) and (3) EPC. The Enlarged Board also held that the application can be refused on that legal basis, irrespective of whether it: a) was filed on the same date as; b) is an earlier application or a divisional application (Art. 76(1) EPC)

in respect of; or c) claims the same priority (Art. 88 EPC) as the European patent application leading to the European patent already granted.

Giving its interpretation of the referred questions, the Enlarged Board explained that the essence of Question 1 was as follows: is there any legal basis under the EPC for refusing an application on the ground of double patenting? In this context the Enlarged Board endorsed the narrow reading of the term "double patenting" given by the referring board (**T 318/14**, points 17 to 23 of the Reasons). The essence of Question 2.1 was as follows: if there is a legal basis in the EPC for the prohibition on double patenting, are all three possible constellations in which double patenting may arise (i.e. constellations in which the granted patent and the application both have the same effective date, see above in chapter II.G.1) to be treated in the same manner?

The Enlarged Board first examined Art. 125 EPC as a possible legal basis for prohibiting double patenting. Drawing on the rules of treaty interpretation pursuant to Art. 31(1) and (2) Vienna Convention, it analysed the term "procedural provision" in Art. 125 EPC in the context of the provisions of Chapter I of Part VII of the EPC. The Enlarged Board observed that this chapter also contained Art. 123(2) and (3) EPC. It concluded that a provision falling under Art. 125 EPC may cover issues which touch upon substantive matters. The Enlarged Board then addressed the question of whether the prohibition on double patenting was a generally recognised principle of procedural law in the practice of the contracting states. It held that there were no data available to it which would allow it to safely establish the practice in all or at least the majority of the contracting states. In a next step, the Enlarged Board considered the implications of the obiter dictum in **G 1/05** and **G 1/06** (OJ 2008, 271 and 307). Given that the Enlarged Board in **G 1/05** and **G 1/06** did not state that it regarded a legitimate interest in the proceedings to be a generally recognised principle of procedural law, and the specific context of the statement on double patenting in these decisions, the Enlarged Board (in **G 4/19**) held that it would be inappropriate to base the double patenting prohibition on the obiter dictum in these earlier decisions.

The Enlarged Board found that it was necessary to have recourse to the preparatory documents of the EPC – as supplementary means of interpretation within the meaning of Art. 32 Vienna Convention – in order to determine the meaning of Art. 125 EPC with regard to double patenting. The Enlarged Board derived from the preparatory documents that the majority agreement recorded in the minutes of the Munich Diplomatic Conference in connection with Art. 125 EPC could be taken as the expression of the legislator's final and unchanged intention on the question of double patenting. In view of the wording of Art. 125 EPC, and the fact that the agreement was explicitly linked to this provision in the minutes, the straightforward interpretation of the recorded agreement was that the (potential) contracting states agreed that the prohibition on double patenting was a generally recognised principle of procedural law in the contracting states and as such applicable under Art. 125 EPC. In view of these findings, the Enlarged Board considered it unnecessary to examine the other provisions proposed as legal basis for the prohibition on double patenting. Regarding Questions 2.1 and 2.2 the Enlarged Board derived from the preparatory documents that all three possible constellations in which double patenting may arise have to be treated in the same manner.

3. Subject-matter and scope of protection

3.1. Introduction

The Enlarged Board did not address in **G 4/19** (OJ 2022, A24) the question of what "the same subject-matter" meant in the context of double patenting as this was not the subject of the referral before it. According to the majority case law of the boards of appeal, a mere overlap of claimed subject-matter and/or scope of protection does not prejudice the grant of a patent (see **T 587/98**, OJ 2000, 497, **T 877/06**, **T 1491/06**, **T 1391/07**, **T 2402/10**, **T 2461/10**, **T 1780/12**, **T 621/15**, **T 1252/16**, **T 2907/19**; different view in **T 307/03** and **T 1128/19**). On the relevance of the scope of protection for the issue of double patenting, see e.g. **T 1780/12** and **T 2563/11**.

3.2. Decisions allowing claims directed to overlapping subject-matter

3.2.1 Independent "parent" claim includes all features of the "divisional" claim with an additional feature

In **T 587/98** (OJ 2000, 497) the examining division, relying on the Guidelines prohibiting "conflicting" claims, had refused a European patent application, filed as a divisional application, on the grounds that its subject-matter overlapped with that of the parent application and that in the overlapping region the same subject-matter was claimed; as legal basis for the refusal it invoked Art. 125 EPC. The board found that there was no express or implicit provision in the EPC prohibiting the presence in a divisional application of an independent claim related to an independent claim in the parent application (or patent, if it had already been granted) in such a way that the "parent" claim included all the features of the "divisional" claim combined with an additional feature.

3.2.2 Overlap relates to dependent claim

In **T 118/91** the board (deciding on the allowability of amended claims of the parent patent in opposition proceedings) stated that it could find nothing to support the contention that features forming part of the subject-matter of the divisional application could not be the subject of a dependent claim in the parent application. The board agreed with the Guidelines that, as a general rule, **one application may claim its own subject-matter in combination with that of the other application**. This approach does not lead to "double patenting" in its normal sense. In this particular case, the board was satisfied that any danger of "double patenting" had been eliminated by extensive restriction of the claims in the divisional application.

In **T 2907/19** the board concluded that the prohibition of double patenting was not pertinent to the fifth auxiliary request because independent claim 1 thereof was different from independent claim 1 of the granted parent application and thus did not define the same subject-matter. According to the board, this was not precluded by the fact that claim 1 of the fifth auxiliary request **corresponded to dependent claim 2 of the granted parent application** (see, however, **T 1128/19** in II.G.3.3.2).

3.2.3 Overlapping scope of protection

In **T 1391/07** the board noted that the practice of prohibition of "double patenting" was confined to patents and applications relating to the same invention as defined by the subject-matter of the corresponding claims and therefore confined to claims conferring notionally the same **scope of protection**. It saw no basis for extending this practice to cover claims not defining the same subject-matter but conferring – as in the case before it – a scope of protection **overlapping** with each other **only partially** in the sense that some, but not all of the embodiments notionally encompassed by one of the claims would also be encompassed by the other one of the claims. In particular, the lack of legitimate interest of an applicant in obtaining two patents for the same subject-matter – as invoked by the Enlarged Board in decisions **G 1/05** (OJ 2008, 271) and **G 1/06** (OJ 2008, 307) – cannot be invoked when the scopes of protection conferred by the respective subject-matters **overlap only partially** with each other as there is no manifest objective reason to deny the legitimate interest of the applicant in obtaining a protection different from – although partially overlapping with – that of the parent patent already granted. Accordingly, the board concluded that the mere fact that the scope of protection notionally conferred by the claim in suit would partially overlap with that of the granted parent patent did not prejudice the grant of a patent (see also **T 587/98**, OJ 2000, 497; **T 877/06**, **T 1491/06**, **T 2461/10**, **T 2563/11**, **T 1780/12**).

In **T 1252/16** the board noted that, contrary to the view adopted in **T 307/03** (see in this chapter II.G.3.3.1), according to established case law, any prohibition of double patenting only applied to the "same subject-matter" and did not extend to claims that conferred a **scope of protection overlapping each other only partially** (citing **T 2461/10**).

On the relevance of the scope of protection for the issue of double patenting, see however also e.g. **T 1780/12** and **T 2563/11** (point 2.11 of the Reasons).

3.2.4 Scope of claims of granted patent fully encompassed in scope of protection of claim request

In **T 2402/10** the respondent raised an objection of double patenting, since claim 1 had been amended during the opposition/appeal proceedings in such a manner that its scope fully **encompassed** the scope of the claims of the patent granted from the grand parent application (the parent patent). But claim 1 contained technical features not required by any claim of the parent patent. Since the parent patent and the patent in suit claimed different subject-matter, the question of double patenting could not arise. The board noted that the respondent also referred to the headnote of **T 307/03**, according to which a double patenting objection could also be raised where subject-matter of the granted claim was encompassed by the subject-matter of the claim later put forward. The board, however, saw this as no reason to depart from the mandatory requirement of "same subject-matter" invoked in decisions **G 1/05** and **G 1/06** and in the established case law. See also **T 1155/11**.

3.3. Decisions rejecting claims directed to overlapping subject-matter

3.3.1 Reclaiming the preferred way of carrying out the invention

In **T 307/03** (OJ 2009, 422) the board held that a double patenting objection can also be raised where the subject-matter of the granted claim is encompassed by the subject-matter of the claim later put forward, that is where the applicant is seeking to re-patent the subject-matter of the already granted patent claim, and in addition to obtain patent protection for the other subject-matter not claimed in the already granted patent. In particular, where the subject-matter which would be double patented is the **preferred way of carrying out the invention** both of the granted patent and of the pending application under consideration, the extent of **double patenting cannot be ignored** as de minimis. See however **T 1391/07** and **T 2402/10** (both summarised in this chapter II.G.3.2).

3.3.2 Combination of features of granted independent and dependent "parent claims"

In **T 1128/19** the examining division had refused the application on the grounds of double patenting. The refused application was a divisional of an application that had been granted. Citing **G 4/19**, the board concluded that the main request and auxiliary requests 1 to 3 were not allowable because they claimed the same subject-matter as claimed in the granted parent patent. According to the board, claim 1 of the main request was an **explicit alternative defined in the claims of the parent patent**, being a combination of claims 1 and 4 and one of the embodiments of claim 5 of the parent patent. The same conclusion applied for auxiliary request 1. Claim 1 of auxiliary request 2 was also an explicit embodiment of the granted claims, differing from claim 1 of the main request in that it incorporated the subject-matter (and wording) of granted dependent claims 1 and 2. Claim 1 of auxiliary request 3 differed from claim 1 of the parent patent in that embodiments from dependent claim 7 of the parent patent had been incorporated. See, however, **T 2907/19** in this chapter II.G.3.2.2.

3.4. Change of claim category

In **T 1766/13** the board held that, with respect to the case at issue, a product and a method for its manufacture were not "the same subject-matter" in the sense of **G 1/05** and **G 1/06**. According to **T 1765/13**, the same was true for the use of a product and a method of fabricating it. See also **T 1708/06**.

In **T 1780/12** the board held that the category of a claim and its technical features constituted its subject-matter and determined the protection conferred (see **G 2/88**, OJ 1990, 93). The claims in question were of **different categories**: **Swiss-type claims** were purpose-limited process claims (Use of X for the manufacture of a medicament for the treatment of Y) and **claims formulated in accordance with Art. 54(5) EPC** were purpose-limited product claims (X for use in the treatment of Y). As regards the technical features, the board concluded that both sets of claims defined the same compound and the same therapeutic use, but that the Swiss-type claims comprised in addition the feature of manufacturing a medicament whereas the claim in accordance with Art. 54(5) EPC did not. The claimed subject-matter was thus different. The board also considered that the

scope of protection was noticeably different. It was generally accepted as a principle underlying the EPC that a claim to a particular physical activity (e.g. method, process, use) conferred less protection than a claim to the physical entity per se (see decision **G 2/88**). It followed that a purpose-limited process claim also conferred less protection than a purpose-limited product claim. See also **T 879/12**, **T 13/14** and **T 15/14** agreeing with the conclusions in **T 1780/12**.

3.5. Different descriptions

In **T 2563/11** the appellants had contended that the prohibition on double patenting did not apply because, despite their identically worded independent claims, the parent patent and the divisional application had **different descriptions** and so each conferred a different extent of protection under Art. 69 EPC. The board observed, however, that the important point for the purposes of the prohibition on double patenting was whether the "same subject-matter" was claimed. A claim's subject-matter was defined by its category and technical features (Art. 84 EPC and R. 43(1) EPC), so the description was **irrelevant** in establishing whether the same subject-matter was claimed, especially if the claims in question were anyway clear and understandable in themselves (see **T 197/10**). By contrast, while the claims were likewise the basis for determining the extent of protection conferred by a European patent, Art. 69(1) EPC provided that the description and drawings were to be used to interpret them for this purpose. This meant that the extent of protection conferred by the patent might be broader than the subject-matter claimed. That what mattered was not the extent of protection that the application being examined would confer as compared to the already granted patent but instead what subject-matter was claimed in each case ("protected subject-matter") was in line with **G 1/05** (point 13.4 of the Reasons) and e.g. **T 2461/10** (point 16 et seq. of the Reasons) and **T 879/12** (points 7, 10 and 14 of the Reasons).

4. Double patenting objection in opposition

According to the board in **T 936/04**, "double patenting" is not a ground for opposition. It is, however, within the discretion of the departments of the EPO to raise the objection in opposition or opposition appeal proceedings against proposed amended claims, but this should be done **only in clear cases**. The purpose behind the principle of prohibition of double patenting was to avoid unnecessary duplication of effort, and not to impose on the departments of the EPO an obligation to make a complex comparison between the case before them and the claims that may have been granted in some other proceedings. In the case at issue, at the time of the decision by the opposition division, a patent had not yet been granted on the divisional application. For this reason alone the opposition division was correct to disregard the objections of double patenting raised before it. At that stage it would only be a matter for the examining division, in the proceedings on the divisional application before it, to avoid double patenting by again allowing claims already granted in the parent patent.

In **T 98/19** the appellants (opponents) requested that the board examine the issue of double patenting of its own motion. The board did not accede to the request. The board held that double patenting did not constitute a ground for opposition, in line with **T 936/04**.

In the case in hand, the patent in suit had not been amended during the opposition proceedings.

In **G 4/19** (OJ 2022, A24) the Enlarged Board stated that the reference to Art. 97(2) EPC in the referred question 1 made it clear that this question was restricted to the applicability of the prohibition during substantive examination proceedings under Art. 94 EPC before the examining division.

III. RULES COMMON TO ALL PROCEEDINGS BEFORE THE EPO

A. The principle of the protection of legitimate expectations

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1. Introduction

The principle of the protection of legitimate expectations is a general principle well established in EU law and generally recognised in the EPC contracting states and boards of appeal case law (**G 2/97**, OJ 1999, 123; see also **R 4/09**). Its application to procedures before the EPO implies that measures taken by the EPO should not violate the reasonable expectations of parties to such proceedings (**G 5/88**; **G 7/88**; **G 8/88**, OJ 1991, 137). The term "good faith" is also used to describe this concept (**J 10/84**, OJ 1985, 71; **J 38/97**; **J 19/13**; **J 19/16**).

The protection of the legitimate expectations of users of the European patent system has two main principles. It requires that the user must not suffer a disadvantage as a result of having relied on erroneous information or a misleading communication received from the EPO (see III.A.3.). It also requires the EPO to warn the applicant of any loss of right if such a warning can be expected in good faith. This presupposes that the deficiency can be readily identified by the EPO (see in this chapter III.A.4.).

Users of the European patent system, who are parties in proceedings before the EPO, must also act in good faith (**G 2/97**, **R 4/09**, **T 861/12**). An alleged violation of the principle of the protection of legitimate expectations is in itself not a ground for a petition for review under Art. 112a EPC (**R 13/11**, **R 1/16**).

On reimbursement of the appeal fee due to a violation of the principle of the protection of legitimate expectations see chapter V.A.11.14.

2. Applicability of the principle of the protection of legitimate expectations

The principle of the protection of legitimate expectations applies to all procedural actions – whether formal or informal – taken by EPO employees vis-à-vis parties to proceedings (**T 160/92**, OJ 1995, 35; see also **T 343/95**; **T 460/95** of 16 July 1996; **T 428/98**, OJ 2001, 494).

It applies to both ex parte and inter partes proceedings (**T 923/95**, see also **T 1037/11** and **J 10/20**; as to a weighing of interests in inter partes cases, see in this chapter III.A. 2.2.3).

The requirements in connection with the principle of good faith to be observed by the EPO are the same vis-à-vis all parties involved in proceedings before the EPO, be they applicants, patent proprietors or opponents (**T 161/96**, OJ 1999, 331, see also **J 12/94**).

The principle of the protection of legitimate expectations also applies to acts performed by other authorities concerned in Euro-PCT proceedings during the international phase such as the USPTO acting as receiving Office or as IPEA (**J 13/03**). It applies also to the conduct of national authorities when dealing with European patent applications filed with them under Art. 75(1)(b) EPC (**J 34/03**). It can also apply in situations in which, while there is no erroneous information from the EPO, the outcome is the same in that a party receives

erroneous information as a result of another party's actions (see **T 353/18**, in which the respondent had mistakenly filed differing clean and annotated versions of the claim).

The principle of the protection of legitimate expectations only protects parties from disadvantageous procedural consequences of the omission of procedural steps, in relying on erroneous information from the EPO. It has no bearing on substantive law and cannot render patentable what otherwise would not be. This applies, in particular, when the information – even if it were wrong – was issued by a department of the EPO that was not competent to examine patentability (**T 2239/15**).

2.1. Sources of legitimate expectations

Sources of legitimate expectations include information provided by the EPO in individual cases, e.g. in the form of communications to the party (see in this chapter III.A.3.1.), telephone conversations (see in this chapter III.A.3.2.), "second" decisions (see in this chapter III.A.3.6.) and individual acts by other patent offices (**J 13/03**, **J 34/03**). They also include information contained in official statements of general applicability and published by the EPO (e.g. the Guidelines and the OJ; see in this chapter III.A.3.7), established practice of departments of the EPO, and decisions taken by the Enlarged Board because of its special role (see **J 25/95**, **J 13/05**; see also **T 905/90**, OJ 1994, 306, Corr. 556). The case law of the boards of appeal may also be a source of legitimate expectation, in particular if it is established case law which has become enshrined in the consistent practice of the department of first instance (see **J 27/94**, OJ 1995, 831; see also in this chapter III.A.6.). Courtesy services provided by the EPO may also be a source of legitimate expectation (see e.g. **J 1/89**, OJ 1992, 17, **J 10/17;** see also in this chapter III.A.3.2.).

2.2. Limits of the legitimate expectations principle

The principle of the protection of legitimate expectations is subject to several limitations. It does not give carte blanche to the person relying on it. For their part, it is the responsibility of users of the European patent system to take all necessary actions to avoid a loss of rights (**J 3/24** citing **J 4/23**). Moreover, not every expectation held by a person is automatically a legitimate one within the meaning of this principle. Whether an expectation is legitimate must be assessed by applying the principle to the facts of the case. It is therefore inherent in the principle of the protection of the legitimate expectations that a person can only successfully invoke an expectation on which they could, on an objective basis, legitimately rely (**J 4/23**).

2.2.1 Knowledge of the relevant legal provisions and the case law

Parties to proceedings before the EPO – and their representatives – are expected to know the relevant provisions of the EPC, even when such provisions were intricate (**J 27/92**, OJ 1995, 288; **T 578/14**; **J 10/17**; **J 1/19**), as well as all notices published by the EPO which are relevant to patent practice (**T 267/08**). In general, the parties to EPO proceedings are presumed to know the law relating to the EPC, including the relevant decisions of the boards of appeal (**R 17/09**).

The board decided in **J 17/98** (OJ 2000, 399) that the principle of the protection of legitimate expectations according to which communications of the EPO, including official forms, must be clear and unambiguous, did not extend so far as to require comprehensive legal advice to be contained in such forms. While forms must be clear and unambiguous, they need not contain detailed explanations of the law. This was especially true for legal issues which directly follow from the provisions of the EPC (see also **T 778/00**, OJ 2001, 554).

The board decided in **J 5/02** that it was not a violation of the principle of the protection of legitimate expectations if the EPO provided a professional representative with incorrect information on the basis of which the professional representative concluded that the relevant legal provisions – in this case Art. 122 EPC 1973 – were no longer applicable. If the professional representative did not realise the information was incorrect, they were guilty of fundamentally inexcusable ignorance of the law; if they did realise it was incorrect, they were not misled. See also **J 4/23** concerning erroneous information published on the EPO's website (relied upon by the appellant) containing an explicit reference to certain provisions of the EPC. According to the board, a person reading those provisions, acting in a reasonable manner, would have immediately realised that the information on the website was erroneous.

In **T 267/08** the board held that professional representatives must be expected to be acquainted with all notices published by the EPO which are relevant to patent practice. The new representative should have realised that the decision of the President of the EPO dated 12 July 2007 on the filing of authorisations (OJ SE 3/2007, L.1) explicitly required an original version of the authorisation to be filed and that the decision of the President of the EPO dated 12 July 2007 concerning the filing of patent applications and other documents by facsimile (OJ SE 3/2007, A.3) forbade the filing of authorisations by fax. The fact that the new representative had previously been notified that the change of representative had been registered should not have misled him into believing that a faxed version of an authorisation would suffice. Only a "fundamentally inexcusable ignorance of the law" (referring to **J 5/02**) could lead him to this conclusion.

In **T 590/18** of 4 July 2018 the board held that a debit order filed on paper (EPO Form 1010) after 1 December 2017 could at most be accepted as a valid payment of the appeal fee if the appellant could successfully claim to have seen still current information clearly indicating the option of paying this way on the EPO website after the entry into force of the change to fee payment methods, to have been entitled to entertain a legitimate expectation as to that information's accuracy, and indeed to have acted in reliance on it. Finding a PDF version of a brochure published before the change's entry into force was not sufficient to establish such a legitimate expectation, especially when the appellant had anyway known about the change.

The Enlarged Board held in **R 4/09**, in the context of an alleged breach of the principle of the protection of legitimate expectations, that a party to the proceedings, at least where it was represented by an authorised representative, was deemed to know the case law, and cannot plead lack of such knowledge as an excuse, "ignorantia legis non excusat" (see also **T 736/14** and **J 6/19**). According to **J 19/10**, the professional representative could be

expected to be familiar with procedural matters in general, and the boards' detailed and consistent jurisprudence in particular.

In **T 1086/09** the board held that the representative's expectation that a refund of 50% of the appeal fee would be available was not legitimate as it was the consequence of an error in law, i.e. an incorrect reading of the new R. 103(2) EPC, which did not apply to the appeal in question.

2.2.2 Interpretation of substantive patent law

In **G 2/07** and **G 1/08** (OJ 2012, 130 and 206) the Enlarged Board held that there could be no "legitimate expectation" that an interpretation of a substantive provision governing patentability given in a decision of the boards of appeal will not be overruled in the future by the Enlarged Board, since recognising such an expectation as legitimate would undermine the function of the Enlarged Board. This holds particularly true for issues on which there is no solid body of decisions all to the same effect but where instead the relevant jurisprudence consists only of a very limited number of individual decisions. See also **T 2516/19**.

2.2.3 Weighing of interests in inter partes cases

In **T 1644/10** the EPO had published an incorrect patent specification B1 and subsequently corrected it as B9. The appellant had relied on the accuracy of the published specification B1 and consequently failed to file notice of opposition within the prescribed period. The board held that whether the protection of legitimate expectations could be applied in an inter partes procedure where there had been a failure to meet the opposition deadline was subject to a weighing-up of interests. There was no general rule that the patentee's legitimate expectation that the grant decision had become final had to be considered subordinate to the opponent's legitimate expectation that the content of the published patent specification was correct. That would run counter to the rule of equal procedural treatment of the parties. In the case in hand, the appellant could not rely on the applicability of the principle of legitimate expectations in relation to its failure to meet the opposition deadline.

In **T 595/11** the appellant had enclosed a debit order for a reduced appeal fee with the notice of appeal. It is only four years after expiry of the time limit for filing the appeal that the EPO first made the appellant aware of an issue with this. The board acknowledged the appellant's legitimate expectations that the fee payment was in good order. After weighing up the legitimate interests of all the parties the board concluded that the original error might have had serious and inequitable consequences through the EPO's failure to discover it. Therefore, it was equitable that the EPO's failure was made good and the error was now allowed to be remedied, as far as possible. Some adverse effect was inevitable. Nonetheless, the possibility of a real, but otherwise in itself not necessarily decisive setback for a party (here the non-occurrence of an immediate success) was more preferable than a certain decisive loss of all rights for another party (see also **T 1037/11**, **T 2554/11**, **T 707/12**).

2.2.4 Area of party's own responsibility

The EPO is generally obliged to draw the party's attention to easily remediable deficiencies. However, the principle of good faith does not impose an obligation to warn a party of deficiencies within the area of the party's own responsibility (for more information, see in this chapter III.A.4.3.1).

In **J 3/24** the board held that the expectation relied on by the appellant was not legitimate. Although it was not clearly apparent whether the Receiving Section had taken the appellant's request into account in its communication, on an objective basis and under the circumstances of that case, it was not reasonable for the appellant to disregard that communication. According to the board, it was expected that communications from the EPO would be observed. It was the appellant's own responsibility to enquire about the situation regarding his request before the expiry of the triggered time limits to ensure that he would not suffer a loss of rights.

2.2.5 Administrative notice with no legal consequences

The Enlarged Board observed in **G 2/97** (OJ 1999, 123) that the notice sent by the Registry of the boards of appeal was a standard form, nothing more than an administrative notice to inform the parties of the reference number of the appeal proceedings. It had no legal consequences; it was not a "communication" within the meaning, for example, of Art. 110(2) EPC 1973 (R. 100(2) EPC). Such a notice could not be considered to give rise to any misunderstanding.

In **T 642/12** the board held that in inter partes appeal cases, the completion of EPO Form 2701 by the formalities officer of the department of first instance does not establish the legitimate expectation that formal requirements of the appeal have already been checked by the EPO.

2.2.6 No communication under Article 101(1) EPC

According to the board in **T 2382/19**, the opposition division had not violated the principle of the protection of legitimate expectations by not issuing communication including its preliminary opinion before giving its written decision. Article 101(1) EPC did not require as a matter of principle that the grounds for not maintaining the patent invariably be set out in a communication, but only if this was "necessary" (see chapter IV.C.6.2).

2.2.7 Communication under Article 15(1) RPBA not binding

The board in **T 1832/18** stated that there could be no legitimate expectation that the board would not deviate from its preliminary opinion. The board had expressly emphasised in its communication under Art. 15(1) RPBA, in line with Art. 15(1), fifth sentence, and 17(2) RPBA, that the comments in this communication merely expressed the board's preliminary and non-binding opinion (see also chapter III.C.6.4.3 and V.A.4.5.6i)).

2.3. Causal link and the requirement of proof

For applicants to be able to claim that they have relied on incorrect information in accordance with the principle of good faith, it has to be established that the erroneous information from the EPO was the direct cause of the action taken by the applicants and objectively justified their conduct (**T 460/95** of 16 July 1996; **G 2/97**, OJ 1999, 123; **J 5/02**; **J 5/07**; **J 10/17**). According to **J 27/92**, it must be established that, on an objective basis, it was reasonable for the appellant to have been misled by the information. Whether or not this was the case would depend on the individual circumstances of each case (see also **J 4/23**, **J 3/24**).

In **T 321/95** the appellant argued that it had an oral agreement with the primary examiner. No such agreement was derivable from the file. Thus, the appellant's arguments on an alleged violation of good faith were no more than the appellant's personal opinion and a mere "miscommunication" between the primary examiner and the applicant.

In **T 343/95** the board considered the contents of a telephone conversation on which the appellant based its arguments with respect to an alleged violation of the principle of good faith. The board held that in a case like the one in hand it was sufficient if the board determined the contents of the conversation on the basis of a balance of probabilities. The conditions for the application of the principle of legitimate expectations were fulfilled (but see **T 188/97**, where the board could not establish the facts surrounding a telephone conversation with sufficient certainty to invoke the principle of legitimate expectations).

3. Information provided by EPO

3.1. Clear and unambiguous communications and forms

According to the case law of the boards of appeal, the principle of the protection of legitimate expectations governing procedure between the EPO and applicants requires that communications addressed to applicants are clear and unambiguous, i.e. drafted in such a way as to rule out misunderstandings on the part of a reasonable addressee. A communication from the EPO containing erroneous information which misleads the applicant into taking action causing the refusal of his patent application is null and void in its entirety (**J 2/87**, OJ 1988, 330). An applicant must not suffer a disadvantage as a result of having relied on a misleading communication (**G 2/97**, **J 3/87**, OJ 1989, 3; **J 23/14**, **J 4/23**, **J 3/24**, **T 2092/13**). On the contrary, if the applicant's actions were based on a misleading communication they are to be treated as if they had satisfied the legal requirements (**J 1/89**, OJ 1992, 17).

In **T 2092/13** the board concluded that a communication from the examining division was ambiguous and had misled the appellant. In the circumstances of the case, the communication had created a realistic and reasonable expectation that any subsequent negative finding on the issue of novelty and/or inventive step was communicated to the appellant before any adverse decision would be taken. The appealed decision was set aside and the case remitted for further prosecution. See also **T 1423/13**.

The Legal Board suggested in **J 17/04** that it was the EPO's responsibility to provide **forms** which catered for all procedural possibilities in a clear and unambiguous manner. In the case in hand the applicant was allowed to rely on a possible interpretation of the text of the EPO Form in accordance with the principle of the protection of legitimate expectations even if another interpretation was more current.

3.2. Information provided as courtesy service

The principle of the protection of legitimate expectations also applies to courtesy services provided by the EPO where these are not worded so as to rule out any misunderstanding on the part of a reasonable addressee. However, an applicant cannot rely on the EPO systematically providing certain courtesy services and therefore is not entitled to base a claim on their omission (**J 12/84**, OJ 1985, 108; **J 1/89**, OJ 1992, 17; **J 27/92**, OJ 1995, 288; **G 2/97**, OJ 1999,123), or on the fact that the communication was not sent to the correct addressee (**J 23/10**).

In **J 1/89** the board held that the applicant was entitled to rely on the accuracy and completeness of information provided as a courtesy service. He could not, however, rely on courtesy services not required by the EPC being systematically provided. If an applicant paid a renewal fee late as a result of a misleading reminder, he had to be treated as if he had paid in time.

In **J 34/92** the fifth-year renewal fee had not been paid in full. The professional representative did not receive the communication the EPO usually issues drawing attention to the fact that late payment of the renewal fee was possible upon payment of an additional fee. The loss of rights communication under R. 69(1) EPC 1973 (R. 112(1) EPC) made, however, reference to such communication. The board held that the communication drawing attention to the possibility of a late payment plus surcharge was only a courtesy service of the EPO. The applicant could not draw any conclusions in his favour from the fact that this communication was not sent.

In **T 2053/20**, however, the board upheld the opponent's legitimate expectations and concluded that the appeal fee had been paid within the time limit of two months provided for in Art. 108 EPC. The appellant had stated that they intended to pay the appeal fee in the notice of appeal and the corresponding accompanying letter. The methods used for this purpose, i.e. automatic debit order and direct debiting mandate from the current account (which had not been issued in the correct electronic format), were not permitted under the ADA and their annexes (version in force in 2019) for paying the appeal fee. However, the corresponding reminder of non-payment, actually provided for in the ADA, had not been communicated by the EPO. In the board's view, in the absence of such a communication from the EPO, the appellant could assume in the circumstances that the payment instructions they had issued to debit the appeal fee had been accepted and executed.

In **J 27/92** (OJ 1995, 288) the appellant's representative had relied on the advice given by the Information Office by telephone as to the amount of the examination fee payable. The board held that where such a service had been rendered, an applicant was entitled to rely

upon its content if the – written or oral – communication from the EPO was the direct cause of the action taken and, on an objective basis, it was reasonable for the appellant to have been misled by the information. See also **J 10/17**.

3.3. Contradictory acts

In **J 27/94** (OJ 1995, 831) the board decided that if a declaration which was subject to a condition and therefore invalid was treated as a valid procedural act by the EPO, the EPO was not allowed later to go back on its own earlier conduct which served as a basis for the applicant's decision on how to proceed, because this would have represented "venire contra factum proprium" and thus offended against a generally recognised legal maxim (see also **T 1825/14**).

In **J 14/94** (OJ 1995, 824), the applicant had failed to pay the third renewal fee. Nevertheless, the EPO continued the examination procedure for several years without informing the applicant of any loss of rights. The board held that if, during a long period of time, the EPO by its conduct led the parties and the public to the legitimate belief that no loss of rights had taken place, the EPO could not later refer to a loss of rights which occurred several years previously as this would constitute "venire contra factum proprium" and therefore contravene the principle of legitimate expectations. In such circumstances, the late payment of a renewal fee might – by way of exception – be considered as having been made in time if the EPO had not informed the applicant of the outstanding payment, had accepted later renewal fees without objection and had continued the examination proceedings for several years.

In **J 1/08** the Legal Board concluded that the mere fact that for an admittedly extremely long time period (from August 2004 to March 2007) the EPO had simply not dealt with the application was not sufficient to justify a legitimate expectation on the applicant's side that the application would be regarded by the EPO as still pending. The situation before the board therefore differed from the facts in **J 14/94**, where the EPO had actively continued the examination proceedings for several years (see also **J 19/16**).

In **J 18/96** (OJ 1998, 403) the board accorded a filing date to protect an applicant's legitimate expectations, although the applicant had not fulfilled a requirement under Art. 80 EPC 1973 (R. 40 EPC). By issuing a communication under R. 85a EPC 1973 (deleted in EPC 2000), the Receiving Section had given the applicant the impression that their application was validly filed (see also **J 5/89**).

In **T 926/09** the board treated the claims in question as if they had been originally filed with the application whereas they had in fact been filed in the period before receipt of the European search report and thus in breach of R. 86(1) EPC 1973 (R. 137(1) EPC). The appellant was entitled to rely on the communication by the Receiving Section indicating that the set of claims was admitted.

In **T 2364/12** the board set aside the opposition division's decision holding the opposition inadmissible on the grounds that the notice of opposition was deemed not to have been filed in due time. The board found that the opponent could, on the basis of the opposition

division's communication informing the appellant that the opposition fee was considered to have been validly filed, reasonably assume that the opposition had been validly filed. See also chapter III.B. "Right to be heard".

In **T 2246/13** the board held that the letter by which the EPO cancelled the oral proceedings and announced that the procedure would be continued in writing in itself resulted in a legitimate expectation on the part of the appellant that it would have the opportunity to file observations, if only to be able to react to the changed situation resulting from the other party's withdrawal of its request for oral proceedings. The appellant thus could not expect that a decision revoking the patent would be issued on the same date. The board set the opposition division's decision aside. See also **T 1423/13**.

In **J 8/18** the appeal fee had been paid twice: once the reduced amount (for SMEs) and once the regular amount. The latter was refunded. A notice from the EPO suggested that it was enough, to benefit from the reduced fee for appeal, if the appellant simply declared that it was a SME at the latest by the time of payment of the reduced fee. Although not binding on the Legal Board, the notice of the EPO could, at least based on the principle of the protection of legitimate expectations, be relied on by the appellant in assuming that its appeal would either be deemed filed or admissible following the refund of the regular appeal fee before the file was transferred to the boards of appeal. See also **J 10/20**, in which the board held that users could rely on the information on the extension of time limits provided in the notices of the EPO without suffering any disadvantages. This was so regardless of whether there was in fact a dislocation in the delivery or transmission of mail due to COVID-19, in the sense of R. 134 EPC (on which the relevant notice was based).

3.4. Information provided by telephone

In **T 160/92** (OJ 1995, 35) the board did not deny that the principle of legitimate expectations should govern all the actions of EPO employees towards parties to the proceedings, including telephone conversations which were not provided for in the EPC and did not, as such, form part of the formal procedure before the EPO. However, since telephone conversations did not form part of the said formal procedure, the board did not consider it necessary to conduct a detailed investigation seeking to clear up what had been said in the relevant telephone conversations, the sequence of procedurally relevant facts having been clearly established in the file.

In **T 428/98** (OJ 2001, 494) the board held that an appellant might rely on information which the board's registrar could be proved to have provided by telephone concerning the method for calculating a time limit the appellant had to observe before the board if the point of law on which that information was based had at that time not yet been clarified in the case law of the boards of appeal.

In **T 1785/15** the appellant had been led to believe in a telephone conversation with a formalities officer that an appeal against the decision to grant would be possible. The board held that the appeal was inadmissible. Suggesting a legal remedy where there was none was at best misleading. The board considered it was likely that the applicant had filed the appeal based on incorrect advice from the EPO. The applicant thereby had at least a

legitimate expectation that the appeal would be found admissible and examined as to its substance, which led the board to order the reimbursement of the appeal fee.

3.5. Decisions of the administrative departments of the EPO

In **T 1448/09** the board held that the appellant was not at fault in failing to address, in its statement of grounds of appeal, a reason which, in the circumstances, could genuinely have been misunderstood. The principle of good faith required adverse decisions not to contain any ambiguity that could affect their comprehensibility.

In **T 1482/21** the board noted that any subsequent reopening of a favourable decision of the Receiving Section on re-establishment of rights would be in conflict with the principle of the protection of legitimate expectations. A party whose request for re-establishment was granted in ex parte proceedings had every reason to believe that it could rely on such decision in its subsequent procedural conduct.

3.6. Correction of already issued decision

In **T 1081/02** the board held that the communication issued by the opposition division's formalities officer during the period for appeal, stating that the decision already issued had been sent by mistake and should therefore be disregarded, could not constitute a legally sound basis for regarding the decision's validity as so doubtful that it could be considered void. According to the applicable principle of the protection of legitimate expectations, however, the parties could not be deemed to have failed to comply with the time limit for filing a notice of appeal (Art. 108 EPC) (see also **T 1176/00**, **T 466/03**).

In **T 830/03** the opposition division had issued a second written decision together with a communication which suggested that the first written decision was superseded. The opponent filed a notice of appeal outside the period of four months after the date of the notification of the first decision, but within the time limit after the notification of the second decision. The board held that the only legally valid written decision was the first decision but that, in application of the principle of protection of legitimate expectations, the appeal was deemed to have been filed in time (see also **T 993/06**).

In **T 124/93** the opposition division, after having delivered its decision, re-delivered the same with an additional enclosure under a new mailing date. This had misled the parties about the time limit for filing the notice of appeal and statement of grounds. Applying the principle of the protection of legitimate expectations, the board ruled that the appeal was to be considered as filed in due time (see also **T 130/07**, **T 972/05**).

In **T 105/11** the examining division, following a request of the applicant, had re-issued the written decision, in corrected form, with a new date. The board established that the date of the notification of the decision refusing the application remained the date of notification of the first written decision. Whilst the notice of appeal was received in time, the statement of grounds of appeal was not. The professionally represented appellant, who had explicitly requested that the written decision be corrected, should have been aware that the second decision intended to correct the first written decision under R. 140 EPC. Moreover,

different from other cases, in the case in hand there had been no explicit statement by the EPO that the first decision was to be ignored. Nevertheless, it was still imputable to the EPO that the second written decision had not been correctly and unambiguously identified as being a correcting decision. The board held, in application of the principle of the protection of legitimate expectations, that the statement of grounds of appeal was deemed to have been filed in time.

3.7. Information provided in the Guidelines

The board in **T 1607/08** recalled that the Guidelines published by the EPO were one of the sources of legitimate expectations. Therefore, where the Guidelines gave the clear indication that the continuation of the opposition proceedings had to be communicated to the patent proprietor, the latter was entitled to expect that such information would be given before a decision on the substantive issues was issued. Otherwise, as in the case in hand, the decision to revoke the contested patent would come as a surprise to the patent proprietor.

In **T 1946/21** the appellant argued that because the Guidelines had consistently provided that the assignment of the priority right to an applicant had to be effective before the filing date of the subsequent application, there was a legitimate expectation in that respect. The board did not contest that the Guidelines may be a source of legitimate expectation. However, what the law required from applicants for them to enjoy a right of priority could not be determined by what was stated in the Guidelines, whether directly or indirectly by way of creating a legitimate expectation. The requirement "before the filing date" was not provided for in the law. Thus, it was irrelevant that the Guidelines considered this a requirement for a valid transfer (see also this decision in chapter II.D.2.7.4).

4. Obligation to draw attention to easily remediable deficiencies

4.1. General principle

In accordance with the principle of good faith, the EPO is obliged to warn users of the European patent system of omissions or errors which could lead to a final loss of rights. A warning would always be necessary when one could be expected in all good faith (**G 2/97**, OJ 1999, 123). This would presuppose that the deficiency could be **easily identified** by the EPO and the applicant was in a position to **correct the deficiency** and thereby avoid the impending loss of rights (**J 13/90**, OJ 1994, 456). In other words, the EPO can only be expected to warn a party of a deficiency if the deficiency is readily identifiable by the EPO, and the party can still correct it within the relevant time limit (**G 2/97**, **J 13/11**, **T 703/19**).

The principle of good faith does not impose an obligation to warn a party of deficiencies **within the area of the party's own responsibility** (**G 2/97**; see in this chapter III.A.4.3.1).

4.1.1 Deficiency correctable within the relevant time limit

In **J 13/11** the appellant requested re-establishment in respect of the time limit for paying the third renewal fee on the last day for doing so and after EPO office hours. The board

held that there was no time for the EPO to warn the appellant about the non-payment of the third renewal-fee and surcharge even if the EPO had been in a position to spot this deficiency. The board distinguished the case in hand from **T 14/89** (OJ 1990, 432) (on which see **G 2/97**) where the EPO had had ample time, about six weeks before the expiry of the time limit for requesting re-establishment, in which to inform the proprietor of the deficiencies of his request. See **T 2726/17**, **T 1633/18**, **T 703/19** and **T 1295/20** for examples of cases in which the board held that the relevant party would still have had time to correct the deficiency at issue if it had been informed of it.

See also **T 1764/08** (concerning the electronic filing of the notice of appeal on the last day of the time limit) and the cases referred to therein, in this chapter III.A.4.2.3. See also in this chapter III.A.4.2.2 (missing or insufficient fee payments).

4.1.2 Obligation to set new time limit

The Legal Board held in **J 13/90** (OJ 1994, 456) that if the applicant could expect to receive a communication warning them of an impending loss of rights, but that communication was not issued in due time, the EPO must set a new period allowing the applicant to remedy the deficiency and perform the omitted procedural act in due time (see also **T 14/89**). However, this only applies to non-absolute time limits, as an absolute time limit (such as the one-year time limit under the third sentence of Art. 122(2) EPC 1973, now R. 136(1) EPC), by definition, is non-extendable (**J 34/92**, but see also **J 6/08**).

4.2. Examples of cases addressing the obligation to draw attention to easily remediable deficiencies

4.2.1 Language issues

In **J 3/00** the appellant filed an international patent application at the EPO as receiving Office under the PCT (RO/EPO). The description and claims were filed, by mistake, in Swedish, a language which the RO/EPO did not accept for filing international applications. The board held that this deficiency in the application was immediately and readily identifiable by the receiving Office on the face of the application in the course of the Art. 11(1) PCT check. The appellant could in good faith have expected a warning.

In **T 1152/05** the notice of appeal was filed in Dutch and thus not in one of the official language of the EPO; this document was, in accordance with Art. 14(4) EPC, deemed not to have been filed. In the board's view, there was prima facie no reason for the formalities officer to consider that the patent proprietor would not be entitled to file its notice of appeal in Dutch. As the deficiency was not readily identifiable, the EPO was not obliged to warn the patent proprietor of the fact that it could not benefit of the provisions of Art. 14(4) EPC.

In **T 41/09** the appellant (patent proprietor), a legal entity having its principal place of business in Spain, filed the notice of appeal in Dutch. The appellant argued before the board that, since the EPO was aware of its nationality, the language deficiency was readily identifiable. The board held that there was no breach of the principle of legitimate expectations of the appellant. It distinguished the situation in the case in hand from the

facts of **J 13/90**. In this decision, the deficiency had been readily apparent from the request itself whereas in the case in hand it was not readily apparent from the notice of appeal, which only referred to the name of the appellant, without any indication of the location of its principal place of business.

See also the following cases, in which the notice of appeal was filed by a Swiss company in Dutch: **T 642/12** (appeal was deemed not to have been filed) and **T 595/11**, **T 1037/11**, **T 2554/11**, **T 707/12** (appeal was deemed to have been filed and considered admissible).

4.2.2 Missing or insufficient fee payments

J 2/94 involved a letter comprising a request for re-establishment without the necessary payment. According to the board the appellant could not have expected to be informed of the missing fee immediately after receipt of his request for re-establishment by the EPO. There had been no evident indication in the appellant's submission which made a clarification or reminder necessary. Indeed, the EPO could, in practice, often establish whether a specific fee had been paid only after the relevant time limit had expired, once the complete data on all payments made during that period was available (see also **T 1815/15**).

In **G 2/97** (OJ 1999, 123) the Enlarged Board held that the principle of good faith did not impose any obligation on the boards of appeal to notify an appellant that an appeal fee was missing when the notice of appeal was filed so early that the appellant could react and pay the fee in time, if there was no indication – either in the notice of appeal or in any other document filed in relation to the appeal – from which it could be inferred that the appellant would, without such notification, inadvertently miss the time-limit for payment of the appeal fee.

Prior to **G 2/97**, the boards had held in a number of decisions that the EPO had a duty to warn the parties of missing or insufficient fee payments. These included **T 14/89** (OJ 1990, 432), **J 13/90** (OJ 1994, 456), **J 15/90** of 28 November 1994 and **T 923/95**. The Enlarged Board held with regard to **T 14/89** that the case turned on its particular facts and that there was no generally applicable principle to be derived therefrom. The board in **T 642/12** suggested that the approach in **T 923/95** was no longer tenable as it plainly contradicted the findings of **G 2/97**.

In **T 296/96** only 50% of the appeal fee was paid before the expiry of the time limit under Art. 108, first sentence, EPC 1973. However, since the formalities officer invited the appellant to pay the remainder of the appeal fee and accepted its subsequent payment without comment, the appellant could assume in all good faith that the appeal was deemed to have been filed (Art. 108, second sentence, EPC 1973) and that, as a consequence, it was not necessary to file a request for re-establishment. The appellant, who was misled by the action of the formalities officer, must, in accordance with the principle of the protection of legitimate expectations, be treated as having paid the appeal fee in time.

In **T 161/96** (OJ 1999, 331) the board came to the conclusion that there was no basis for assuming an obligation on the part of the EPO to warn the party of an impending loss of rights relating to an underpayment of 40% of the opposition fee.

In **T 445/98** the board considered that, because the department which cashed the fee was not the same as the one which received the notice of appeal, the deficiency was not easy to identify and the time between payment of the appeal fee and expiry of the non-observed two-month time limit for filing the notice of appeal was too short, so that the opponent could not expect a warning.

In **T 642/12** the board held that a potential possibility of discovering the error (80% instead of 100% of the appeal fee had been paid) was not sufficient to establish the legitimate expectation that a registrar of the boards of appeal would warn an appellant within seven working days before the expiry of the time limit that a reduced appeal fee had been relied on in error. The appeal fee was thus deemed not to have been paid (but see **T 595/11** in this chapter III.A.2.2.3). See also **T 2422/18, T 416/21** and **T 1060/19** on payment of a reduced fee by persons not fulfilling the criteria of the relevant notice from the EPO dated 18 December 2017 (OJ 2018, A5).

In **T 703/19** the board considered that EPO users could legitimately expect a plausibility check to be carried out on the filing of an appeal. On filing its notice of appeal, the appellant had stated in it that the appeal fee had thereby been paid via the Online Fee Payment service. The letter accompanying subsequently filed items, however, contained information on the kind of fees and the amount payable but nothing on the method of payment, for which "not specified" appeared. The bank account number was missing too. The board considered that this lack of information was clearly at odds with the stated intention of paying the appeal fee at the time of filing the notice of appeal. The deficiency had at any rate been readily identifiable as both the accompanying letter and the notice of appeal had contained very little information.

In **T 71/21** the appellant (opponent) had attempted to pay the appeal fee within the appeal period by setting up an automatic debiting procedure. This could not succeed because this online payment method was inadmissible for opponents (see chapter III.U.2.2.4). In the opinion of the board, the deficiency in the present case was not easily identifiable. See, however, **T 2053/20** in chapter III.A.3.2.

4.2.3 Electronic filing of documents

Under decision of the President of the EPO dated 14 May 2021 (OJ 2021, A42), electronic filing of documents is admissible in opposition and appeal proceedings. There are numerous cases which deal with electronic filing of appeals before this became permissible (see, with regard to the principle of the protection of legitimate expectations, **T 781/04** of 30 November 2005 **T 991/04** of 22 November 2005 and **T 331/08;** see also **T 2726/17** and **T 1633/18**, in which the board considered that a notice of appeal filed via the EPO Web-Form Filing service was validly filed; see also **T 1295/20** of 28 January 2021).

In **T 1764/08** the appellant filed its statement setting out the grounds of appeal via *epoline*® on the very last day of the period specified in Art. 108, third sentence, EPC. The board held that, even if the EPO had warned the appellant, the warning would not have allowed the appellant to re-file the statement of grounds of appeal by an acceptable means within said period. Therefore, under the principle of good faith, there was no duty on the part of the EPO to warn the appellant. The DBA was of the same view in **D 36/21** with regard to an appeal against a decision of the Examination Board which had been filed via email on the last day of the relevant period at 19:53 hours (see chapter V.C.2.6.2). To that extent, these cases differed from cases **T 781/04**, **T 991/04** of 22 November 2005, **T 514/05** and **T 395/07**, where the deficiency could have been identified in good time before the expiry of the relevant period.

4.2.4 Further examples involving easily identifiable deficiencies

In **T 460/95** of 16 July 1996 the board found that in the case in hand the irregularity was obvious and easy to identify, and the appellant could easily have put it right during the time remaining. The registrar, when he received the request for an extension, could and indeed should have seen that it was based on a misunderstanding during a telephone conversation.

The principle of the protection of legitimate expectations was applied in **J 11/89** where the Receiving Section failed to take any particular action upon the receipt of patent documents intended to be considered as priority documents, but whose priority was not claimed in the request for grant.

4.3. Limits of the obligation to draw attention to easily remediable deficiencies

4.3.1 Area of party's own responsibility

The case law demonstrates that the principle of good faith does not impose an obligation to warn a party of deficiencies within the area of the party's own responsibility (**G 2/97**, OJ 1999, 123; see inter alia **J 41/92**, OJ 1995, 93; **J 4/96**; **T 690/93**; **T 161/96**, OJ 1999, 331; **T 778/00**, OJ 2001, 554; **T 267/08**, **T 1271/20**; **R 4/09**; **T 578/14**). The reason for this is that users of the European patent system, who are parties in proceedings before the EPO must act in good faith, and have the responsibility to take all necessary procedural actions to avoid a loss of rights (**G 2/97**, **R 4/09**).

a) Filing of valid appeal

The Enlarged Board held in **G 2/97** that the appellant's responsibility for fulfilling the conditions of an admissible appeal could not be devolved to the board. There can be no legitimate expectation on the part of users of the European patent system that a board will issue warnings with respect to deficiencies in meeting such responsibilities. To take the principle of good faith that far would imply that the boards would have to systematically assume the responsibilities of the parties to proceedings before them, a proposition for which there was no legal justification in the EPC or in general principles of law.

In **T 703/19** the board held that, although it was the appellant's own responsibility actually to pay the appeal fee, the same did not necessarily go for all related aspects of the process. Were that so, the Enlarged Board would not have concluded in **G 2/97** that, in the hypothetical example given there, the board ought to have drawn the appellant's attention to a missing cheque. In the board's view, the point of that example had instead been to illustrate a situation where a clearly identifiable intention to perform a procedural act on filing notice of appeal (payment of the appeal fee) was at odds with what had actually been done and this discrepancy was readily identifiable.

In **T 267/08** the board made it clear that it was under no obligation to warn a party of deficiencies in the filing of an authorisation; rather, the party itself had the responsibility to take all necessary steps to avoid a loss of rights. Responsibility for filing a valid authorisation could not be devolved to the board.

b) Filing of divisional application

In **J 2/08** (OJ 2010, 100), the appellant (applicant) contended that the EPO had violated the principle of good faith on several occasions (omission to inform in respect of filing a divisional application; publication of the divisional application; late noting of loss of right). In his view, by taking no action the EPO induced the appellant into believing that everything was in good order with the divisional application, until it became too late to file an appeal against the decision refusing the parent application. In the board's view it was exclusively the responsibility of the applicant and his representative to decide on the factually and legally most appropriate filing actions to be taken. Furthermore no legitimate expectations concerning the validity of an application may be based on the fact that an application has been published. Finally, the communication under R. 69 EPC 1973 (R. 112 EPC), which is not just a warning but a procedural act, had to be sent after the end of the appeal period.

c) Bank account information

The board in **T 1029/00** decided that the appellant could hardly cite the lack of bank account information on EPO correspondence as the reason for making an incorrect cash payment. Applicants had to ascertain such bank account information for themselves.

4.3.2 No obligation to scrutinise submissions for deficiencies

J 7/97 concerned an application filed with the EPO by fax. One page of the description was missing, whilst another was transmitted twice. The board took the view that a single page missing from a lengthy description was not an "obvious error" under the case law, at least in the circumstances of this particular case. The applicant could not in good faith expect the EPO to check application documents for completeness on the very day it received them. Nor could any such obligation be inferred from the President of the EPO's decision on fax transmissions (OJ 1992, 299), in which Art. 3 (now Art. 6, decision of the President of the EPO of 20 February 2019, OJ 2019, A18) required the filing office to notify the sender as soon as possible "where a document transmitted ... is illegible or incomplete"; the latter adjective clearly referred to the transmission rather than the actual document.

In **T 585/08** the board found that the deficiency in the request for re-establishment (insufficient statement of grounds and facts, R. 136(2) EPC) had not been readily identifiable. First, a number of letters had been filed, and second, it would only have been possible to detect the deficiency if these letters had been studied carefully. In the board's view, the principle of good faith did not impose any obligation on the EPO to scrutinise several letters on file to establish whether grounds and facts with respect to a request for re-establishment were missing. The board distinguished this case from **T 14/89** (OJ 1990, 432) in which the lack of substantiation of the request for re-establishment had been readily identifiable.

5. Obligation to enquire in case of unclear nature of request

In **J 15/92** the Legal Board held that in the case of a request whose true nature was uncertain (here it was unclear whether it was a request for re-establishment or a request for a decision), the EPO should clarify the matter by asking the requester. It would have been sufficient in the case in hand for the EPO to invite the applicant to define his request more precisely. For the EPO to interpret the request arbitrarily constituted an error rendering the impugned decision null and void (see also **J 25/92**, **J 17/04**).

In **J 6/08** the board added that a request (for a decision or re-establishment) filed with a view to obtaining the redressal of a loss of rights within the meaning of R. 69(1) EPC 1973 (R. 112(1) EPC) had to be interpreted by the EPO in the light of the requester's objectively discernible will and taking account of the particular circumstances of the case. In case of doubt the EPO is obliged to establish what the requester really wanted and may also be obliged to point out any still outstanding procedural steps in connection with this request (in this case, observance of the period of one year under Art. 122(2) EPC 1973, now R. 136(1) EPC).

Though not expressly relying on the principle of the protection of legitimate expectations, the Enlarged Board held in **R 14/10** that in cases where a request of a party during oral proceedings was considered unclear, it was the duty of the deciding body to ask for clarification before deliberation. However, if the requests as read out before the debate was declared closed did not correspond to the petitioner's intention, it was the petitioner's duty to intervene at that point.

6. Legitimate expectation and case law

There might be cases in which the public has a legitimate expectation that the department of first instance will not deviate from the **established case law** which has become enshrined in the consistent practice of the department of first instance (see **J 27/94**, OJ 1995, 831). A **single decision** of a board of appeal cannot, however, create a legitimate expectation that it will be followed in future (**J 25/95**, **T 500/00**). The users' confidence in the continuity of a practice based on a decision of the Enlarged Board might be considered particularly legitimate since all boards of appeal were expected to follow the Enlarged Board's interpretation of the EPC (**J 25/95**).

6.1. Case law deviating from or overruling the practice

In **J 27/94** (OJ 1995, 831) the board stated that there might be cases in which the public had a legitimate expectation that the department of first instance would not deviate from the established case law. This might apply if the relevant case law had become enshrined in the consistent practice of the department of first instance, and in particular if this had been made known to the public in published Guidelines, legal advice or notices from the EPO. In such a situation, an applicant might legitimately expect that a practice allowing or even recommending a particular way of proceeding would not be changed without appropriate advance information. In the case in hand, the board held that the department of first instance was therefore not obliged by the principle of the protection of legitimate expectations, on the basis of decision **J 11/91** (OJ 1994, 28), to allow the filing of a divisional application after the approval of the text intended for grant until opinion **G 10/92** (OJ 1994, 633) was made available to the public.

In **J 25/95** the board stressed that the publication of **J 11/91** in the OJ (OJ 1994, 28) as well as in the CLB did not create a legitimate and reasonable expectation that a divisional application could be filed up until the decision to grant. If there was any doubt whether the established practice in this respect existed, it was up to the appellants to seek clarification by means of an enquiry to the EPO which would have revealed quickly that the department of first instance did not apply **J 11/91**.

In **T 740/98** the appellant submitted that the disclaimer had been allowed by the examining division in conformity with the Guidelines (1994 version) and the then established case law of the boards of appeal. Consequently, the standards set out in the subsequent decision **G 1/03** (OJ 2004, 413) could not be applied, since this would offend against the principle of good faith and the protection of the legitimate expectations of the users of the EPO. The board noted that the legal system established under the EPC did not treat either the Guidelines or established case law as binding. Thus, any principle of protection of legitimate expectations could not be based on earlier Guidelines or case law. The board held that the standards set out in **G 1/03** were applicable to the case. In **T 500/00** the board added that what counted was not whether the opposition division had acted in accordance with the Guidelines, but whether it had acted in accordance with the EPC. The principle of good faith could not be invoked against the application of principles concerning the allowability of disclaimers laid down in **G 1/03** to pending cases.

6.2. Point in time from which a new decision which deviates from existing practice becomes generally applicable

In three decisions the Enlarged Board reached the conclusion that these decisions overturning earlier rulings would not be applied up to the date on which they were made available to the public (**G 5/88**, OJ 1991, 137, concerning an administrative agreement; **G 5/93**, OJ 1994, 447, concerning the possibility for Euro-PCT applicants to have their rights re-established with regard to the time limit for paying the national fee provided for in R. 104b EPC 1973; and **G 9/93**, OJ 1994, 891, holding that a European patent cannot be opposed by its own proprietor, thereby overturning **G 1/84**). These three decisions do not,

however, form the basis of a general rule that new case law must never be applied "retrospectively" (**J 8/00**; see also **T 2360/19** below).

In **T 716/91** the board came to the conclusion that **G 4/93** (corresponding to **G 9/92**, OJ 1994, 875) had also to be applied to pending cases. The situation in the case in hand was not analogous to the situation in **G 9/93**, where the Enlarged Board had held that it was inequitable to apply the law as interpreted in **G 9/93** to pending cases. The board pointed out that **G 4/93** did not contain any indication limiting the applicability of the law as interpreted therein to pending cases.

In **T 739/05** the board saw no reason to suspend the further prosecution and the final decision of the case until a decision of the Enlarged Board was issued on an important point of law which might have been of importance for the case under consideration. The board held that the decision of the Enlarged Board could not affect the outcome of the case because of the principle of the protection of legitimate expectations relating to pending cases. Where existing long-standing practice laid down in publications of the EPO is overruled by a new decision, consistent case law (**G 5/93**, **G 9/93**, **T 905/90**, **J 27/94**, **J 25/95**) allows the applicants of pending cases a transitional period during which they may rely on the previous practice until the modifying decision is made available to the public.

Decision **G 2/08** (OJ 2010, 456) stated that in order to ensure legal certainty and to protect legitimate interests of applicants, the interpretation of the law given by the Enlarged Board in this decision should have no retroactive effect, and an appropriate time limit of three months after publication of the present decision in the OJ was set in order for future applications to comply with this new situation. On the same grounds, in **G 3/19** (OJ 2020, A119 – see point XXIX of the Reasons) the Enlarged Board specified that the new interpretation of Art. 53(b) EPC given in the opinion had no retroactive effect on European patents containing the claims of the type at issue which were granted before 1 July 2017 (when R. 28(2) EPC entered into force) or on pending European patent applications seeking protection for such claims which were filed before that date.

In **G 2/07** and **G 1/08** (OJ 2012, 130 and 206) the Enlarged Board held that, in the past, it had granted a transitional period in cases in which its decision had brought about a change in relation to an established procedural practice, which change the parties could not be expected to foresee. By contrast, the existence of "legitimate expectations" has never been acknowledged for issues before the Enlarged Board concerning the correct application, i.e. interpretation, of substantive patent law.

In **T 2360/19** the opponents, citing **G 2/08** and **G 3/19**, argued that the rebuttable presumption established in **G 1/22** (see in chapter II.D.2.6.1) could not be retroactively applicable to applications and patents having a priority date before **G 1/22**, as this would constitute a breach of legitimate expectations. Referring to **G 2/07** and **J 8/00**, the board disagreed. The board noted, inter alia, that the legitimate expectations were being invoked by the opponents, who did not have to take any actions in the context or in view of the filing of the patent applications in the case in hand. It could not be seen – and they also did not say – on which established practice they could legitimately have relied on, and

what actions they might have made based on their expectations. See also **T 2516/19** and **T 2689/19**.

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1. Introduction

The right of parties to a fair trial is a generally recognised procedural principle under Art. 125 EPC (**T 669/90**), and is to be observed in all proceedings before the EPO (**R 2/14** of 17 February 2015). The predictability and verifiability of all state actions are indispensable elements of the rule of law and respect for fundamental procedural rights (**G 3/08**, OJ 2011, 10). It is a fundamental right of the parties which has to be safeguarded, irrespective of the merits of the party's submissions. The necessity to respect it is absolute (**R 3/10**).

Under Art. 113(1) EPC the decisions of the EPO may only be based on grounds or evidence on which the parties concerned have had an opportunity to present their comments. The right to be heard under Art. 113(1) EPC is a fundamental principle (**J 13/10**) and of fundamental importance for ensuring a fair procedure between the EPO and a party to proceedings before it (**J 20/85**, OJ 1987, 102; **G 4/92**, OJ 1994, 149). It is intended to ensure that no party is caught unawares by grounds and evidence in a decision turning down a request on which that party has not had the opportunity to comment (**R 2/14**). In inter partes proceedings Art. 113(1) EPC reflects the principle that each party should have a proper opportunity to reply to the case presented by an opposing party (**G 4/95**).

Under Art. 113(2) EPC the EPO shall examine and decide upon the European patent application or the European patent only in the text submitted to it, or agreed, by the applicant for or proprietor of the patent. This is a fundamental procedural principle, being part of the right to be heard, such that any infringement of it, even as the result of a mistaken interpretation of a request, must, in principle, be considered to be a substantial procedural violation (**T 647/93**, OJ 1995, 132).

However, the board in **T 737/20** clarified that the right to be heard was not an end in itself. A party must be heard on matters, whether substantive or procedural, only if these lead to decisions which could adversely affect the legitimate interest of that party. Where a board opted not to remit a case and to decide the case on the merits, no party was adversely affected and, thus, there was no legal obligation under Art. 113 EPC to hear the parties on this matter. In the opposite constellation, where a board does intend to remit a case to the first instance for further prosecution, an opponent might have a legitimate interest in obtaining legal certainty as to the scope and existence of a monopoly right. Thus, if a board were to contemplate remitting a case instead of deciding it itself, there might be a case for hearing the parties on the issue. According to the board in **T 1213/19**, neither Art. 113(1) nor Art. 113(2) EPC gives any right to an applicant or patent proprietor in the sense that the EPO is in any way bound to consider a request for amendment put forward by them. In **T 2382/19** the board explained that the right to be heard was not a question of whether the view taken by the EPO was correct or not. The crucial point was whether the parties had had an opportunity to comment on the grounds on which a decision was based.

A violation of the right to be heard in first-instance proceedings may constitute a fundamental deficiency under Art. 11 RPBA that justifies the remittal of the case to the department of first instance (see chapter V.A.9.4.), as well as a substantial procedural violation under R. 103(1)(a) EPC that may, if equitable, justify the reimbursement of the appeal fee (see chapter V.A.11.6.8); see e.g. **J 13/10**, **T 820/10**, **T 623/12**.

A fundamental violation of Art. 113 EPC in appeal proceedings can be the basis for filing a petition for review to the Enlarged Board (Art. 112a(2)(c) EPC; see chapter V.B.4.3.). A petition for review can also be based on the failure to arrange requested oral proceedings, and on the failure to decide on a party's request. Both of these additional grounds also reflect an aspect of the right to be heard (see chapter V.B.4.4. "Article 112a(2)(d) EPC – any other fundamental procedural defect"). The case law of the Enlarged Board under Art. 112a EPC is primarily to be found in chapter V.B.4., to which the reader is also directed in order to cover all the jurisprudence in relation to the right to be heard. Decisions on the right to be heard taken by the Legal Board and by technical boards of appeal are, on the other hand, almost exclusively dealt with in the present chapter, and only exceptionally referred to in chapter V.B.4.3. "Article 112a(2)(c) EPC – alleged fundamental violation of Article 113 EPC".

For the right to be heard in **examination proceedings**, see chapter IV.B.2. (in particular chapter IV.B.2.3., on the refusal of an application after a single communication and chapter IV.B.2.6., on issuing a further communication). In **opposition proceedings** the right to be heard is inextricably linked to the principle of **equal treatment**, see chapter IV.C.6.1. and, with regard to opposition appeal proceedings, chapter V.B.4.3.6 on boards' obligation to

remain neutral; as to the opposition division's obligation to invite the parties as often as necessary to file observations, see chapter IV.C.6.2.; as to the opportunity to comment on new grounds of opposition, see chapter IV.C.3.4.6. With regard to the observance of the right to be heard in the context of the taking of **evidence**, see chapter III.G.3.3. The right to be heard may also play a role in the decision whether to accept **late-filed submissions** (see chapter IV.C.4. "Late submission of documents, lines of attack and arguments"). With regard to the requirement for **reasoned decisions** under R. 111(2) EPC, see chapter III.K.3.4.

2. The right to be heard under Article 113(1) EPC

2.1. Violation of the right to be heard examined ex officio

The boards of appeal can examine the facts of the case of their own motion pursuant to Art. 114(1) EPC and verify whether or not Art. 113 EPC has been complied with by the departments of first instance (see e.g. **T 186/02**, **T 2276/22**).

2.2. Decisions within the meaning of Article 113(1) EPC

Article 113(1) EPC requires that **decisions** may only be based on grounds on which the parties concerned have had an opportunity to present their comments.

In **T 2175/15** the board found that the contents of a communication stating the board's preliminary opinion could not constitute a violation of the right to be heard. This already followed from the wording of Art. 113(1) EPC. It was far more the case that a communication stating the board's provisional opinion was to be seen as safeguarding the parties' right to be heard.

2.3. Causal link between the violation of the right to be heard and the final decision

2.3.1 Appeal proceedings

When reviewing appeal proceedings, the Enlarged Board's review is limited to "fundamental" violations of the right to be heard. This requires a causal link between the alleged violation and the final decision. Such a causal link does not exist when, even if a procedural violation can be demonstrated, the same decision would have been taken for other reasons (see chapter V.B.4.3.2 "Fundamental" violation of Article 113 EPC – causal link and adverse effect").

2.3.2 First-instance proceedings

When reviewing first-instance proceedings the boards' review is, in principle, not limited to fundamental violations of the right to be heard.

However, remitting a case to the department of first instance under Art. 11 RPBA also requires a "fundamental" deficiency in first-instance proceedings, and under R. 103(1)(a) EPC the appeal fee is only reimbursed in case of a "substantial" procedural

violation. In **T 689/05** the board linked these concepts, stating that a "fundamental" deficiency within the meaning of Art. 11 RPBA is not caused by all procedural violations but rather only by a "substantial" procedural violation. See also chapters V.A.9.4. "Remittal following fundamental deficiencies", V.A.11.6. "Substantial procedural violation" and V.A.11.7.1 "Causal link between substantial procedural violation and filing of appeal".

In **T 1550/18** the board concluded that in view of a causal link between the infringement of the right to be heard and the decision handed down by the examining division, the infringement constituted a substantial procedural violation justifying the reimbursement of the appeal fee under R. 103(1)(a) EPC and a fundamental deficiency requiring an immediate remittal of the case to the department of first instance under Art. 11 RPBA (see also **T 1655/21** and **T 1677/21**). In **J 7/83** a substantial procedural violation was defined as an objective deficiency **affecting** the entire proceedings (see also **T 1529/20** and **T 135/22**), in **J 11/20** as **affecting** the reasons on which the appealed decision was taken (see also **T 135/22**) and in **T 682/91** as a deficiency adversely **affecting** the rights of the parties (see chapter V.A.11.6.2 "Violation must be substantial and affect the entire proceedings").

In **T 2024/21** the examining division did not appoint oral proceedings requested repeatedly by the applicant in particular for the discussion of the objections under Art. 84 and 123(2) EPC. According to the board, the examining division's approach of informing the applicant at that stage of the proceedings that it had not admitted the amended documents of the patent application under R. 137(3) EPC and that there had therefore been no valid text to which the applicant had given its consent under Art. 113(2) EPC constituted a substantial procedural violation. Moreover, it was evident from the further course of the proceedings that this procedural deficiency had adversely affected the entire further proceedings.

In **T 990/91** the lack of opportunity to reply to a supererogatory and incidental argument put forward by the examining division could not be considered to be a violation of the right to be heard, let alone a substantial one.

2.4. Surprising grounds or evidence

2.4.1 General principles

Article 113(1) EPC requires that decisions may only be based on grounds or evidence on which the parties concerned have had an opportunity to present their comments.

According to the Enlarged Board (see chapter V.B.4.3.9 "Reasons for a decision allegedly surprising"), this implies that a party may not be taken by surprise by the reasons of a decision, referring to unknown grounds or evidence (**R 3/13**, **R 5/22**; see also **T 1378/11**). A purely subjective surprise, however, has no bearing on whether a party had an adequate opportunity to comment. "Grounds or evidence" within the meaning of Art. 113(1) EPC need not emanate from the board, it is sufficient if another party raises the objection (**R 2/08**). If the reason given in a decision corresponds to an argument put forward by the other party (see also **T 405/94**), the petitioner was aware of it and thus not taken by surprise (**R 4/08**, **R 12/09** of 15 January 2010, **R 8/14**) unless the board clearly indicated

that it regarded those arguments as not convincing (**R 11/12**). While Art. 113(1) EPC presupposes that the opportunity to present comments must not be of a purely theoretical nature, it does not release a party from its obligation to present its response promptly (**R 24/22**).

Although parties may not be taken by surprise by the reasons for a decision, it is also settled case law of the Enlarged Board under Art. 112a EPC that a board of appeal is not required to provide the parties in advance with all foreseeable arguments in favour of or against a request. In other words, parties are not entitled to advance indications of all reasons for a decision in detail (see chapter V.B.4.3.5 "No obligation to provide detailed reasons for a decision in advance"). In **T 1634/10**, **T 2405/10**, **T 1378/11** and **T 1090/18** the boards explicitly applied this case law of the Enlarged Board in relation to Art. 112a EPC to first-instance proceedings.

In **T 996/09** the board held that the right to be heard was a fundamental guarantor for the parties that proceedings before the EPO would be conducted fairly and openly (with further reference to **J 20/85** and **J 3/90**) and was intended to ensure that the parties to the proceedings were not taken by surprise by grounds mentioned in an adverse decision (following **T 669/90**, **T 892/92**, **T 594/00** and **T 343/01**; see also **T 197/88**, **T 220/93**). In **T 435/07** the board held that the grounds on which a decision were based had to be communicated to the applicants in such a way that they were put in the position to defend their rights. An objection against the grant of a patent had to be raised in such a way that the applicants were able to understand its factual basis and to react accordingly without first having to guess what the examining division might have had in mind. According to the board in **T 898/21**, the crucial factor was not whether the department of first instance would have come to the same conclusion after hearing the parties on a specific objection, but whether the parties were given an opportunity to comment on that objection.

In **T 1065/16**, lack of reproducibility as a ground for opposition had not been a subject of the opposition proceedings until the oral proceedings. It therefore amounted to a fresh ground for opposition and its introduction came as a surprise. In its summons, the opposition division had expressly stated that only novelty and the inventive step of claim 1's subject-matter were to be examined. As the patent proprietor had not been given sufficient opportunity to comment on this new ground for opposition, the opposition division had infringed Art. 113(1) EPC and thus committed a substantial procedural violation.

In **T 2351/16** the board found that the examining division had issued a decision of refusal after only one communication under Art. 94(3) EPC as such did not constitute a violation of the appellant's right to be heard (see also chapter IV.B.2.3. "Refusal after a single communication"). However, in its decision the examining division had raised (for the first time) an additional argument in support of the division's objection, following the applicant's reply to the Art. 94(3) EPC communication. This constituted a violation of the applicant's right to be heard and, therefore, a substantial procedural violation.

In **T 2054/19** the Art. 94(3) EPC communication had concerned a different set of claims compared to the one underlying the decision by the examining division to refuse the application. The applicant had neither been made aware that the examining division had

considered the scope of claim 1 before it to be identical to the scope of claim 1 as originally filed and objected to in the European search report, nor of the fact that it had relied on the search opinion. The board held that in this case the immediate refusal of the application following the Art. 94(3) EPC communication amounted to a violation of the right to be heard.

In **T 505/20** the board held that the opposition division's failure to consider the valid claim as submitted at the oral proceedings had resulted, among others, in the violation of the appellants' right to be heard. The opposition division had decided that the patent could be maintained in amended form on the basis of this claim request for reasons that the appellants had not been given the opportunity to comment on. This constituted a substantial procedural violation.

In **T 1198/20** the board confirmed that Art. 101(1), second sentence, EPC did not require the opposition division to send a communication with a preliminary opinion before giving its decision. It merely required the opposition division to invite the parties to file observations on communications from another party or issued by itself "as often as necessary" in order to satisfy the right to be heard under Art. 113(1) EPC. The board found that the opposition division had based its decision on the grounds and evidence set out in the notice of opposition, i.e. on grounds and evidence on which the patent proprietor had already had an opportunity to present its comments. The board, thus, considered the requirements of Art. 113(1) EPC fulfilled.

In **T 1976/22** the board found that the appellant's rights under Art. 113 EPC were fully respected by the board's immediate decision in writing since it had been issued on the basis of the appealed decision and the statement of grounds of appeal.

2.4.2 The meaning of "grounds or evidence"

"Grounds or evidence" under Art. 113(1) EPC are to be understood as meaning the essential legal and factual reasoning on which the decision is based (**R 16/13**, **R 5/22**, **T 532/91**, **T 105/93**, **T 187/95**, **T 1154/04**, **T 305/14**). In **T 951/92** (OJ 1996, 53) the board ruled that the term "grounds or evidence" should not be narrowly interpreted and was to be understood as referring to the legal and factual reasons leading to refusal of the application, and not in the narrow sense of a requirement of the EPC (see also **T 1423/15** and **T 2276/22**).

In **T 556/15**, the examining division's impugned decision was based entirely on a lack of compliance with Art. 123(2) EPC. The board compared the objections under Art. 123(2) EPC raised by the examining division in its two communications with those forming the grounds for its decision. The appellant had never had a chance to comment on those grounds. In the board's view, the term "grounds or evidence" in Art. 113(1) EPC was not to be interpreted narrowly but rather within the meaning of **T 951/92** (see also **T 233/18**). However, this case differed from **T 951/92**; in **T 556/15** the examining division's communications contained objections under Art. 123(2) EPC that, while detailed, did not concern any of the matters on which the decision was ultimately based. The appellant had thus been unaware of which features of the claims under discussion had violated

Art. 123(2) EPC until it received the decision, despite the appellant having had several opportunities to amend the claims before the decision.

In **T 375/00** the appellant (opponent) considered that the technical problem mentioned by the opposition division in its decision was different from that discussed in the preceding proceedings. The board held that the appellant's right to be heard had not been violated, because the definition of the objective problem was part of the arguments, not part of the grounds as specified in Art. 113(1) EPC.

In **T 33/93** the board stated that the citation of a board of appeal decision for the first time in the decision under appeal was not a fresh ground or piece of evidence within the meaning of Art. 113(1) EPC, but a mere repetition of arguments, since it only confirmed the position duly brought to the appellant's attention.

In **T 1634/10** the examining division had issued a reasoned communication setting out its objections in the light of two prior art documents. The board held that the mere fact that the examining division had not agreed with the submission of the appellant did not amount to a breach of the right to be heard.

In **T 2238/11** the appellant argued that the examining division had surprisingly concluded in the "Further Remarks" section in the decision under appeal that the claimed subject-matter lacked novelty and objected that it had not been heard on that aspect. However, the decision under appeal had been based on lack of inventive step, not on lack of novelty. The board held that a party's right to be heard was not violated if the party did not have the opportunity to comment on observations in an obiter dictum (**T 725/05** and **T 726/10**). The "Further Remarks" section in the decision under appeal did not form part of the actual decision. See also **R 5/22**. The board in **T 1019/22** held that the requirements of Art. 113(1) EPC were, however, contravened if the decision was subsequently based on an "omitted" ground contained in an obiter dictum. In the case in hand, the obiter dictum provided for an assessment of inventive step on the basis of D11. It was apparent to the board that the use of an obiter dictum had not been appropriate, at least owing to the fact that it had contained a part of the finding on which the decision was based. The board concluded that it was not possible to establish that D11 as the closest prior art had not been in the opposition proceedings. The discussion in the opposition proceedings of document D11 as the closest prior art, however, did not appear to have been complete and the board could not ascertain that both parties had been heard on the substance of this issue.

2.4.3 Opportunity to comment on evidence

In **J 20/85** (OJ 1987, 102) the Legal Board pointed out that a decision on an issue of fact could only properly be made by the EPO after all the evidence on which such decision was to be based had been identified and communicated to the party concerned. In **T 820/10** the examining division refused the application on the ground of lack of inventive step in view of documents that were cited for the very first time in the appealed decision itself. The board held that the decision therefore relied upon evidence on which the applicant had not had an opportunity to present its comments. Furthermore, in **J 3/90** (OJ 1991, 550)

the Legal Board held that where the EPO had examined the facts, Art. 113(1) EPC was not complied with unless the parties concerned had been fully informed about the enquiries made, and of the results, and had then been given sufficient opportunity to present their comments before any decision was issued (see also **J 16/04**).

In **T 1677/21** the board expressed the view that the reasoning of the opposition division could only be followed if the table on page 8 of D7 was actually taken into consideration. This table was, however, not available in English and was addressed for the first time during the oral proceedings. The board found that the decision was thus based on facts and evidence on which the patentee had had no opportunity to present their comments; the patentee could not have been expected to provide comments before the oral proceedings and the relevant facts had not been provided in an EPO official language. This constituted a violation of the appellant's right to be heard (see also chapter III.I.8 "Opposition procedure").

In **T 1401/16** the examining division based its conclusions concerning critical issues, at least in part, on two Wikipedia entries cited in the decision. However, this evidence was never referred to during the examination proceedings and both entries were mentioned for the very first time in the appealed decision itself. In consequence, the applicant had no opportunity to present its comments in that respect. This constituted a violation of the provisions of Art. 113(1) EPC.

See also chapter III.G.3.3. "Right to be heard".

2.4.4 Documents supplied by applicants but used against them

The right to be heard has not been observed if a decision to refuse an application is based essentially on documents which, though supplied by the applicant in support of its case, are used against it to produce an effect on which it has not had an opportunity to make observations (see **T 18/81**, OJ 1985, 166 and **T 188/95**).

2.4.5 Document cited containing information already known

In **T 643/96** the examining division relied in its decision on a document for which it gave only incomplete bibliographic data. The board held that the examining division's failure to provide the applicant with a copy of the document did not amount to a substantial procedural violation (regarding the right to be heard) because the document added nothing to the case, and contained only information already known to the applicant. See also **T 1564/18** in which no communication of the examining division contained the essential legal and factual reasons leading to the finding in the appealed decision that claim 1 of the main request lacked novelty over the prior-art device considered for the first time in the novelty assessment of the refusal. Since no reason had been given why the amendments made in advance of the oral proceedings held in absentia justified the change to this new closest prior art, the decision was issued in violation of the right to be heard even though the prior-art device on which the refusal was based was disclosed in the same document as a closest prior art considered previously in the examination procedure.

2.4.6 Reliance on the International Preliminary Examination Report

In **T 587/02** the board held that if the only communication preceding the decision to refuse an application merely draws attention to an IPER, the requirements of Art. 113(1) EPC are met provided the IPER constitutes a reasoned statement as required by R. 51(3) EPC 1973 (R. 71(2) EPC), using language corresponding to that of the EPC; in the case of an inventive-step objection this requires a logical chain of reasoning which can be understood and, if appropriate, answered by the applicant. In the case in hand, the IPER did not fulfil these requirements, and the board held that the applicant's right to be heard had been violated (see also **T 1020/15**).

In **T 1065/99** the board stated that when an IPER drawn up by the EPO under the PCT was relied on by the examining division, such reliance should not be presented to applicants in such a manner as to suggest that the examining division had not given objective consideration to the patentability requirements of the EPC. In this case, the IPER had been adopted by the examining division as the only basis for its opinion that the application did not meet the requirements of the EPC. The board came to the conclusion that there were three objections which were only obliquely touched upon in the IPER, and thus in the communication under R. 51(2) EPC 1973 (R. 71(1) EPC). Therefore, the party had had no opportunity to contest those objections.

2.4.7 No sufficient time for an adequate response to the deciding body's objections

In **T 2535/22** the board pointed out that if an applicant was of the opinion that they had not had enough time for an adequate response to the deciding body's objections, it was their duty to either request more time or a postponement of the oral proceedings. In the examination proceedings, the appellant (applicant) had filed a further amended set of claims one day before the oral proceedings. All requests had been discussed with respect to their admittance and, for those admitted, with respect to their allowability, during the oral proceedings. In the absence of information to the contrary in the minutes of the oral proceedings, the board was of the opinion that the appellant had not established that it had not been given enough time to react to all objections on which the appealed decision was based. The board concluded that the examining division had not violated the appellant's right to be heard.

2.4.8 Change of provisional opinion

In **T 68/94** the appellant submitted that the opposition division had violated Art. 113 EPC by changing its provisional opinion after the oral proceedings without giving the appellants an opportunity to comment on the grounds on which the contested decision was based. The board pointed out that provisional opinions were never binding. The purpose of oral proceedings was to summarise and discuss the parties' arguments. All arguments in the case had been known to both parties**.**

In **T 1824/15**, the board held that the members of an examining division were free to change their minds at any point in the procedure, including during oral proceedings, as long as the requirements of Art. 113(1) EPC were fulfilled.

In **T 1094/20** the board likewise held that an opposition division is at liberty to change its provisional opinion, but that this must be reasoned in a comprehensible way in the decision.

2.4.9 Statement of grounds of appeal not received by respondent

For the EPO's failure to deliver the opponent's statement of grounds of appeal to the patentee (respondent) see chapter V.B.4.3.21 "Successful petitions under Article 112a(2)(c) EPC".

2.4.10 Patent proprietor unaware of opposition proceedings

In **T 1529/20** the appellant argued that they received neither the communication informing them about the notice of opposition (EPO Form 2316), nor the communication under R. 79(1) EPC, which would have given them the opportunity to file observations and amendments in response to the opposition (EPO Form 2317), nor the decision of the opposition division revoking their patent. The board held that, as a matter of principle, the notice of initiation of proceedings must be duly served on the persons/legal entities against whom the decision takes effect or who/which may be adversely affected by it. The communication under R. 79(1) EPC was not a mere formality. Rather, it had the function of allowing the patent proprietor to both contribute to the opposition division's appreciation of the facts and to defend its interests. The board found that the missing opportunity of the appellant to present their arguments during the opposition proceedings amounted to a substantial procedural violation in the sense of Art. 113(1) EPC. See also chapters III.S.2.1. "Notification by postal services", III.S.5. "Burden of proof and safeguards", IV.C.2.2.8f) "No burden of proof with regard to negative facts" and IV.C.6.4. "EPO communication concerning submissions by the other party – adequate opportunity to reply".

2.5. Consideration of the parties' arguments, requests, evidence and other submissions

2.5.1 General principles

The right to be heard under Art. 113(1) EPC requires that those involved be given an opportunity not only to present comments (on the facts and considerations pertinent to the decision) but also to have those comments considered, that is, reviewed with respect to their relevance for the decision on the matter (see, with regard to Art. 112a EPC, chapter V.B.4.3.11 "Consideration of the parties' arguments in the written decision" and, with regard to R. 111(2) EPC, chapter III.K.3.4. "Reasons for the decision"). However, it is not necessary to consider each and every argument of the parties in detail in a decision. The boards may also refute arguments implicitly, and may disregard irrelevant arguments (**R 5/15**). Furthermore, according to the Enlarged Board in **R 10/18**, a board is presumed to have taken into account a party's submissions that it did not address in the reasons for its decision. An exception may apply if there were indications to the contrary, e.g. if a board did not address in the reasons for its decision submissions by a party that, on an objective basis, were decisive for the outcome of the case, or it dismissed such submissions without

first assessing them as to their correctness. See also **T 1550/18** in which the board applied these principles by analogy to a department of first instance, as well as chapter III.K.3.4.2 "Right to be heard – right to have submissions taken into consideration".

In **R 6/20** the Enlarged Board clarified that the requirement that "the Board substantively considered those submissions" (point 1, second paragraph, of the Catchword in **R 10/18**) should be given the meaning that "the Board considered the contents of those submissions", with this consideration comprising matters pertaining to admittance of facts, evidence and requests, and/or relating to substantive law, i.e. the merits of a case. See also chapters III.K.3.4.2 "Right to be heard – right to have submissions taken into consideration" and V.B.4.3.11 "Consideration of the parties' arguments in the written decision".

2.5.2 Decision must demonstrably show that arguments were heard and considered

The deciding department must demonstrably hear and consider parties' comments (**T 206/10**, with further reference to **T 763/04**, **T 246/08**; see also **T 1709/06**, **T 645/11**). Merely repeating the parties' submissions is not enough; rather, it has to be clear from the reasons that the substance of their core arguments has been addressed in arriving at the decision (**T 2352/13**).

A decision which fails to take into account the arguments submitted by a party and which is based on a ground on which the party had had no opportunity to present its comments, contravenes Art. 113(1) EPC and this constitutes a substantial procedural violation (see **J 7/82**, OJ 1982, 391; **T 778/98**, **T 1039/00**, **T 1312/10**). When a decision refusing an application is based on several grounds supported by respective arguments and evidence, it is of fundamental importance that the decision as a whole meets the requirements of Art. 113(1) EPC (**T 1034/11**). A decision must show that all potentially refutative arguments adduced by a party are actually refutable (see **T 246/08**, **T 337/17**, **T 1655/21**). See also chapter III.K.3.4.2 "Right to be heard – right to have submissions taken into consideration".

In **T 763/04** the board held that Art. 113(1) EPC is contravened if facts and arguments which, according to the appellant, are clearly central to their case and which may speak against the decision taken, are completely disregarded in that decision. See also **T 2227/09**, **T 1898/11**, **T 1206/12**, **T 1592/13**, **T 212/17** and **T 1655/21**. According to **T 740/93**, in addition to the logical chain of facts and reasons, the decision should include some motivation on the crucial points of dispute. In **T 1557/07** the board held that the examining division had commented on the crucial points of dispute, giving the applicants a fair idea of why their submissions were not considered convincing. In **T 2012/17** the board found that the contested decision neither explicitly nor implicitly addressed the appellant's arguments with respect to at least two crucial points of dispute. See also **T 431/21**.

In **T 1094/20** the board held that the opponent's argument that the patent proprietor's right to be heard could not have been violated in view of the fact that the oral proceedings had lasted over ten hours was invalid. The board cited established case law according to which

the right to be heard is not just the right to present views, but also to have those views duly taken into consideration in the decision. In the board's opinion, the failure to consider core arguments on features whose disclosure was essential for the assessment of patentability was a substantial procedural violation.

In **T 1843/11** the appellant alleged that a substantial procedural violation had occurred because it had raised an argument concerning sufficiency of disclosure that had not been addressed in the decision of the opposition division. The board recalled that, according to R. 111(2) EPC, decisions of the EPO which are open to appeal must be reasoned. Although the opposition division was not required to address each and every argument of a party (see in this chapter III.B.2.5.3), the important question was whether the party concerned could objectively understand whether the decision was justified or not. The decision should contain at least some reasoning on crucial points of dispute, in order to give the party concerned a fair idea of why its submissions were not considered convincing and to enable it to base its grounds of appeal on relevant issues (see **T 70/02**). According to the board, it was not sufficient for the requirements of Art. 113(1) EPC to be met that the appellant had been given the opportunity to (and in fact had) put forward the argument. What was additionally important was that the opposition division demonstrably heard and considered this argument (see **T 763/04**). As this condition had not been met, a substantial procedural violation had occurred. See also **T 689/20** in chapter III.K.3.4.4 "Deficient reasons".

In the case at issue in **T 1411/07**, the patent proprietor had challenged the admissibility of the opposition on the ground of lack of substantiation, but the opposition division had found it admissible without stating any reasons. The board considered the opposition division's failure to make any reference to the patent proprietor's submissions a breach of R. 68(2) EPC 1973 (R. 111(2) EPC) and a substantial procedural violation.

In **T 655/13** the board held that the examining division would need to provide the translation of at least the referenced larger section of document D1 on which it based its reasoning, or identify the relevant passage as clearly as possible, to enable the appellants (and if necessary the board) to understand and verify whether the examining division had taken their arguments into account, thereby respecting their right to be heard.

In **T 1385/16** there was no discussion in the decision under appeal of the appellant's submissions made in letters of 12 December 2012 and 17 August 2012 regarding application of the Guidelines H-V, 3.2.1 and H-V, 3.1 at that time, which it regarded as being relevant to the question of assessing whether the amendment constituted an unallowable intermediate generalisation. Indeed the board held that there did not appear to have been any adequate discussion of these submissions at any point during the examination procedure. Since the examining division had failed to address fundamental submissions made by the appellant in the decision under appeal, the board found that a substantial procedural violation had occurred.

In **T 2188/22** the board found that the appellant's right to be heard had been violated, since the parties had neither been heard on the question of admissibility of auxiliary requests 3 to 17 (filed in the written proceedings), nor had the content of those auxiliary

requests been discussed in the proceedings before the opposition division. According to the board, this constituted a "serious procedural deficiency", which justified the setting aside of the contested decision, the remittal of the case to the opposition division and the reimbursement of the appeal fee (see also chapter III.I.8. "Opposition procedure").

According to the board in **T 2054/19**, the appellant's argument, whilst made in the context of a different set of claims, had also been relevant to the claims as originally filed and to the claims underlying the decision. The board stated that the decision had failed, however, to address, explicitly or implicitly, this argument. In **T 1997/21** the applicant made a written request for a "decision on the file as it stands". The board was of the opinion that, by including detailed statements in the same letter and introducing new arguments, the applicant had nevertheless created a situation in which a decision merely referring to earlier "communications" was not permissible from a procedural point of view. According to the board, the decision should have dealt with the new arguments put forward in any case. See also chapter III.K.3.4.4b) "Deficient reasoning insufficient for the purposes of Rule 111(2) EPC".

In **T 238/94** the board considered that, although the opposition division's decision indeed contained no direct reference to the appellants' submissions concerning lack of inventive step, the opposition division had considered in its decision the disclosures of all the documents cited by the appellants and respondents, and also the possible combinations of their teachings. Thus, in the board's view, the appellants' submissions had actually been taken into account, albeit indirectly, in the process of arriving at the contested decision (see also **T 1004/96**).

In **T 1230/15** the board found that the appellant's (opponent's) apparent understanding that there existed an absolute right to present all possible inventive-step attacks orally before the opposition division – and that anything else constituted a violation of the right to be heard – was in fundamental contradiction to the problem-solution approach as applied by the departments of the EPO for assessing inventive step. That the discussion to establish the (single) closest prior art had not taken place with the necessary clarity of purpose, or may have even been omitted, was, on its own, not sufficient for the board to decide that a violation of the right to be heard had occurred, let alone a substantial one.

In **T 1068/20** the appellant (applicant) had contested the examining division's broad interpretation of one of the features of the claim. The board stated that it did not matter, in respect of the right to be heard, whether the examining division had adopted a correct or an incorrect interpretation of the feature in question. However, it should have explained why the arguments of the appellant contesting this interpretation were not convincing.

2.5.3 No obligation to address each and every argument

Provided that the reasons given enable the parties concerned to understand whether the decision was justified or not, the deciding organ is under no obligation to address each and every argument presented by the party concerned (see chapter V.B.4.3.11 "Consideration of the parties' arguments in the written decision"; see also **T 1557/07** quoted in **T 1969/07**, **T 698/10**, **T 1199/10**, **T 1898/11**, **T 1961/13** and **T 1094/20**).

Moreover, a party has no absolute right to be heard separately on each and every one of its auxiliary requests (see also chapter V.B.4.3.14 "No right to be heard separately on all requests").

2.5.4 Failure to consider submissions made after a communication

In **T 1709/06** it was held that, not only must an opportunity to present comments be given, but these comments must actually be taken into account (see also in this chapter III.B.2.5.2). The decision "on the state of the file" expressly stated that the applicant had filed no submissions after the final communication, which was incorrect. Because the examining division had therefore ignored potentially significant arguments presented in a reply following a communication containing a new objection, the applicant had been denied its right to comment on all the grounds for refusing the application.

In **T 1456/22** the board held that the examining division's decision to grant had overlooked a higher-ranking request for deferment. This had constituted a breach of the applicant's right to be heard. In **J 11/20** the Legal Board saw a substantial procedural violation in the fact that the Receiving Section had disregarded the appellant's objection of lack of receipt of the communication inviting them to remedy formal deficiencies, and given no consideration to the request for re-establishment of rights. The Legal Board held that, by simply disregarding the appellant's submissions, the Receiving Section had violated the right to be heard.

The board in **T 1997/08** held that for an examining division not to violate an applicant's right to be heard, its decision had to actually address the arguments put forward by the applicant in its reply to the communication (see also **T 1068/20**). It may be assumed that the right to be heard has been contravened if the reasons given for the examining division's decision merely repeat the reasons given for the communication issued before the said reply (see also **T 116/12**).

In **T 921/94** the board held that the appellant's bona fide submissions and the technical information provided in reply to a communication substantially changed the points at issue, and that the examining division had an obligation under Art. 96(2) EPC 1973 (Art. 94(3) EPC) and 113(1) EPC to inform the appellant of the objections arising in the new situation and to invite it to file further observations before refusing the application. A decision which only comprises a mere formal acknowledgement of the applicant's submissions, without dealing with them in substance, contravenes the general principle of good faith and fair proceedings that reasoned decisions contain at least some reasoning on the crucial points of dispute in order to give the party concerned a fair idea of why their submissions were not considered convincing (see also **T 1154/04**).

In **T 452/16** the board found that just indicating that the applicant's arguments filed in response to a communication were unconvincing, without addressing them in detail, might be sufficient in a communication preparing oral proceedings. However, the mere reference to such a communication could not suitably replace the grounds for a decision to refuse the application, because the reasons why the examining division upheld its opinion were obscure.

In **T 296/96** the applicant had submitted unconvincing arguments in its reply to the first and only communication. The examining division refused the application on the basis of the objections mentioned in the first communication, and did not issue a second one. Since, however, the main arguments for refusing the application were a mere repetition of those mentioned in the first communication, the contested decision was based on grounds on which the applicant had had an opportunity to present its comments (see also **T 2316/10**).

2.5.5 Failure to consider evidence

According to **T 1536/08** it is well-established in the jurisprudence of the boards of appeal (see e.g. **J 7/82**, **T 94/84** and **T 135/96**) that the right to be heard enshrined in Art. 113(1) EPC also guarantees the right to have relevant grounds that could potentially influence the outcome taken into account in the written decision. A decision rejecting the opposition must therefore take into account the ground(s) for opposition raised as well as facts and evidence put forward in support of these grounds, including the cited prior art documents. Failure to consider evidence will normally constitute a substantial procedural violation of this fundamental right as it deprives the party of the right to have its case fully heard (see also **T 1098/07** below). In the case at issue, the opposition division had completely ignored the unambiguous offer by the opponent in the notice of opposition to provide the original printed versions of crucial prior art documents. The failure to consider this offer constituted a violation of the right to be heard.

In **T 1110/03** (OJ 2005, 302) the board held that enshrined in Art. 113(1) and Art. 117(1) EPC is a basic procedural right generally recognised in the contracting states, i.e. the right to give evidence in appropriate form, specifically by the production of documents (Art. 117(1)(c) EPC), and the right to have that evidence heard. See also **T 2294/12** in which one of the appellants had submitted two sets of comparative tests during the written phase; with reference to the right to give evidence in an appropriate form as set out in **T 1110/03**, the board held that the examining division had denied the appellants their right to be heard because the decision under appeal gave no reason why the division had found the first set irrelevant and did not even mention the second.

In **T 1098/07** the board stated that failure to consider evidence will normally constitute a substantial procedural violation in that it deprives a party of basic rights enshrined in Art. 113(1) and Art. 117(1) EPC. In the board's opinion, certain factors may nevertheless mitigate the severity of the violation. Thus, whether or not a failure of the decision to expressly mention material offered by a party in support of its case constitutes a substantial procedural violation will depend on the (prima facie) significance and evidential value of such material. The questions to be asked are: what facts is it intended to prove, how relevant is it to these facts and how likely is it that it will prove them? In the case at issue, the failure to consider the evidence was a pardonable error that had not deprived the appellant of any fundamental rights.

In **T 21/09** the board held that the opposition division had either (i) disregarded the experimental evidence submitted by the appellant as late-filed, or (ii) considered the evidence, but failed to give proper reasons why it did not support the alleged technical

effects. In the first case, the patent proprietor had not been heard on the admission of the evidence, and, more importantly, the decision was absolutely silent about it. In the second case, the decision under appeal suffered from a severe deficiency in the reasons given by the opposition division for the adverse findings on inventive step. In either case, the decision could not be regarded as being in conformity with R. 111(2) EPC.

In **T 2415/09** the appellant (patent proprietor) argued that new documents and experiments submitted by the respondent had only been transmitted to the appellant six weeks before the oral proceedings before the opposition division. The board said it could not comment on the exact period needed to conduct comparative experiments. Even if the periods specified in R. 132(2) EPC did not apply in the case in point (R. 116(1) EPC), they showed that a party could not be required to conduct comparative experiments in a period as short as six weeks. The board concluded that the opposition division had failed to respect the appellant's right to be heard.

In **T 94/84** (OJ 1986, 337) the board held that the right to be heard guarantees that grounds put forward are taken into consideration, and was contravened because a translation, subsequently filed in an official language, of a Japanese document cited in due time was disallowed.

In **T 2541/11** the appellant (opponent) submitted that the non-admission of a document without a full discussion as to its relevance violated its right to be heard. The board stated that a right to present all arguments as if the document had been admitted, instead of arguments as to why it should be admitted, amounted to a de facto admittance of the document, implying, contrary to Art. 114(2) EPC, that the board had no discretion to disregard a late-filed document. According to the board, the right to respond is not absolute but must be balanced inter alia against the need for procedural economy and due diligence that underpins Art. 114(2) EPC, which affords the board discretionary power to disregard evidence not submitted in due time.

See also chapter III.G.3.3. "Right to be heard".

2.5.6 Mere reference to jurisprudence

In **T 1205/12** the board stated that according to established jurisprudence of the boards of appeal Art. 113(1) EPC is contravened where facts and arguments, which from the appellant's submissions are clearly central to their case are completely disregarded in the decision. The board held that the applicant's arguments had not been dealt with in the impugned decision and stated that the mere reference to jurisprudence of the boards of appeal does not, by itself, constitute or replace an argument in a first-instance decision. If a deciding body, in a decision, wants to rely on an argument put forward in a decision of the boards it is insufficient merely to refer to it or to recite it. The deciding body must also make clear that it adopts the argument and explain why, in what respect and to what extent this argument applies to the case at hand (see also **T 1206/12**, **T 1592/13**).

2.6. The right to be heard and the timing of decisions

2.6.1 Decision could not be expected

In **T 849/03** the board held that a decision should not catch the parties unawares. In the examination procedure the right to be heard is therefore violated not only in the event of failure to inform the applicant beforehand of the reasons forming the basis of a rejection but also if, at the time the decision is issued, the applicant had no reason to expect such a decision (see also **T 1022/98** and chapter V.B.4.3.10 "Timing of a decision allegedly surprising").

In **T 611/01** the board decided that a substantial procedural violation was occasioned by the examining division holding out to the appellants the prospect of a further opportunity to file arguments before any decision would be issued, and then issuing the decision without providing for that opportunity (regarding a false impression raised concerning amended claims, see also **T 309/94**).

In **T 2054/19** the examining division had raised objections under R. 137(4) and 137(5) EPC in its Art. 94(3) EPC communication and indicated therein that it had been "at present not practicable to carry out a full examination of the application". In response the applicant filed a new set of claims, upon which the examining division based its decision to refuse the application. The board held that when the applicant had sought to remedy deficiencies by filing a new set of claims, they could expect that the examination proceedings would be continued. The board found that the appellant had been taken by surprise by the timing of the decision.

In **T 966/02** the board stated that it had been clear that the appellant (patent proprietor) had regarded both filed notices of opposition as inadmissible and had thus felt that there was no sense in commenting on the facts until the situation had been clarified. The appellant could not have foreseen that the opposition division would give a final decision without first clarifying the procedural situation, and it came as a complete surprise to it that it did so.

In **T 922/02** (ex parte) the board stated that the provisions of Art. 113(1) EPC were only complied with in a case where the decision was taken after remittal for further prosecution, if the notification and invitation was made after the remittal, typically by announcing the resumption of the proceedings, setting out the objections, if any, and asking the appellant whether or not they wished, within a fixed period of time, to present their comments or modify their request(s). Otherwise any final decision would come as a surprise to the appellant, which was contrary to the principle of good faith and fair hearing established by Art. 113(1) EPC. The board followed in this respect the case law developed in **T 892/92** (OJ 1994, 664) and **T 120/96** for opposition proceedings, which was equally applicable to examination proceedings, because the right to be heard was an essential procedural principle governing both procedures.

In **T 281/03** of 17 May 2006 the issue of inventive step was not discussed at the oral proceedings, and the opposition division, after deliberating and announcing its decision on

novelty, immediately announced the decision to reject the oppositions. The board held that, in order to guarantee the right to be heard, there should have been an explicit step, recorded in the minutes, giving the opponent the opportunity to comment on inventive step before the final deliberation, or alternatively an opportunity after the deliberation to comment on the opposition division's conclusion.

In **T 451/06** the board distinguished the situation at hand from that in decision **T 281/03**. In the case underlying **T 281/03**, the opposition division had failed to give the opponent an opportunity to comment on lack of inventive step, thereby depriving the opponent of any possibility of substantiating a ground of opposition (see **G 1/95**). By contrast, in the case in hand, the opponent had been given the opportunity to substantiate the ground of opposition of lack of inventive step. The Chair's invitation to present all the objections in respect of inventive step had in effect been an invitation to the opponent to present both its "main and auxiliary requests". After the initial statement of the Chair that the issue to be discussed was lack of inventive step, the substantiation of the ground of opposition was exclusively the responsibility of the opponent.

2.6.2 Issuing of decision before expiry of time limit to comment

In **T 663/99** the board decided that the patent proprietor's right to be heard was violated if the time limit fixed under R. 57(1) EPC 1973 (R. 79(1) EPC) for presenting comments on the opposition had not expired by the date of handing over a revocation decision to the EPO's internal postal service (see also **T 804/94**).

In **T 1081/02** the board of appeal decided that the principle of the right to be heard had been violated, since the opposition division, after inviting the patent proprietor to file the documents considered necessary to maintain the patent within two months, did not wait until this time limit had expired but issued an interlocutory decision prior to its expiry.

In **T 685/98** (OJ 1999, 346), the board held that the phrase "fails to reply in due time to any invitation under ... paragraph 2" in Art. 96(3) EPC 1973 (Art. 94(4) EPC) had to be construed in the light of the purpose of the invitation pursuant to Art. 96(2) EPC 1973 (Art. 94(3) EPC) and R. 51(2) EPC 1973 (R. 71(1) EPC), which was to afford the applicant an opportunity to exercise their right to present comments in accordance with Art. 113(1) EPC. Hence, a letter from the applicant which neither exercised nor waived that right was not a reply for the purposes of Art. 96(3) EPC 1973 (Art. 94(4) EPC). In the case in hand, the examining division believed erroneously that the applicant, by making a simple procedural request, had forfeited its right to present comments during the remainder of the term set for reply. Thus the precipitate refusal, while there were still some two months of the term for reply unexpired, did contravene Art. 113(1) EPC.

2.6.3 Immediate refusal after communication

An examining division does not exceed its discretionary power by immediately refusing an application after only a single communication. However, the decision must comply with Art. 113(1) EPC, i.e. must be based on grounds on which the applicant has had an opportunity to present comments (see **T 201/98** and **T 1002/03**; see also **T 84/82**,

OJ 1983, 451 and **T 300/89**, OJ 1991, 480; see chapter IV.B.2.3. "Refusal after a single communication"). If the factual basis is not sufficiently given in the single communication so that the applicant has to speculate about the examining division's assessment and thus is not put in the position to properly defend its rights, the requirements of Art. 113(1) EPC are not met; coming to a final decision after such a single deficient communication results therefore in a substantial procedural violation (**T 435/07**).

In **T 305/14** the board stated that only if a preceding communication pursuant to Art. 94(3) EPC sets out the essential legal and factual reasoning to support a finding that a requirement of the EPC has not been met, can a decision based on such a finding be issued without contravening Art. 113(1) EPC. In the case at hand, the board held that the decisive statement had been put forward in the communication in an abstract way only, without the necessary logical chain between the given statement and the particular technical facts of the case. Because the appellant learnt about the essential reasoning for the first time in the impugned decision, it did not have an opportunity to present its comments with respect to that reasoning.

In **T 17/22** the examining division had issued two communications before refusing the patent application. The first was a communication under R. 161(1) and 162 EPC. The second, with a period for reply of one month, was headed "Invitation pursuant to R. 137(4) EPC and Art. 94(3) EPC". The board considered neither of them a substantive communication under Art. 94(3) EPC. The board reasoned, among others, that the short period of one month specified in R. 137(4) EPC was inappropriate for a reply to substantive issues and that the mere reference to Art. 94(3) EPC in the heading of the communication did not affect the conclusion that the communication under R. 137(4) EPC was not a substantive communication under Art. 94(3) EPC. The board held that the omission of a communication under Art. 94(3) EPC, with an appropriate time limit to respond, was a substantial procedural violation as it had deprived the applicant of the opportunity to react to such communication.

2.6.4 Invitation to oral proceedings at short notice

In **T 166/04** the board held that the late introduction of additional prior art documents together with an invitation to oral proceedings was not necessarily improper, even if they formed part of a critical argumentation. The board considered that the time frame of two and a half months for the applicant to respond was in conformity with R. 71(1) EPC 1973 (R. 115(1) EPC) and was not unduly short. Further, apart from the non-extendable time limit, the appellant had had an opportunity to respond to the summons in writing as if it had responded to a communication under Art. 96(2) EPC 1973 (Art. 94(3) EPC), which it had actually done by submitting amendments and further arguments. In addition, the board pointed out that the applicant had decided not to participate in the first-instance oral proceedings during the course of which it could have made further submissions.

2.7. The right to be heard in oral proceedings

The right to oral proceedings regulated by Art. 116(1) EPC forms a substantial part of the right to be heard granted by Art. 113(1) EPC (**T 209/88**, **T 862/98**, **T 1050/09**). The right to

be heard in oral proceedings subsists so long as proceedings are pending before the EPO (**T 598/88**, **T 556/95**, **T 114/09**).

The right to present comments enshrined in Art. 113(1) EPC does not need to be exercised in writing but may be satisfied by way of oral proceedings (**T 1237/07**). This does not mean, however, that it is for the boards to ensure, of their own motion, that all points raised at some point in the proceedings are discussed at the oral proceedings. Rather, it is for the parties to address any point they consider relevant and fear may be overlooked and to insist, if necessary by way of a formal request, that it be discussed (**R 17/11**). This also applies in oral proceedings before the opposition division (**T 7/12**).

In **T 2232/11** the board held that the mere announcement of a further submission based on additional documents, at the opening of the discussion on an invention's reproducibility, was insufficient to oblige the examining division to follow this announcement up ex officio later on in the oral proceedings. The applicant was therefore responsible for notifying the examining division, where necessary via a formal request, of its intention to make further submissions on the topic. Given the course of the proceedings, the applicant ought to have expected that the examining division might reach a final decision after interrupting the proceedings to deliberate.

Conversely, Art. 113(1) EPC cannot be interpreted in a way that a party's right to be heard is already satisfied if a party, having requested oral proceedings according to Art. 116 EPC, has had the opportunity to argue in writing. If this interpretation of Art. 113(1) EPC were to be followed, the parties' right to oral proceedings under Art. 116 EPC would be redundant, with the unacceptable consequence that an opposition division or a board of appeal would be entitled, with regard to a controversial issue discussed during written procedure, to give a decision right at the beginning of oral proceedings without hearing the parties (**T 1077/06**). See also **T 2610/19**, in which the board concluded that the opposition division's refusal to hear the opponent on the relevance of other starting points constituted an infringement of the opponent's right to be heard.

In **T 1414/18** the board held that a statement such as "the next procedural step will be summons to oral proceedings during which the application will be refused" made prior to a final decision to refuse a patent application may infringe a party's right to be heard and thus may lead to a substantial procedural violation. The phrase "will be refused" – on an objective basis – implied that, regardless of any facts or arguments the applicant could potentially have brought forward thenceforth, the application was finally to be refused under Art. 97(2) EPC. Such a conduct of the proceedings was contrary to the very aim and purpose of the right to be heard under Art. 113(1) EPC.

Non-compliance with a request for oral proceedings deprives the party of an important opportunity for presenting its case in the manner it wishes and using the possibilities open to it under the EPC. By virtue of its request for oral proceedings, the party can rely on such proceedings being appointed before an adverse decision is issued, and therefore has no reason to submit further arguments in writing (see **T 209/88**, **T 1050/09**; and also chapter III.C.3. "Right to oral proceedings"). In **T 2024/21** the board concluded that the examining

division's continual refusal to appoint oral proceedings and indeed its explanation for not doing so, had made it evident that the appellant had been left with no realistic possibility to have its request for oral proceedings met. The board noted that, although the appellant had ultimately withdrawn its request for oral proceedings and requested a decision on the state of the file, in view of the overall course of the examination proceedings, it had been deprived of its right to be heard in oral proceedings as enshrined in Art. 113(1) and 116(1) EPC (see also in this chapter III.B.2.3.2, chapter III.C.3.1. "Right to oral proceedings in examination, opposition and appeal proceedings" and chapter III.C.5.3.4 "Duty to hold oral proceedings not affected despite withdrawal of request for oral proceedings").

Conducting oral proceedings effectively and efficiently, although subject to the discretionary power of the Chair, must nevertheless guarantee that the fundamental procedural rights of each party in adversarial proceedings, i.e. the right to fair and equal treatment, including the right to present comments in oral proceedings (Art. 113(1) and 116 EPC) are respected (**T 1027/13**; see also chapter IV.C.6.1. "Principle of equal treatment").

There is no infringement of the right to be heard where an examining division refuses to minute a party's submissions during oral proceedings (**T 1055/05**).

A party's right to be heard under Art. 113(1) EPC does not imply a separate right of the party's representative to be heard and therefore does not imply a right to have oral proceedings before the EPO held by video conference (**T 2068/14**). In **T 1624/20** the board held that deciding to change the format of the oral proceedings to videoconferencing without giving the appellant any prior opportunity to present their comments did not constitute an infringement of the right to be heard. The board noted that there had already been an exhaustive exchange of arguments on the format that oral proceedings were to take prior to them being held (see also **T 250/19)**. The Enlarged Board made it clear in **R 12/22** that a merely theoretical possibility of impaired communication and discussions in oral proceedings held by videoconference before a board of appeal did not amount to a violation of Art. 113(1) EPC. See also chapter III.C.8.3. "Format of oral proceedings".

2.7.1 Introduction of a new claim or relevant document

In a case where an opposition division or a board of appeal feels bound by Art. 114(1) EPC to examine new facts or evidence submitted for the first time during oral proceedings, it must, in accordance with Art. 113(1) EPC, give the other parties the opportunity to comment before issuing a reasoned decision based on such facts or evidence (**G 4/92**, OJ 1994, 149; see also **T 484/90**, OJ 1993, 448; with regard to late submissions see **T 330/88**, **T 356/94** and chapter IV.C.4. "Late submission of documents, lines of attack and arguments"). The same principle has also been applied to decisions of examining divisions (see e.g. **T 376/98**). The applicant does not have a right in principle to continuation in writing; the party's right to be heard under Art. 113(1) EPC is also observed if the applicant is given an adequate amount of time to study the document and present comments. How much time is sufficient depends on the nature of the newly introduced document and the preceding procedure (**T 2434/09**).

At the same time not admitting requests submitted during oral proceedings itself does not constitute a breach of the party's right to be heard, provided that the party had been given the opportunity to comment on their admittance (see e.g. **T 763/15**, **T 2204/18**).

a) Cases in which Article 113(1) EPC was violated in relation to the introduction of new claims or relevant documents

In **T 951/97** (OJ 1998, 440), although document D4 had been mentioned in the European search report, it had not been cited at any stage in the examination procedure prior to the oral proceedings. The board found that the half an hour adjournment of the oral proceedings had been too short a period for an adequate analysis of the complex text of D4. As D4 was essential to the finding of the examining division in relation to inventive step, the decision was based on evidence on which the applicants had not had a sufficient opportunity to present their comments as required by Art. 113(1) EPC (see also **T 492/03**).

In **T 783/89** the opposition division had proposed a new version of the main claim at the start of the oral proceedings, giving the opponents ten minutes to consider it. The board ruled that this had taken the opponents by surprise, and that the time given had not been sufficient to study the allowability of the amendments.

In **T 2235/12** the examining division had introduced, two days before the oral proceedings, two additional documents and a new objection into the procedure. The appellant's request for a postponement of the oral proceedings was rejected, and the appellant did not attend the oral proceedings. The board held that the new objection was not related to the points indicated in the summons and that the appellant should have been given an adequate opportunity to react to the new objection. Attending the oral proceedings would not have changed the fact that the timeframe was too short for the representative to get instructions from the client and to prepare for oral proceedings with a new focus. The board concluded that rejecting the appellant's request for a postponement of the oral proceedings infringed the appellant's right to be heard.

In **T 75/10** the board saw no reason to overturn the opposition division's admission of late-filed documents that appeared highly relevant for novelty. These had been generated from an archive different from the databases commonly used for a prior-art search. The board considered that the opposition division should have granted the patentee's request for postponement of the oral proceedings, after deciding to admit these. The board stated that there was an essential difference between a prima facie assessment of the possible relevance and publication date of a late-filed document for deciding upon its admission into the proceedings and the full in-depth assessment of novelty vis-à-vis such a document, which required determining whether the document was made available to the public before the effective filing date.

In **T 1238/14**, the appellant had filed auxiliary requests 1 and 2 in response to the examining division's summons to oral proceedings, but the division – without holding the oral proceedings – had then decided to refuse the claims according to those auxiliary requests too as not patentable. The defects in those claims had not been communicated to the appellant in advance for comment. Instead, it had first – and only – learned of them

on receiving the decision to refuse the application on the basis of both the main request and the two auxiliary requests. The board held that, where an applicant had been summoned to oral proceedings, it was entitled to assume that they would actually take place and that it would be given an opportunity there to respond to any objections raised by the examining division.

In **T 1558/21** the board considered it as established that the decision of the opposition division was not based on the intended wording of the auxiliary request that had been discussed during oral proceedings. The additional feature of the auxiliary request on which the decision was based, and which was submitted by email during oral proceedings, was ignored during those proceedings. According to the board, the opposition division had decided either on the wrong request not in keeping with the order in the decision, or on a request on which the parties had not been heard (see also this chapter III.B.3.4.). The board found that both scenarios constituted a serious procedural violation.

In **T 482/16** the board concluded that, by rejecting the appellant's request for postponement of the oral proceedings, the examining division had not provided the appellant with the appropriate opportunity to present its comments on documents the examining division had introduced for the first time during the oral proceedings.

b) Cases in which Article 113(1) EPC was not violated even though new claims or relevant documents were introduced

In **T 484/89** the board held that the opposition division was empowered under Art. 114(1) EPC to take account of and refer to all relevant documents cited. In the case in question the opposition division had considered it necessary to refer to a document during the oral proceedings. In such cases the parties should, at their request, be granted an adjournment or else new oral proceedings should be appointed. Since no such request was made, according to the decision and the record of the oral proceedings, Art. 113(1) EPC had not been breached.

In **T 608/08** the board considered that, in principle, when the patent proprietor submits new claims during oral proceedings, an opponent must be afforded an opportunity to familiarise itself with the new situation, which must at least involve a sufficiently long interruption of the oral proceedings. However, that applied only to requests incorporating new content. In the case at issue, the new auxiliary requests consisted of a combination of features from sub-claims belonging to the main request. The technical features of the sub-claims were straightforward and did not put the subject-matter of the main request in a new and more complex technical context. Consequently, the admission of the auxiliary request did not entail a surprisingly new procedural situation requiring the opposition division to interrupt the oral proceedings (in contrast to **T 783/89**, in which a completely reformulated text of the claim introduced a new feature; see above).

The board in **T 1795/19** was equally unable to see a procedural violation in the opposition division's approach. It relied firstly on the minutes of the oral proceedings, from which it could see that they had been interrupted several times to give the opponent time to study the second auxiliary request and the relevant documents. Secondly, it relied on the fact

that the minutes of the oral proceedings did not contain any information on any request by the opponent for a further interruption of the proceedings or any rejection by the opposition division.

In **T 1031/12** the appellant claimed that a new document had unexpectedly been mentioned for the first time at the end of the oral proceedings before the examining division, without its being given an opportunity to present counter-arguments. The board noted that the representative had been afforded the time he himself had identified as necessary for a reply. Therefore he had had not only the opportunity but also sufficient time to comment.

In **T 376/98** the examining division had referred to document D4 for the first time during the oral proceedings, and had stayed the oral proceedings to give the applicant time for consideration. When the oral proceedings were resumed, the appellant requested a decision based on the documents on file. Regarding the introduction of D4 at the oral proceedings, the board noted that no procedural limitations were placed upon the examining division to cite relevant documents during any stage of the examination procedure, as long as the applicant was given a fair chance to comment on the objections raised before a final decision was taken (see **T 1198/97**). In the board's opinion, the appellant's request for a decision could only be taken to mean that the appellant was not interested in a further debate about the relevance of D4.

In **T 566/91** the opposition division based its decision to revoke the patent on a version of a citation which was more complete than the version which had been cited by the opponents when filing the opposition. The decision of the department of first instance was thus based, albeit inadvertently, on evidence on which the parties had not had the opportunity to comment. In order to comply with Art. 113 EPC in the appeal proceedings, the board offered the parties a half-hour suspension of the oral proceedings to enable them to study the fuller version of the document with the help of the interpreters.

In **T 834/14** while the opposition division had accepted to consider other objections raised by the opponent only during the oral proceedings, which would normally have given a right to file a response to these new objections, the fact that there was one objection which had been on file right from the start of the opposition proceedings and which could and should have been addressed earlier seemed to the board to be enough to justify the opposition division refusing that any new requests be filed. Such a decision by the opposition division might be considered harsh, but in the case in hand the board found that it did not constitute a substantial procedural violation.

c) Cases where no new claims or relevant documents were introduced

In **T 195/84** (OJ 1986, 121) the appellant (patentee) objected at the oral proceedings that new grounds on inventive step were presented to which it had not had an opportunity to reply. The board did not share this opinion as the appellant had been aware that such prior art existed, and had thus had sufficient time to consider it in full. Furthermore, it had not requested any additional time and had not asked for an adjournment.

In **T 327/92** the opposition division, at oral proceedings, had relied on a document as closest prior art against an amended main claim, which had been cited in the opposition against a dependent claim only. The board did not consider this a substantial procedural violation, as the patentee was dealing with a document which had always been part of the opposition, and could further examine this document at the oral proceedings.

d) Cases in which Article 113(1) EPC was violated in relation to a non-admission of auxiliary requests

In **T 763/15** the board could not see any indication that the appellant had been allowed to argue during the oral proceedings on the issue of admissibility of auxiliary request 2. In the opposition proceedings the Chair, after commenting on the amendment made to claim 1 of auxiliary request 2, immediately announced "that AUX2 is not admitted in the proceedings". A decision taken and pronounced by the opposition division cannot be challenged any more in the same proceedings. Therefore, the board considered it to be irrelevant that "The Patentee did not react on this decision not to admit AUX2 in the proceedings", as recited in the minutes.

e) Cases in which Article 113(1) EPC was not violated even though auxiliary requests were not admitted

In **T 2204/18** the opposition division did not admit an auxiliary request submitted during oral proceedings. The board held that not admitting requests submitted by the patent proprietor did not constitute a breach of the proprietor's right to be heard, provided that the patent proprietor had been given the opportunity to comment on their admittance.

In **T 951/19** the board found that the admissibility of auxiliary request 1 filed during the oral proceedings had been discussed during the oral proceedings and both parties had been heard on it. Furthermore, the opponent had not argued that the opposition division had not given it sufficient time and had not requested that the oral proceedings before the opposition division be interrupted or adjourned. The board therefore considered that the case in hand was different from **T 783/89**, that there was no violation of the right to be heard and that the opposition division had correctly exercised its discretion and also justified it in the contested decision.

The board in **T 2156/17**, considering the admissibility of an auxiliary request filed during oral proceedings before the board, held that the right to be heard under Art. 113 EPC did not entail the right to be given further possibilities to file new requests if earlier attempts failed. According to the board, the appellant's right to be heard was met under the circumstances, since the appellant was aware of the objections to the admissibility of the earlier requests and had the opportunity to contest them and present its arguments.

In **T 562/20** the board emphasised that the appellant could not derive from the right to be heard a claim to file auxiliary requests at any given time in the appeal proceedings. Moreover, according to the board Art. 13(2) RPBA did not contradict the parties' right to be heard, enshrined in Art. 113(1) EPC, even when a party's amended submission was not taken into account in the appeal proceedings. Art. 13(2) RPBA only regulated the strict

requirements for the consideration of amendments filed at a late stage if the party concerned had failed to take the opportunity to make such amendment at an earlier point in time.

2.7.2 Introduction of new arguments

In **T 248/92** the examining division had based its decision on arguments submitted for the first time during oral proceedings. The board held that the examining division's decision had not been taken contrary to Art. 113(1) EPC. Although one of the purposes of oral proceedings was to settle as far as possible all outstanding questions relevant to a decision, they did not have a constraining effect in the sense of requiring an immediate decision to be taken at the end of those proceedings. If the appellant had felt the need for further reflection, it could have asked for the oral proceedings to be adjourned or for the proceedings to be continued in writing so that it could study carefully the newly introduced arguments, which had obviously been crucial to the decision. In **T 390/20** the appellant claimed that it had been "ambushed" by an objection under Art. 83 EPC which had been substantiated by the examining division for the first time during oral proceedings. According to the board, however, the impugned decision was based solely on Art. 56 EPC. Therefore, any further objections raised during oral proceedings were irrelevant for the assessment of whether the right to be heard was given to the appellant and did not lead to an infringement of Art. 113 EPC.

In **T 623/12** the opposition division had found, on the basis of an argument first submitted by the opponent during the oral proceedings, that several auxiliary requests did not comply with Art. 123(2) EPC. The opposition division gave the patent proprietor only one opportunity to file a new claim, based on one of the previous auxiliary requests, and warned that "other requests may suffer from other deficiencies under Art. 123(2) EPC". It then decided that the new auxiliary request still did not comply with Art. 123(2) EPC. According to the board, the opposition division's warning did not provide the patentee with a basis for an informed choice since neither the objections nor the requests affected by them were specified. By acting in this manner, the opposition division did not exercise its discretion in respect of the admissibility of the patentee's late-filed request but arbitrarily decided not to allow the request. This arbitrary decision deprived the patent proprietor of a proper opportunity to comment on the admissibility of its further request and to reply to the objections of the opposing party.

In **T 1014/10** the appellant (patent proprietor) argued that during the opposition proceedings it had been given no opportunity to study the opponent's submissions because they were delivered to its office only on the day of the oral proceedings. The board observed that it was the duty of the parties – and of the board – to check the content of the electronic file in order to make sure that no submission had been added in the days before the oral proceedings. Moreover, the proprietor could have requested an interruption of the oral proceedings to study the submissions, or even asked the opposition division not to admit them into the proceedings. As shown by the minutes, the proprietor did not make use of these procedural options. Under these circumstances, the late-filed submissions, which furthermore did not contain any new facts, were to be put on the same

footing as new arguments which might have been put forward and discussed anyway during the oral proceedings. The board did not see any violation of Art. 113 EPC.

In **T 776/17** the opposition division had rejected the appellant's request to adjourn oral proceedings. The board held that not providing the appellant (patent proprietor) with sufficient time to react to an inventive-step attack presented by the opponent for the first time during oral proceedings before the opposition division constituted a violation of the appellant's right to be heard.

2.7.3 Introduction of a new ground of opposition by the opposition division

In **T 515/05** the appellant had based its opposition only on the grounds of Art. 100(a) EPC. In the summons to the oral proceedings the opposition division itself introduced a further ground for opposition under Art. 100(b) EPC. At the beginning of the oral proceedings the Chair of the opposition division stated that no discussion of the ground of opposition under Art. 100(b) EPC would take place because it had not been sufficiently substantiated by the opponent. Denying the appellant the opportunity to comment on this ground, albeit introduced by the opposition division itself, was considered a substantial procedural violation. The fact that the appellant did not file written arguments in response to the summons to attend the oral proceedings did not deprive it of its right to be heard. The appellant was entitled to expect that it would still have an opportunity to comment on this new ground during the oral proceedings.

2.7.4 Hearing witnesses

For relevance of the evidence see chapter III.G.3.1. "Relevance of the evidence" and for further aspects of the right to be heard while taking evidence see chapter III.G.3.3. "Right to be heard".

In **T 142/97** the board held that the opposition division had violated the opponent's right to be heard under Art. 113(1) EPC by not hearing the witness offered in connection with a prior use that had been adequately substantiated in the notice of opposition. See also **T 959/00** in which the board held that the opposition division's failure to hear the witness, and the absence in the decision under appeal of any reference to a reason why it had not been necessary to hear the witness, amounted to a fundamental procedural violation of the right to be heard.

In **T 269/00** the board held that the case before it differed from **T 142/97** because the ground of prior use was not adequately substantiated during the opposition period, but completed piecemeal during the opposition proceedings. The board concluded that not hearing the witness did not amount to a substantial procedural violation.

In **T 474/04** (OJ 2006, 129), the board held that if assertions made in an unsworn witness declaration remained contested, a request to hear the witness had to be granted before these assertions were made the basis of a decision against the contesting party.

In **T 909/03** the hearing of a witness took place in the morning and the oral proceedings continued in the afternoon. The board held that it was not necessary for a party to be given a copy of the minuted testimony before commenting on that testimony. During the oral proceedings the party had been given sufficient opportunity to comment. No substantial procedural violation had thus occurred.

In **T 716/06** the board confirmed that where oral evidence of a witness was requested by a party the competent department should grant this request only if it considered this oral evidence necessary to clarify matters that were decisive for the decision to be taken. However, where an opponent requested that a witness be heard on an alleged public prior use and on the disclosure of a certain feature by this prior use, the competent department as a rule had to grant this request before deciding that the alleged public prior use was neither established nor constituted a novelty-destroying state of the art.

In **T 1100/07** the board held that the opposition division should have heard one of the offered witnesses. Since the opposition division had based its final decision on a failure to establish the prior existence of a single given feature and the witness would allegedly have been able to give evidence on that very point, the refusal to hear him was wrong and might have affected the outcome of the decision. The appellant was entitled under the EPC to adduce evidence by any of the methods set out in Art. 117 EPC and thus failure to allow it to do so constituted a substantial procedural violation. See also **T 2386/19** and **T 2517/22**. Moreover, according to the board in **T 2517/22**, it is an opposition division's duty to take its decision on the basis of all the relevant evidence actually available rather than to expect the presentation of more preferred pieces of documentary evidence, to speculate on the reasons of and draw conclusion from their absence (see also chapter III.G.3.3.4 "Improper reasons for rejection of evidence offered").

In **T 1738/21** the board held that the opposition division's failure to hear three of the offered witnesses amounted to a "serious procedural violation". According to the board it appeared that the witness testimonies had been relevant for the features which had been decisive for the decision in the opposition proceedings. The board could not find any mention in the decision under appeal of the appellant's offer of witnesses nor any indication of the opposition division's reasons for not hearing the witnesses offered. The board recalled that Art. 117(1) and 113(1) EPC embody a basic procedural right, namely that a party can give evidence in an appropriate form and have that evidence heard. If the evidence offered related to alleged facts that were decisive to the decision to be taken, the department hearing the case had, as a rule, to order it to be taken.

In **T 423/22** the board emphasised that hearing the witness by videoconference in the case in hand had not infringed the appellant's right to be heard because it had not substantially limited the interaction between the opposition division, the parties and the witness compared to hearing a witness in the courtroom. Even if part of the body language could not be seen, this drawback could never affect a party's right to be present and to put questions to the witness to such an extent that its right to be heard, i.e. the "opportunity to present comments on grounds or evidence" (Art. 113(1) EPC), would be violated. For more information on this decision see also chapters III.C.8.3.3e) "Applicability of considerations

set out in G 1/21 to first-instance proceedings and to hearing a witness" and III.G.3.1.8 "Means of taking evidence by videoconference".

2.7.5 Oral submissions of an accompanying person

For the denial of a request for an accompanying person to present oral submissions see chapter V.B.4.3.20 "Further examples of unsuccessful petitions". See also chapter III.V.5. "Oral submissions by an accompanying person".

2.8. The right to be heard in case of the non-attendance of oral proceedings

The proceedings may continue without the duly summoned but non-attending party (R. 115(2) EPC). The case law of the boards demonstrates, however, that the non-attending party's right to be heard under Art. 113 EPC must not be ignored.

2.8.1 Facts and evidence put forward for the first time during oral proceedings

In **G 4/92** (OJ 1994, 149), which explicitly relates to inter partes proceedings only, the Enlarged Board held that, in view of the right to present comments, a decision against a party who had been duly summoned but who failed to appear at oral proceedings could not be based on facts put forward for the first time during those oral proceedings. Evidence put forward for the first time during oral proceedings could not be considered unless it had been previously notified and it merely supported the assertions of the party which had submitted it. New arguments, on the other hand, did not constitute new grounds or evidence, but were reasons based on the facts and evidence already put forward. As regards new arguments, the requirements of Art. 113(1) EPC could thus be satisfied even if a party who chose not to appear did not have the opportunity to comment on them during oral proceedings.

According to Art. 15(3) RPBA (formerly: Art. 11(3) RPBA 2003, then Art. 15(3) RPBA 2007), "[t]he Board shall not be obliged to delay any step in the proceedings, including its decision, by reason only of the absence at the oral proceedings of a party duly summoned who may then be treated as relying only on its written case." The preparatory documents to this article (initially in the RPBA 2003) state that this provision does not contradict the principle of the right to be heard pursuant to Art. 113(1) EPC since that article only affords the opportunity to be heard and, by absenting itself from the oral proceedings, a party gives up that opportunity (CA/133/02 dated 12 November 2002). This RPBA provision superseded the findings of **G 4/92** with regard to the non-attendance at the oral proceedings before the boards (**T 706/00**). To the extent that **G 4/92** supports the general admissibility of new arguments in appeal proceedings, it was also modified by the amendments to the RPBA introduced with effect from 1 May 2003, which made the introduction of new arguments subject to the discretion of the boards (**T 1621/09**, summarising previous case law). **G 4/92** still applies for the departments of first instance (see Guidelines E-III, 8.3.3.2 – April 2025 version). With regard to proceedings before the examining divisions, see also the notice published in OJ 2020, A124.

In **T 2138/14** (ex parte) the board stated that it was established case law that a non-attending party's right to be heard under Art. 113(1) EPC must not be ignored (see in this chapter III.B.2.8.). This view was confirmed by analogy to Opinion **G 4/92**. Although **G 4/92** explicitly only concerned inter partes proceedings, the same principle has been applied in ex parte proceedings (see in this chapter III.B.2.8.2).

2.8.2 Non-attendance at oral proceedings before the boards – case law on G 4/92

In **T 341/92** (OJ 1995, 373) the board held that it was possible to base a decision on a ground discussed for the first time during oral proceedings, at least if the stage reached in the case was such that the absent – albeit duly summoned – patent proprietors could have expected the question to be discussed and were aware of the actual basis on which it would be judged. The board did not consider itself prevented by reasons of procedural law from rendering a decision on the basis of Art. 123(3) EPC, on an issue brought up by the board for the first time at the oral proceedings. It argued that the situation differed from **G 4/92** in that the extension of the protection conferred, to which objection had been made, arose solely from a comparison of the wordings of the claims, and therefore not from facts that had only been introduced during oral proceedings.

In **T 802/12** the board likewise dismissed the appeal on the basis of Art. 123(3) EPC, which had been discussed for the first time at the oral proceedings. The board referred to **T 341/92** and found that the appellant could have expected the amendments it had made to be examined at the oral proceedings as to their conformity with the requirements of the EPC (**G 9/91**, OJ 1993, 408). A party duly summoned to oral proceedings could not rely on the proceedings being continued in writing or the case being remitted to the department of first instance simply because they had not attended the oral proceedings (Art. 15(3) and (6) RPBA; see in this chapter III.B.2.8.3 "Non-attendance at oral proceedings before the boards – Article 15(3) RPBA").

In **T 133/92** the board concluded that considering and deciding in substance on the maintenance of the patent on the basis of claims as amended during oral proceedings in the absence of the appellants (opponents) did not conflict with the opinion of the Enlarged Board in **G 4/92**. The board stated that the respondent's (patentee's) restrictions to the claims removed objections already raised by the appellants. In such a situation the appellants could not have been taken by surprise, because they had to expect that the respondent would try to overcome all objections. The submission of auxiliary requests was clearly not a "fact" within the meaning of **G 4/92** (see also **T 771/92**, in which the board held that the submission of restricted claims was neither a fact nor could it be evidence). In cases **T 912/91**, **T 202/92**, **T 856/92**, **T 890/92**, (see also **T 673/06** and **T 235/08**), which were based on similar facts, the board also concluded that Art. 113(1) EPC had been satisfied.

In **T 1448/09** refusal of the European patent application was based on the common general knowledge as illustrated by document D3. That stance was first taken in the oral proceedings before the examining division, which the appellant did not attend. According to **G 4/92**, arguments could be presented at any time, even during oral proceedings in the absence of a party, but the same did not apply to new facts forming the basis for a decision.

A reference to the common general knowledge could be presented as an argument, but the existence of that knowledge was a matter of fact. If its alleged existence was disputed, the facts relevant in that regard had to be established. That meant that the party against which this knowledge was cited had to have the opportunity to dispute or accept it. In the case in hand, the appellant had neither been aware of the examining division's invocation of the common general knowledge nor of the existence of document D3 until the decision was announced. This violated the appellant's right to be heard on the relevance of document D3 and, by extension, on the existence of the invoked common general knowledge.

In **T 1049/93** the board held that, where a duly summoned respondent (opponent) chooses not to attend oral proceedings, a board can still consider prior art which might be an obstacle to the maintenance of the patent in suit. The opportunity to be heard is offered by summoning the parties to a hearing before the board. If the respondent chooses not to avail itself of this opportunity, its right to be heard is exhausted to the extent that it concerns facts and arguments in support of its position. **G 4/92** should not be construed as extending or prolonging the rights of a voluntarily absent party.

In case **T 414/94** the board stated that there was no general prohibition on amending requests during a party's absence from oral proceedings. An absent party (here, the opponent) must expect reactions of the opposing party (here, the patentee) within the legal and factual framework of the case established prior to oral proceedings, and the possibility of decisions taking account of, and being based on, such reactions.

In **T 501/92** (OJ 1996, 261) the board ruled that if a new ground for allowing the appeal based upon the file record (here, the patentee's failure to file a formal request to maintain the patent) was raised by the appellant (opponent) for the first time during oral proceedings from which the respondent (patentee) was voluntarily absent, it would be contrary to Art. 113(1) EPC and the principles underlying **G 4/92** to allow the appeal on the basis of this new ground without giving the respondent an opportunity to comment.

In **T 892/94** (OJ 2000, 1) the board held that the right to be heard of a party absent from oral proceedings as expounded in **G 4/92** could, in appropriate circumstances, be surrendered by a party. The respondents'/patentees' declaration, before the oral proceedings that they would take no further part in the proceedings could only be construed as an unequivocal decision to surrender, voluntarily, their rights according to Art. 113(1) EPC and to no longer to avail themselves of the opportunity to present their comments on any objections, facts, grounds or evidence which could be introduced into the proceedings by the appellants or the board and which could turn out to be decisive.

In **T 191/98** the board referred to **G 4/92** and considered that the respondent (patentee), when informing it of its non-appearance, should have expected that the board would decide in substance on the patent in its granted form, taking into account any piece of evidence filed by the appellant (opponent) and arguments based on that evidence, including a line of argument further developed during the oral proceedings.

2.8.3 Non-attendance at oral proceedings before the boards – Article 15(3) RPBA

The introduction of Art. 11(3) RPBA 2003 (Art. 15(3) RPBA) superseded the findings of **G 4/92** for the non-attendance at the oral proceedings before the boards (**T 706/00**). For cases in which the applicant files amended claims in appeal proceedings after the oral proceedings have been arranged and then does not attend them, see CLB, 10th edn. 2022, V.A.5.5.4a). The appellant can reasonably expect that during the oral proceedings the board will consider the objections and issues raised in its communication. By not attending the oral proceedings, the appellant effectively chooses not to avail itself of the opportunity to present its observations and counter-arguments orally but instead to rely on its written case (Art. 15(3) RPBA; see e.g. ex parte cases **J 15/10**, **T 1625/06**, **T 628/07**; see also **T 55/91**). As quoted in **T 991/07**, the explanatory notes to then Art. 11(3) RPBA (CA/133/02, dated 12 November 2002) state that Art. 11(3) RPBA 2003 (Art. 15(3) RPBA) "does not contradict the principle of the right to be heard pursuant to Art. 113(1) EPC since that Article only affords the opportunity to be heard and, by absenting itself from the oral proceedings, a party gives up that opportunity."

a) Ex parte proceedings

In **T 991/07** the board decided, with reference to Art. 15(3) and 12(2) RPBA 2007 (now Art. 15(3) and 12(3) RPBA), that it could base its decision on objections which would be new to the appellant, but which could not be communicated to it due to the fact that the appellant was not present at the oral proceedings, without infringing the appellant's right to be heard (Art. 113(1) EPC). The board observed that in line with established case law (see e.g. decisions **T 823/04** and **T 1059/04**; see also **T 1704/06**, **T 532/09**, **T 1278/10** – all ex parte cases), the appellant who decided not to attend oral proceedings had nonetheless had the opportunity to do so and that the requirements of Art. 113 EPC were thus met. A further justification for such an approach was that a party who filed substantive amendments to its case and then deliberately absented itself from oral proceedings in order to avoid any adverse decision being reached would infringe the general principle that it is incumbent on both the EPO and users of the European patent system to act in good faith (**G 2/97**). This was especially true in situations where the appellant had initially requested that oral proceedings be held.

In **T 578/14** the board took the view that, in the case in hand, the duly summoned appellant, who of her own volition did not attend the oral proceedings, could not be placed in a more advantageous position than she would have been if she had attended. The appellant's voluntary absence could not therefore be a reason for the board not to raise issues it would have raised if the appellant had been present.

In **T 1367/09** the board did not raise Art. 84 EPC in its communication pursuant to Art. 15(1) RPBA 2007. When reconsidering the case in preparation for the oral proceedings, the board noted that Art. 84 EPC should also be addressed. The oral proceedings were held in the absence of the appellant. In its decision, the board stressed that a board's communication has a preliminary character and does not have to be exhaustive. In general, new grounds for refusal have to be discussed during the oral proceedings. However, if a duly summoned appellant does not attend the scheduled oral

proceedings, it waives the opportunity to present its comments on new grounds which were not mentioned in the communication under Art. 15(1) RPBA 2007 but are decisive for the decision. In view of the principle of procedural economy, the board is not obliged to delay its decision. A board's decision dealing with new grounds, on which the appellant has not presented its comments, does not contravene the right to be heard (Art. 113(1) EPC) in such a case.

In **T 1000/03** the board held that the appellant had been duly summoned, and at the oral proceedings could easily have corrected the minor deficiencies in the description. To delay the decision pending their correction was uncalled for (see Art. 15(3) RPBA). Under Art. 113(2) EPC, the board had to keep to the text submitted by the appellant (applicant), who by not appearing at the oral proceedings had taken the risk of the application being refused even for easily remediable deficiencies (see also the ex parte case **T 1903/06**).

b) Inter partes proceedings

In **T 986/00** (OJ 2003, 554) the board held, with reference to Art. 113(2) EPC and Art. 11(3) RPBA 2003 (Art. 15(3) RPBA), that a patent proprietor who chooses not to be represented at oral proceedings should ensure that they have filed all the amendments they wish to be considered. All the more when, as in the case at issue, the proprietor had been expressly warned about the possible necessity of amending the claims and the description.

In **T 1010/13** oral proceedings took place in the presence of appellant I only. Although appellants II, III and IV did not attend the oral proceedings, the board held that the principle of the right to be heard pursuant to Art. 113(1) EPC was observed since that article affords only the opportunity to be heard, and by absenting itself from the oral proceedings a party gives up that opportunity (see CA/133/02 dated 12 November 2002, which is the explanatory note to former Art. 11(3) RPBA 2003 – now Art. 15(3) RPBA – cited in **T 1704/06**); see also CLB, 10th edn. 2022, V.A.5.5.4a).

2.9. Changes in the composition of the competent department of first instance

Generally, changes in the composition of the competent department of first instance do not, in themselves, constitute a violation of the right to be heard if they take place before oral proceedings. In principle, the right to be heard is also not violated if the composition stays the same after oral proceedings.

For further cases, also with regard to changes in the opposition division's composition after the oral proceedings, see also chapter III.K.1. "Composition of the competent departments of first instance".

2.9.1 Composition change before oral proceedings

In **T 1090/18** the board found that, in principle, the opposition division composition change after the summons to oral proceedings and before the oral proceedings did not lead to the conclusion that the patent proprietor (appellant in the case in hand) had been denied its

right to be heard if the new member had had sufficient opportunity to familiarise themselves with the case and the opportunity to hear both parties at the oral proceedings. The board saw no reason for doubting that these conditions were fulfilled with respect to the interlocutory decision under appeal. See also **T 1652/08**.

The same principles apply in proceedings before the examining division, according to **T 2344/16**.

2.9.2 Composition change after oral proceedings

In **T 960/94** the composition of the opposition division had changed between the decision announced orally and the written decision. The board decided that issuing the written decision on behalf of an opposition division whose first member was not present at the oral proceedings amounted to a substantial procedural violation of both Art. 113(1) and 116 EPC, as it had been issued on behalf of a first member before whom the parties had been given no opportunity to present their comments at oral proceedings.

In **T 862/98** the decision of the department of first instance was signed by an opposition division different from that before which the oral proceedings had taken place. Oral proceedings being a fundamental expression of the right to be heard (see e.g. **T 209/88**), any findings at oral proceedings relevant to the final decision should be made in the presence and with the involvement of those members giving the final decision. The board decided that changes in the composition of an opposition division after oral proceedings should generally be avoided, even if no final substantive decision had been given at the oral proceedings. Where changes were unavoidable, new oral proceedings must in general be offered to the parties (see the analogous rule in Art. 8(1) RPBA). Such offers might be forgone in exceptional cases. Referring to **T 862/98**, the board in **T 2020/20** recalled that if a change in the composition of the department of first instance occurred after oral proceedings, parties should be offered new oral proceedings. Failure to do so constituted a substantial procedural violation. According to the board it was irrelevant to the finding of a substantial procedural violation that the examining division in its former composition had not announced its decision at the oral proceedings but instead had merely expressed opinions on the requests which had been to become the subject of the decision under appeal.

In **T 837/01**, the final decision of the opposition division had only been signed by three members of the division, whereas the copy sent to the parties bore the name of all four members, including the legally qualified examiner. Upon enquiry by the board, it turned out that the legally qualified member had not simply forgotten to sign the decision but had not been involved in taking the decision which constituted a substantial procedural violation (see also **T 990/06**).

2.10. Changes to the composition of a board

2.10.1 Composition change after oral proceedings

If the composition of a board is changed after oral proceedings, the parties shall be informed that, at the request of any party, fresh oral proceedings shall be held before the board in its new composition. Each new member shall be bound to the same extent as the other members by an interlocutory decision which has already been taken (see Art. 8 RPBA).

Because it deemed the outcome of pending referral cases **G 1/22** and **G 2/22** (OJ 2024, A50) to be relevant for the board's decision, and since the retirement of one of the five board members was approaching, the board in **T 2643/16** of 16 February 2023 and **T 2643/16** of 3 June 2024 stayed the proceedings and issued an interlocutory decision. This decision dealt with the issues for which the parties could provide their comments at the oral proceedings and for which the board closed the debate. The board held that this interlocutory decision avoided a situation, detrimental to procedural economy and legal certainty, in which the board in a new composition may need to rehear the parties on matters dealt with at the oral proceedings. After the decision in the consolidated cases **G 1/22** and **G 2/22** was issued, the board in its new composition sent a communication to the parties with its preliminary opinion, in which it invited the parties to submit comments or requests and made clear that if no replies or requests were received within the set period, the parties could expect the board to issue a decision in writing without holding further oral proceedings.

3. Text submitted or agreed by applicant (patent proprietor) – Article 113(2) EPC

3.1. General

Under Art. 113(2) EPC the EPO may consider and decide upon the European patent application or the European patent only in the text submitted to it, or agreed, by the applicant for or proprietor of the patent. See also chapters IV.B.3.2.3 "Decisions with no text submitted or agreed by the applicant (Article 113(2) EPC)" and IV.D.2. "Requests for revocation during opposition and opposition appeal proceedings".

When taking its decision a board of appeal (or department of first instance) has no authority to order the grant of a European patent containing claims which are different in their content or interdependency from those submitted by the applicant (**T 32/82**, OJ 1984, 354). Art. 113(2) EPC is a fundamental procedural principle, being part of the right to be heard, and is of such prime importance that any infringement of it, even as the result of a mistaken interpretation of a request, has, in principle, to be considered to be a substantial procedural violation (**T 647/93**, OJ 1995, 132; see also **J 19/84**, **T 32/82**, **T 690/09**, **T 996/12**). In any case, such violation occurs when the examining division does not make use of the possibility of granting interlocutory revision under Art. 109 EPC after the mistake has been pointed out in the grounds of appeal (**T 647/93**).

According to the board in **T 996/12**, Art. 113(2) EPC guarantees the fundamental principle of party disposition (ne ultra petita; see also **R 14/10**).

Art. 113(2) EPC does not give any right to an applicant in the sense that the EPO is bound to consider a request for amendment put forward by the applicant. The effect of the provision is merely to forbid the EPO from considering and deciding upon any text of an application other than that submitted to it or agreed by the applicant or proprietor (**G 7/93**, OJ 1994, 775; see also chapter V.B.4.3.19 "Alleged violation of Article 113(2) EPC"). The board in **T 1104/14** held that this had to be understood to refer only to the decision on whether to admit the (filed) request; it did not mean the boards had the power to refuse to permit the filing of a request or not to record or accept a request during oral proceedings. That would generally constitute a serious breach of the autonomy granted by Art. 113(2) EPC to the applicant or patent proprietor to determine the text of its patent ("principle of free party disposition").

In **R 8/16** the Enlarged Board held that, as a matter of principle, the board was free to examine the (pending) claim requests in any order, and therefore it was also free to conduct the discussion on them in any order, without having to give reasons. It further stated that the principle of party disposition expressed in Art. 113(2) EPC did not extend so as to permit a party to dictate how and in which order a deciding body of the EPO may examine the subject-matter before it. The only obligation on the EPO was not to overlook any still pending request in the final decision. The order of examination or discussion is a question of procedural economy, for which mainly the deciding body is responsible. A board has no particular duty to give reasons why it chose to proceed as it did. See also chapter III.I.2.2. "Order of examination of requests".

In **T 1477/15** the board stated that it is generally accepted that in appeal proceedings the principle of party disposition applies (see e.g. **R 13/13**, point 15 of the Reasons), meaning that parties can put forward, withhold or withdraw their requests as they see fit. In other words, if a patent proprietor withdraws or no longer agrees to a text (two auxiliary requests, in this case), this principle prevents the board of appeal from deciding on these issues.

3.2. The requirement of a text submitted by the applicant

In **T 1440/12** the board held that in the case of opposition, the intention behind Art. 113(2) EPC is that the EPO may not maintain a patent according to a particular text unless the proprietor has consented unambiguously to the patent being maintained in that form. The "text submitted" is to be understood to mean a text submitted by the proprietor with the clear intention that the patent be maintained according to that text, at least as an auxiliary measure. In the case in issue, although six new requests were enclosed with the reply to the statement of grounds of appeal, the proprietor/respondent did not actually request maintenance of the patent on the basis of any of them, but merely described them as "six auxiliary requests that the proprietor may subsequently choose to rely upon". This phrase, although the submissions in question were termed "requests", made it clear that the proprietor was not at that point requesting maintenance of the patent based on them, but merely leaving open the possibility that it might choose to make such a request subsequently.

3.3. The requirement of a text agreed by the applicant

In **T 73/84** (OJ 1985, 241) the board held that the European patent was to be revoked if the patent proprietor stated in opposition or appeal proceedings that they no longer approved the text in which the patent was granted (and, in the case in hand, **maintained after opposition**) and would not be submitting an amended text (see also **T 655/01**, **T 1526/06**, **T 2405/12**, **T 203/14**,**T 55/16**,**T 766/16**, **T 1268/17**, **T 301/18** and **T 1233/19**). According to **T 1244/08**, such a statement by an appellant, who is the proprietor of **a patent which has been revoked by an opposition division**, clearly and unambiguously indicating that they no longer have an interest in the appeal proceedings, is equivalent to a declaration of withdrawal of the appeal, and it is not possible to retract it and continue the proceedings (see chapter IV.D.2. "Requests for revocation during opposition and opposition appeal proceedings"). In **T 990/16** the respondent (patent proprietor) had indicated that it no longer approved the text of the patent as granted. Moreover, it had withdrawn all its pending requests and had indicated that it would not be filing a replacement text. The board found that there was no approved text on the basis of which it could consider the appeals of the opponents and that it was also no longer possible to take a decision as to substance. The board concluded that, according to the established case law, the appeal proceedings must be terminated by a decision ordering revocation of the patent since the patent proprietor no longer challenged the request for revocation of the opposed patent, and the patent could not be maintained against the proprietor's will (see also chapter IV.D.2. "Requests for revocation during opposition and opposition appeal proceedings").

In **T 454/15** the proprietor lodged an appeal against the opposition division's decision to revoke its patent, but prior to the oral proceedings stated that it no longer approved of the text of the patent as granted and would not be proposing an amended text. The board stated that where a fundamental requirement for allowing the appeal of the patent proprietor against a decision of the opposition division to revoke the patent was lacking, the proceedings should be terminated by a decision ordering the dismissal of the appeal, without going into the substantive issues (see also **T 163/99**, **T 1637/06**, **T 2524/12** and **T 784/14**). The board stressed that its order could not be the same as in **T 2405/12** (revocation) because unlike in that case the patent had already been revoked by the opposition division and thus could not be revoked again. However, the order to dismiss the appeal ultimately had the same outcome, namely that the decision to revoke the patent became final.

The board in **T 706/00** pointed out that the EPO cannot depart from a request once made. It can only grant or deny the request; it cannot grant more, less or even something different. Unless a grantable text is submitted, at least auxiliarily, the request is rejected in full. In **T 549/96**, the board noted that an applicant had to unambiguously indicate, at the end of the proceedings, which text they proposed. Otherwise, the examining division would be unable to decide on the basis of which version it should proceed and the application would eventually have to be refused, since there would be no clear request at all. Thus, if an applicant failed to indicate their approval of the text of an allowable subsidiary request, e.g. by express disapproval or by maintaining one or more unallowable higher-preference

requests, the examining division could refuse the application under Art. 97(1) EPC 1973 (Art. 97(2) EPC) (see also **T 976/97**).

In **T 237/96** the board held that Art. 113(2) EPC could not be interpreted in the sense that the examining division was bound to accept any amendment which the applicant might propose, only to ensure that there was a version approved by the applicant. In circumstances in which, as in the case in question, amendments proposed by the applicant after the R. 51(4) EPC 1973 (R. 71(3) EPC) communication were with good reason not allowed by the examining division by virtue of R. 86(3) EPC 1973 (R. 137(3) EPC) and the applicant did not give their agreement to any other version, the established practice of the EPO, sanctioned by consistent case law, was to refuse the application on the ground that there was no version approved by the applicant within the meaning of Art. 113(2) EPC.

In the inter partes case **T 917/95** a patent proprietor had submitted a new claim but no amended description or drawing. The descriptions and drawings relating to the previous claims were incompatible with the new claim. Because the proprietor failed to appear at the oral proceedings, no documents were available on the basis of which the patent could have been maintained (see also **T 725/00** and **T 1174/01**).

In **T 255/05** the board held that under Art. 113(2) EPC, it is the applicant's responsibility to define the text on the basis of which it requests a patent to be granted. When the appellant, even after having been invited to do so by the board, does not clearly indicate the order in which its requests are submitted and what the exact content of each of these requests is, there is no text submitted or agreed by the applicant within the meaning of Art. 113(2) EPC, and no request which could be considered by the board.

In **T 690/09** the examining division had refused to consent to the latest submitted set of claims under R. 137(3) EPC, despite these being maintained by the applicant. The board held that this would not automatically revive the previous set of claims that the examining division had consented to consider, unless the applicant had indicated that it was relying on these as an auxiliary request. According to the board, deciding to refuse an application on the ground that claims are not allowable contravenes Art. 113(2) EPC if the applicant is no longer putting forward these claims and amounts to a substantial procedural violation (see e.g. **T 946/96**). Similarly, in **T 996/12** the board held that, unlike the situation in which an applicant submitted one or more auxiliary requests, submitting a new main request automatically leads to the replacement of any previous main request(s). By basing its decision explicitly on an earlier set of claims, the examining division decided upon a text to which the appellant (no longer) agreed.

In **T 1227/14** the appellant (patent proprietor) submitted that, contrary to what was indicated in the minutes of the oral proceedings, it had not delegated the adaptation of the description to the opposition division. It had instead requested a return to written proceedings for the adaptation of the description, but that had been omitted from the minutes. In spite of this, it had not requested the correction of that omission by the opposition division. The opposition division, however, had issued the impugned interlocutory decision on the text in which the opposed patent could be maintained without first submitting that text – containing the division's adapted description – to the patent

proprietor. It had thus violated the principle of the right to be heard laid down in Art. 113(2) EPC. Even and especially where adaptation of the description is delegated to an EPO department, there is no scope for releasing it from this obligation.

The board in **T 861/16** noted that there was no mention anywhere, in either the minutes or the decision, that the patent proprietor had approved the amended text. Nor had the respondent (opponent) offered any evidence that the patent proprietor had explicitly approved a text submitted before the opposition division's decision. The board held that since the principle of tacit acceptance (qui tacet consentire videtur) was not established in the EPC, it was not enough to ask the patent proprietor if it wished to comment on the amendments to the description carried out by the opposition division. The opposition division had to ensure that the patent proprietor had given its agreement. The board held that in the absence of the patent proprietor's approval of the version as maintained, the proceedings before the opposition division were vitiated by a substantial procedural violation (Art. 113(2) EPC).

In **T 536/13** the board held that the "decision according to the state of the file" evidently did not take into account the comments and amended application documents filed by the applicant (appellant) in response to the examining division's second communication. The board found that the decision consequently did not comply with the requirement of Art. 113(2) EPC. The board also found that the decision was not reasoned within the meaning of R. 111(2) EPC. In the absence of any reasoning in respect of the applicant's latest comments and amendments, the board and the appellant were left in doubt as to which of the previously-raised objections still applied. See also chapters III.B.2.5.4 "Failure to consider submissions made after a communication", III.K.3.5. "Decisions according to the state of the file".

In **T 1558/18**, the opposition division's decision to terminate the opposition proceedings, with the result that the contested patent had been maintained unchanged, had been at direct odds with the appellant's request that the patent be maintained in an amended version. The contested decision thus infringed the fundamental procedural principle of "party disposition" enshrined in Art. 113(2) EPC.

In **T 935/20** the board disagreed with the appellants that the examining division had based its decision on a wrong set of claims. The board admitted that the examining division had indeed made a drafting error in the written reasons of the decision. However, it was evident from other parts of the decision that the examining division had taken into account all limitations of the applicants' main request before reaching its decision, and that the drafting error had not had any impact on the outcome of the examination proceedings.

3.4. Cases where the EPO is uncertain or mistaken about the approval of the text

In **T 382/10** the board held that, to avoid any misunderstanding, in particular when requests were amended during oral proceedings, the examining division should clarify the final requests before pronouncing its decision at the conclusion of oral proceedings (see also chapter V.B.4.4.2 "Rule 104(b) EPC – failure to decide on a party's request"). In accordance with prevailing case law (**T 666/90**, **T 552/97** and **T 1439/05**, see below), the

fact that the final requests were not established contravened Art. 113(2) EPC and was considered a substantial procedural violation. In **T 1104/14** it was held that failure to obtain clarification where needed also amounted to a procedural violation because it was then not clear which version of the patent was being put forward by the patent proprietor for decision, resulting in a breach of Art. 113(2) EPC. Basing a decision on the wrong requests constituted a substantial procedural violation because freedom of disposition was cardinal and disregarding it adversely impacted the entire proceedings.

In **T 666/90** the status of the requests was not clarified during oral proceedings before the opposition division. This resulted in a disagreement between the patentee and the opposition division in the period between oral proceedings and the drafting of the decision. According to the board, the appropriate action would have been to request, prior to the decision being issued, a written copy of the final version of the requests and a clarification of their order. In **T 552/97** the opposition division had taken no decision on the main request, incorrectly assuming that it was no longer in the proceedings. The board pointed out that EPO departments should clarify the position before issuing decisions, especially if requests had been amended in oral proceedings. In **T 355/03** it was unclear which text the applicant wished to have as the basis for grant. The board held that the examining division should have established what the applicant really wanted.

In **T 1653/16**, the appellant (applicant) argued that its main request had not been addressed in the examining division's decision. Instead, the decision was based on a version of a claim "unofficially submitted" by e-mail as a basis for discussion, of which there was no record on the file. From the minutes of the oral proceedings, it was not clear whether the main request was still maintained or whether the applicant even requested a decision on the amended claim since it appeared that at the end of the proceedings, before announcing the decision, the applicant was not asked to state its final requests. The board concluded that as the examining division had not established whether the main request which it refused was the version agreed by the applicant, it had violated Art. 113(2) EPC thereby committing a substantial procedural violation.

In **T 1558/21** the board considered it established that the decision of the opposition division was not based on the intended wording of the auxiliary request discussed during the oral proceedings. The auxiliary request on which the decision was based had been submitted by email during the oral proceedings. However, it was not what the appellant (patent proprietor) intended nor had it been discussed during the oral proceedings. According to the board, the opposition division had decided either on the wrong request not in keeping with the order in the decision, or on a request on which the parties had not been heard (see also this chapter III.B.2.7.1a)). The board found that both scenarios constituted a serious procedural violation.

In **T 425/97**, the text of the single claim attached to the written decision of the opposition division was different from the text apparently held patentable at the oral proceedings. From the original minutes of the oral proceedings, the history of the case and further circumstances, the board concluded that the opposition division, in violation of Art. 113(2) EPC, had taken a decision on the patent on the basis of a text which had neither been submitted nor agreed by the proprietor of the patent.

In **T 543/92** and **T 89/94** the opposition division unintentionally failed to take account of a document introducing amended claims. In both cases the patent was revoked. The board ruled that once an item of mail had been received at the EPO it had to be considered to have been received by the organ deciding the case. Responsibility for the correct processing of mail thereafter lay with the relevant departments within the EPO. The decision under appeal was thus in breach of Art. 113(2) EPC.

In **T 1439/05** it was held that if there were several requests in the form of a main request and successive auxiliary requests submitted in order of relevance, the examining division was bound in its decision by the order in which the requests had been submitted.

In **T 1351/06**, the main request had not been withdrawn and had therefore remained pending. As a result, the decision to grant the patent on the basis of the text approved by the applicant as an auxiliary request was contrary to Art. 113(2) EPC.

In **T 736/14** the board held that, if an applicant whose application is non-unitary responds unclearly and/or in a misleading way to an invitation from the examining division to designate which searched invention it wishes to prosecute further, it could not be automatically assumed that the applicant selected the invention covered by the main request for examination. Rather, the examining division had to clarify, e.g. via a further communication, which of the searched inventions the applicant actually wanted it to examine. Confronting the applicant with an irrevocable decision not to admit an auxiliary request covering one of the inventions searched constituted a substantial procedural violation of the applicant's right to be heard. The examining division had presented the applicant with a fait accompli.

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1. Introduction

According to Art. 116(1) EPC, oral proceedings shall take place either at the instance of the EPO if it considers this to be expedient or at the request of any party to the proceedings. In other words, oral proceedings are not held automatically in each case.

Besides Art. 116 EPC, there are also other provisions relevant for the preparation and conduct of oral proceedings: R. 115 EPC – summons to oral proceedings (see in this chapter III.C.7.2.), R. 116 EPC – preparation of oral proceedings (see in this chapter III.C.7.3.), R. 124 EPC – minutes of oral proceedings (see in this chapter III.C.8.10.), as well as various notices concerning the practice for fixing the date of oral proceedings (see in this chapter III.C.7.1.1). For the boards of appeal, see also Art. 15 and 15a RPBA.

2. Purpose of oral proceedings

The purpose of oral proceedings is to safeguard a party's right to be heard as well as to settle as far as possible all outstanding questions relevant to the decision.

The Enlarged Board specified in **R 3/10** that the purpose of oral proceedings was to allow (i) each party to make an oral presentation of their arguments, (ii) the board to ask each party questions, (iii) the parties to respond to such questions and (iv) the board and the parties to discuss issues, including controversial and perhaps crucial issues.

In **T 1790/17** the board underlined that the purpose of oral proceedings was, for the appellant, to better explain their case and, for the board, to understand and clarify points which, perhaps, up to that point were not sufficiently clear. This was particularly relevant in ex parte cases, where besides the applicant (appellant) no other party was involved. If amendments resulting from such discussions were not possible, oral proceedings would be pointless.

In **T 247/20** the board stated that oral proceedings form an important part of proceedings before the boards of appeal. Their prominence was underlined by the absolute right of a party to oral proceedings under Art. 116 EPC. They served to allow a discussion of the matters pertinent to the board's decision. Oral proceedings would serve no purpose if the parties were limited to presenting a mere repetition of the arguments put forward in writing. Instead, parties must be allowed to refine their arguments, even to build on them provided they stayed within the framework of the arguments, and the evidence, submitted in a timely fashion in the written proceedings (see also **T 747/21**).

The board in **T 596/22** emphasised that oral proceedings were not a mere appendix to the written proceedings, but the time and place where the parties' arguments were put to the test by direct discussion, by argument and counter-argument.

3. Right to oral proceedings

3.1. Right to oral proceedings in examination, opposition and appeal proceedings

The right to an oral hearing is an extremely important procedural right which the EPO should take all reasonable steps to safeguard (**T 668/89**; **T 808/94**; **T 556/95**, OJ 1997, 205; **T 996/09**; **T 740/15**). If a request for oral proceedings (see in this chapter III.C.5.) has been made, such proceedings have to be appointed. This provision is mandatory and leaves no room for discretion (**T 283/88**, **T 795/91**, **T 556/95**, **T 1048/00**, **T 740/15**, **T 596/22**), i.e. parties have an **absolute right** to oral proceedings (**T 552/06**, **T 189/06**, **T 263/07**, **T 1426/07**, **T 653/08**, **T 1251/08**, **T 1829/10**, **T 247/20**; see however also the case law in this chapter III.C.3.1.5). Considerations such as the speedy conduct of the proceedings, equity or procedural economy cannot take precedence over this right (**T 598/88**, **T 731/93**, **T 777/06**, **T 2024/21**). Furthermore, according to the board in **T 2024/21** none of the following were reasons not to comply with the appellant's repeatedly expressed wish to hold oral proceedings: (i) the fact that oral proceedings caused costs, (ii) the reminder in the contested decision of the applicant's duty to submit an EPC compliant version of the application documents, or (iii) the repeated indication in the examination division's communications that amendments would not be admitted to the proceedings or had not been admitted under R. 137(3) EPC, so that no version of the application documents approved by the applicant would exist in the proceedings.

The right to be heard in oral proceedings subsists so long as proceedings are pending before the EPO (**T 556/95**, **T 114/09**).

Where several parties are involved, e.g. in opposition proceedings, the EPC provides only for oral proceedings to which all the parties are invited, so as to respect the principles of judicial impartiality and the equal rights of parties (**T 693/95**).

In **T 1224/21** the board held that there was no indication that Art. 116(1) EPC would also encompass a right of the party having requested oral proceedings to have the appeal case decided on the date of the scheduled oral proceedings (see also in this chapter III.C.8.9.).

In **T 1452/16** the board noted that there was no right for parties to have oral proceedings conducted by the board in a particular manner. It was up to the board to decide what points were to be addressed during the oral proceedings, and in which order.

3.1.1 Right to oral proceedings even after a Rule 71(3) EPC communication

The board in **T 556/95** (OJ 1997, 205) held that the discretion of an examining division to allow amendments up to the decision to grant the patent did not mean that that department had discretion to refuse a request for oral proceedings dealing with such amendments. The examining division had to have regard to Art. 116(1) EPC when exercising its discretion under R. 86(3) EPC 1973 in case of amendments requested after the issue of a communication under R. 51(6) EPC 1973 (equivalent in substance to R. 71(3) EPC). The Enlarged Board – which in **G 7/93** (OJ 1994, 775) had given some guidance as to how an examining division should exercise such discretion – could not limit the application of Art. 116(1) EPC by means of such guidance.

3.1.2 Right to oral proceedings even if no new arguments are presented

In **T 383/87** the board pointed out that Art. 116(1) EPC guaranteed the right of any party to request oral proceedings, i.e. to argue its case orally before the relevant department of the EPO. A party might feel that it could present its case better orally than in writing, even if it had no new arguments. It was then its genuine right to request oral proceedings without being inhibited by the fear of having to pay additional costs, unless the request for oral proceedings was a clear abuse of the law. See also **T 125/89**, **T 318/91**, **T 1051/92**, **T 6/98**. However, the lack of introduction of new points in oral proceedings was an aspect considered in **T 167/84** (OJ 1987, 369) for the board making an award on costs. On the apportionment of costs, see chapter III.R.2.2. "Acts or omissions prejudicing the timely and efficient conduct of oral proceedings".

3.1.3 Right to oral proceedings before a division in the composition in which it takes the final decision

In **T 2020/20** the board clarified that the right to oral proceedings under Art. 116(1) EPC could only mean a right to have oral proceedings before the examining division in a composition which also takes the final decision on the case. If the division conducting the oral proceedings could be different from that taking the final decision, oral proceedings would be deprived of their purpose and Art. 116(1) EPC would be meaningless. See also chapters III.K.1.1. "General comments on changes in composition of the competent

departments of first instance", III.K.1.2. "Examining division", III.K.3.3.2 "Examples of invalid or missing signatures" and III.B.2.9.2 "Composition change after oral proceedings".

3.1.4 No right to telephone conversation

According to the established case law, the EPC foresees the absolute right to oral proceedings under Art. 116(1) EPC, but not the right to a telephone interview or an informal telephone consultation. This applies to the proceedings before the boards of appeal, as well as to the proceedings before the examining division (see also chapter IV.B.2.7. "Informal communications").

A board is not required to contact the appellant by holding a telephone interview, for instance with the rapporteur, either after receipt of the response to the summons, or on the day of the oral proceedings (**T 189/06**, **T 552/06**, **T 1984/07**, **T 578/14**).

In **T 263/07** the appellant had requested that the rapporteur of the board telephone the appellant's representative to discuss the case so that the oral proceedings could possibly be cancelled. The board held that it was important that the same case was presented to all the board's members. For one of the board's members to be privy to evidence or arguments not available to the other members would be a breach of the principle of collective decision-making and in conflict with Art. 21 EPC 1973. Since the requested telephone interview could have led the rapporteur to take a position on an issue where a collective decision would have been required, or to commit the board without preliminary discussion, the request was refused. See also **T 1109/02**, **T 653/08**, **T 911/10**. This was confirmed in **T 1251/08**, in which the board added it wished to avoid giving the impression that it was never appropriate for parties in ex parte proceedings to telephone the rapporteur.

In **T 1984/07** the board did not rule out that there may be circumstances in which a telephone call may be appropriate: for example, if only minor objections remain which could be easily attended to by straightforward amendments. However, in the case in hand, the objections were of such nature that any further amendments were likely to entail more than just a simple modification to the wording of the claims or a straightforward adaptation of the description. Examples of cases in which the rapporteur contacted the applicant by phone are: **T 182/90** (OJ 1994, 641), **T 329/90**, **T 594/94**, **T 931/99**, **T 845/10**, **T 680/13**.

In **T 702/17** the board explained that conducting oral proceedings with a party over the telephone was not provided for in the EPC. Accordingly, the examining division had acted correctly in refusing to allow the inventor to take part in the oral proceedings over the phone. Furthermore, the inventor had still been allowed to speak over the telephone, with the representative relaying the inventor's words to the examining division – a course of action the representative had agreed to, according to the minutes. The board found that there was therefore no substantial procedural violation which would justify a refund of the appeal fee.

3.1.5 No absolute right to oral proceedings?

In **G 2/19** (OJ 2020, A87) the Enlarged Board considered that a third party within the meaning of Art. 115 EPC who has filed an appeal against a decision to grant a European patent has no right to have its request for an order that examination proceedings in respect of the European patent be reopened for the purpose of removing allegedly unclear claims (Art. 84 EPC) heard at oral proceedings before an EPO board of appeal. Given the variety in the scope of application of Art 116(1), first sentence, EPC, its nature could not be considered so, as it were, absolute. The legislator had clearly intended it to serve as a basic rule governing the typical cases facing EPO departments in their everyday practice but it could not be ruled out that exceptions to this basic rule might be made where its application would make no sense in the specific circumstances of an individual case. Instead, Art. 116(1), first sentence, EPC was to be interpreted narrowly, such that a purely formal position as de facto party to appeal proceedings was not enough to confer a right to require that oral proceedings be held if the person requesting them had no standing to appeal, because they had not been a party to the foregoing proceedings in the legal sense, or if the grievance they invoked was not appealable (see referral in **T 831/17** of 25 February 2019).

The Legal Board in **J 6/22** held that in light of the principles of a fair trial and legal certainty in due time, there was no absolute right to oral proceedings under all circumstances (not followed by **T 596/22**). The right to oral proceedings upon a party's request was subject to inherent restrictions by the EPC and procedural principles generally recognised in the EPC contracting states (Art. 125 EPC). A literal interpretation of Art. 116(1) EPC conflicted with the legislature's aims when oral proceedings served no purpose and would thus only prolong proceedings to no one's avail. The very purpose of Art. 116(1) EPC could be seen as providing for the essential right to be heard in oral proceedings only in so far as these served a legitimate purpose and thus did not run counter to the requirement of legal certainty in due time as a further essential element of a fair trial for all parties. In a case like the one at hand, legal certainty in due time, just as procedural economy, as a further essential cornerstone of a fair trial, had to prevail (see also **T 2542/22**). See also in this chapter III.C.5.3.2f) as well as chapters III.H.2.3.5 "Secondary considerations: dynamic interpretation" and III.H.7. "The European Convention on Human Rights".

3.2. Right to oral proceedings before the Receiving Section

Under Art. 116(2) EPC oral proceedings must take place before the Receiving Section at the request of the applicant only where the Receiving Section considers this to be expedient or where it envisages refusing the European patent application. The Legal Board, exercising the powers within the competence of the Receiving Section, can refuse a request for oral proceedings made by an applicant in the course of an appeal against a decision of the Receiving Section for the same reasons (**J 20/87**, OJ 1989, 67).

Although according to Art. 116(2) EPC the Receiving Section is entitled not to grant a request for oral proceedings, the applicant has the right to a decision on that request (**J 16/02**). Not deciding on a request put before the Receiving Section constitutes a substantial violation of the applicant's right to be heard (**J 9/18**). The discretion foreseen

in Art. 116(2) EPC in dealing with the request for oral proceedings is not without limits and has to be exercised in light of recognised procedural principles such as the right to be heard set out in Art. 113(1) EPC (**J 17/03**).

The decision confirming a loss of a right (R. 69(2) EPC 1973, R. 112(2) EPC) is not a case in which the Receiving Section "envisages refusing the European patent application" within the meaning of Art. 116(2) EPC 1973 (**J xx/xx**=**J 900/85**, OJ 1985, 159; **J 17/03**).

4. Oral proceedings at the instance of the EPO

Oral proceedings may take place even if they were not requested, as according to Art. 116(1) EPC oral proceedings shall take place at the instance of the EPO if it considers this to be expedient.

4.1. Expediency of oral proceedings

In **T 660/12** the board held that the wording of both Art. 116(1) EPC and the Guidelines made it clear that the only criterion for oral proceedings to take place at the instance of the EPO was that the examining division considered it expedient. Even if it were at all possible to argue in retrospect that the holding of oral proceedings was not "expedient", such argument would ignore the wording of Art. 116(1) EPC, which makes the decision to hold oral proceedings dependent on the subjective assessment of the division.

In **T 1734/10** the board held that evaluating whether oral proceedings were indeed expedient was part of the examining division's discretion, which was to be exercised taking into account the progress made in the examination proceedings. For assessing expediency, the main consideration in the Guidelines was procedural economy and certainly not the condition of a complete lack of progress in the examination ("last resort situation").

In **T 120/12** the board held that it was up to the examining division to decide, taking the circumstances of the case into account, whether or not it considered it to be expedient to summon the applicant to oral proceedings under R. 115(1) EPC. Neither the EPC nor the Guidelines required that reasons for this decision be given with the summons.

In **T 446/09**, in view of its decision not to remit the case to the first instance, the board considered it to be expedient to hold oral proceedings in order to bring the case to a conclusion, and therefore refused the appellant's request to cancel the oral proceedings.

In **T 166/04** the board held that, in particular, clarity problems could be handled expediently during oral proceedings.

In **T 1388/10** the board held that it was not expedient to hold oral proceedings where an applicant merely submitted that it considered a particular objection overcome without putting forward any arguments in support of its position.

4.2. Effects of withdrawal of a request for oral proceedings in case of oral proceedings at the instance of the EPO

The withdrawal by a party of its request for oral proceedings, with its further request for continuation of the proceedings in writing have no effect in a case where the oral proceedings are held at the instance of the EPO (**T 1578/05**, **T 556/07**).

5. Request for oral proceedings

A party's right to oral proceedings is subject to a clear and unambiguous request for such proceedings (**T 352/89**,**T 663/90**, **T 1976/08**, **T 1500/13**). The refusal of a request for oral proceedings normally constitutes a violation of the right to present comments. If the request for oral proceedings is ignored, even due to an oversight, the decision must be set aside as null and void (**J 12/15**; **T 19/87**, OJ 1988, 268; **T 93/88**; **T 766/90**; **T 556/95**, OJ 1997, 205; **T 996/09**; **T 740/15**; **T 1951/16**).

In **T 1050/19** the board admitted a late-filed request for oral proceedings on the basis that it was an exercise of the right to be heard rather than an amendment to the appeal case within the meaning of Art. 13(1) RPBA.

5.1. Doubt as to the nature of the request for oral proceedings

The question whether a request for oral proceedings has been made must be decided on the individual facts of each case. Whether a request in the legal sense has been made does not merely depend upon the actual use of the word "request" (**T 283/88**, **T 263/91**, **T 1829/10**). If there is the slightest doubt, clarification should be sought from the party concerned (see e.g. **T 299/86**, OJ 1988, 88; **T 19/87**; OJ 1988, 268; **T 870/93**; **T 417/00**; **T 1829/10**; **T 2373/11**; **T 2557/12**; **T 1500/13**).

If an EPO department has any doubt as to whether a party has requested oral proceedings (e.g. if the request is for a "hearing"), it must clarify the matter in order to avoid committing a substantial procedural violation (**T 1829/10**, **T 2373/11**, **T 1972/13**). As a request for an "interview" is different from a request for oral proceedings, the examining division can refuse such a request without seeking clarification (**T 1606/07**, **T 1976/08**).

Nevertheless, in **T 528/96**, the board explained that, although the opposition division might reasonably have been expected to query whether a request for oral proceedings was in fact intended, the fact that it failed to do so did not constitute a procedural violation, since the onus to make a clear request was on the party itself (see also **T 26/07**).

In **T 2687/17** the board considered it irrelevant that the request for oral proceedings had "only" been made on Form 2300 and not repeated in the statement of grounds for opposition because there was no obligation to state the reasons for a request for oral proceedings.

5.2. Wording of request

5.2.1 Wording constituting a request

In **T 19/87** (OJ 1988, 268) the board considered that the request for "an interview as a preliminary to oral proceedings" could only be construed as both a request for an interview (which might or might not be granted) and request for oral proceedings.

In **T 668/89** the phrase "applicant's representative claims his right to appear and argue the case orally" was deemed to be a valid request for oral proceedings.

In **T 494/90** the wording "We request that we be given the opportunity to attend an oral hearing which may be appointed" was accepted as request for oral proceedings in the circumstances of the case.

In the ex parte case **T 95/04** the appellant's request for a telephone call from the examiner was followed by a further request "in any event" for an opportunity to be heard before an adverse decision was taken. In the board's view, the expression "in any event" implied that, if the examiner was to exercise his discretion and not to communicate further with the applicant, then the applicant wished to have a further opportunity to be heard which under the circumstances could only be provided by appointing oral proceedings.

In **T 1829/10** the applicant's response to the examining division's first communication was that a hearing would be "expedient" (German: "sachdienlich") if basic concerns regarding patentability persisted. The board of appeal held that the term "hearing" was synonymous with "oral proceedings".

In **T 2557/12** the examining division had considered that the following phrase did not constitute a request for oral proceedings: "In the case of the Examining division would decide to reject the application, an oral proceeding would be requested pursuant to article 116 EPC". The board held that the phrase in question left little doubt about the applicant's intention to avoid an immediate refusal of its application. It should be considered more likely as a request for oral proceedings than not.

5.2.2 Wording not constituting a request

In **T 528/96**, the final paragraph of the patentee's response to the opposition – the last document on the file before the opposition division took its decision – read as follows: "Should the opposition division feel that further information is required, the patentee will be pleased to respond in due course, either in writing or during the oral hearing". The statement did not constitute a formal request for oral proceedings.

In **T 299/86** (OJ 1988, 88) a party "reserved the right to request oral proceedings". This was interpreted as meaning that the party had not yet decided whether to request oral proceedings. See also **T 263/91**.

In **T 433/87** the board interpreted the patent proprietor's request "to conclude the opposition proceedings and if necessary arrange oral proceedings as soon as possible" to mean that oral proceedings were requested only in the event of their being considered necessary by the opposition division. See also **T 650/94**.

The statement "if there are any outstanding problems, the writer would welcome an opportunity to discuss the case with the examiner" could not be understood as a valid request for oral proceedings either (**T 88/87**). See also **T 454/93**, **T 1606/07**, **T 1500/13**.

In **T 60/13** the board did not consider the respondent's statement that "if an oral hearing was to take place we wish to attend" to constitute a request for oral proceedings. Furthermore, the indication regarding the language used in "possible oral proceedings" and the request to use Swedish in oral proceedings, after the statement that "we find it unnecessary to attend an oral proceeding" were not seen to constitute a clear request for oral proceedings.

In **T 1310/17** the board found that a party announcing that it would not be attending oral proceedings and at the same time requesting that they be postponed if they could not be held online was not to be treated as an independent request for oral proceedings. Instead, the party was merely commenting on the modalities of the oral proceedings scheduled (at the opposing party's request), should such a hearing take place. A conditional request for postponement made for the mere eventuality that the hearing might be held online was thus to no avail.

5.3. Withdrawal of request for oral proceedings

Generally, the request for oral proceedings can only be withdrawn by virtue of a clearly expressed intention not to proceed with the request (see in this chapter III.C.5.3.1). However, in a considerable number of decisions, announcing a party's non-attendance has also been treated as equivalent to a withdrawal of the request for oral proceedings (see in this chapter III.C.5.3.2a)). Furthermore, there is case law according to which a party's announcement of non-attendance or other specific circumstances of the case do not necessarily entail a withdrawal of the request for oral proceedings, but may still result in no oral proceedings being held (see in this chapter III.C.5.3.2b) – f)).

5.3.1 Withdrawal only by virtue of a clearly expressed intention not to proceed with the request

A party's request for oral proceedings can be withdrawn only by virtue of a clearly expressed intention not to proceed with the request, for example in the form of an unambiguous written statement to that effect on the file (**T 1548/11**). Silence on the part of a party cannot be interpreted as withdrawal of the request for oral proceedings (**J 12/15**, **T 766/90**, **T 35/92**, **T 686/92**, **T 1951/16**, **T 2687/17**). A withdrawal of the request for oral proceedings requires an unambiguous expression of the party's wish to withdraw (**T 795/91**, **T 879/92**, **T 2687/17**). If there is no unequivocal proof of the withdrawal of the request, it has to be assumed that the request, once submitted, remains valid and was therefore also valid at the time of the contested decision (see **J 12/15**, **T 283/88**, **T 598/88**,

T 663/90, **T 1951/16**). In case of doubt, the relevant deciding body should check with the party concerned whether they wish to maintain their request for oral proceedings (see **T 283/88**).

5.3.2 Oral proceedings not held despite the lack of an explicit withdrawal

In a considerable number of decisions boards saw no need for oral proceedings despite the lack of an explicit withdrawal of the request for oral proceedings.

A large part of these decisions treat the announcement of non-attendance of the oral proceedings as equivalent to a withdrawal of the request (see e.g. **T 3/90** and further examples in this chapter III.C.5.3.2a)). Some decisions consider the announcement of non-attendance as resulting in a request becoming ineffective (see e.g. **T 245/19**; see also in this chapter III.C.5.3.2b)) or as a waiver of the party's opportunity to present their case orally (see e.g. **T 1066/19** and further examples in this chapter III.C.5.3.2c)). In some decisions the boards pointed out that if a party announces it will not attend oral proceedings, the board is not obliged to hold oral proceedings in the party's absence (see e.g. **T 1750/19** and further examples in this chapter III.C.5.3.2d)).

In several decisions the lack of statement of grounds of appeal followed by lack of response to a notification of the inadmissibility of the appeal is regarded as equivalent to an abandonment of a request for oral proceedings (see e.g. **T 1042/07** and further examples in this chapter III.C.5.3.2e)).

In some decisions the boards found that if oral proceedings would not serve any legitimate purpose, oral proceedings need not be held, notwithstanding a request for oral proceedings (see e.g. **T 1573/20** and further examples in this chapter III.C.5.3.2f)).

For general remarks on exceptional limitations to the right to oral proceedings, see in this chapter III.C.3.1.5. For cases in which a decision in favour of a party resulted in no oral proceedings being held, see in this chapter III.C.5.5. and III.C.5.6.

a) Announcing non-attendance – equivalent to a withdrawal of the request for oral proceedings

Where oral proceedings are scheduled upon a party's request and that party subsequently expresses its intention not to attend, such statement is interpreted in a considerable number of decisions as equivalent to a withdrawal of the request for oral proceedings.

In **T 3/90** (OJ 1992, 737) oral proceedings were appointed as a result of a party's request. The party subsequently stated that it would not be represented at the oral proceedings. The board held that such a statement should normally be treated as equivalent to a withdrawal of the request for oral proceedings (see also **T 696/02**, **T 1027/03**, **T 1482/05**, **T 871/07**, **T 1229/12**, **T 2188/12**, **T 320/16**, **T 517/17**, **T 576/17**, **T 1020/17**, **T 232/18**, **T 849/18**, **T 901/18**, **T 1359/19**, **T 1521/19**, **T 1675/19**, **T 2200/19**, **T 2718/19**, **T 2773/19**, **T 2899/19**, **T 3224/19**, **T 3257/19**, **T 872/20**, **T 976/20**, **T 1446/20**, **T 1022/21**, **T 1598/21**, **T 124/22**, **T 441/22**, **T 2542/22**, **T 104/23**).

By stating that it will not attend oral proceedings and by requesting a decision on the record, a party unequivocally expresses that it is interested in an immediate decision on the file as stood and that it does not wish to present its arguments orally in the requested oral proceedings (**T 1482/05**; see also **T 1278/21**, **T 832/22**). Notwithstanding the missing request for a decision on the record, the board held in **T 2152/19** that when a party states that it will not be attending oral proceedings, it is unequivocally expressing its interest in an immediate decision on the file as it stands and implying that it does not wish to present its arguments orally in the previously requested oral proceedings. See also **T 320/16**, **T 502/16** and **T 2542/22**.

b) Announcing non-attendance – request for oral proceedings becoming ineffective

In **T 245/19** the board was of the opinion that a party's announcement that it would not be attending the hearing did not necessarily entail the withdrawal of a previously made request to present their arguments orally. It rather resulted in its request for oral proceedings becoming ineffective, irrespective of a declaration that the request for oral proceedings was explicitly maintained. The right to oral proceedings could not be understood as the right to have the board hold oral proceedings with the other parties to the proceedings. The board found that in view of the resulting ineffective request, the board may dispense with oral proceedings if no other reason made it necessary or desirable to hold them. See also **T 2015/16**.

c) Announcing non-attendance – waiver of the party's opportunity to present their case orally

In **T 1066/19** the board pointed out that the right to oral proceedings had to be seen in the light of the right to be heard pursuant to Art. 113 EPC. The board held that the principle of the right to be heard pursuant to Art. 113(1) EPC had not been violated by the decision in question, considering it sufficient that the appellant had had the opportunity to be heard. By declaring that it would not be attending oral proceedings, the appellant had waived the opportunity to present its arguments orally at the scheduled oral proceedings and had indicated its wish to rely instead on the arguments presented in the written proceedings (see also **T 73/17**, **T 3002/19**, **T 3104/19**, **T 1192/20**, **T 1/21**, **T 1224/21**, **T 536/22**, **T 1531/22**).

d) Announcing non-attendance – no obligation to hold oral proceedings in the party's absence

In **T 1750/19** the board held that it is established case law that, if oral proceedings are scheduled as a result of a party's request for such proceedings on an auxiliary basis, and if that party subsequently states that it will not be represented at the oral proceedings, the board is not obliged to hold oral proceedings in the party's absence. Under these circumstances, it was within the discretion of the board to decide whether the scheduled oral proceedings were to be maintained or cancelled, since it could not be the purpose of Art. 116 EPC that a party could oblige a board to hold oral proceedings in its absence (see also **T 1103/22**).

In **T 910/02** the board remitted the case to the department of first instance for further prosecution without oral proceedings, since all the parties who had presented their comments in the appeal proceedings had either withdrawn their auxiliary request for oral proceedings or had stated that they would not attend oral proceedings. In such a case the board has discretion either to abide by the date for the oral proceedings in order to announce a decision, or to cancel the oral proceedings and issue a decision based on written proceedings (see also **T 154/17**, **T 1750/19**, **T 1103/22**). **T 663/10** confirmed **T 910/02**, adding that the board was not obliged to hold oral proceedings in the absence of the party, even if the appellant had explicitly maintained its request for oral proceedings (see also **T 1750/19**, **T 1103/22)**. In **T 671/12** the board followed these decisions and held that it could not be the purpose of Art. 116 EPC that a party could oblige a board to hold oral proceedings in its absence. See also **T 166/17**, **T 1750/19**, **T 3002/19**, **T 1103/22**.

Referring to **T 671/12** and **T 663/10** the board considered in **T 263/22** that if the sole party in ex parte proceedings indicated that it would not be attending oral proceedings, the board was not obliged to hold oral proceedings in the absence of the party, i.e. with the board being the only participant. It furthermore clarified that if the appellant was legally required to be represented by a professional representative, an indication that the representative would not be attending equated to the appellant not participating in the oral proceedings.

In the ex parte proceedings of **T 674/19** the board did not interpret the appellant's announcement it would not attend the oral proceedings as a withdrawal of its request for oral proceedings. Instead, it considered holding oral proceedings to be appropriate in order to close the debate and to announce a decision at the oral proceedings. According to the board, it had discretion under Art. 116(1), first sentence, EPC to either maintain the date of the oral proceedings, in order to announce a decision at the oral proceedings, or to cancel the oral proceedings and issue a decision based on written proceedings, taking into account the appellant's right to be heard under Art. 113(1) EPC.

e) No substantive response to a notification of inadmissibility of the appeal – equivalent to abandonment of the request for oral proceedings

In the absence of anything that can be regarded as a statement of grounds of appeal, the lack of any substantive response to a notification of the inadmissibility of the appeal is considered as equivalent to an abandonment of a request for oral proceedings initially made in the notice of appeal (see inter alia **T 1042/07**, **T 234/10**, **T 179/11**, **T 2162/14**, **T 95/17**, **T 362/18**, **T 1321/18**, **T 278/21**).

f) Oral proceedings serving no legitimate purpose – exceptions to the right to oral proceedings

Due to the lack of any substantive response to a notification of inadmissibility of the appeal, the board in **T 1573/20** found that holding oral proceedings would have served no other purpose than confirming the (undisputed) preliminary finding that no statement of grounds of appeal had been filed. There was no contentious matter on which the appellant had to be heard according to Art. 113(1) EPC. Oral proceedings would thus have had no legitimate aim. Even more, had the appellant insisted on holding oral proceedings in the

absence of any dispute, this would have amounted to a breach of the duty to act in good faith (**G 2/97**). The board found that this situation was comparable to the "clearly inadmissible appeals" considered in decisions **G 1/97** (OJ 2000, 322) and **G 2/19** (OJ 2020, A87; See also in this chapter III.C.3.1.5). These decisions were concerned with appeals by a non-party or based on non-existing remedies only. The board was convinced that the Enlarged Board did not consider these examples to be exhaustive. Rather, it acknowledged as a matter of principle that there are exceptions to the right to oral proceedings under Art. 116 EPC (see also **T 2377/19**).

The Legal Board in **J 6/22** found that the requirement for immediate and complete substantiation of the request for re-establishment in respect of the time limit for filing the statement of grounds of appeal had not been fulfilled. The Legal Board held that no further procedural steps were thus permissible, notably no appointment of oral proceedings. If oral proceedings did not serve any legitimate purpose, the requirement of legal certainty in due time would trump and even prevent a board from appointing them (see also **T 2542/22**). See also in this chapter III.C.3.1.5 as well as chapter III.H.2.3.5 "Secondary considerations: dynamic interpretation" and chapter III.H.7. "The European Convention on Human Rights".

In the absence of an agreed text of the patent, the board in **T 990/16** held that there was no matter as to substance on which the board had the power to hear the parties. The board emphasised that it could not be the purpose of Art. 116 EPC and R. 115(2) EPC that a party may oblige a board to hold oral proceedings in which the matter raised by that party cannot be discussed at all. In such a case, a party had no legitimate interest in pursuing its request for oral proceedings. Insisting on them amounted to a breach of that party's duty to act in good faith (**G 2/97**) and could be regarded as an abuse of right. The board concluded that no serious or legitimate interest existed in the current circumstances for holding oral proceedings, and the procedural right to oral proceedings under Art. 116(1) EPC would thus be exercised for a purpose other than its intended legal aim.

5.3.3 Withdrawal of request for oral proceedings – reimbursement of appeal fee

Under R. 103(4)(c) EPC, 25% of the appeal fee is reimbursed if any request for oral proceedings is withdrawn within one month of notification of the communication issued by the board in preparation for the oral proceedings, and no oral proceedings take place. For further information, see chapter V.A.11.12. "Partial reimbursement (25%) under Rule 103(4) EPC".

In some decisions boards dealt with whether R. 103(4)(c) EPC applied only if the party explicitly withdrew its request for oral proceedings. While some boards required an explicit withdrawal, other boards considered an appellant's indication that it would not attend oral proceedings as complying with the requirement of a withdrawal under R. 103(4)(c) EPC.

On whether a withdrawal of a request for oral proceedings can lead to a different apportionment of costs under Art. 104 EPC, see chapter III.R.2.2. "Acts or omissions prejudicing the timely and efficient conduct of oral proceedings".

a) Explicit withdrawal required

In **T 73/17** the board held that the case law interpreting an announcement of non-attendance as an implicit withdrawal of the request for oral proceedings was not transferable to R. 103(4)(c) EPC. According to the board, it followed from the preparatory work and the circumstances of the revision of R. 103 EPC that the legislator drew a clear-cut distinction between a party's simple announcement that it would not be attending oral proceedings and the express withdrawal of its request for them. R. 103 EPC explicitly required that the request for oral proceedings be withdrawn for a partial reimbursement of the appeal fee to be granted; it was insufficient for a reimbursement if oral proceedings were simply not held. According to this interpretation, R. 103(4)(c) EPC thus applies only if the party **explicitly** withdraws its request for oral proceedings (see also **T 191/17** and **T 2698/17**).

b) Explicit withdrawal not required

In **T 517/17** the appellant's indication that it would not attend oral proceedings was considered by the board as complying with the requirement of a withdrawal under R. 103(4)(c) EPC. Unlike the board in **T 73/17**, the board found that an explicit withdrawal was not required. The board held that, if it was true that the express announcement of not attending arranged oral proceedings before the board was equivalent to a withdrawal of the request for them, this must be true and valid for all effects that the EPC and the case law attach to a withdrawal. See also **T 202/18**, **T 901/18**, **T 1888/18**, **T 441/22**, **T 104/23**.

The board in **T 104/23** held that with the appellant's announcement of the intention not to attend the oral proceedings, the legislative intention under R. 103(4)(c) EPC had been met: the board could not have cancelled the oral proceedings but for the appellant's statement. Thus, oral proceedings were ultimately not held and the legislative purpose of facilitating and streamlining proceedings was achieved.

In **T 3257/19** the appellant's indication that it would not attend oral proceedings was also considered by the board as complying with the requirement of a withdrawal under R. 103(4)(c) EPC. No reimbursement of the appeal fee could however be ordered since the appellant's indication had not been submitted within one month of the notification of the board's communication under Art. 15(1) RPBA (as in force until 31 December 2023), as required by R. 103(4)(c) EPC.

5.3.4 Duty to hold oral proceedings not affected despite withdrawal of request for oral proceedings

In **T 2024/21** the board concluded that the examining division's continual refusal to appoint oral proceedings and indeed its explanation for not doing so, had made it evident that the appellant had been left with no realistic possibility to have its request for oral proceedings met. Thus, maintenance of the request for oral proceedings had clearly been rendered futile. According to the board, withdrawal of the request for oral proceedings under these particular circumstances had not absolved the examining division from its duty to hold the originally requested oral proceedings (see also chapter III.B.2.3.2 "First-instance

proceedings", chapter III.B.2.7. "The right to be heard in oral proceedings" and in this chapter III.C.3.1.).

5.4. Further oral proceedings before the same department

According to Art. 116(1), second sentence, EPC the EPO may reject a request for further oral proceedings before the same department where the parties and the subject of the proceedings are the same.

5.4.1 Same subject of proceedings

According to the case law of the boards of appeal, the subject of the proceedings is the same if no substantially new situation has arisen after the first oral proceedings that could justify renewed oral proceedings (see **T 692/90**, **T 755/90**, **T 25/91**, **T 327/91**, **T 748/91** and **T 941/16**).

In **T 298/97** (OJ 2002, 83) the board observed that the right to oral proceedings was not to two oral proceedings on the same subject. Any further oral proceedings on the issue of admissibility would therefore be a matter for the board's discretion.

In **T 547/88** the board rejected the request for further oral proceedings. The purpose of continuing the proceedings in writing after the first oral hearing was merely to provide further clarification of the same facts. In addition, in **T 614/90** the board rejected the request to comment in writing on the board's reasons for refusing further oral proceedings because the reasons for the refusal had already been given in a communication.

In **T 529/94** the examining division, in exercising its discretionary power under R. 86(3) EPC 1973, had considered newly filed claims 3 and 4 as inadmissible. The board held that the legal consequence of this was that claims 3 and 4 were never integrated into the text of the application and never became part of it. For this reason, refusing to hold oral proceedings a second time, during which proceedings it was intended to discuss the allowability of proposed amendments already judged as inadmissible, could not constitute a procedural violation.

5.4.2 Not the same subject of proceedings

In **T 731/93** the board stated that where fresh evidence had been admitted into the proceedings, the "subject" of such proceedings, as construed by reference to the text of Art. 116(1) EPC in all three official languages, could no longer be the same.

In **T 194/96** new citations were submitted after the first oral proceedings that were more pertinent than the documents on file and which could and in fact did radically change the nature of the decision. The board held that in such a case the subject of the proceedings could no longer be the same.

In **T 1880/11** after the board had in a first decision ordered a patent to be granted on the basis of the main request and the description to be adapted accordingly, the examining

division refused the application a second time without holding oral proceedings. The board held that there had been a new subject before the examining division, namely how to adapt the description and the figures in order to fulfil the board's order. It could at least have been discussed during oral proceedings whether the section of the first appeal decision on which there was disagreement between the division and the applicant belonged to the ratio decidendi of that decision and how this section should be interpreted.

In **T 2106/09** the board had in a previous decision remitted the case to the opposition division. In its statement of grounds for the earlier appeal, the appellant had changed the subject of the proceedings by introducing a new citation and claiming a lack of inventive step on the basis of a combination of the teachings of various citations. The opposition division had thus been wrong to consider that the subject of the proceedings was the same and, by issuing the contested decision without holding oral proceedings, as requested by the appellant, it had infringed the right to be heard. See **T 120/96**, **T 679/97**, **T 1548/11**.

In **T 1775/12** the board held that the procedural issue of admission under R. 137(3) EPC of amendments filed in response to a communication under R. 71(3) EPC constituted a "subject of the proceedings" within the meaning of Art. 116(1) EPC, second sentence, EPC which was distinct from the discussion of matters of substantive law that had previously taken place at oral proceedings.

5.5. Auxiliary request for oral proceedings

There is no requirement in the EPC or in the case law that only unconditional requests to oral proceedings are admissible. It is normal practice to request oral proceedings e.g. only for the eventuality of an imminent adverse decision (see inter alia **T 870/93**, **T 1136/10**). According to the established practice of the boards of appeal, a request for oral proceedings on an auxiliary basis is interpreted as a request for oral proceedings unless the board intends to decide the case in favour of this party (see **T 3/90**, OJ 1992, 737).

In **T 902/04** the board held that, since the opponent's request was allowed, there was no need to hold the oral proceedings which only the opponent had requested on a purely auxiliary basis. See also **T 545/08**, **T 749/15**, **T 494/21**. In **T 606/22** the board allowed the appeal and found that the appellant's auxiliary request for oral proceedings therefore had no procedural effect (see also **T 990/16**).

In **T 344/88** the appellants requested that oral proceedings be held if the opposition division intended to maintain the patent in whole or in part. The opposition division rejected the opposition as inadmissible without appointing oral proceedings. The board found that while it was true that, in rejecting the opposition as inadmissible, no formal decision had been taken to maintain the patent, this was nevertheless the consequence of the decision. According to the board, this showed that an auxiliary request for oral proceedings should not be assessed solely on the basis of its wording.

In numerous decisions the boards concluded that a party was not adversely affected by a decision to remit a case for further prosecution without any consideration of the substantive issues, so that there was no need to appoint oral proceedings requested on an auxiliary

basis (see inter alia **T 147/84**, **T 42/90**, **T 47/94**, **T 1434/06**, **T 1367/12**, **T 1727/12**, **T 1205/13**, **T 1051/20**). In **T 924/91** the board specified that while remittal meant that the patent was not yet to be granted, it also meant that the decision under appeal was being set aside and that the application was not refused (see also **T 222/87**). In the board's view in **T 47/94**, it was furthermore neither necessary nor appropriate to appoint oral proceedings solely to discuss whether or not the case should be remitted to the opposition division (see also **T 1051/20**), particularly since this would further delay the final decision.

5.6. Decision in favour of the party – no oral proceedings despite unconditional request

In their statement of grounds of appeal the appellants in **T 494/92** made an unconditional request for oral proceedings. The board stated that in view of the positive conclusion it had reached regarding the question of inventive step, and in the absence of any other substantive and/or procedural issues, such oral proceedings would serve no purpose. The board thus treated the request as merely conditional (see also **T 2445/11**). In **T 1050/09**, the opposition division, referring to **T 494/92**, had treated the opponent's unconditional request for oral proceedings as merely conditional as it had decided in favour of the opponent. The board agreed and added that a successful party had no reason to doubt the correctness of the procedure leading to the decision in its favour. In **T 1066/19** too, the board allowed the respondent's main request and so could see no reason to grant its unconditional request for oral proceedings for the purposes of guaranteeing its right to be heard.

5.7. Request for oral proceedings in relation to further prosecution proceedings after remittal

According to the established case law, "further prosecution" proceedings on remittal by the board of appeal are to be regarded as a continuation of the original opposition proceedings, particularly where the original interlocutory decision had been set aside by the board and was therefore no longer legally effective. Thus, with remittal, parties' requests valid in the opposition proceedings, including any auxiliary request for oral proceedings, become effective again, if they were not withdrawn (**T 892/92**, **T 120/96**, **T 742/04**, **T 1425/05**, **T 1548/11**).

In **T 1866/08** the board considered that the appeal procedure was separate from the examination procedure (see e.g. **G 8/91**, **T 34/90**). It followed that a request for oral proceedings to be held before the examining division could not validly be made during the appeal proceedings. As a consequence, the appellant would have to file a new request for oral proceedings after the procedure was resumed by the examining division. **T 901/10** confirmed **T 1866/08**, adding that oral proceedings in possible further appeal proceedings in the future would have to be requested again during such proceedings.

5.8. Request for oral proceedings as a reply to a communication

In **T 1382/04** the appellant had been invited to file observations on the board's communication under R. 100(2) EPC. Failure to reply to such an invitation in due time

would result in the application being deemed withdrawn (R. 100(3) EPC). The appellant had not made any substantive observations on the board's communication but had filed a request for oral proceedings. The board considered the request for oral proceedings as a reply avoiding a deemed withdrawal under R. 100(3) EPC. Similarly, the board in **T 861/03** stated that a request for oral proceedings could be a valid reply to a communication under Art. 96(2) EPC 1973 (now Art. 94(3) EPC).

6. Non-attendance at oral proceedings

The absence of parties from oral proceedings is in general governed by R. 115(2) EPC and – for the boards of appeal – by Art. 15(3) and (6) RPBA. Concerning non-attendance at oral proceedings before the examining division, see also the notice from the EPO, OJ 2020, A124.

According to Art. 15(3) RPBA, the board is not obliged to delay any step in the proceedings, including its decision, by reason only of the absence at the oral proceedings of a party duly summoned who may then be treated as relying only on its written case (see also Art. 15(3) RPBA 2007, which has essentially the same wording as Art. 15(3) RPBA). The board may therefore, in accordance with Art. 15(6) RPBA, ensure that the case is ready for decision at the conclusion of the oral proceedings, unless there are special reasons to the contrary.

6.1. Right to present comments and non-attendance of a party by choice

According to **T 1500/10** R. 115(2) EPC makes it clear that the oral proceedings are themselves an opportunity for the applicant to present its comments, in accordance with Art. 113(1) EPC. If a party decides not to attend the oral proceedings without a serious reason, it chooses not to make use of the opportunity to comment at the oral proceedings on any of the objections raised during them, and it has no right to make additional written submissions. Serious reasons are the same reasons that could justify postponement of oral proceedings (see in this chapter III.C.7.1.5).

In **T 1339/14** the board held that the purpose of oral proceedings was to give parties an opportunity, in addition to their written submissions, to make their cases orally as well, and to be heard in this form. Oral proceedings also enabled parties to amend their cases and to respond directly in that forum to any such changes made by the opposing party. A party who failed to attend the oral proceedings forfeited this opportunity.

In **T 1801/17** the board noted that there is no legal obligation to attend the oral proceedings. The patent proprietor dealt with all the outstanding objections during the written opposition proceedings, including filing auxiliary requests aimed at overcoming the added subject-matter ones known at the time. This was a legitimate way of defending oneself against an opposition and does not suggest any intention to avoid a ruling on the matter at first instance. By proceeding in this way, the proprietor did not forfeit the right to defend itself in appeal against objections that were only raised during oral proceedings.

On the question of whether a decision pronounced against a party who has chosen not to attend oral proceedings may be based on new facts, evidence and/or arguments introduced during those oral proceedings, see chapter III.B.2.8. "The right to be heard in case of the non-attendance of oral proceedings".

6.2. Non-attendance of party who filed new claims without amended description before oral proceedings; no reason for postponement of ruling

In **T 917/95** the board held that a patentee who, in inter partes proceedings, filed a new claim but no amended description prior to the oral proceedings before the board of appeal and who failed to attend the oral proceedings could not rely on the board's postponing its ruling simply to permit amendment of the description, even if the new claim was allowable (see also **T 725/00**, **T 109/02**, **T 181/02**, **T 776/05**, **T 651/08**, **T 2294/08**). In **T 1810/06** the board extended this finding of **T 917/95** to an ex parte case. In **T 985/11** the board stated that it still has discretion under Art. 111 EPC to decide how to proceed in this situation, and in particular whether to remit the case to the opposition division for adaptation of the description or exercise the powers of the opposition division and either continue the proceedings in writing or revoke the patent.

6.3. Obligation to give notice if not attending oral proceedings

In **T 930/92** (OJ 1996, 191) the board also pointed out that there was an equitable obligation on every party summoned to oral proceedings to inform the EPO as soon as it knew that it would not attend as summoned. This was the case whether or not that party had itself requested oral proceedings, and whether or not a communication had accompanied the summons to oral proceedings. According to the board in **T 939/21**, the boards generally consider it highly undesirable for summoned parties to announce too late that they would not be attending oral proceedings, in particular when no reasons are given. Such conduct was inconsistent both with the responsible exercise of rights and with the basic rules of courtesy. See also **T 556/96**, **T 258/13**. In these inter partes cases, the boards held that an apportionment of costs in favour of the attending party was justified (see in this chapter III.C.9.1.).

In **T 69/07** the respondent had requested oral proceedings but did not appear at the oral proceedings at the appointed time. The board noted that, in accordance with Art. 6 of the Code of Conduct of the epi, of which the representative is obligatorily a member, the members are required to act courteously in their dealings with the EPO. The representative of the respondent had had sufficient time to inform the board of its intended non-appearance at the oral proceedings. This would have avoided keeping the other party and the board first of all courteously waiting for the representative in case he had unintentionally been delayed, and then obliging the registrar of the board to carry out enquiries to establish if the representative intended to attend the oral proceedings. See also chapter V.C.4.1. "General professional obligations" and **T 954/93**, **T 1760/09**, **T 1939/10**, **T 2991/18**.

While recalling that according to Art. 6 of the epi Code of Conduct, members are required to act courteously in their dealings with the EPO, the board in **T 124/22** added that the

same principle applied to behaviour towards other representatives (Art. 5(a) of the epi Code of Conduct). By notifying the board of his non-attendance only one day before the scheduled oral proceedings, the respondent's representative failed to communicate promptly its intention not to attend oral proceedings.

In **T 653/91** the board held that if, having been summoned to oral proceedings, a party did not wish to attend such proceedings, both the board (through its registrar) and any other parties to the proceedings should be notified in writing of this fact as early as possible before the appointed day. Except in special circumstances, telephone communications concerning such matters were inappropriate, especially in inter partes proceedings. See also **T 582/97**, **T 692/00**.

In **T 692/00** the board held that for the appellant (patent proprietor) to announce shortly before the appointed date for oral proceedings that it might or might not attend while maintaining its request for oral proceedings could only be an abuse of procedure.

In **T 13/19** the board stated that a party communicating as early as possible its intention not to attend the oral proceedings, or any impediment to attending, amounted to the usual degree of courtesy owed to a board of appeal as a court of final appellate jurisdiction. See also other ex parte cases **T 1485/06**, **T 1930/07**, **T 218/11**, in which the boards noted that a professional representative has a duty to inform the EPO, as soon as possible, of a party's intention not to be represented at oral proceedings.

In **T 533/15** the board stated that the number of oral proceedings that could be held each day was severely limited, due to COVID-19 measures, and this meant that many proceedings had been cancelled or postponed. By informing the board only two days before the oral proceedings, the appellant made it impossible to use the hearing room for a different case. This was unfortunate and was something that parties should try to avoid.

7. Preparation of oral proceedings

7.1. Fixing or changing the date for oral proceedings

7.1.1 Legal provisions and notices

The practice for fixing the date of oral proceedings before the departments of first instance and the boards of appeal was published in a notice in OJ 2000, 456 ("the 2000 Notice"). The EPO's notice of 18 December 2008 (OJ 2009, 68) ("the 2008 Notice") adjusted the procedure for changing the date before the departments of first instance.

For proceedings before the boards of appeal, Art. 15(2) RPBA deals with the possibility of changing the date. It replaces Art. 15(2) RPBA 2007 and supersedes the notice of the Vice-President dated 16 July 2007 of the EPO ("the 2007 Notice"), OJ SE 3/2007, 115. Art. 15 RPBA entered into force on 1 January 2020.

7.1.2 Oral proceedings in closely-related cases

As the case at hand in **T 2702/19** was closely related to appeal cases **T 2401/19** and **T 953/21**, the oral proceedings in these three cases were held consecutively, starting with case **T 953/21** and continuing with cases **T 2401/19** and **T 2702/19**. Having heard the parties in the other related cases, the board announced a final decision in each of these three appeal cases on the same day.

7.1.3 Request for changing the date of oral proceedings

It is within the board's discretion to change the date at the request of a party (Art. 15(2) RPBA). A request of a party for a change of the date fixed for oral proceedings may be allowed if the party has put forward serious reasons which justify the fixing of a new date. According to Art. 15(2)(a) RPBA the request shall be filed in writing, reasoned and, where appropriate, supported by documentary evidence. The request shall be filed as soon as possible after the summons to oral proceedings has been notified and the serious reasons in question have arisen.

For the departments of first instance, see point 2.2 of the 2008 Notice (OJ 2009, 68). The wording of the notice makes it clear that the decision of the department of first instance is of a discretionary nature. The request must be filed as soon as possible after the grounds preventing the party concerned from attending the oral proceedings have arisen, and shall be accompanied by a sufficiently substantiated written statement indicating these reasons. A change in the date of oral proceedings can only be requested in case of "serious reasons" that justify the fixing of a new date.

For as long as a request for postponement of oral proceedings has not been granted, the requesting party cannot simply assume that it will be. The party has to consider the possibility of a refusal of the request and has to prepare the case accordingly to minimise the risk of time pressure (**T 1102/03**, **T 2526/11**).

Where a request for postponement of oral proceedings is refused on the ground that the request was not sufficiently substantiated, the decision of the examining division should state in clear terms what should have been submitted or explained (**T 447/13**).

The decision to change the date for oral proceedings is a discretionary one (concerning the departments of first instance see **T 1505/06**, **T 2526/11**, **T 447/13**; concerning the boards of appeal, see Art. 15(2) RPBA). It is inherent from the discretionary nature of the decision whether to change (or not) a date for oral proceedings that a request will not succeed simply because the reasons for it fall within the examples of acceptable reasons (**T 699/06**, **T 861/12**).

For the question of whether a request for postponement of oral proceedings can lead to a different apportionment of costs under Art. 104 EPC, see chapter III.R.2.2. "Acts or omissions prejudicing the timely and efficient conduct of oral proceedings".

7.1.4 Request or reasons for postponement filed too late

A request for postponing the date of oral proceedings may be refused if it is late filed (**T 601/06**, **T 1053/06**, **T 518/10**, **T 1101/13**, **T 1663/13**, **T 932/16**).

In **T 1080/99** (OJ 2002, 568) the board had made it clear in a letter sent almost three months before appointed oral proceedings that a request by a party for postponement of the oral proceedings did not meet all the requirements of the 2000 Notice. The party, instead of attempting to supplement its original request as soon as possible, chose to react to the board's letter only one week before the appointed oral proceedings. The board held that the additional reasons and evidence for the request for postponement were received too late and could therefore not be accepted.

In **T 601/06** the board considered the request to postpone the oral proceedings to be late filed. The representative should have been aware when receiving the summons that he would be prevented from attending the oral proceedings and should have filed his request immediately. Filing the request more than one month later was not considered to fulfil the respective requirements of Art. 15(2) RPBA 2007 or of the 2007 Notice (see also **T 485/09**, **T 182/14**). The board also referred to **T 514/06**, in which a request for postponement was made a couple of days before the set date was granted. The board in **T 601/06** considered that, taking into account the circumstances of **T 514/06** (a case of death within the family), the request had not been late filed. See also **T 231/13**.

In **T 676/16** the board received the request for postponement only three working days before the oral proceedings. The appellant, who was based in Ireland, cited the travel restrictions in place caused by the ongoing Covid-19 pandemic as a serious reason. The board stated that pursuant to Art. 15(2)(a) RPBA, such a request should be filed as soon as possible after the summons to oral proceedings had been notified and the serious reasons in question had arisen. Parties were expected to consult the publicly available list of international risk areas by the Robert Koch Institute, in order to determine and inform the board in good time whether they would attend the arranged oral proceedings. The request for postponement of the oral proceedings was therefore refused.

In **T 174/16**, considering the particularities of the case in hand (flight cancellation along with the impossibility of using other travel means), the board held that it was unreasonable to draw the conclusion that the request for postponement filed less than 24 hours before the scheduled oral proceedings had been late filed. The board considered that the opposition division had committed a substantial procedural violation by not postponing oral proceedings.

In **T 1869/17** the request to postpone the oral proceedings was refused. The board stated that there is no bar to holding two oral proceedings on the same day. The reason for holding both oral proceedings on the same day was that both cases concerned divisional applications deriving from the same parent application. The description of both patents was essentially the same, so that any reasonable person would conclude that the cases were strongly related to each other.

7.1.5 Reasons submitted in a request for postponement

According to Art. 15(2) RPBA (see also the 2007 Notice) and the 2008 Notice (departments of first instance), a change in the date of oral proceedings can only be requested in case of "serious reasons" justifying the fixing of a new date. Differences in detail exist between Art. 15(2)(b) RPBA and the 2008 Notice. Art. 15(2)(b) RPBA and the 2008 Notice give examples of serious reasons that may justify a change of date. The lists are non-exhaustive.

Art. 15(2)(b) RPBA sets out a list of examples of reasons which have been taken, with slight adaptations from the 2007 Notice. The list of examples include: (i) notification of a summons to oral proceedings in other proceedings before the EPO or a national court received before notification of the summons to oral proceedings before the board; (ii) serious illness; (iii) a death within the family; (iv) marriage or formation of a similar recognised partnership; (v) military service or other obligatory performance of civic duties; (vi) holidays or business trips which have been firmly booked before notification of the summons to oral proceedings. Art. 15(2)(c) RPBA sets out a non-exhaustive list of examples of reasons which, as a rule, do not justify a change of date: (i) filing of new requests, facts, objections, arguments or evidence; (ii) excessive work pressure; (iii) unavailability of a duly represented party; (iv) unavailability of an accompanying person; (v) appointment of a new professional representative.

According to Art. 15(2) RPBA and if the party is represented, the serious reasons must relate to the representative, and not the client (see also **T 1916/09**, **T 2125/11**, **T 231/13**).

a) Serious illness

In **T 447/13** the board held that, for the purposes of deciding whether to grant a request for postponement of oral proceedings on grounds of illness, "serious illness" means an illness which is sufficiently serious to prevent the representative travelling to oral proceedings and satisfactorily presenting the case on the appointed day.

In **T 1246/10** the board accepted a first postponement of the oral proceedings in view of the exacerbation of the appellant's serious illness and the fact that the respondent did not object to a postponement. However, the board refused the second request to postpone oral proceedings filed less than one month before the scheduled date. The respondent opposed any postponement thereof. Furthermore, the board had no indication that a further postponement for a few months could change the appellant's personal health situation. The appellant should have appointed a representative if he could not attend the oral proceedings himself.

In ex parte case **T 999/16** the board did not grant the last of numerous appellant's requests for a further postponement of the oral proceedings, filed on the grounds of serious illness. Though it could be expected that a professional representative would be appointed if the appellant could not attend the proceedings, the appellant remained unrepresented. The medical certificate annexed to the aforementioned last request, like the previously provided certificates, had been issued in the Czech language (without any translation

provided) and had not covered the actual date of the arranged oral proceedings. Given that none of the medical certificates on file constituted sufficient evidence that the appellant had indeed been prevented from attending and presenting its case on the appointed day and given that no professional representative had been appointed before or after the start date of the appellant's "duration of incapacity for work", the board was unable to accede to the appellant's request.

b) Booked holidays

The board in **T 1102/03** stated that, while a holiday was a possible valid basis for a request, it was not necessarily a sufficient reason for postponement. The board held that the case in hand presented circumstances which entailed a special organisational burden. The effort of postponing fixed oral proceedings until a date might be found which would suit numerous parties, the members of an extended board, and the facility management of the EPO, outweighed the effort of postponing or interrupting one representative's holiday booked to a destination within Europe. See also **T 601/06**, **T 1610/08**.

In **R 11/12** the request for postponement was rejected since the representative's holidays ended three days before the scheduled oral proceedings; in addition, the planned birthday party for the day after the oral proceedings could not be regarded as being a serious reason justifying the postponing of the oral proceedings.

c) Business trips

Point 2.3 of the 2008 Notice lists "business trips which have been firmly booked before the notification of the summons to oral proceedings" as a serious reason for changing the date of oral proceedings (departments of first instance). In (vi) of Art. 15(2)(b) RPBA business trips have been added to holidays.

Concerning appeal proceedings, the board in **T 869/06** accepted such a reason for changing the date of oral proceedings.

d) Speaking at a conference

In **T 699/06** the board held that if European representatives wished to speak at conferences (even with the approval of clients whose cases are thereby delayed), the work of the boards of appeal and the interests of their clients' adversaries and the public should not be affected as a result. A representative who undertook such a commitment did so in the knowledge that this would make them unavailable to their clients, and unavailable to appear at any oral proceedings, on the date in question. See also **T 2526/11**. However, see **T 902/07**, in which the board referred to **T 699/06**, but granted the request to postpone oral proceedings after considering the agreement of the adversarial party's representative.

e) National holiday

In **T 664/00** the appellant (patent proprietor) had requested an adjournment of oral proceedings due to a public holiday in the USA. The board rejected the request as national

holidays in individual contracting states are not recognised by the EPO for practical reasons (see **J 5/98**). To allow for national holidays in non-contracting states throughout the world would be even less practical. See also **T 2125/11**.

f) Newly appointed representative

In **T 37/97** a new representative had been appointed after the summons to oral proceedings had been duly issued. The board rejected the request for postponement and held that the new representative, before taking on the mandate, could be expected to have made sure he was available on the appointed date or to arrange for alternative representation. Furthermore, a professional representative could be expected to be able to prepare for oral proceedings with all due care within a month unless the case was exceptionally difficult, which it was not. See also **J 4/03**.

In **T 2018/17** the board stated that the examining division gave no reasons why the appointment of a new representative was not regarded as being a serious reason for changing the date for oral proceedings. However, such a reasoning needs to be given if a division relies on it.

In **T 693/95** the board had waited for two years to give the appellants time to find a legal representative of their choice. This they had failed to do. After such a long delay there was no valid reason for postponing oral proceedings.

g) Obligation to give reasons as to why a representative cannot be substituted

According to Art. 15(2)(c)(v) RPBA the appointment of a new professional representative, as a rule, does not justify a change of date. The obligation mentioned in the 2007 Notice to state in the request why another representative cannot stand in for the one prevented from attending has been dispensed with. For further decisions on this topic, see CLB, 9th edn. 2019, III.C.6.1.5.

The 2000 and 2007 notices (points 2.5 and 2.3 respectively) stated that any request to set another date for oral proceedings should indicate why another representative could not stand in for the one unable to attend. This meant that if and when the board was satisfied that the representative was prevented from attending, it must therefore be considered whether another representative, who did not have to be from the same firm, could substitute the prevented representative (**T 699/06**, **T 861/12**). If the appellant has signed a general authorisation to a law firm, the representative had to provide convincing reasons as to why no other representative of this firm could substitute the representative (**T 518/10**).

h) Absence of duly represented party or of inventor

In **T 275/89** (OJ 1992, 126) the board considered that the illness of a duly represented party was not a sufficient reason for postponing appointed oral proceedings unless the party who was ill needed to be present. A request to change an appointment could only be allowed if unforeseen, exceptional circumstances had arisen, which either made oral

proceedings impossible (such as a representative's or unrepresented party's sudden illness) or could have a decisive impact on the course of the proceedings (such as unforeseen unavailability of an important witness or expert). See also **T 1923/06**.

In **J 4/03** the Legal Board decided that the desire of the appellant to be present himself at oral proceedings did not in itself amount to a serious ground for postponing the oral proceedings, in the absence of other special circumstances. The appeal turned essentially on how the law was to be applied to facts which were not in dispute, and so the presence or absence of a party who was duly represented in the proceedings should have no impact on the course of the proceedings or the final decision.

In **T 231/13** the board held that the aim of Art. 15(2) RPBA 2007 and of the 2007 Notice was to fulfil the need for procedural economy while ensuring that the party could be duly represented during the oral proceedings. Attendance of one of the inventors was not relevant for the discussion of formal and substantive points in the oral proceedings, unless special issues arose, for example, in connection with a particular technical point. See also **T 1212/04**.

i) Flight cancellation along with impossibility of using other travel means

In **T 174/16** the board held that it was unreasonable to consider a flight cancellation, along with the impossibility of using other travel means, not to constitute "serious reasons" within the meaning of the relevant provisions. See also **T 1292/21**.

j) Loss of the representative's passport

In **T 1810/18** the appellant requested that the oral proceedings be postponed. The reason provided was that its representative's passport had been lost with the result that the representative was unable to travel overseas to attend the oral proceedings. The board stated inter alia that the difficulty in finding a new date for oral proceedings increased with the number of parties involved (here three parties). Time was a crucial factor in the present case: the patent in suit had already expired and there was a request for remittal of the case, which, if granted, would have further increased the duration of the proceedings. A significant delay in the proceedings at this stage would not have been reasonable for the parties or the public. Fixing of a new date for the oral proceedings was not justified by the overall circumstances. The request for a change of the date was rejected. In accordance with the appellant's auxiliary request and in view of both respondents' consent, the oral proceedings were conducted by videoconference.

k) Postponement because of late receipt of board's communication

In **T 569/11** the fact that the appellant became aware of the board's communication only shortly before the oral proceedings was not per se a reason that obliged the board to postpone the proceedings. Nevertheless, it was necessary to verify whether, in the light of the content of the communication, a postponement should be made in order to allow time for the appellant to react to the comments made by the board. This required an analysis of the points covered in the communication. In the case in hand, the board's

communication did not include any new objection or any new evidence in comparison with the decision of the examining division. The facts of the case did not constitute an extraordinary circumstance (see **T 1610/08**) that would justify a postponement of the oral proceedings.

l) New evidence or requests

According to Art. 15(2)(c)(i) RPBA, the filing of new requests, facts, objections, arguments or evidence, as a rule, do not justify a change of date.

In **J 4/03** the Legal Board held that the desire of an applicant to file unspecified new evidence at an unspecified future date could not amount to a serious reason for postponing oral proceedings. Even in ex parte proceedings the appellant had to attempt to file any facts or evidence he wished to rely on before the set date of oral proceedings so that the board could exercise its discretion under Art. 114(2) EPC whether to admit the further evidence or not, on the basis of the relevant material.

In **T 881/95** the request for postponement was refused because the evidence, which could only have been provided later, was not such as to affect the decision.

In **T 427/05** the appellant filed one new main and 71 new auxiliary requests approximately six weeks before the oral proceedings. The respondent (opponent) submitted that none of these requests should be admitted into the proceedings; they were late-filed and too voluminous. Failing that, the oral proceedings should be postponed. The board decided there was no reason to postpone the oral proceedings in view of its decision to admit only those late-filed requests which related (albeit narrowed down in some cases) to the subject-matter which had been central to the discussions from the outset.

m) Proceedings before a national court

In **T 392/97** the board ruled that the **subsequent** appointment of oral proceedings by a national patent court to take place on the same date as the previously appointed oral proceedings before the board was not in itself a sufficient reason for adjournment. See also **T 932/16**.

In **T 228/09** the board considered, having regard to Art. 2.2 of the 2007 Notice, that unforeseen infringement proceedings could not generally be regarded as an acceptable ground for adjournment.

n) Postponement in order to avoid adverse decision of the board

In **T 1053/06** the reasons given by the appellant (applicant) for requesting postponement of the oral proceedings clearly indicated that the appellant had chosen not to pursue the case further and would prefer its patent application to be lost for non-payment of the next renewal fee at a later date rather than by an adverse decision of the board at that time. Those reasons had to do solely with the convenience of the appellant, which, until it

received the board's negative preliminary opinion, had preferred to pursue the appeal proceedings. The board refused the request for postponement.

o) Ongoing takeover negotiations between both parties

In **T 1535/14** the board held that the reasons put forward, namely the existence of ongoing merger proceedings between both parties, did not prevent the parties attending the oral proceedings, but rather concerned their economic interests. Since both parties were appellants it appeared likely that oral proceedings would have to be held even in the event of the merger taking place. Postponement would be against procedural efficiency.

p) Expected childbirth by the partner of the professional representative

According to **T 1101/13**, that the partner of a professional representative was expected to give birth on a date close to the fixed oral proceedings could be accepted as a substantive reason for requesting a change of the date for oral proceedings. In the circumstances of the case, the board decided to maintain the date fixed for the oral proceedings.

q) COVID-19 pandemic

In **T 437/17** the board stated that the mere general reference to the COVID-19 pandemic and health risks with travel in Germany to and from the boards of appeal did not amount to serious reasons justifying the fixing of a new date for oral proceedings.

r) Representative unable to identify authorised person

In **T 1150/13** the appellant's representative requested postponement of the oral proceedings, because he had been unable to identify the person at the appellant's company that was authorised to provide him with instructions on the case. He was making investigations with a view to identifying the authorised person, but anticipated that this would take some time. Thus, in order to give sufficient time to the instructing party to consider and respond to the summons to oral proceedings, the representative requested that the oral proceedings be rescheduled for a later date. In the case in hand the reason lay entirely in the sphere of the appellant and could in the board's view have been alleviated. It therefore did not constitute a serious reason for changing the date of the oral proceedings (Art. 15(2)(b) RPBA).

s) Unavailability of an accompanying person – Article 15(2)(c)(iv) RPBA

In **T 777/17** the board stated that the reason provided by the respondent for requesting the postponement related to the impossibility of in-house counsel attending these oral proceedings; however, this reason is specifically listed in Art. 15(2)(c)(iv) RPBA as one of the reasons which, as a rule, do not justify a change to the date of the oral proceedings. The argument that the representative was relying on the support of the in-house counsel was not convincing as the representative must have been able to properly present the case without such support.

7.1.6 Postponement of the oral hearing at the instigation of the EPO

In **T 679/14** the board found that it was unacceptable to repeatedly postpone oral proceedings without serious reasons, especially if it was done several times in the same examination proceedings after long delays had already occurred. The postponement of oral proceedings on five occasions at the instigation of the examining division without serious reasons constituted a procedural deficiency in the circumstances of the case.

7.2. Notice of two months in the summons

Under R. 115(1), second sentence, EPC (R. 71(1), second sentence, EPC 1973) the notice given in the summons to oral proceedings must be at least two months, unless the parties agree to a shorter period. Art. 15(1), first sentence, RPBA reads: "Without prejudice to R. 115 (1) EPC, the Board shall, if oral proceedings are to take place, endeavour to give at least four months' notice of the summons".

In **J 14/91** (OJ 1993, 479) the Legal Board ruled that a dispute about a third party's right to inspect the application dossier before publication had to be decided promptly (i.e. before publication), otherwise Art. 128(2) EPC 1973 became null and void. If oral proceedings would facilitate a prompt decision, the summons under R. 71(1) EPC 1973 could give shorter notice – even without the other party's agreement – provided the parties were given enough time to prepare. The Legal Board referred to Art. 125 EPC and stated that it was a generally recognised principle of procedural law that notice could be curtailed in urgent cases. The degree of curtailment should be decided on a case-by-case basis.

In **T 111/95** the board stated that the examining division had no right simply to set a date for oral proceedings about two weeks after despatch of the summons. The board found that there was nothing on file to establish that the applicants' representative, at any time and unconditionally, accepted the date set. The onus of proving that an agreement for a shorter notice period was reached lay with the examining division. The board thus held that the summons was null and void, as were the actions following and resulting from it. See also **T 772/03**.

In **T 1550/21** the board found that the examining division had not fulfilled their onus as required for applying the exception provided in R. 115(1) EPC. According to the board, in addition to the violation of R 115(1) EPC, the communication accompanying the new summons had included an entirely new line of arguments and, in effect, the substantive examination had been restarted less than two months before the date of oral proceedings. Thus, the violation of R. 115(1) EPC constituted a decisive part of the examination proceedings and hence amounted to a substantial procedural violation.

In **T 601/06** and **T 869/06** the boards offered an alternative date within a period of about two months from the date of the request in view of the balance of interests of the parties and the public. The period of about two months arose from the fact that, except for when the parties consent, new summons had to be issued at least two months in advance of a hearing, so that dates within the two-month period from the date of the request could not be used for other cases.

According to the board in **T 2534/10**, R. 115 EPC equally applied where oral proceedings were continued on a date other than that fixed in the summons and that a fresh summons for that date therefore had to be issued. See also **T 1674/12**.

Where the board has sent more than one summons to oral proceedings, it is normally the summons which was sent first which is "the summons to oral proceedings" within the meaning of Art. 25(3) RPBA (**T 1511/15**).

7.3. Final date for written submissions in the preparation for oral proceedings and late submission of new facts and evidence – Rule 116 EPC

7.3.1 General issues

Rule 116(1) EPC (R. 71a(1) EPC 1973) stipulates, inter alia, that, when the EPO issues the summons to oral proceedings, a final date for making written submissions in preparation for the oral proceedings must be fixed. New facts and evidence submitted after this date need not be considered, unless admitted on the grounds that the subject of the proceedings has changed. The same is true for applicants or patentees invited under R. 116(2) EPC (R. 71a(2) EPC 1973) to submit documents which meet the requirements of the EPC (i.e. new amendments to the description, claims and drawings).

As construed according to its **object and purpose**, R. 116 EPC (R. 71a EPC 1973) is intended to give the decision-making department and other procedural parties enough time to prepare thoroughly for the oral proceedings and so ensure that they are not faced with surprising new facts and do not take potentially inappropriate decisions in undue haste (**T 765/06**; as to the reasons for the introduction of R. 71a EPC 1973 see **T 343/08**). The purpose of R. 116(1) EPC is to provide the EPO with a case-management framework for the preparation of oral proceedings (**T 798/05**, **T 66/14**). In **T 1067/08** the board held that the purpose of this provision was in particular to prevent parties from seeking unjustified procedural advantages by abusive tactics in disregard of procedural economy and to the disadvantage of other parties.

In **T 1750/14** the board interpreted R. 116(1) EPC in conjunction with R. 132(2) EPC. From the wording of R. 116(1) EPC it was not clear whether the non-applicability of R. 132(2) EPC to R. 116(1) EPC also precluded the possibility of extending specified periods, implying that the final date for making submissions in preparation for the oral proceedings set under R. 116(1) EPC could not be changed. The board considered that a **change of the final date** should normally be allowable when the date for oral proceedings is postponed. At least in cases where a final date is specified relative to the date for oral proceedings (usually one month before the scheduled oral proceedings), it could even be argued that the final date was postponed automatically when the oral proceedings were postponed.

According to the established case law, R. 116(1) EPC (former R. 71a EPC 1973) should **not be construed as an invitation to submit further evidence** (see **T 39/93**, OJ 1997, 134; **T 452/96**; **T 628/14**; **T 710/15**). There is no general duty for an examining division to provide feedback on an applicant's reply to a summons to oral proceedings, in

advance of such oral proceedings (**R 2/13**, **T 462/06**, **T 343/08**). In **T 462/06** the board also stated that R. 116 EPC did not mean that already in the communication all lines of arguments or a detailed reasoning for the decision should be set out. In **T 601/06** the board held that R. 71a(1) EPC 1973 did not impose an obligation on the EPO to give a preliminary opinion on the allowability of individual claims when issuing the summons.

In **T 355/13** the board held that nothing in the expression "the **points to be discussed**" could lead to the conclusion that reasons for a preliminary opinion of an opposition division on the matter related to the points to be discussed should be given. The annex to the summons could legitimately only mention the points that needed to be discussed. The annex to the summons in an adversarial inter partes procedure such as opposition proceedings should not give rise to the impression that the case was decided without having heard the parties, and thus it should not comprise any definite opinion on the final conclusion of the case. However, an opposition division could express a preliminary opinion on the case.

Rule 116 EPC (R. 71a EPC 1973), and Art. 114(2) EPC on which it is based, refer to late-filed facts and evidence but not to new **arguments**, which can be made at any stage in the first-instance proceedings (**T 131/01**, OJ 2003,115; **T 926/07**; **T 1553/07**; **T 2430/09**; **T 2238/15**).

7.3.2 Examination and opposition proceedings

In **T 755/96** (OJ 2000, 174) the board observed that R. 71a EPC 1973 gave the EPO a discretionary power. The EPO's power to accept or refuse late-filed new facts or evidence was in fact governed by Art. 114(2) EPC, and the discretionary power to refuse new requests for amendments was governed by Art. 123 EPC 1973 and the corresponding Implementing Regulations. As to the exercise of discretion under R. 71a EPC 1973 to admit or refuse amended claims, the board held that the discretion was to be exercised by considering all relevant factors which arose in a particular case and by balancing the applicant's interest in obtaining proper patent protection for their claimed invention and the EPO's interest in bringing the examination procedure to a speedy close by the issue of a decision (following **G 7/93**, OJ 1994, 775). See also **T 545/08**.

In **T 755/96** the board also drew a **distinction** between the **application stage** and the **opposition stage**. The reasons given for introducing R. 71a EPC 1973 made it clear that a particular concern was that in opposition proceedings other parties were not taken by surprise. Parties to opposition proceedings were often represented by professional representatives, who would need to consult their clients and technical experts for further instructions to deal with new requests or evidence. Thus, there could be good reasons to refuse material filed after the final date set under R. 71a EPC 1973, or to postpone oral proceedings. However, the same considerations did not apply to an examining division which had its own technical expertise and did not have to obtain instructions from third parties. If prepared for oral proceedings, it should normally, even in relation to requests filed at the oral proceedings, be in a position to assess whether a new request was clearly not allowable. An examining division which in exercising such discretion does not admit amended claims must give the reasons therefore.

In **T 712/97** the respondent (opponent) had filed a report of comparative experiments on the last day of the period set for filing comments pursuant to R. 71a(1) EPC 1973. The opposition division allowed this experimental report into the proceedings, but not the appellant's experimental report in response thereto. The board held that admitting the respondent's experimental report into the proceedings meant that the subject of the proceedings had changed within the meaning of R. 71a(1) EPC 1973 and that the report in question should therefore also have been admitted into the proceedings. That this report would not affect the outcome of the proceedings was in these circumstances not a valid consideration. A party was entitled to know that its response was admitted into the proceedings, even if it proved not to be decisive for the outcome before that instance.

In **T 484/99** the appellant (patentee) alleged that the refusal, under R. 71a EPC 1973, by the opposition division to consider or even look at amendments to the requests presented on the day of the oral proceedings before them amounted to a procedural violation. The board disagreed because it was clear from the wording of R. 71a(2) EPC 1973, that submissions by the patent proprietor presented after the final date did not need to be considered. In **T 64/02** the board stated that R. 71a(2) EPC 1973 also applied to the belated submission of amended patent claims in an auxiliary request, even if those claims had not been requested in the summons (see also **T 1067/08**).

In **T 951/97** (OJ 1998, 440) the board held that the subject of the proceedings was changed within the meaning of R. 71a(1) and (2) EPC 1973, inter alia, where the examining division itself introduced a new document, which was pertinent new material, into the proceedings for the first time during oral proceedings convened following a R. 71a EPC 1973 notification. In **T 2434/09** the board held that the applicant did not have a right to continuation in writing if the department of first instance introduced a new document in oral proceedings and thereby changed the subject of the proceedings. The party's right to be heard under Art. 113(1) EPC was observed if the applicant was given an adequate amount of time to study the document and present comments.

In **T 765/06** the examining division had pointed out in the summons that preparatory submissions and new claims should not be filed later than one month before the date of oral proceedings. Six days before the oral proceedings, the applicant filed new requests which the rapporteur, in a telephone conversation with the applicant, regarded as prima facie non-protectable and which were not admitted in the oral proceedings pursuant to R. 71a EPC 1973. The board found that conceding permission to file new claims did not comprise an assurance that such claims would be considered in the proceedings, with a considerable restriction of the time available for examination.

In **T 798/05** the board held that R. 71a EPC 1973 did not constitute an absolute bar on late submissions in opposition proceedings, which would rule out prima facie examination. R. 71a EPC 1973 did not override or restrict the principle of ex officio examination enshrined in Art. 114(1) EPC, since an implementing regulation ranked lower than an EPC Article. The actual wording of R. 71a EPC 1973 using the expressions "brauchen, need not, peuvent" left room for discretion over the admission of late submissions.

In **T 937/09** the board held that, if the applicant filed amendments to the application before the final date set by the examining division under R. 116(1) EPC, the examining division could still refuse such amendments under R. 137(3) EPC. See also **T 2355/09**.

7.4. Communication under Article 15(1) RPBA

7.4.1 General issues

Art. 15(1) RPBA now provides that a communication is to be issued by the board: "In order to help concentration on essentials during the oral proceedings, the Board shall issue a communication drawing attention to matters that seem to be of particular significance for the decision to be taken. The Board may also provide a preliminary opinion". The issue of a communication under Art. 15(1) RPBA 2007 was not mandatory.

7.4.2 Purpose of communication under Article 15(1) RPBA 2007 or Article 15(1) RPBA

In **T 1459/11** the board held that the purpose of the communication under Art. 15(1) RPBA 2007 was to establish the framework of the oral proceedings (see also **T 2006/13**). The communication did not – explicitly or implicitly – represent an invitation or opportunity to file further written submissions or to shift the focus of the case to be heard at oral proceedings (see also **T 751/16**). The terms of the appeal were rather determined by the statement of grounds of the appeal and the reply thereto (Art. 12(2) RPBA 2007). Consequently there was no legal basis in either the EPC or the RPBA for the filing of a "response" to a communication pursuant to Art. 15(1) RPBA 2007. A board was under no obligation to take such a "response" into account. Any submissions – whether arguments or requests – contained in such a "response" might constitute an amendment to the case presented.

This view was confirmed with regard to Art. 15(1) RPBA in e.g. **T 2703/16**. See also e.g. **T 752/16**, **T 995/18** and **T 2271/18**.

7.4.3 Boards not bound by communication under Article 15(1) RPBA 2007 or Article 15(1) RPBA

In **T 1635/13** the board held that it was clearly set out in the board's communication that it expressed the "preliminary and non-binding" opinion of the board to streamline and prepare the oral proceedings. Therefore it was self-evident that the board could come to a different evaluation of the facts and submissions during the subsequent proceedings, in particular the oral proceedings, for whatever reason. Such a different evaluation was in itself neither a sufficient reason for admitting subsequently filed requests nor a fundamental procedural defect (see **R 3/09**). See also **T 614/89** (in relation to Art. 11(2) RPBA 1980), **T 2006/13**.

For case law on Art. 15(1) RPBA, see the chapter V.A.4.5.4h) "Change of the board's opinion" (see in particular **T 995/18**).

7.4.4 Boards' discretion to send communication under Article 15(1) RPBA 2007

According to Art. 15(1) RPBA 2007 it was in the board's discretion to send a communication under Art. 15(1) RPBA 2007. Under Art. 15(1) RPBA this is now mandatory. The introduction of Art. 15(1) RPBA superseded **G 6/95** (OJ 1996, 649) in this respect. In **G 6/95** the Enlarged Board held that the boards continued to have discretion as to whether or not to send a communication when issuing a summons to oral proceedings, as provided for in Art. 11(2) RPBA 1980, since the then newly introduced R. 71a(1) EPC 1973 (now R. 116(1) EPC) did not apply to the boards of appeal. The Administrative Council could not amend the Implementing Regulations in such a way that the effect of an amended rule was in conflict with the RPBA – adopted under Art. 23(4) EPC 1973 by the Presidium of the boards of appeal and approved by the Council as reflecting the boards' independence. See inter alia **T 382/02**, **T 355/13**.

7.5. Location of oral proceedings

In **T 1012/03** the applicant, having been summoned to oral proceedings before the examining division in The Hague, had requested that oral proceedings take place in Munich instead. The board noted that Art. 116 EPC 1973 did not expressly stipulate the location where oral proceedings had to take place. The board examined whether the President of the EPO had the power to establish examining divisions in The Hague and concluded that such a power was provided for by Art. 10(1), (2)(a) and (b) EPC 1973. The board concluded that in the case in hand the justification for conducting oral proceedings in The Hague could be deduced from Art. 116 EPC 1973 in conjunction with Art. 10(1), (2)(a) and (b) EPC 1973. See also **T 689/05**, **T 933/10**, **T 1142/12**.

The examining division's rejection of the applicant's request that the oral proceedings be held in Munich instead of The Hague must be reasoned, R. 111(2) EPC, R. 68(2) EPC 1973 (see **T 689/05**, **T 933/10**).

In **T 1142/12** the board considered that the practical aspects of the organisation of oral proceedings were matters of EPO management, which came under the power of the President of the EPO as provided by Art. 10(2) EPC. The board held that the examining divisions were clearly not allowed to take a decision on this matter. When not acceding to a request to hold oral proceedings in Munich instead of The Hague, the examining division did not take a decision but only expressed the way the EPO was managed. Consequently, that issue was not subject to appeal, nor could the board refer a question on the venue of oral proceedings to the Enlarged Board. In **R 13/14** the Enlarged Board clarified that the wording used in **T 1142/12** did not mean that the board had refused to decide on the issue; rather, the board had implicitly decided on the request and refused it.

In **G 2/19** (OJ 2020, A87) the Enlarged Board held that oral proceedings before the boards of appeal at their site in Haar do not infringe Art. 113(1) and 116(1) EPC. The Enlarged Board observed that the fact that the boards currently performed their judicial function in Haar was the result of organisational acts adopted and implemented by the mandated organs of the European Patent Organisation in exercise of their powers.

8. Conduct of oral proceedings

8.1. Length and structuring of oral proceedings

8.1.1 Speaking time during oral proceedings and interruptions by the board

In **T 601/05** of 2 December 2009, in the evening of the second day of the oral proceedings, the board had limited the speaking time to ten minutes for each party for a "final round" of discussion with respect to a particular argument. In the board's view, the limitation of time was a necessary procedural measure by which the right to be heard pursuant to Art. 113(1) and 116 EPC had not been violated. On the one hand, it was the attorneys' responsibility to structure their pleadings in such a way that the time frame of the oral proceedings, which had been communicated to the parties with the summons and had not been objected by them, can be complied with. On the other hand, it was the board's responsibility to conduct oral proceedings in such a way that the time frame was kept to and to ensure that the case was ready for decision at the end of the oral proceedings. It followed from Art. 15(4) and (6) RPBA 2007 that the structuring of the oral proceedings was within the discretion of the board.

In **T 792/12** the board held that a Chair may interject in a party's submissions to ensure that the proceedings are efficiently conducted, in particular to avoid a party repeating arguments. Any member of the board may interrupt to ask questions which are considered important for reaching a decision.

8.1.2 Oral proceedings scheduled from the start for more than one day

In **T 1642/11** the board held that when oral proceedings were scheduled for more than one day, a party could not have the expectation that the hearing would finish on the first day. If a party was absent on the second day, the oral proceedings could continue without that party (R. 115(2) EPC and Art. 15(3) RPBA 2007).

8.1.3 Continuation of oral proceedings beyond the last scheduled day

In case **T 2534/10** the Chair of the opposition division had proposed, late in the evening of the only scheduled hearing date, that the oral proceedings be continued the next day. Although the patent proprietor had objected to this proposal, the proceedings had been continued the next day, and both parties had attended. The board observed that the two months' notice to be given in summons to oral proceedings under R. 115 EPC met the parties' fundamental need to be able to plan for and estimate the likely course of those proceedings. They had the same need when it came to continuing proceedings on a calendar day other than that specified in the summons. Accordingly, a fresh summons had to be issued if proceedings were to be continued beyond the calendar day specified in the original summons.

In **T 1674/12** the opposition division had continued the oral proceedings on 9 September 2011, even though the summons was only for 8 September and two opponents had objected. The board held that, in the light of **T 2534/10**, the opposition

division had committed a procedural error, irrespective of the opponents' objections: to continue the proceedings on 9 September, it had to have the express consent of all parties. **T 2534/10** had also ruled that remittal was necessary only if the error had affected the final decision; a case could be remitted only to recommence procedural acts performed on the second day, not covered by the summons. In the case in hand, the proceedings would have taken essentially the same course, even if the division had adjourned the oral proceedings on the evening of 8 September rather than continuing them the following day.

8.1.4 Duration of deliberations

In **T 1138/12** the board pointed out that the EPC did not prescribe for how long an opposition division had to deliberate to reach a decision. It was therefore conceivable that the members, having discussed the case in advance, might find their preliminary opinion confirmed by the submissions at the oral proceedings and then agree that that was the case by, for instance, simply making eye contact or nodding at the end of the discussion with the parties. Both the duration and the form of an opposition division's deliberations depended on the scope and complexity of the case in hand, the degree of compatibility of the members' opinions, which might diverge, playing a major role in this regard.

8.2. Excluding the public from oral proceedings

In **T 1401/05** of 20 September 2006 the board excluded the public from that part of the oral proceedings which concerned the exclusion of certain documents from file inspection. Under Art. 116(4) EPC, oral proceedings shall in principle be public in so far as the board does not decide otherwise in cases where admission of the public could have serious and unjustified disadvantages, in particular for a party to the proceedings. The board held that as the debate dealt with the request for exclusion of certain documents from file inspection, which had been excluded provisionally, the public could not be admitted to the hearing on this point. Otherwise, the purpose of the provisional exclusion would have been frustrated. In such a situation, the danger of serious and unjustified disadvantages had to be deemed to exist.

In **J 2/01** (OJ 2005, 88), at the beginning of the oral proceedings, the Legal Board informed the appellant that these proceedings were not public. Although the requirements of R. 48(2) EPC 1973 for non-publication of the application appeared not to have been met, the application in suit had in fact not been published. Since Art. 116 EPC required publication as a prerequisite for oral proceedings to be public, the Legal Board had corrected its original summons to public oral proceedings.

Referring to R. 144(a) EPC (R. 93(a) EPC 1973), boards excluded the public from oral proceedings on the matter of objections to members of the boards in **T 190/03** (OJ 2006, 502), **R 2/14** of 17 February 2015, **R 8/13** of 20 March 2015 and **T 1938/09** of 2 October 2014. In **T 190/03**, at the end of the oral proceedings, the public was readmitted and the decision was given.

8.3. Format of oral proceedings

8.3.1 Legal provisions and sources of information

While holding oral proceedings pursuant to Art. 116 EPC by videoconference (upon request) has been a long-standing practice before examining divisions (see notices from the EPO applicable prior to the coronavirus (COVID-19) pandemic: OJ 1997, 572; OJ 2006, 585; OJ 2012, 354; OJ 2018, A96), this practice was only extended to opposition divisions, the Receiving Section, the Legal Division and the boards of appeal in 2020, due to the pandemic situation.

a) Boards of appeal

(i) Communications published in 2020

In the communication entitled "Oral proceedings before the Boards of Appeal – restrictions due to the coronavirus (COVID-19) pandemic and introduction of video-conferencing technology in appeal proceedings", published on the website of the Boards of Appeal on 6 May 2020 (the "communication of 6 May 2020"), the Boards of Appeal informed the public of the possibility of conducting oral proceedings before the boards using videoconferencing technology, which would require the **agreement of all parties**. Later, updated information concerning oral proceedings by videoconference was published on the website of the Boards of Appeal (dated 15 May, 25 May, 29 July and 19 October 2020). By the communication entitled "Oral proceedings before the Boards of Appeal – continuation of the measures adopted due to the coronavirus (COVID-19) pandemic and revised practice on oral proceedings by VICO", published on the website of the Boards of Appeal on 15 December 2020, the public was informed that, from 1 January 2021, boards would be able to conduct oral proceedings by videoconference even **without the agreement** of the parties concerned. This was because the new Art. 15a RPBA merely clarified an existing possibility. Boards could therefore adapt their practice as regards dispensing with the need to obtain the agreement of the parties concerned even before the date of its entry into force.

(ii) Current rules

According to Art. 15a RPBA, which entered into force on 1 April 2021, oral proceedings can be held by videoconference if the board considers it appropriate to do so, either upon request by a party or of its own motion (OJ 2021, A19). The agreement of the parties is not required. See also **G 1/21** (OJ 2022, A49) and in this chapter III.C.8.3.2.

Art. 15a RPBA also provides for "**mixed-mode** oral proceedings", in which some parties, representatives or accompanying persons attend by videoconference while others are physically present in the oral proceedings room together with board members (Art. 15a(2) RPBA).

On 25 January 2023 the communication entitled "Oral proceedings before the Boards of Appeal – pandemic measures cease; oral proceedings by VICO still provided" was

published on the website of the Boards of Appeal. It informed the public of the **end** as from 1 February 2023 of **pandemic measures** regarding the arrangement and conduct of oral proceedings before the boards of appeal. Conduct of oral proceedings using **videoconferencing** continues to be provided for.

b) Departments of first instance

(i) Rules prior to the COVID-19 pandemic

The possibility to request that oral proceedings before an examining division be held as a videoconference was introduced for applicants and their representatives as from 1 January 1998. Where the request could not be allowed, the person making the request was informed by a communication indicating the reasons for the refusal. No appealable decision was issued on the matter (see especially OJ 1997, 572 and OJ 2006, 585).

(ii) Rules prior to 1 January 2023

During the COVID-19 pandemic several decisions of the President of the EPO and notices from the EPO concerned oral proceedings by videoconference before the departments of first instance.

According to the decisions of the President of the EPO dated 1 April 2020 and 17 December 2020 (OJ 2020, A39, A134), oral proceedings before examining divisions were to be held by videoconference **as a rule** and could only be held on the premises of the EPO, either at the request of the applicant or at the instigation of the examining division, if there were serious reasons against holding the oral proceedings by videoconference. If a request to hold oral proceedings on the premises of the EPO was refused, the applicant was informed of the reasons; such a refusal was not separately appealable (see also OJ 2020, A40, A122).

With the entry into force on 4 May 2020 of the decision of the President of the EPO dated 14 April 2020 concerning the pilot project for oral proceedings by videoconference before opposition divisions (OJ 2020, A41), oral proceedings before opposition divisions could be held by videoconference **at the discretion** of the opposition division and with the **agreement of all parties**. As of the entry into force on 4 January 2021 of the decision of the President of the EPO dated 10 November 2020 concerning the modification and extension of the pilot project for oral proceedings by videoconference before opposition divisions (OJ 2020, A121), oral proceedings before opposition divisions were held by videoconference **as a rule** and could only be held on the premises of EPO, either at the request of a party or at the instigation of the opposition division, if there were serious reasons against holding the oral proceedings by videoconference. If a request to hold oral proceedings on the premises of the EPO was refused, the parties were informed of the reasons; such a refusal was not separately appealable (see also OJ 2020, A122).

As of 1 July 2021, oral proceedings before the Receiving Section (OJ 2021, A49) and the Legal Division (OJ 2021, A50) were to be held by videoconference **as a rule** and could

only be held on the premises of the EPO, either at the request of a party or at the instigation of the concerned department, if there were serious reasons against holding the oral proceedings by videoconference. If a request to hold oral proceedings on the premises of the EPO was refused, the parties were informed of the reasons; such a refusal was not separately appealable.

(iii) Current rules

The various decisions of the President of the EPO and notices from the EPO issued during the COVID-19 pandemic were replaced. The decision of the President of the EPO dated 22 November 2022 concerning the format of oral proceedings before examining and opposition divisions, the Legal Division and the Receiving Section and the respective notice from the EPO (OJ 2022, A103, A106) now provide that oral proceedings before examining divisions, opposition divisions, the Legal Division and the Receiving Section **are to be held** by videoconference. They may be held on the premises of the EPO, either at the request of a party or at the instigation of the concerned department, if there are **serious reasons** against holding the oral proceedings by videoconference. If a request to hold oral proceedings on the premises of the EPO is refused, the parties will be informed of the reasons; such a refusal is not separately appealable.

8.3.2 Oral proceedings by videoconference in case of general emergency – G 1/21

In **T 1807/15** the board referred the following question to the Enlarged Board: Is the conduct of oral proceedings in the form of a videoconference compatible with the right to oral proceedings as enshrined in Art. 116(1) EPC if not all of the parties to the proceedings have given their consent to the conduct of oral proceedings in the form of a videoconference?

In **G 1/21** of 16 July 2021 (OJ 2022, A49), the Enlarged Board held that during a general emergency impairing the parties' possibilities to attend in-person oral proceedings at the EPO premises, the conduct of oral proceedings before the boards of appeal in the form of a videoconference is compatible with the EPC even if not all the parties to the proceedings have given their consent to the conduct of oral proceedings in the form of a videoconference. The Enlarged Board found it justified to limit the scope of the referral to oral proceedings before the boards of appeal and to take the specific context of the referral, a general emergency (i.e. the COVID-19 pandemic), into account.

The Enlarged Board interpreted Art. 116 EPC and, taking in particular the object and the purpose of oral proceedings into account, namely to give parties an opportunity to plead their case orally, came to the conclusion that oral proceedings in the form of a videoconference were oral proceedings within the meaning of Art. 116 EPC. The Enlarged Board held that even if the videoconference format had certain shortcomings, it provided parties with an opportunity to present their case orally.

The Enlarged Board then considered whether a videoconference is equivalent to an in-person hearing and whether it is a suitable format for conducting oral proceedings. It acknowledged that oral proceedings by videoconference could not, at least at that point in

time, provide the same level of communication as is possible when all participants are physically present in the courtroom. The Enlarged Board concluded that the limitations then inherent in the use of video technology had made this format suboptimal for oral proceedings, though normally not to such a degree that a party's right to be heard or right to fair proceedings was seriously impaired.

The Enlarged Board also discussed whether a party has a right to oral proceedings in person. Parties wishing to have oral proceedings held in person could only be denied this option for good reasons. Firstly, there must be a suitable alternative. If in a particular case a videoconference is not suitable, the oral proceedings will need to be held in person. Secondly, there must also be circumstances specific to the case that justify the decision not to hold the oral proceedings in person. These circumstances should relate to limitations and impairments affecting the parties' ability to attend oral proceedings in person at the premises of the EPO. In the case of a pandemic, such circumstances could be general travel restrictions or disruptions of travel possibilities, quarantine obligations, access restrictions at the EPO premises, and other health-related measures aimed at preventing the spread of the disease. Thirdly, the decision whether good reasons justify a deviation from the preference of a party to hold the oral proceedings in person must be a discretionary decision of the board of appeal.

As to the applicability of the **G 1/21** reasoning to oral proceedings held during a general emergency, see in this chapter III.C.8.3.4. As to the applicability of the **G 1/21** reasoning to oral proceedings held beyond a general emergency, see in this chapter III.C.8.3.3.

8.3.3 Case law concerning oral proceedings held after the end of pandemic measures at the Boards of Appeal

Two main lines can be identified in the case law after the end of pandemic measures at the Boards of Appeal. In some decisions, the reasoning of **G 1/21** is considered applicable beyond a general emergency and as imposing certain limits on how the discretion under Art. 15a(1) RPBA is to be exercised (**T 2432/19**, **T 1171/20**, **T 1501/20**). According to another view, Art. 15a(1) RPBA was a "follow-up" provision to **G 1/21** and the reasoning of the latter currently had only a "limited applicability" (**T 618/21**).

Some decisions do not discuss the applicability of **G 1/21** beyond a general emergency and simply either apply criteria foreseen therein (**T 489/20**) or abstain from referring to them (**T 3277/19**, **T 1067/21**, **T 2075/21**).

Further aspects have also been addressed in the case law, e.g. requirements for holding "mixed-mode" oral proceedings (**T 1946/21**) and the applicability of **G 1/21** to first-instance proceedings and to hearing a witness by videoconference (**T 423/22**).

a) G 1/21 – limited applicability beyond a general emergency

(i) Oral proceedings held by videoconference without a party's consent

In **T 618/21** the board decided to hold the oral proceedings in March 2023 as a videoconference without the appellant's consent. In particular, the board mentioned the following points apparent from the wording of Art. 15a(1) RPBA: (a) it was for the board to decide whether to conduct oral proceedings as a videoconference and it could even decide to do so against the parties' wishes; (b) the conferred discretion was to be exercised in the light of considerations as to what was appropriate; and in particular (c) there was nothing in the provision to suggest that it was applicable only when there was a general emergency.

The board further found that, both generally and in the specific case in hand, a videoconference was a nearly equivalent alternative to in-person proceedings. According to the board, Art. 15a RPBA had closed the gaps in the law that had existed at the time of the referral in **G 1/21** and had to be regarded as a follow-up provision to **G 1/21**. Art. 15a RPBA now governed non-emergency situations too, which the Enlarged Board had deliberately refrained from addressing in **G 1/21**. The conclusions drawn in **G 1/21** were anyway no longer fully applicable to the present, because the initial premise behind decision **G 1/21** (namely the difference in quality between a videoconference and in-person proceedings) no longer held.

b) G 1/21 – applicability beyond a general emergency

(i) Oral proceedings held in person without a party's consent

In **T 2432/19** oral proceedings took place in person in April 2023 despite the appellant's (patent proprietor's) request that the oral proceedings be held by videoconference. The board stressed that while it was evident from Art. 15a(1) RPBA that the board had discretion to decide whether to hold oral proceedings by videoconference, **G 1/21** put certain limits on how this discretion was to be exercised. The board did not share the view expressed in **T 618/21** with regard to Art. 15a RPBA that the exercise of discretion in deciding on the format of the oral proceedings was to be based on the criterion of the "appropriateness" of the format only. According to the board, **G 1/21** had established general criteria which applied not only to a situation of general emergency, but were valid also in non-emergency times. It also followed from **G 1/21** that parties did not have a right to a format that had deficiencies, i.e. parties could not force boards to hold oral proceedings by videoconference instead of in person. The board cited **G 1/21**, according to which in-person hearings are the "gold standard". Unlike the boards in **T 758/20** and **T 618/21**, the board held that the situation had not changed since **G 1/21**. At the time of issuing the present decision, the parties relied on the same kind of hardware and software as were available at the time of **G 1/21**. Furthermore, no significant improvements that had increased "immediacy" to the level of in-person hearings could be recognised.

In **T 1171/20** the oral proceedings in May 2023 were held in person, contrary to what the opponent (appellant) – without giving any reasons – had requested. The board stressed

that the Enlarged Board had looked beyond a general emergency situation in **G 1/21**. The board did not share the view taken in **T 618/21** that Art. 15a RPBA had "to be regarded as a follow-up provision to **G 1/21**". It therefore could not see how Art. 15a RPBA could restrict the Enlarged Board's findings in **G 1/21** (see **T 2432/19**). It endorsed the finding in **T 2432/19** that the circumstances in which in-person oral proceedings might be preferable were ones the board too could take into account when exercising its discretion under Art. 15a(1) RPBA. Therefore, as a general rule, the board could also decide to hold oral proceedings in person at its own discretion and against the parties' wishes (see **T 2432/19**).

(ii) Oral proceedings held in mixed mode with parties' consent

In **T 1501/20** the oral proceedings were held in a "mixed-mode" format. On this point, the board observed that the decision in **G 1/21** imposed certain limits on the exercise of discretion under Art. 15a(1) RPBA. In doing so, the board followed the decision in **T 2432/19**, according to which Art. 15a(1) RPBA was to be interpreted restrictively in view of the decision in **G 1/21**. Art. 15a(1) RPBA thus offered no legal basis for holding oral proceedings as a videoconference against the wishes of one of the parties when there was no general emergency impairing the parties' ability to attend in-person oral proceedings on the EPO premises. The board also made it clear that it did not share the view taken in **T 618/21** that Art. 15a(1) RPBA had "to be regarded a follow-up provision to **G 1/21**".

c) Applicability of G 1/21 beyond a general emergency – not addressed

(i) Oral proceedings held by videoconference without a party's consent

In **T 1067/21** the board decided to hold oral proceedings by videoconference in March 2023 without the appellant 2's (opponent's) consent. The board referred to Art. 15a RPBA and indicated that this article provided the board with discretion to hold oral proceedings by videoconference. The board did not refer to the reasoning and criteria of **G 1/21**.

(ii) Oral proceedings held in person without a party's consent

In **T 489/20** oral proceedings were held in person in March 2023 without the consent of respondent-opponent 2 and respondent-opponent 3. The board reasoned that according to Art. 15a(1) RPBA the board may decide to hold oral proceedings by videoconference if the board considers it appropriate to do so. In view of respondent-opponent 2 and 3's disapproval to hold the oral proceedings by videoconference, and in the absence of any particular circumstances as mentioned in **G 1/21**, the board did not consider it appropriate to hold the oral proceedings by videoconference. Though the applicability of **G 1/21** reasoning was not addressed, with the assessment of "particular circumstances" as mentioned in **G 1/21** the board seems to have implicitly confirmed its applicability beyond a general emergency situation.

In **T 3277/19** oral proceedings were held in person in September 2023 despite the parties' requests for oral proceedings by videoconference. The board's reasoning included that the subject-matter of the proceedings involved complex explanations of the duct at issue's geometry in relation to the visualisation of several virtual planes and intersections, which made in-person proceedings the appropriate format in this case (see also **T 2075/21**). The board also noted that while it always had the possibility to alter the format to a videoconference at short notice if a party were restricted in travelling, the appellant had not shown that it had been restricted in this regard.

d) Requirements for holding mixed-mode oral proceedings

In **T 1946/21** the appellant's and the intervener's representative requested that oral proceedings be held in a mixed-mode format to allow the representatives to attend the hearing in person and other attendees to attend remotely. The board did not grant this request, reasoning that from the request for mixed-mode oral proceedings, it had not been apparent how the participation of additional "other attendees" was relevant to the case. Citing **G 4/95**, the board stated that it might permit submissions made by persons who were not professional representatives but this required a reasoned request to that effect. Absent any such request, the board saw no reasons which would outweigh the increased technical and organisational complexity caused by setting up and operating an additional parallel hybrid channel while running in-person proceedings at which all parties are already fully represented and in which all attendees may participate as well.

e) Applicability of considerations set out in G 1/21 to first-instance proceedings and to hearing a witness

In **T 423/22** the opposition division had heard witness M by videoconference without the consent of the appellant (patent proprietor). As to the appellant's argument that it had not been able to observe the witness's body language during their hearing, the board noted inter alia that most of the body language could be perceived in the camera-section visible to the other participants of the videoconference. The board also noted that its considerations did not contradict **G 1/21**. In the board's view, it could not be assumed that, under the current technical possibilities, the Enlarged Board would have considered there to be a general obstacle against holding a witness hearing by videoconference. Whether **G 1/21** required a general emergency in order to hear a witness by videoconference, however, did not have to be addressed since, according to the board, **G 1/21** had not concerned oral proceedings in opposition proceedings nor taking of evidence, but instead had been limited to oral proceedings in appeal proceedings. For more information on taking evidence by videoconference, see chapters III.B.2.7.4 and III.G.3.1.8.

8.3.4 Case law concerning oral proceedings held after G 1/21 and prior to the end of pandemic measures at the Boards of Appeal

After the **Order** of **G 1/21** (16 July 2021) and later the **Reasons** for this decision (28 October 2021) were issued, the boards referred to either of them (especially to points 47-51 of the Reasons) when deciding on the format of oral proceedings. In most decisions the boards confirmed that during a general emergency, holding oral proceedings

by videoconference without a party's consent was in line with **G 1/21** and Art. 15a(1) RPBA (see e.g. **T 758/20**, **T 1158/20**). Some of these decisions also dealt with objections based on an alleged infringement of Art. 113 EPC (see e.g. **R 12/22**, **T 250/90**, **T 1624/20**). For more information on the right to be heard, see chapter III.B.2.7. "The right to be heard in oral proceedings".

Boards have also stated that holding oral proceedings in person without a party's consent was in line with **G 1/21** (**T 1198/17**, **T 2303/19**).

Some boards had to react to parties' allegations as to the absence or existence of a general emergency situation (see e.g. **T 2303/19**, **T 758/20**, **T 1158/20**). In some decisions, oral proceedings by videoconference were considered to be an **equivalent alternative** to in-person oral proceedings (**T 758/20**, **T 1158/20**). Further issues, e.g. technical aspects of videoconferencing (**T 250/19**, **T 758/20**, **T 1158/20**) and applicability of considerations set out in **G 1/21** to opposition proceedings (**T 1041/21**), were also addressed in the case law.

a) Compliance with G 1/21 – holding oral proceedings by videoconference without a party's consent

In **T 2817/19** in application of the Order of the Enlarged Board in case **G 1/21**, which allowed the conduct of oral proceedings before the boards of appeal in the form of a videoconference during a general emergency even if not all of the parties to the proceedings had given their consent thereto, the respondent's request that the oral proceedings be held in person was rejected.

T 1197/18 is another example of a decision issued at the time when only the Order in **G 1/21** was available. In **T 1197/18** the board concluded that the pandemic was a general emergency and that, as had been ruled in **G 1/21**, its holding oral proceedings via a videoconference in these circumstances was compatible with the EPC, even if the appellant had not given their consent.

In **T 2474/17** the board stated that the conclusion to hold the oral proceedings as a videoconference was in line with Art. 15a(1) RPBA and in line with **G 1/21**. According to the Enlarged Board's reasoning, the pandemic was a "general emergency impairing the parties' possibilities to attend in-person oral proceedings at the EPO premises", thus constituting "good reasons" for the conduct of oral proceedings by videoconference, despite the appellant's explicit wish for in-person oral proceedings. The continued delay of holding oral proceedings during a pandemic was further ground to overrule a party's wish to hold oral proceedings in person (as to the argument of a continued delay, see also **T 541/17**, **T 1296/17**, **T 934/18**). The board also held that the complexity of the case was not such that a videoconference would be inadequate (as to the argument concerning the substance of a case, see also e.g. **T 541/17** and **T 934/18**).

In **T 1791/19** the board decided to hold oral proceedings by videoconference in view of the COVID-19 pandemic situation, the then ongoing lockdown and general travel constraints. Just before the board announced the order, the respondent (patent proprietor) stated that

it had never given its consent to oral proceedings by videoconference. The board held that it was incumbent on the respondent to raise issues and file requests at the appropriate time so that such requests could be given due consideration. Otherwise, a party could wait to raise such an objection until faced with an adverse decision, but refrain from doing so when faced with a favourable decision. This appeared to the board to be inequitable. The board took the view that when it ordered the hearing to be held by videoconference, it was within its discretionary powers under Art. 15a RPBA as qualified by decision **G 1/21**.

In **T 250/19** the appellant (opponent) had requested during oral proceedings by videoconference that they be adjourned so that they could be held with the parties physically present. Citing Art. 15a(1) RPBA and **G 1/21** in particular, the board observed that the board's decision on the format of the oral proceedings was a discretionary one. Holding oral proceedings by videoconference was a "suitable" alternative to holding them in person if it was compatible with parties' right to be heard (**G 1/21**, points 33 to 43 of the Reasons). The board pointed out that the compatibility of oral proceedings by videoconference with a party's right to be heard under Art. 113 EPC did not depend on whether that party had consented to their being held as a videoconference but only on whether the party was given sufficient opportunity to set out its position and make its case (see also **T 1624/20**).

Citing **G 1/21**, the Enlarged Board in **R 12/22** reiterated that, as a rule, holding oral proceedings by videoconference against a party's will did not infringe the right to be heard. It therefore found the petitioner's contention that even a merely theoretical possibility of impaired communication and discussions amounted to an infringement of Art. 113(1) EPC to be **at odds with G 1/21**. As regards Art. 15a RPBA, the Enlarged Board pointed out that, since holding oral proceedings by videoconference had no impact on the right to be heard, an improper exercise of discretion in favour of holding them in that form could not result in an infringement of that right if no specific practical shortcoming was asserted or otherwise apparent.

In **T 934/18** the board rejected appellant 2's request for in-person oral proceedings. The board held that "good reasons" for which parties can be denied in-person hearings according to **G 1/21** existed, because the COVID-19 pandemic was not yet over and there were still limitations and impairments such as quarantine obligations, access restrictions at the EPO premises and other health-related measures. In addition, the board noted that oral proceedings in the present case had already been postponed once. A continued postponement was to be avoided to prevent a further delay in deciding the appeal. Moreover, the board did not consider that in substance this case pertained to matters that required in-person oral proceedings (for similar reasoning concerning the substance of a case, see also e.g. **T 541/17** and **T 2474/17**).

In **T 2791/19** the board decided to hold the oral proceedings as a videoconference without the appellant's consent. The board's reasons for this included that Art. 15a RPBA expressly allowed the boards to hold oral proceedings by videoconference, even on their own initiative. Moreover, as the Enlarged Board had ruled in **G 1/21**, a hearing held in the form of a videoconference qualified as oral proceedings within the meaning of Art. 116 EPC. In the board's view, the circumstances in the case in hand (a rising number of new

infections in the Munich area) justified not holding the oral proceedings in person. It had therefore decided to exercise its discretion to hold the oral proceedings by videoconference even without the appellant's consent as a way of protecting all the parties.

In **T 1158/20** the oral proceedings were held by videoconference without the appellant's consent. The board observed that from the wording of Art. 15a(1) RPBA, it was evident that it had discretion to decide whether to hold oral proceedings by videoconference. The board further saw no conflict with **G 1/21**. Irrespective of this, the board also assessed whether oral proceedings by videoconference could be considered an equivalent alternative to an in-person hearing (stated to be the "gold standard" in **G 1/21**). The board concluded that even in view of **G 1/21**, in this case oral proceedings by videoconference had been not only suitable but also represented an equivalent alternative to in-person oral proceedings. For more arguments in **T 1158/20** on videoconference as an "equivalent alternative", see in this chapter III.C.8.3.4d); for arguments on the pandemic situation, see in this chapter III.C.8.3.4c); and for arguments on technical aspects of videoconferencing, see in this chapter III.C.8.3.4e).

Most of the reasoning in **T 758/20** is comparable to that in **T 1158/20** (above). Moreover, the board emphasised that it did not interpret **G 1/21** as meaning that it was for the party to choose the format of the oral proceedings. The decision on whether good reasons justified a deviation from the preference of a party to hold the oral proceedings in person was a discretionary decision of the board summoning it to the oral proceedings. According to the board, the Order in **G 1/21** could not be read as restricting the possibility of summoning for oral proceedings by videoconference contrary to the will of one party to only when there is a general emergency. For more arguments, see in this chapter III.C.8.3.4b), III.C.8.3.4c) and III.C.8.3.4d).

In **T 1624/20** the board had changed the format of the oral proceedings to a videoconference in view of the pandemic situation (COVID-19) prevailing at the time. Challenging this new format, the appellant argued in particular that the emergency situation related to COVID-19 had come to an end and so imposing a videoconference was at odds with **G 1/21**, that there had been no official announcement by a government agency and that Art. 15a RPBA could not be invoked because it was incompatible with **G 1/21** in the case at hand. Referring to the wording of Art. 15a RPBA, the board explained that a videoconference was not incompatible with **G 1/21** in this case. According to point 50 of the Reasons in **G 1/21**, it was for the board to assess whether there was a general emergency impairing the parties' ability to attend in person. There had been special circumstances that justified the decision not to hold the oral proceedings in person.

In **T 2526/19** the board changed the format of the oral proceedings from in-person to videoconference, in view of the pandemic developments in Bavaria at the relevant time. The risk for an infection for all participants was to be weighed up against the respondent's reservations as to holding oral proceedings by videoconference, the complexity of the case, and the suitability of the case for a hearing in this format. The board came to the conclusion that a hearing by videoconference was indeed a suitable format for such proceedings under Art. 15a(1) RPBA. Moreover, the compliance of Art. 15a RPBA with the EPC had not been questioned by the Enlarged Board in case **G 1/21**, whether or not a

"general emergency" applied. Art. 15a RPBA had thus remained applicable, without any qualification, to these and future appeal proceedings.

b) Compliance with G 1/21 – holding oral proceedings in person without a party's consent

In **T 2303/19** the appellant requested that the oral proceedings take place by videoconference arguing that this would facilitate attendance of the appellant's in-house counsel and reduce the risk of any last-minute travel disruption due to uncertainty surrounding COVID-19 cases. The respondent did not consent to this request and suggested a mixed-mode format. The board decided to hold the oral proceedings in person. The board agreed with the respondent that at the relevant time there were no COVID-19-related travel restrictions which would impair the parties' possibilities to attend in-person oral proceedings at the EPO premises, and that in-person oral proceedings were at that time the **optimum format** as expressed in decision **G 1/21** (see also **T 1198/17**). The board also considered that the possible attendance of an accompanying person could not determine the format of the oral proceedings.

In **T 1198/17** the oral proceedings were held in person without the respondent's consent. The board recalled that, in accordance with Art. 15a(1) RPBA, the board may decide to hold oral proceedings by videoconference if the board considers it appropriate to do so. Hence, there was no absolute right of a party to have oral proceedings conducted in a specific format, either by videoconference or in person. The discretionary nature of this decision had been confirmed in **G 1/21**. The board held that, in the case at hand, there were neither general nor particular circumstances related to limitations and impairments affecting the parties' ability to attend that justified denying the appellant's request to have in-person oral proceedings.

c) Establishing the (non-)existence of a general emergency

In some decisions, the boards had to react to parties' allegations as to the absence or existence of a general emergency impairing the parties' possibilities to attend oral proceedings in person. Exceptionally, neither parties raised this issue nor did the board explicitly deal with the existence of a general emergency. Examples of this case law are provided below.

In **T 541/17** the board confirmed that there had been neither travel restrictions nor quarantine requirements in force in Germany in March 2022, when the board had communicated its intention to hold the oral proceedings by videoconference. However, in that period the Omicron variant of COVID-19 had been spreading at a high rate in Germany. Experience in the preceding two years had shown that restrictions could be reintroduced by health authorities at short notice. Therefore, in March 2022 there had been good reasons for the board to change to videoconference the format of the oral proceedings of 18 May 2022 as provided for by Art. 15a(1) RPBA (for the same reasoning see also **T 1296/17**).

On the constraints or obstacles impairing the parties' ability to attend in person, the appellant in **T 250/19** argued that the pandemic had come to an end in Germany in November 2021 as the state of emergency had not been extended and only hygiene measures had remained in place since then. The board disagreed and pointed out, among other things, that it was for the board to assess whether there was an emergency situation, even if it took announcements made by authorities into account. It then observed that restrictions had remained in place and had continued to apply on dates relevant in the case in hand. Lastly, it was not only the situation in Germany that counted; the respondent's representatives had their place of business in France, which had been classed as a "high-risk area" at the time.

In **T 2341/16** the appellant referred to the COVID-19 infection rates in the United Kingdom and in Munich and requested that the oral proceedings be held as a videoconference. In a communication dated 11 April 2022, the board noted that there seemed to no longer be any official limitations or impairments affecting the appellant's ability to attend oral proceedings in person. Hence the board was not convinced by the appellant's arguments and maintained its intention to hold the oral proceedings in person.

In **T 2303/19** the board agreed with the respondent that at the relevant time (November-December 2022) there were no COVID-19-related travel restrictions which would have impaired the parties' possibilities to attend in-person oral proceedings at the EPO premises, and that in-person oral proceedings were at that time the optimum format as expressed in decision **G 1/21** (see also **T 1198/17**).

In **T 1158/20** the board stated that despite the appellant's allegation to the contrary, the COVID-19 pandemic was ongoing in November 2022 and there were still restrictions at the premises of the Boards in Haar. The absence of travel restrictions was not a clear indication that oral proceedings must be held in person. The appellant argued that the absolute number of infections in the region of Munich but also the incidence of infections was low at the date of the oral proceedings. The board took the view that it was not possible to objectively define a threshold for the number of infections (or for any other parameter) below which it would be acceptable to expose the parties or the members of the board to the virus (see also **T 758/20**).

Challenging the videoconference format of the oral proceedings in **T 1624/20**, the appellant argued in particular that the emergency situation related to COVID-19 had come to an end, that imposing a videoconference was at odds with **G 1/21** and that there had been no official announcement by a government agency. The board observed that, according to point 50 of the Reasons in **G 1/21**, it was for the board to assess whether there was a general emergency impairing the parties' ability to attend in person. The board found that the incidence rates in Germany and in France, where the representatives had their places of business, had been increasing in December 2022. In view of that risk, there had still been a general emergency within the meaning of **G 1/21**.

In **T 1709/18** opponent 1 had requested that the oral proceedings be held by videoconference. The only reason it gave was that its legal representative's place of business was in Berlin. The board informed opponent 1 that it did not consider this to be

a sufficient reason to change the plan to hold the oral proceedings in person. Opponent 1 did not raise the issue of whether the parties' ability to attend in person might be impaired in this specific case by a general emergency, and the board did not address it in its reasons either.

d) Oral proceedings held by videoconference as an "often equivalent alternative" to in-person oral proceedings

Since late 2022, some decisions have stated that oral proceedings by videoconference are an equivalent alternative to oral proceedings in person. Examples of this case law are provided below.

In **T 1158/20** the board established that holding oral proceedings by videoconference can meanwhile often be considered an equivalent alternative to oral proceedings in person, among others because since **G 1/21** the boards and the parties had gained extensive experience with videoconferencing and using the tools involved. The technical requirements had been met on the boards' side but also on the side of the representatives to allow for stable videoconferences with high-quality picture and sound such that holding oral proceedings by videoconference was no longer as far from the "gold standard" as it had been when decision **G 1/21** had been taken (see also **T 758/20**).

e) Technical aspects of videoconferencing

According to the board in **T 250/19**, a party could easily reproduce the fairly basic "whiteboard" function and share the screen. Besides, the very Zoom application used by the boards for videoconferences offered the possibility of using a virtual whiteboard. Similar considerations applied to using a "flipchart".

In response to the appellant's argument that filing further auxiliary requests during oral proceedings in **T 1158/20** would not be possible during a videoconference, the board noted that, were the patent proprietor to submit further auxiliary requests, this could be accommodated by email filing, using a dedicated email address, during the videoconference.

In **T 758/20** the board recalled that the software used for the videoconferences allowed for screen sharing with all participants. It was thus possible to display figures and even handmade sketches (which had to be scanned in advance) and share them with all participants of oral proceedings. When screensharing, it was furthermore possible to point to details of the shared view using the mouse pointer.

f) Applicability of considerations set out in G 1/21 to first-instance proceedings

In **T 1041/21** the opposition division had refused the two parties' request for postponement of the oral proceedings scheduled to take place by videoconference. The board found that **G 1/21** had not been limited to boards for any particular reason, for instance because other or stricter criteria had to be applied to oral proceedings before opposition divisions; there had simply been no need for any specific clarification beyond that in the referred case. It

therefore saw no reason not to apply the fundamental considerations of **G 1/21** to the case before it too. Nor could it see any reasons to support the view that a videoconference was a less suitable format for holding oral proceedings in opposition than on appeal.

8.3.5 Case law concerning oral proceedings held during the COVID-19 pandemic and prior to G 1/21

a) Consent to holding oral proceedings before the boards of appeal by videoconference initially required

In **T 1378/16** the oral proceedings that took place on 8 May 2020 were the first held by videoconference in the history of the Boards of Appeal, and were held with the agreement of the appellant. The board considered it appropriate to address the legal basis for oral proceedings within the meaning of Art. 116 EPC: In the past, the boards had rejected requests for oral proceedings to be held by videoconference, mainly on the grounds that there was no "general framework" to this effect, as, in particular, no provision was made for suitable VICO rooms and for the public to attend VICO-based hearings (see e.g. **T 1266/07**, **T 2068/14**). At the same time, the boards had held that Art. 116 EPC did not mandate oral proceedings taking place with the physical presence of the parties. Several boards had considered that it had been within their discretion to decide whether or not to select this form for the parties' oral submissions (**T 2068/14**, **T 932/16**). In **T 1378/16** the board endorsed this earlier interpretation of the legal framework. The board pointed out that, in contrast to the circumstances under which previous decisions of the boards of appeal had been issued, boards now had at their disposal suitable rooms at their premises for hearings by videoconference and that, by means of the communication of 6 May 2020, appropriate provisions had been made for the public to attend such hearings.

T 492/18 dealt with the issue of the attendance of an accompanying person by means of video connection. The oral proceedings took place in person. The board reasoned that the respondent had not agreed to holding the oral proceedings by videoconference. The board furthermore stated that the possibility of holding oral proceedings by videoconference was predicated by the boards' ability to offer the necessary technical facilities. At the time the decision was taken (October 2020), facilities for holding oral proceedings in mixed mode, with members of a party attending at the Office's premises and other members attending remotely, were not available to the board for the oral proceedings. For these reasons, the board was not able to accede to the appellant's request.

b) Consent to holding oral proceedings before the boards of appeal by videoconference no longer required

T 2320/16 was the first case before the Boards of Appeal for which oral proceedings by videoconference were held without the agreement of a party to the appeal proceedings (this decision predated **T 1807/15**). The board referred in this context to the communication published on the website of the Boards of Appeal dated 15 December 2020, informing the public that from 1 January 2021 boards may conduct oral proceedings by videoconference even without the agreement of the parties concerned. The board stated that Art. 116 EPC did not define the exact form of oral

proceedings, other than the proceedings being oral in nature. In particular, it did not explicitly exclude oral proceedings by videoconference. In the board's view, a prerequisite for oral proceedings was that the parties can see the members of the board and vice versa. It must be, at the same time, possible in real time for the board to interrupt or question the parties where necessary.

In **T 328/16** the board refused a request, filed after the oral proceedings by videoconference had been opened, for their cancellation and the scheduling of a new date for oral proceedings attended by all parties in person. It informed the parties that switching from in-person oral proceedings to oral proceedings by videoconference was not only in the interests of keeping all parties safe in view of what was happening with the COVID-19 pandemic but also in line with the protective measures in place in the European Patent Organisation's host state and throughout the rest of Europe. Granting the request would have delayed the proceedings considerably, especially given that oral proceedings initially planned for 8 May 2020 had already had to be rescheduled as a result of the pandemic. The board had discretion to hold oral proceedings under Art. 116 EPC by videoconference either at a party's request or, as here, at its own instance if it considered this expedient. The boards' practice since May 2020 of conducting oral proceedings by videoconference had been codified in new Art. 15a RPBA.

In **T 2030/18** the board held that, despite the appellant having argued in favour of oral proceedings being held in person, it was justified to hold oral proceedings by videoconference since the COVID-19 pandemic was ongoing, the oral proceedings in the present case had already been postponed by a year and, also for reasons of procedural economy, a further postponement had not been appropriate. In the written reasoning of the decision dated 29 October 2021, the board also considered that the decision to hold the oral proceedings as a videoconference on 27 May 2021 had been in line with Art. 15a(1) RPBA and the Enlarged Board's Order and reasoning in **G 1/21** published in the meantime.

In **T 245/18** the appellant (opponent) challenged the board's decision to go ahead as planned with holding the oral proceedings by videoconference even though one of the parties had not consented, instead of staying the proceedings until the Enlarged Board had issued its decision in **G 1/21**. The board held that by setting a date under Art. 15(9) RPBA, instead of announcing its decision straight away, it had ensured that, in this particular case, its decision to hold the oral proceedings by videoconference would not conflict with the Enlarged Board's then still pending decision. Had the outcome of the since issued decision been different, the board, instead of taking a final decision, could have set a new date for oral proceedings and reopened them. The clarification in **G 1/21** that it was at any rate permissible to hold oral proceedings by videoconference without a party's consent in emergency situations was, the board found, applicable here. There had undoubtedly been such an emergency at the time at issue in this case, given that the COVID-19 pandemic declared in March 2020 had been far from over and was still entailing significant travel restrictions in May 2021. It was therefore not necessary to reopen the oral proceedings.

In **T 1870/16** the board appointed oral proceedings to be held in a "mixed mode". The respondent attended the oral proceedings in person, whereas the appellant attended via videoconference. The respondent argued that in view of case **G 1/21** pending before the Enlarged Board it would be "normal" and "proportionate" to await the outcome of this case. The board held that it was at its discretion whether or not a case was to be stayed pending a decision of the Enlarged Board in another case. The board could not see that the possibility for the respondent to present their case orally and to hear and respond to the case of the opponent was in any way negatively affected by holding mixed-mode oral proceedings, since the respondent was attending them in the presence of the board in the "normal" way. Given that the respondent's right to be heard at the oral proceedings in the physical presence of the board had been fully respected (Art. 113(1) EPC), the need for the board to hear and decide cases during the ongoing COVID-19 pandemic had outweighed any theoretical risk that the Enlarged Board may subsequently find the use of mixed-mode oral proceedings "illegal".

c) Oral proceedings by videoconference before opposition divisions

The board in **T 762/21** noted that there were cases, as the one in hand, in which oral proceedings could be more efficiently conducted in person than by videoconference. In the case in hand, however, the board saw – as submitted by the respondent by reference to **G 1/21** – no procedural deficiency in the fact that the oral proceedings before the opposition division had been conducted by videoconference. In particular, the appellant's submission that they had not been allowed to share their screen in order to show a PowerPoint presentation would not amount to a procedural deficiency that could be attributed to the oral proceedings being held by videoconference. The same would have happened if the oral proceedings had been conducted in person and the appellant had tried to present arguments on the basis of the mentioned PowerPoint presentation which had not been announced nor submitted in writing in advance.

In **T 2011/21** the appellant (opponent) contested the decision of the opposition division to hold oral proceedings and carry out the inspection of the child safety seat "Sirona" per videoconference. The board considered that the opposition division had erred in not granting the opponent's request to take evidence by inspection in presence. The opponent's request had been substantiated and was, in the board's view, well-founded, in particular because the object to be inspected was a complex three-dimensional item and it could not a priori be ruled out that the images on the screen would allow the participants to appreciate the full extent of the disclosure. This error, however, did not constitute a substantial procedural violation because the decision of the opposition division to consider the subject-matter of independent claim 1 of the patent as maintained novel in view of the prior use "Sirona" had actually been neither determined nor influenced to the detriment of the appellant (opponent) by the fact that the inspection had taken place by videoconference.

8.3.6 Case law concerning oral proceedings held prior to the COVID-19 pandemic

a) Oral proceedings by videoconference before the boards of appeal

Prior to the publication of the communication of 6 May 2020, and prior to the subsequent introduction of Art. 15a RPBA, oral proceedings before the boards of appeal were only held in person.

The boards previously rejected requests for oral proceedings to be held by videoconference, see **T 1266/07** (lack of "general framework" on this matter). It would have, among others, been necessary to ensure that the use of videoconferencing was reconciled with the requirement that oral proceedings before the boards be public. See inter alia **T 37/08**, **T 663/10**, **T 1427/10**, **T 2425/10**, **T 1081/12**, **T 1930/12**, **T 1942/12**, **T 2313/12**, **T 932/16**.

In **T 2068/14** the board considered that holding oral proceedings by videoconference had not been expressly provided for in the EPC, its implementing regulations or the RPBA, nor had it been excluded. It furthermore held that it had discretion regarding the organisation of oral proceedings, including, holding them by videoconference, considering in particular whether the case in hand was ex parte or inter partes. A further important issue was the availability of suitable rooms for oral proceedings before the board by videoconference. This would typically require that provision also be made for the public (see **T 1266/07**). See also **T 1427/10**, **T 2468/10**, **T 928/11**, **T 1081/12**, **T 2313/12**, **T 932/16**.

b) Oral proceedings by videoconference before examining divisions

As to the possibility to hold upon request oral proceedings by videoconference before examining divisions the board confirmed in **T 677/08** that, according to point 2 of the notice from the EPO (OJ 2006, 585), the examining division had a discretionary power and would, on a case-by-case basis, decide on the suitability of holding oral proceedings by videoconference. In the board's opinion, whether a case is suitable for oral proceedings by videoconference hinged not only on the substance of the case but also on organisational matters. The examining division had to take the principle of procedural economy into account. If no videoconference room was available for the given date, that meant that a new date would have to be found, a new room would have to be booked, etc. If the examining division wanted to avoid that and stick to the original date, then it could exercise its discretion according to applicable principles and no procedural violation occurred by refusing the request to conduct oral proceedings by videoconference.

8.4. Computer-generated presentations and other visual aids

According to established case law, a computer-generated slideshow presentation is in essence the presentation of written material (**T 1122/01**; **T 1110/03**, OJ 2005, 302; **T 601/06**; **T 1556/06**). It is also established case law that the principles relating to the use of visual aids such as flip charts should also be applied to PowerPoint presentations. Therefore, a party wishing to use such a presentation should announce this intention early enough before the oral proceedings and should send both the board and the other parties

a copy. Any objections could then be raised and considered at the oral proceedings before the presentation was given, and a decision could be made if need be (**T 1122/01**, **T 1110/03**, **T 555/06**, **T 608/08**).

In **T 1122/01** the board pointed out that a PowerPoint presentation could be a way of introducing new means of evidence, or it could lead to a completely new and unexpected presentation of the case by a party. There was therefore a risk of the other parties being caught unawares by this, of new procedural issues being raised, and of the oral proceedings becoming protracted. See also **T 1110/03**, **T 555/06**.

In **T 373/05**, a few days prior to oral proceedings before the board the appellant (patent proprietor) asked for a screen for showing PowerPoint slides at the hearing, without however saying what the slides were about. At the start of the oral proceedings, it distributed paper versions of the slides, setting out arguments about the admissibility of the respondent's opposition and regarding sufficiency of disclosure. The board took the view that since they contained no new facts, their late submission was no reason to disregard them under Art. 114(2) EPC. On the contrary, it felt that presenting the appellant's arguments visually on paper had also helped the respondents to prepare their responses. See also **T 1528/12**.

In the board's view in **T 1556/06**, the opposition division has discretion as to the way oral proceedings were conducted. It was not a wrongful exercise of this discretion, and thus not a procedural violation, to refuse to allow a party to use a PowerPoint presentation during oral proceedings if the party was not thereby prevented from presenting its arguments orally. See also **T 608/08**.

8.5. Sound recording

In **R 17/09** the Enlarged Board held that to allow or refuse a recording of the oral proceedings was a matter of discretion for the board concerned (see also **T 1938/09** of 9 March 2015). Refusal to allow recording could not be treated as a procedural violation.

In **T 1938/09** of 9 March 2015 the board held that, even if a sound recording of the proceedings were made, there would have been no legal basis for making it available to the parties.

In **T 8/13** the appellant had requested to be given authorisation to make a sound recording of the oral proceedings. The board stated that sound recordings were not allowed and referred to the corresponding notice of the Vice-President of DG 3 (OJ SE 3/2007, 117).

8.6. Handwritten amendments during oral proceedings before the board

In **T 1635/10** the board took note of the notice from the EPO of 8 November 2013 (OJ 2013, 603) regarding the practice on handwritten amendments to patent documents. In the case in hand, the documents as proposed for the maintenance of the patent contained handwritten amendments, carried out at the oral proceedings before the board. For the board to do what was required by the above notice would, in the case in hand, be

detrimental to the principles of due process and procedural economy. The board therefore found that the documents as presented at the oral proceedings, for which the above checks could easily be performed and on which the appellant had had the opportunity to comment, were sufficient to base its (final) decision on. Since the department of first instance in any case would have to perform further formal steps before it actually maintained the patent in accordance with the board's order, it could apply its new practice to the relevant documents. See also **T 37/12**.

8.7. Interpreting in oral proceedings

As to the issue of interpreting costs during oral proceedings, see in this chapter III.C.9.2.; for the application of R. 4 EPC see chapter III.F.3. "Derogations from the language of the proceedings in written proceedings and in oral proceedings".

8.8. Oral submissions by an accompanying person

Reference is made to chapter III.V.5., "Oral submissions by an accompanying person".

8.9. Closing and reopening the debate

According to the established practice, the closing of the debate marks the last moment in the oral proceedings at which parties can still make submissions (**G 12/91**, OJ 1994, 285; **R 10/08**; **R 14/10**; **T 595/90**, OJ 1994, 695; **T 196/22**). Once the debate has been closed, further submissions by the parties must be disregarded unless the deciding body allows the parties to present comments within a fixed time limit or decides to reopen oral proceedings for further substantive debate (**G 12/91**). Reopening of the debate is at the deciding body's discretion (**T 595/90**, **T 683/14**, **T 2401/19**).

In **T 577/11** the board held that if the debate on a particular topic had been closed without announcement of a decision on the matter, the board had discretion over whether it would reopen the debate and over the extent to which it would do so. A decision given orally by a board became effective and binding by virtue of being pronounced (see **G 12/91**). It excluded any reopening of the debate. In addition to announcing a decision or reopening the debate, the board could announce conclusions of its deliberations or invite the parties to discuss the next topic. A reopening of the debate was an exception (see also **R 10/08**) and there was no right of a party to have the debate reopened.

In **T 1525/19** the board held that a main consideration for reopening the debate was whether the parties had had sufficient opportunity to comment on the grounds and evidence on which the decision was based (Art. 113(1) EPC).

In **T 2401/19** the debate had been closed shortly before oral proceedings were interrupted. After the resumption of oral proceedings, the appellant filed an objection under R. 106 EPC on the grounds that its right to be heard had been violated during the oral proceedings. In view of the purpose of an objection under R. 106 EPC, the board considered it appropriate to reopen the debate, but only with respect to this objection.

In **T 196/22** the board found that it was unlikely to reopen the discussion once the parties had been properly heard and the board felt in a position to form an opinion. It was within its discretion to refuse a request by a party for time to formulate questions to the Enlarged Board, the only purpose for which could be to reopen a debate that had already been closed and upon which the board had relied to reach its conclusions (as to a referral under Art. 112(1)(a) EPC see also chapter V.B.2.3.1 "General").

In **T 888/17** the board held that there was no provision in the EPC pursuant to which a board was under an obligation to render a decision at the end of the oral proceedings (see also **T 1224/21**) and that it lay within the discretion of the board to continue the proceedings in writing if it considers that the matter was not ripe for a decision.

Examples of cases in which the debate has been reopened are: **T 932/04**, **T 577/11**, **T 117/15**, **T 2401/19**.

With regard to reopening the debate before the EPO departments of first instance, see **T 683/14**.

8.10. Minutes of oral proceedings (Rule 124 EPC)

According to R. 124(1) EPC, minutes of oral proceedings and of the taking of evidence shall be drawn up, containing the essentials of the oral proceedings or of the taking of evidence, the relevant statements made by the parties, the testimony of the parties, witnesses or experts and the result of any inspection. According to Art. 12(1)(a) RPBA the appeal proceedings shall be based on the decision under appeal and minutes of any oral proceedings before the department having issued that decision.

8.10.1 Content of minutes

In **T 642/97** the board stated that R. 76 EPC 1973 (R. 124 EPC) did not require that the minutes reflect the full arguments of the parties. It was within the discretion of the minute-writer to decide what was "essential" or "relevant" (see **T 212/97**; see also **T 468/99**, **T 2185/15**, **T 2370/16**: the board was responsible for deciding upon what was necessary to be recorded in the minutes; **T 1608/22**). Whereas minutes were required to contain the requests or similarly important procedural statements, most of the arguments concerning patentability were normally apparent from the previous written submissions or from the facts and submissions in the written decision and did not need to be contained in the minutes.

In **T 263/05** (OJ 2008, 329) the board held that the minutes of oral proceedings before the boards of appeal should record the requests of the parties on which a decision of the board is required, such as the allowability or otherwise of the appeal, the form in which the patent proprietor seeks maintenance of the patent, requests for remittal of the case or relating to appeal fees or costs. The minutes should also record specific statements which have an impact on the definition of the subject-matter, such as statements of surrender or abandonment of subject-matter, where these are relevant to the decision to be taken (see also **T 212/97**, **T 928/98**, **T 550/04**, **T 71/06**, **T 2351/08**, **T 1934/14** of 8 October 2018,

T 2370/16). The arguments of the parties concerning patentability should not be recorded. They will be apparent from the facts and submissions set out in the written decision.

According to the board in **T 1934/14** of 8 October 2018, a request for interruption of the oral proceedings belonged to the essentials of the oral proceedings.

In **T 397/03** the board held that the **text of requests** filed by a party at oral proceedings before the opposition division was an essential element that should be contained in the minutes. In **T 240/09** the board held that, as far as the parties' requests were concerned, only the final requests to be stated by the Chair before declaring the debate closed (Art. 15(5) RPBA 2007) were essential for the oral proceedings **on appeal**. Requests which had been withdrawn were usually irrelevant for the board's decision, and therefore not "essential". See also **T 957/99**, **T 966/99**.

In **T 231/99** the board held that an **essential function** of the minutes was to record for the appellate body the essentials of the oral proceedings at the previous instance (see also **T 1608/22**).

In **T 396/89** the board held that if an important matter of fact was conceded, that **concession** ought to be carefully recorded in the minutes.

In **T 1735/08** of 27 September 2012 the board held that there was no need under R. 124(1) EPC, nor was it usual practice in proceedings before the boards of appeal, to record in the minutes that the board had expressed a **provisional opinion on patentability** before announcing its decision. Where it was decided to set aside the contested decision and remit the case to the department of first instance for further prosecution, the set of claims on which that department was to base its fresh decision and the reasons why, in the board's opinion, that set of claims met some of the patentability requirements were not set out in the minutes, but rather in the reasons for the decision.

According to **T 317/09** the relevance required under R. 124 EPC related to the decision to be taken by the board. The appellant's statement describing how it understood certain features of the invention neither affected the course of the proceedings, nor was it, as the **appellant's subjective assessment**, relevant for the decision to be taken by the board. See also **T 468/99**.

In **T 281/03** of 17 May 2006 the board held that, in order to guarantee the right to be heard, there should have been an explicit step, recorded in the minutes of the **opposition division**, giving the opponent an opportunity to **comment on inventive step** before the final deliberation, or alternatively an opportunity after the deliberation to comment on the opposition division's conclusion that such an objection was not prima facie apparent. The fact that before the final deliberation "the floor was given to the opponent again" or that the opponent made a "last submission", reported in the minutes, was not enough to meet this requirement.

In **T 1359/04** the board observed that the **examining division's introduction of new documents** only at the oral proceedings was an unusual step, and that the utmost care

therefore had to be taken to safeguard the applicant's right to be heard. The proceedings should normally be interrupted to give the affected party sufficient opportunity to study the new evidence and reconsider how to present their case. The very function of the minutes in such cases was to document that the proper procedural steps had been duly taken.

In **T 1798/08** the board held that it was not the function of the minutes to record statements which a party considers to be possibly relevant, such as the statement relating to the board's **alleged denial of the legal right to be heard**. This statement did not relate to the surrender or abandonment of subject-matter and did not otherwise have any impact on the definition of the subject-matter to be dealt with by board. It did not form part of the essentials of the oral proceedings and was not relevant for the present decision, either.

In **R 14/09** the Enlarged Board held that an **objection under R. 106 EPC** must be recorded in the minutes since it was a relevant statement of a party (see **R 17/10**; see also **R 2/12** of 17 October 2012 "at least at a party's request"; **T 1934/14** of 8 October 2018). According to the board in **T 1690/22**, the essentials of the oral proceedings having to be recorded in the minutes under R. 124(1) EPC might include the fact as such that an objection had been raised, but not the supporting grounds and arguments put forward by the party concerned and required to make the objection admissible. See chapter V.B.3.7.5 "Minutes as evidence that the objection was raised".

In **T 2405/10** the appellant's request to include a statement regarding the problem-solution approach was made **after the proceedings had been closed**. As this statement was not part of the oral proceedings, there was no reason to include it in the minutes.

8.10.2 No recording of statements for use in subsequent national proceedings

According to **T 928/98**, **T 550/04**, **T 263/05** (OJ 2008, 329), **T 71/06**, **T 61/07** and **T 916/09** it is not the function of the minutes to record statements which a party considers will be of use to that party in any subsequent proceedings in national courts, for example in infringement proceedings as to the extent of protection conferred by the patent in suit. This is because such statements are not "relevant" to the decision which the board has to take, within the meaning of R. 124(1) EPC. Such matters are within the exclusive jurisdiction of the national courts (see also **T 1826/18**). On this basis the board in **T 550/04** concerning the opponent's request to record in the minutes that the expression "oxygen-free atmosphere" in claim 1 had the meaning of "completely oxygen-free atmosphere" stated that this statement would not have an impact on the definition of the subject-matter of the patent for the questions the board had to decide and was thus not proper subject-matter for the minutes. Concerning requests for recording statements of parties in the minutes, see also **T 468/99**, **T 957/99**, **T 966/99**, **T 459/01**, **T 2009/08**, **T 1824/09**.

8.10.3 Correction of minutes

It is the boards' settled case law that parties and their representatives are expected to check minutes carefully as soon as they receive them, especially to ensure that nothing is missing and that they are accurate, and to point out any deficiency promptly, since the minutes are the only means of ascertaining what actually occurred during the oral

proceedings at first instance (**T 1679/17**). If a party was of the opinion that the minutes were incomplete or wrong, since essential submissions were not reflected at all in the file, that party might request the opposition division to correct the minutes to preserve the party's rights (**T 642/97**, **T 231/99**, **T 898/99**, **T 68/02**, **T 99/08**). The same is true in proceedings before the examining division (**T 937/07**, **T 2434/09**). Concerning the boards of appeal, see **T 1934/14** of 8 October 2018, **T 888/17**.

In **T 162/09** the board held that the parties and their representatives could be expected to check the minutes carefully, especially to ensure that nothing was missing, immediately on receipt and to point out any deficiency promptly, since the minutes were the only means of ascertaining what had occurred during the oral proceedings. See also **R 6/14**.

In **T 1891/20** of 16 May 2022 the board recalled that a request for correction of the minutes has to be submitted promptly after their receipt by the parties (see **R 6/14**). The board understood this to require an immediate action from a party, i.e. to submit a request for correction of the minutes in the shortest time possible after their receipt. This ensured that the relevant facts and submissions were still fresh in the minds of the members of the deciding body and, if applicable, the other party or parties (see also **R 2/23**). The contents of the written decision following oral proceedings did not have any bearing on whether the minutes of oral proceedings were incorrect or incomplete. The respondent therefore erred when stating that it was "compulsory" to wait for the written decision before submitting a request for correction of the minutes. Such conduct was incompatible with a party's obligation to request correction of the minutes in the shortest time possible after their receipt.

In **T 690/09** the appellant had not questioned the correctness of the minutes; the board held that the correctness of the minutes was therefore not formally in doubt and it had to consider the minutes as correctly reflecting the course of the oral proceedings. See also **T 162/09**, **T 1138/12**, **T 1227/14**, **T 320/15**.

In **T 1005/08** the board held that, according to the consistent jurisprudence of the boards of appeal, it was in principle the department before which oral proceedings had been held which was competent to correct its minutes of the oral proceedings (see also **T 2150/15**). Where parties consider the minutes of oral proceedings to be incomplete or wrong because essential submissions are not or inaccurately reflected, it is their own responsibility to ensure their rights are safeguarded by asking the department that issued them to correct them accordingly (**T 1481/19**).

In **T 231/99** it was held that the board's responsibility for the decision on the validity of the patent did not extend to deciding on the accuracy of the minutes of first-instance proceedings (see also **T 1198/97**, **T 162/09**, **T 2150/15**). In **T 508/08** the board stated that if the department of first instance (opposition division) saw fit to ignore its obligations (to respond to a request for correction of the minutes) there was nothing the board could do; it had no power to compel the division to fulfil them (see also **T 803/12**, **T 2150/15**).

In **T 212/97** the board explained that only decisions could be contested. Since the minutes of oral proceedings were neither a decision nor part of the decision, they could not be

"annulled" by the board of appeal (see also **T 838/92**, **T 68/02**). A procedural violation could be said to have occurred if the limits of the minute-writer's discretion as to what they considered "essential" or "relevant" were overstepped, e.g. if a party's unambiguous statement of surrender were omitted from the minutes.

Citing **R 7/17**, **T 212/97**, **T 642/97**, **T 468/99** and **T 1891/20**, the board in **T 1482/21** recalled that it was in the discretion of the minute writer what to consider "essential" or "relevant" under R. 124(1) EPC. The board added that it was responsible for deciding what needs to be recorded in the minutes, not the parties (**T 468/99**, **T 1721/07**), and that a summary of the arguments made by the parties during the oral proceedings was usually not included in the minutes (**T 263/05**, **T 1721/07**). It was thus neither incomplete nor incorrect that the minutes stated that, after discussion on the need for adaptation, the board "provided the parties with its conclusion on the required adaptations".

In **T 1063/02** the board held that it could not order the amendment of the opposition division's minutes of oral proceedings unless they manifestly and definitely differed from the actual course of the proceedings.

In **T 740/00** the appellant informed the opposition division of its opinion that the minutes did not reflect the actual conduct of the proceedings. Instead of examining whether the minutes actually fulfilled the requirements of R. 76(1) EPC 1973 and then deciding whether or not to correct them, the opposition division argued in essence that the minutes were correct because the minutes said so. The board considered such a reasoning circular and thus as not fulfilling the requirements of R. 68(2) EPC 1973, which required decisions of the EPO to be reasoned. This constituted a procedural violation (see also **T 819/96**).

In **T 4/00** the board held that the decisions on the correction could not be taken by the formalities officer as that would be contrary to the requirements of R. 76(3) EPC 1973 (R. 124(3) EPC), from which it was clear that only members of the opposition division bore responsibility for the minutes.

In **T 1721/07** the board refused the appellants' request that a summary they had drawn up of the parties' various arguments and the board's conclusions be added to the minutes of the oral proceedings. It observed that preparation of the minutes of oral proceedings was a task entrusted to the boards. This task could not be transferred or delegated, in whole or in part, to the parties, let alone just one of them (see also **T 433/11**).

In **T 980/19** dated 27 April 2022 the board refused opponent 9's request for correction of the minutes of oral proceedings. The board did not find that the opponent's proposed texts contained essential elements of the oral proceedings that needed to be mentioned in the minutes. Moreover, a sentence of a proposed text was misleading. More importantly, another proposed text did not reflect properly what had been stated during the oral proceedings. With regard to a further correction requested, according to the board's detailed notes as well as its recollection of events in the oral proceedings, the allegedly incorrect statement was accurate.

Referring to **T 263/05**, the board in **T 262/17** dated 30 August 2022 recalled that the minutes of oral proceedings before the boards of appeal should record the requests of the parties on which a decision of the board is required. The board noted that neither of the two requested corrections concerned the submission or the withdrawal of a request, nor a surrender or abandonment of subject-matter. Moreover, some passages of the requested corrections did not correctly reflect the course of the oral proceedings (see also **T 450/20** and **T 1494/21**). Thus, the patent proprietor's request to correct the minutes of the oral proceedings had to be refused.

8.10.4 Refusal to record statement not an infringement of the right to be heard

According to **T 1055/05** the refusal of the division to record statements made by a party at the oral proceedings could not constitute an infringement of the right to be heard.

8.10.5 Signing of minutes

According to R. 124(3) EPC, the minutes shall be authenticated by the employee responsible for drawing them up and by the employee who conducted the oral proceedings or taking of evidence, either by signature or by any other appropriate means.

In case **T 2076/11** the minutes were signed by a director rather than by the Chair who had presided over the oral proceedings before the opposition division. This was a substantial procedural violation.

8.11. Presence of assistants during deliberations of the board

According to Art. 19(1), second sentence, RPBA only members of the board may participate in the deliberations; the Chair may, however, authorise other officers to attend. In **T 857/06** the board stated that in several EPC contracting states the judicial work of courts, in particular supreme courts and constitutional courts, is supported by assistants. Also the active involvement of assistants in preparing the ground for judicial decisions appeared to be widely accepted. In accordance with this practice, a limited number of assistants supports the EPO's boards of appeal. The board concluded that the discretion under Art. 19(1), second sentence, RPBA 2007 may be exercised to allow the board's assistant to attend and to take part in the deliberations.

9. Costs

9.1. Apportionment of costs

A different apportionment of costs may be ordered in accordance with Art. 104 EPC and Art. 16 RPBA, if a party, for example, withdraws a request for oral proceedings, asks for their postponement, or fails to attend them (see chapter III.R.2.2. "Acts or omissions prejudicing the timely and efficient conduct of oral proceedings").

9.2. Interpreting costs during oral proceedings

Under R. 4(1) EPC (R. 2(1) EPC 1973), "any party to oral proceedings before the EPO may use an official language of the EPO other than the language of the proceedings, if such party gives notice to the EPO at least one month before the date of such oral proceedings or provides for interpretation into the language of the proceedings" (see also Communication dated 16 July 2007, OJ SE 3/2007, 118). For more information, see chapter III.F.3. "Derogations from the language of the proceedings in written proceedings and in oral proceedings".

In **T 473/92** the respondents asked the EPO, three days before the oral proceedings, to arrange for and bear the cost of interpreting services. According to the respondents, the period of one month stipulated in R. 2(1) EPC 1973 had not been observed because the EPO had failed to draw their attention to the period of notice mentioned in R. 2(1) EPC 1973. The board, however, decided that the respondents had to bear the costs of interpreting at the oral proceedings. If the parties were being offered a free interpreting service, the EPO should at least be enabled to minimise its costs by having sufficient time to organise the interpreting efficiently. Nor was the EPO under any obligation to draw the respondents' attention to the notice period of one month.

In **T 818/21** the board recalled that it was indicated at the bottom of EPO Form 3018 that the parties were requested to inform the board as soon as possible if there was any change that could affect the arrangements made, in particular if interpreting services were no longer needed. If the board was informed well in time unnecessary expenses could have been avoided as well as an unnecessary preparation on the side of the interpreters who needed to study the documents on file in advance. The fact that the appellant's representative had not had the required technical equipment, allowing interpreters to provide interpretation, could have involved the need to reschedule oral proceedings. Also such rescheduling would have meant a waste of (limited) resources.

In **T 44/92** the board came to the conclusion that if a patent proprietor with several appointed representatives chose to use another official language for the oral proceedings in addition to the language of proceedings, the EPO would not bear the costs of interpreting (R. 2(1) and (5) EPC 1973). See also **T 131/07** and **T 2696/16**.

D. Time limits, documents transmitted by fax, further processing and interruption of proceedings

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1. Calculation, determination and extension of time limits

Rule 131 EPC gives details for the calculation of time limits and R. 132 EPC provides criteria for the determination and extension of periods to be specified by the EPO, whilst R. 134 EPC contains provisions covering certain contingencies.

Time limits in the EPC have two conceptual elements: firstly, a period of time determined in years, months or days, and secondly, a relevant date, which serves as the starting date of the time limit, and from which the period of time is counted (**J 18/04**, OJ 2006, 560).

The term "deadline" is broader than the terms "time limit" and "period" as it encompasses any last date for validly performing an action and says nothing about the nature of the underlying time restriction (**J 10/12**). By contrast, the term "time limit", as a legal concept of the EPC procedural system, has a precise meaning (R. 131 EPC). It is a period of time of defined duration which is computed by reference to a relevant event (dies a quo). Thus, the last date up until which a procedural act can be validly performed ("deadline") is the result of this computation of the period of time specified in the legal provision establishing the time limit by reference to the dies a quo (see **J 18/04**).

1.1. Calculation of time limits under Rule 131 EPC

By decision dated 13 October 2022, the Administrative Council of the EPO amended R. 126(2), 127(2) and 131(2) EPC (OJ 2022, A101). These provisions as amended apply to documents notified by the EPO on or after 1 November 2023.

Amended R. 126(2) and 127(2) EPC introduce a new notification fiction, according to which postal and electronic notification are deemed to occur on the date of the document. As a result, the notification fiction according to which the deemed notification of a document occurred ten days after it was issued ("ten-day rule") was abandoned from 1 November 2023. See notice from the EPO of 25 November 2022 concerning legal changes to support digital transformation in the patent grant procedure (OJ 2022, A114) and notice from the EPO of 6 March 2023 concerning amended Rule 126, 127 and 131 EPC (OJ 2023, A29).

Amended R. 131(2) EPC provides that, in case of notification, it is the deemed receipt of the document notified which will constitute the relevant event for the purposes of time limit calculation. As a result, periods will be triggered by deemed notification under revised R. 126(2) EPC and 127(2) EPC. The decisions below were issued before said amendments took effect.

In **J 14/86** (OJ 1988, 85) the Legal Board held that the fact that R. 83(2) EPC 1973 (R. 131(2) EPC) fixed the point in time from which all the time limits ran and defined this point as the day following that on which the event giving rise to the time limit occurred, could not be interpreted as requiring the addition of a day to time limits expressed in years, months and weeks, hence the grant of an additional day for reasons of equity. The expiry date of time limits expressed in years, months or weeks was derived from R. 83(3) to (5) EPC 1973 (R. 131(3) to (5) EPC). These paragraphs, in conjunction with paragraph 2 of the same rule, established unequivocally that the time limits were fixed in full years, months, and weeks, without any possibility of their being reduced or extended (see also **J 9/82**, OJ 1983, 57).

In **J 13/88** the Legal Board demonstrated how to calculate the 12-month priority period referred to in Art. 87 EPC. The event representing the point in time from which a time limit started to run was the filing date of the application in respect of which priority was claimed, which was 5 May 1986. The period expired in the relevant subsequent month on the day which had the same number as the day on which the said event occurred, which was 5 May 1987 (R. 131(2) and (4) EPC).

T 2056/08 concerned the calculation of the period for filing an appeal when combined with the former ten-day rule for notification by postal delivery. The board noted that the two-month period stipulated in Art. 108 EPC started from the day of the presumed or actual notification. If any rule of thumb could be suggested to calculate the appeal period, it should have been "ten days plus two months" rather than "two months plus ten days".

R 18/10 concerned the calculation of the two-month time limit under Art. 112a(4) EPC. The relevant decision had been posted on 31 August 2010 and the actual notification occurred on 6 September 2010. According to R. 131(2) EPC, where a procedural step is a notification, the relevant event shall be the receipt of the document notified, unless otherwise provided. According to R. 126(2) EPC, in cases where notification is effected by registered letter such a letter is deemed to be delivered to the addressee on the tenth day following its posting. Therefore, regardless of the fact that actual notification occurred on 6 September 2010 the time limit ended pursuant to R. 126(2) EPC on 10 November 2010.

For events which trigger the start of a time limit in connection with re-establishment of rights, see below chapter III.E.4.1.1 "Two-month time limit from the removal of the cause of non-compliance"; for "notification" as an event which triggers the start of a time limit, see chapter III.S.; for the relevant event for calculating the time limit under Art. 78(2) EPC 1973 (R. 38 EPC), see **J 13/04**.

1.2. Determination and extension of periods under Rule 132 EPC

1.2.1 Relevant criteria when time limits are extended upon request (R. 132(2), second sentence, EPC)

According to R. 132(2), second sentence, EPC (R. 84, second sentence, EPC 1973), in special cases, a certain period may be extended upon request. This provision gives discretionary power to departments of the EPO to decide on the request (**T 954/98** of 9 December 1999, **J 12/07**, **J 29/10**). The Guidelines set out examples of special cases, see Guidelines E-VIII, 1.6.1 – April 2025 version. Only a narrow definition of acceptable grounds for further extensions of time limits beyond a total period of six months is justified (**J 12/07**, **J 29/10**, see also **T 79/99**).

In **T 79/99** the board held that when considering requests for additional time, it would take into account not only any reasons put forward but also the number of previous extensions (if any), the views of the other party or parties (if known), the effect of delays on other appeals pending before it and the general principle that all delays are to be avoided where possible.

The application of Art. 120 EPC 1973 and R. 84 EPC 1973 to cases where the time limits had expired before the entry into force of EPC 2000 is considered in **J 12/07**.

1.2.2 Applicability of Rule 132 EPC to the Rules relating to Fees

In case **J 7/07** the Receiving Section had given the appellant a period of one month to submit evidence and pay the surcharge under Art. 8(4) RFees. The appellant argued that

this one-month time limit was too short and amounted to a substantial procedural violation as it was not in compliance with R. 84 EPC 1973. Though R. 84 EPC 1973 referred only to the EPC and the Implementing Regulations, the Legal Board concluded that R. 84 EPC 1973 applied to the time limit in the then Art. 8(4) RFees. The Legal Board explained that no provision of the EPC stated explicitly that the EPC took precedence over the Rules relating to Fees in cases of conflict between them. However, the EPC was clearly the higher legal norm, and in case of conflict, by analogy with Art. 164(2) EPC, the provisions of the EPC should take precedence over the provisions of the Rules relating to Fees.

1.3. Extension of time limits ipso jure on account of public holidays or dislocation in delivery of mail (Rule 134 EPC)

1.3.1 Public holidays (Rule 134(1) EPC)

According to R. 134(1) EPC, if a period expires on a day on which one of the filing offices of the EPO is not open for receipt of documents or on which mail is not delivered there, the period shall extend to the first day thereafter on which all the filing offices are open for receipt of documents and on which mail is delivered. This also applies to periods concerning payments (**J 1/81**). See also **J 05/15**.

1.3.2 General dislocation or interruption in delivery or transmission of mail in a contracting state (R. 134(2) EPC)

Rule 134(2) EPC provides for a time limit to be extended if it expires on a day on which there is a general dislocation in the delivery or transmission of mail in a contracting state or in the contracting state where the EPO is located. The duration of the period of dislocation shall be as stated by the EPO. The term "general interruption" was deleted in the process of revising R. 85(2) EPC 1973. However, as evidenced by the preparatory documents, the retained term "dislocation" also refers to interruptions (CA/PL 17/06, p. 356). Decisions which interpret the term "general interruption" are still cited in the following as an aid to interpreting the "general dislocation" referred to in R. 134(2) EPC.

In **T 1640/22**, the board clarified that the term "party" in R. 134(2) EPC included not only persons who were already a party to pending proceedings but also persons who intended to become a party, such as potential opponents. Such (broad) interpretation was in accordance with the purpose of R. 134(2) EPC, which was to grant extraordinary relief where, due to general dislocation, users of the EPO system could not make their submissions in time. This finding is in line with **T 702/89**, which indicated that R. 85(2) EPC 1973 (predecessor of R. 134(2) EPC) also applied to the time limit of Art. 99(1) EPC for filing a notice of opposition.

In **J 10/20** the Legal Board stated that R. 134(2) EPC did not distinguish between statutory periods and periods specified by a department of first instance or a board of appeal. Its scope of application was therefore not limited to the one or the other. The time limit for filing the statement of grounds of appeal may also be extended under this provision. If the requirements of R. 134(2) EPC are fulfilled, any time limit which expires within the period of interruption or dislocation is extended by operation of law (with regard to R. 85

EPC 1973, see **J 11/88**). The notices of the EPO concerning the disruptions due to the COVID-19 outbreak (see e.g. notice of 1 May 2020, OJ 2020, A60) refer to "the problems caused by the disruptions due to the COVID-19 outbreak". Rule 134(2) EPC, however, did not refer to a "general dislocation" as such, but to a "general dislocation in the delivery or transmission of mail". The EPO's notices were silent on whether there was a general dislocation in the delivery or transmission of mail in Germany. It thus seemed likely that these notices were based on an application of R. 134(2) EPC by analogy. Users and representatives could not be expected to question, without any apparent reason, statements on the extension of time limits which were made in publications under R. 134(4) EPC. Even if there had been no general dislocation in the delivery or transmission of mail, users could still rely on such publications without suffering any disadvantages.

In **T 1338/20** the impugned decision was notified on 28 January 2020. Under normal circumstances, the two-month time limit under Art. 108, first sentence, EPC for filing the notice of appeal would therefore have expired on 7 April 2020 (R. 126(2) EPC as valid from 1 April 2015 to 31 October 2023). However, the notices of the EPO concerning disruptions due to the COVID-19 outbreak, dated 16 April 2020 (OJ 2020, A43) and 1 May 2020 (OJ 2020, A60), came into play here. With these notices, the EPO announced that time limits expiring on or after 15 March 2020 had been extended for all parties first to 4 May 2020 and then to 2 June 2020 under R. 134(2) EPC. As per **J 10/20**, even if there had been no "general dislocation in the delivery or transmission of mail" within the meaning of R. 134(2) EPC, users could still rely on these publications without suffering any disadvantages.

In **J 4/23** the Legal Board explained that the Legal Board in **J 10/20** had relied in its reasoning on the fact that users and representatives could not be expected to question, without any apparent reason, statements on the extension of time limits made in publications under R. 134(4) EPC, nor could they be expected to engage in individual investigations on whether and during which exact periods a dislocation had occurred in one of the contracting states, which might not even be their own. These statements confirmed that it was decisive whether users could be expected to question the information given to them and, if so, whether they would then have come to a conclusion different from the one provided in the EPO's information.

In **T 1678/17** the appellant withdrew its request for oral proceedings and requested a partial refund of the appeal fee. The request for oral proceedings was not in fact withdrawn within one month of notification of the communication issued by the board. However, in view of the notice from the EPO dated 1 May 2020 concerning the disruptions due to the COVID-19 outbreak (OJ 2020, A60) and R. 134(2) and (4) EPC, the board held that the conditions for reimbursement of 25% of the appeal fee, stipulated in R. 103(4)(c) EPC, were fulfilled.

In **J 11/88** (OJ 1989, 433) the Legal Board held that any time limit under the EPC 1973 which expired within the period of interruption or dislocation was extended **by operation of law**. Accordingly, if the President of the EPO did not issue a statement as to the duration of that period, because he did not have the relevant information at the right time, this could

not affect the rights of a person adversely affected by the interruption or dislocation. Whether or not an interruption qualified as a "general interruption" was a question of fact, which had to be decided in the light of any credible information available; in case of doubt, the EPO should make official enquiries of its own motion in application of Art. 114(1) EPC 1973.

In **J 4/87** (OJ 1988, 172) the Legal Board reaffirmed that in the event of an unforeseeable postal delay causing non-compliance with a time limit, the EPO had no discretion to extend the time limit other than in the cases referred to in R. 85(2) EPC 1973.

In **J 3/90** (OJ 1991, 550) the Legal Board interpreted the concept of a **general** interruption, explaining that R. 85(2) EPC 1973 was not restricted to nationwide interruptions. In the case in hand, the Legal Board decided that the limited geographical extent of the disruption did not disqualify the interruption from being general. Whether or not a representative had undertaken all possible measures to avoid the effects of a postal strike was not a relevant test under R. 85(2) EPC 1973.

In **J 1/93** the Legal Board again stated that for an interruption in the delivery of mail under R. 85(2) EPC 1973 to be considered general in character **the public in general** residing in an area of some magnitude, even if of limited geographical extent, had to be affected. The loss of a single mailbag might affect a number of individual addressees but not the public in general.

In **J 14/03** the Legal Board confirmed that evidence of a disruption within the meaning of R. 85(2) EPC 1973 provided by the appellant can lead to a retrospective extension of time in a particular case, as occurred in **J 11/88**, if this evidence, had it been known at the time, would have been such as to warrant a presidential statement under R. 85(2) EPC 1973. However, in contrast to the probative value of the evidence in **J 11/88**, in the case in hand the evidence was inconclusive.

1.3.3 Dislocation due to an exceptional circumstance (Rule 134(5) EPC)

In **J 13/05** the Legal Board highlighted that R. 85(5) EPC 1973 was inserted into the EPO following the events of 11 September 2001 because the legal remedies available at that time were inadequate. It was decided not to extend R. 85(2) EPC 1973 to postal interruptions outside the contracting states, as only for those states could the EPO be sure of obtaining the information necessary to enable the President to announce a general interruption or dislocation. Therefore, unlike the preceding paragraphs, R. 85(5) EPC 1973 was drafted so as to place the **burden of proof** on the party asserting a general interruption or dislocation of the mail service. Like R. 85(2) EPC 1973, R. 85(5) EPC 1973 required that more than one person using the mail service be affected or theoretically capable of being affected by the interruption or dislocation, even if a merely minor or geographically limited interruption might be sufficient.

In **T 1547/20**, due to the COVID-19 pandemic and associated disruptions, all periods expiring on or after 15 March 2020 had been extended to 2 June 2020 under R. 134(2)

and (4) EPC. After that date, R. 134(5) EPC could be invoked in cases of failure to observe time limits due to exceptional occurrences (see notice in OJ 2020, A74).

1.4. Statutory periods of grace, additional period for payment of renewal fees and the fiction of observance of a time limit for fee payments

1.4.1 Additional period for payment of renewal fees under Rule 51(2) EPC

The substance of Art. 86(2) EPC 1973 (late payment of renewal fee and payment of additional fee) is now contained in R. 51(2) EPC.

In **J 4/91** (OJ 1992, 402) the Legal Board held that when calculating the six-month period for the payment of a renewal fee with additional fee under Art. 86(2) EPC 1973, R. 83(4) EPC 1973 should be applied mutatis mutandis in the light of R. 37(1), first sentence, EPC 1973. This meant that the six-month period did not end on the day of the subsequent sixth month corresponding "in number" to the due date according to R. 37(1), first sentence, EPC 1973 but on the day which was equivalent to this due date by virtue of its being the "last day of the month". For the purposes of calculating the additional period under Art. 86(2) EPC 1973, therefore, R. 83(4) EPC 1973, in the context of R. 37(1), first sentence, EPC 1973, resulted in a period running "from the last day of the month to the last day of the month". The additional period started on the last day of the month specified in R. 37(1), first sentence, EPC 1973 even in the circumstances mentioned in R. 85(1), (2) and (4) EPC 1973. The occurrence of such circumstances at the beginning of the period did not result in the end of the period being postponed beyond the end of the sixth month and into the seventh month.

In **J 14/12** the Legal Board explained that R. 51(3), first sentence, EPC provided that renewal fees already due in respect of an earlier application at the date on which a divisional application was filed also had to be paid for the divisional application and were due on its filing. In the case in hand, several renewal fees for the earlier application were due on the date of filing of the divisional application. The Legal Board noted that these fees and any renewal fees due within four months of filing the divisional application could be paid within that period without an additional fee (R. 51(3), second sentence, EPC). As R. 51(2) EPC also provided, in case a renewal fee was not paid in due time, the fee could still be paid within six months of the due date, provided that an additional fee was also paid within that period. Consequently, payment of the renewal fees that fell due for the present divisional application could be made until 1 February 2011 without an additional fee and until 1 April 2011 with an additional fee of 50% of the belated renewal fee.

1.4.2 Period of grace for payment of fees under Rule 85a EPC 1973

In the context of the EPC revision exercise (EPC 2000), R. 85a and 85b EPC 1973 were deleted to take account of the extended application of further processing under Art. 121 EPC (OJ SE 1/2003, 190). See CLB, 5th edn. 2006, VI.D.1.3.2, for a detailed, or CLB, 6th edn. 2010, VI.D.1.4.2, for a short, overview of the case law on this provision.

1.4.3 Fiction of fee payment in due time pursuant to Article 7(3) and (4) RFees

Reference is made to chapter III.U.3.4.

2. Date of receipt of documents transmitted by fax

As from 1 July 2024, patent applications and other documents may not be filed by fax at the EPO. See decision of the President of the EPO dated 22 April 2024 concerning the abolition of facsimile (fax) as a means of filing patent applications and other documents (OJ 2024, A41) and notice from the EPO dated 22 April 2024 concerning the abolition of facsimile (fax) as a means of filing patent applications and other documents (OJ 2024, A42).

In **T 858/18** the board held that if a facsimile transmission of a document within the meaning of R. 50(3) EPC begins on an earlier date and extends beyond midnight to a later date, the entire document is accorded the later date as the single date of receipt. There was no legal basis for according the earlier date as the date of receipt for the part of the document arriving at the EPO before midnight.

In **T 2307/15** the board pointed out that although some paragraphs were missing in the statement setting out the grounds of appeal filed by the appellant on 15 February 2016, when compared with the version filed on 16 February 2016, the former still allowed the reader to understand the reasons according to which the appellant requested the impugned decision to be set aside and the facts and evidence on which the appeal was based. The board held that the statement setting out the grounds of appeal received by fax on 15 February 2016 was therefore to be seen as being complete, since it fulfilled the purpose which it was meant to achieve. Hence, the board confirmed the approach taken in **T 2061/12** and **T 2317/13** (last page of statement of grounds was received minimally late). The dissenting decision in **T 858/18** remained an isolated decision in an individual case on a factual basis different from the case in hand.

This point was also addressed in the following decisions, reported elsewhere in the present publication: **J 7/97** (one page missing from the description), **T 683/06** (some application documents received before and some after midnight) and **T 2061/12** (part of the notice of opposition received before and part of it after midnight).

3. Further processing under Article 121 EPC

Under Art. 121(1) EPC, the applicant can apply for the further processing of its application if it fails to observe a time limit vis-à-vis the EPO. However, Art. 121(4) and R. 135(2) EPC lay down exceptions to this general rule, especially with regard to the time limits for priority, remedies and the request for further processing and re-establishment of rights, and with regard to the non-observance of certain time limits for which a special remedy provision exists in the Implementing Regulations (e.g. R. 58 and 59 EPC). Hence, in contrast to the provisions under the EPC 1973, further processing can be applied to the time limits for the payment of filing, search and designation fees, the national basic fees and the examination fees, and to the time limit for filing the request for examination (OJ SE 4/2007;

MR/2/00, 157). The request is made simply by payment of the prescribed fee (OJ SE 5/2007).

In **J 37/89** (OJ 1993, 201) the Legal Board pointed out that the applicants could overcome a loss of rights under Art. 96(3) EPC 1973 (which corresponds to Art. 94(4) EPC) resulting from the **refusal of a request for a time-limit extension** by requesting further processing in accordance with Art. 121 EPC 1973. At the same time, they could request reimbursement of the fee for further processing. This secondary request had to be decided on in connection with the final decision. Under Art. 106(3) EPC 1973 (Art. 106(2) EPC), the decision on the secondary request could be appealed together with the final decision. The appeal could also be confined to contesting the decision on the secondary request (see also **J 29/10**).

In **J 47/92** (OJ 1995, 180) the Legal Board stated that further processing under Art. 121 EPC 1973 was available only in respect of those time limits the duration of which was to be determined or set by the EPO. This question has been overtaken by the new version of Art. 121 EPC which applies irrespective of whether the time limits are set by the EPO or are specified in the Convention or Implementing Regulations (MR/2/00, p. 157).

In **J 16/92** the Legal Board held that the omitted act within the meaning of Art. 121(2) EPC 1973 (R. 135(1) EPC) consisted in filing a reply in substance to a first communication. It was not completed by filing a request for an extension of time for submitting that reply, since a request for a time limit was not equivalent to the act the party in question had proposed performing within the time limit requested.

In **J 8/18** the appellant argued that further processing under Art. 121 EPC should be available in respect of missing the time limit in R. 49*ter*.2(b)(i) PCT. The Legal Board pointed out that Art. 121(4) EPC expressly ruled out further processing inter alia in respect of the time limit for requesting re-establishment of rights. A request for restoration of rights as specified in R. 49*ter*.2 PCT was equivalent, and identical in legal nature, to a request for re-establishment of rights under the EPC. The EPO was not entitled to grant further processing under Art. 121(4) EPC.

In **T 646/20** the examining division had issued a decision to grant based on the applicant's explicit approval. Following the decision to grant, the appellant voiced its disapproval together with a request for further processing. The board held that in the case of grant an application ceases to be pending on the day before the mention of its grant is published, **G 1/09** (OJ 2011, 336). The request for further processing was thus filed at the stage when the patent application was no longer pending. The board accepted that the remedy of further processing did not require a pending application at the time the request is filed. But already the term "further processing of an application" indicated that it required an application. An application that is deemed withdrawn can return to the stage of a pending application once the request for further processing is successful, but an application that has been granted cannot.

4. Interruption of proceedings under Rule 142 EPC

When proceedings have been interrupted because of the death of the applicant or proprietor or for any of the other reasons specified in R. 142 EPC, time limits are subject to the provisions of R. 142(4) EPC.

4.1. Application of Rule 142 EPC by the EPO of its own motion

The EPO must apply the provisions of R. 142 EPC (R. 90 EPC 1973) of its own motion (**J 902/87**, OJ 1988, 323; **J 23/88**; **T 315/87** of 14 February 1989; **J 49/92**; **T 854/12**; **J 7/16**; **T 54/17**, **J 2/22**). Entering an interruption in the Register is not constitutive and is merely declaratory in effect (**T 854/12**, **J 9/21**). The consequence of an interruption in the proceedings is that the time limits in force as regards the applicant or patentee at the date of interruption of the proceedings, shall begin again as from the day on which the proceedings were resumed (see R. 142(4) EPC). However, the time limit for making the request for examination and the time limit for paying renewal fees are only suspended (see in this chapter III.D.4.8. "Consequences of interruption of proceedings (R. 142(4) EPC)").

The decision of the President of the EPO dated 21 November 2013 concerning the responsibilities of the Legal Division provides that the sole responsibility for the interruption and resumption of proceedings shall be vested in the Legal Division (see point 1.2(b), OJ 2013, 600).

However, in **T 54/17** the board took the view that, in cases where an appeal was pending, the Legal Division did not have exclusive competence to decide on an interruption. It thereby endorsed the view taken in **T 854/12** that a board could decide on this for itself in any proceedings before it because, otherwise, a department outside the Boards of Appeal could deprive it of its power over those proceedings without it being able to do anything about it, especially if interrupting them retrospectively. In the same vein, in **J 2/22** the Legal Board explained that the competence of the boards under Art. 21(1) EPC for appeal proceedings, including decisions on the merits and ancillary procedural matters, was not affected by the competence of the Legal Division for decisions as to entries in the European Patent Register under Art. 20 EPC. The decision of the President of the EPO concerning the responsibilities of the Legal Division of 21 November 2013 (OJ 2013, 600), did not transfer any powers and competences from the Boards of Appeal to the Legal Division on the basis of R. 11 EPC, but only concerned the allocation of functions between the first-instance departments. From the mere fact that the Legal Division was responsible for entries in the Register regarding the dates of interruption or resumption of proceedings pursuant to R. 142 EPC, it could not be derived that the Legal Division would also be responsible for the decision to interrupt.

In **J 9/21,** the Legal Board recalled that, under Art. 127(1) EPC in conjunction with R. 143(1)(t) EPC, the European Patent Register, for which the Legal Division was responsible pursuant to Art. 20(1) EPC, had to contain inter alia entries on dates of interruption and resumption of proceedings under R. 142 EPC. It also emphasised that the EPO should endeavour to avoid conflicting decisions on the interruption of proceedings under R. 142(1)(b) EPC which concern the same applicant or patent proprietor and the

same set of facts in multiple proceedings, and agreed that the approach taken in **T 1389/18** could avoid two conflicting final decisions of boards of appeal being taken on the same legal question. The Legal Board agreed with the finding in **T 1389/18** and **J 10/19** that the Legal Division had the power to determine an interruption of the proceedings, and noted that, as such, this power was not denied in **T 854/12** either, where it was only concluded that the Legal Division's power in that regard was not exclusive.

In **T 1389/18** the board held that the Legal Division generally had the power to establish that proceedings had been interrupted under R. 142(1)(b) EPC with retrospective effect too.

4.2. Amended Rule 142(2) EPC

By decision dated 27 March 2020, the Administrative Council of the European Patent Organisation amended the R. 142(2) EPC provision on resuming interrupted proceedings (OJ 2020, A36). The newly inserted second sentence permits the EPO to set a date on which it intends to resume proceedings of its own motion if, three years after publication of the date of their interruption in the European Patent Bulletin, it still has not been informed who is authorised to continue them. Amended R. 142(2) EPC entered into force on 1 July 2020. For further details see the notice from the EPO dated 29 May 2020 concerning implementation of amended Rule 142(2) EPC (OJ 2020, A76).

4.3. Concept of legal incapacity (Rule 142(1)(a) and (c) EPC)

The EPC does not define the concept of "legal incapacity", which is assessed differently according to whether the person concerned is the applicant or patentee or a professional representative: In **J 900/85** (OJ 1985, 159) and **J 903/87** (OJ 1988, 177) the Legal Board held that the capacity of the **applicant or patent proprietor** to carry out legal transactions relating to his application or patent must be determined in accordance with the relevant **national law** because the interest in the patent application or the patent is an interest in property (see Art. 74 and 2(2) EPC; see also **J 49/92**). On the other hand, **J 900/85** (OJ 1985, 159) states that a **uniform standard** of judging legal incapacity of **representatives** shall apply in order to avoid differences in the application of R. 90(1)(c) EPC 1973 (R. 142(1)(c) EPC) depending on the nationality of domicile of the representative.

The Legal Board in **J 2/22** observed that the legal incapacity of a person meant that they were suffering from a disturbance of their mind which made them unable to form the necessary voluntary intention to carry out legal transactions binding upon them, and that in the context of the procedural system of the EPC, which does not distinguish between civil and procedural legal capacity, this also meant that they could not act on their own in proceedings before the EPO. The Legal Board analysed the jurisprudence on the concept of legal incapacity at length and concluded that within the legal system established by the EPO, there had to be a standard to be set and applied by the EPO. It referred to **G 1/22** and **G 2/22**, which, albeit in a different context, reaffirmed the general approach of applying the autonomous law of the EPC, being inspired and supplemented by the national laws of the EPC contracting states, to arrive at uniform standards for all parties before the EPO.

In particular, the Legal Board held that the standards for assessing legal capacity regarding natural persons should be the same as those regarding professional representatives, as only unified standards according to the autonomous law of the EPC could guarantee equal treatment of the parties, as an essential element of fair trial.

4.4. Determining legal incapacity of the applicant or patent proprietor for the purpose of Rule 142(1)(a) EPC

In **J 903/87** (OJ 1988, 177) the Legal Board ruled that a brief medical certificate attesting that the applicant had been in a state of physical and mental exhaustion and depression, was not sufficient to establish incapacity within the meaning of R. 90(1)(a) EPC 1973 since the certificate said nothing about the seriousness and duration of this condition. See also **T 1680/13**.

In **J 49/92** the Legal Board had no evidence – such as a medical certificate – to suggest that the applicant's health, according to German legal practice, was in such a condition as to exclude the rational exercising of his will, since he had still managed to transfer the fees for the application, even if they had been sent by mistake to the German Patent Office instead of the EPO.

In **J 2/22** the Legal Board observed that, in addition to medical certificates, the behaviour of the person concerned during the proceedings could indicate legal incapacity.

4.5. Determining legal incapacity of the representative for the purpose of Rule 142(1)(c) EPC

The basic consideration for a decision on R. 142(1)(c) EPC is whether the representative concerned was either in a fit mental state to do the work required of him at the material time or whether he lacked the capacity to make rational decisions and to take the necessary actions, see **J 900/85** (OJ 1985, 159), **J 7/99**, **J 7/16**. In **J 5/99** the Legal Board stated that that meant carefully weighing up all reliable relevant information. Also indispensable was a reliable medical opinion taking account of all material facts (see also **J 7/16**).

In **J 900/85** (OJ 1985, 159) the Legal Board noted that, although there were differences in the national laws of contracting states as to the concept of "legal incapacity" and as to its consequences, there seemed to be a broad agreement that a person of full age was legally incapacitated when he was suffering from such a disturbance of his mind that he was unable to form the necessary voluntary intention to carry out legal transactions which would be binding upon him, e.g. to make valid contracts. Such a disturbance of his mind could be recognised by national law even if it was temporary only (e.g. a disturbance caused by physical injury or by the influence of alcohol or other drugs) or occurred from time to time, as was the case with some mental illnesses in which the patient had lucid intervals. Disturbance of the mind causing legal incapacity was always recognised by law if it was of long duration, a fortiori if it was permanent and irreversible. Since there was a unified European profession of representatives before the EPO, there should be a uniform standard of judging legal incapacity, in order to avoid differences in the application of

R. 90(1)(c) EPC 1973 (R. 142(1)(c) EPC) depending on the nationality or domicile of the representative. The question of determining the legal incapacity of a representative for the purposes of R. 90(1)(c) EPC 1973 (R. 142(1)(c) EPC) was one for the EPO, applying its own standards, developed in the light of experience and taking into consideration principles applied in the national laws of the contracting states. See also **J 5/99**, **J 7/99**.

The legal incapacity had to be of a persistent nature **J 901/86** (OJ 1987, 528). For the purposes of R. 90(1)(c) EPC 1973 (R. 142(1)(c) EPC), the EPO must establish whether and if so when the representative was legally incapacitated, and in the light of its findings specify the time limits which might have been interrupted **J 902/87** (OJ 1988, 323).

In **J 7/99** the Legal Board held that legal incapacity pursuant to R. 90(1)(c) EPC 1973 (R. 142(1)(c) EPC) meant a mental state in which the representative was so totally or nearly totally unable to take rational decisions that all his professional duties, and not just one isolated case, were affected by his mental state. In the case in hand, legal incapacity was not established. See also **J 2/98**, **J 7/16**.

In **J 7/20** the Legal Board noted that the criteria for interruption of proceedings under R. 142(1)(c) EPC are framed, word-for-word, as a closed list of triggering events (i.e. grounds): death of the representative; legal incapacity of the representative; prevention of the representative for legal reasons resulting from action taken against his property from continuing the proceedings. The list of interruption-triggering events of proceedings under R. 142(1)(c) EPC is exhaustive. It follows that any other events, including any encompassed by the notion of force majeure, fall outside the scope of this Rule. External, practical and one-off kind of events (inter alia heavy snow, cancelled flights and failed communication) do not constitute "legal incapacity of the representative" under R. 142(1)(c) EPC.

4.6. Legal incapacity of a representative from outside the contracting states

In **J 23/88** the Legal Board accepted the finding of the Receiving Section that an American patent attorney was not covered by R. 90(1)(a) EPC 1973 (R. 142(1)(a) EPC), being neither the applicant nor the proprietor of a European patent, nor a person authorised by national law to act on his behalf. "Person authorised by national law" covered legal representatives of the applicant or proprietor, but did not extend to a patent attorney authorised under the laws of a non-contracting state. However, the Legal Board held that the US patent attorney in the case in hand was, at the relevant time, a legally incapacitated representative of the applicant within the meaning of R. 90(1)(c) EPC 1973 (R. 142(1)(c) EPC). This interpretation was fully consonant with the preparatory documents regarding the desirability of equal treatment of applicants from contracting and non-contracting states. The difference in the wording of R. 90(1)(c) EPC 1973 (R. 142(1)(c) EPC) from that of R. 90(1)(a) EPC 1973 (R. 142(1)(a) EPC) was deliberately chosen so as to create equal treatment between applicants in the contracting and in non-contracting states. The Legal Board observed that Art. 133(2) EPC 1973 provided a limited exception to the normal requirement for professional representation within the meaning of Art. 134 EPC 1973 in the case, and only in the case, of the filing of the European patent application. Such a filing could validly be made by the applicant himself or by any representative duly authorised by

him. Once the processing of the international application had properly started in the EPO, any interruption in proceedings occasioned by the death or legal incapacity of the American patent attorney would no longer be covered by R. 90(1)(c) EPC 1973.

4.7. Interruption of proceedings because of insolvency (Rule 142(1)(b) EPC)

According to R. 142(1)(b) EPC (R. 90(1)(b) EPC 1973) proceedings before the EPO shall be interrupted in the event of the applicant for or proprietor of a patent, as a result of some action taken against his property, being prevented by legal reasons from continuing the proceedings before the EPO. An interruption under R. 142(1)(b) EPC serves the protection not only of the interests of the patent proprietor but also those of its creditors. This rule protects these interests by preventing any measure with legal effect from being taken, be it by the proprietor or the EPO, that is liable to adversely affect the patent's value as an asset (**T 1389/18**). For cases in which an **opponent** requested interruption of proceedings because of insolvency, see **T 1533/07** and **T 516/14** (the application of R. 142(1)(b) EPC to an opponent by analogy is not justified).

The decisive criterion for interruption under R. 142(1)(b) EPC is whether the action against the property was such as to make it legally impossible for the applicant to continue with the proceedings (**J 26/95**, **J 16/05**, **J 9/21**).

In **T 854/12** the board held that R. 142(1)(b) EPC was applicable where a proprietor initially unrestricted in his procedural conduct was later "prevented from continuing the proceedings", but not where a patent was transferred with the administrator's consent to another proprietor who was already insolvent and therefore did not become a party to the proceedings but was instead represented from the outset by the administrator, whose powers of disposal were unlimited.

In **J 9/90** the Legal Board held that for R. 90(1)(b) EPC 1973 to be applied in the light of Art. 60(3) EPC 1973 and R. 20(3) EPC 1973, the applicant entered in the European Patent Register and the insolvent person (here a limited company) had to be legally identical. See also **J 16/05**.

In the cases **J 9/94** and **J 10/94**, it was regarded as being analogous to a case of legal impossibility where the applicant, as a consequence of an action against his property, did not have at his disposal any remaining property by means of which he could have effected the required payment and he was thus, as a result of the action against his property, placed in a situation where it was factually and legally impossible for him to continue the proceedings before the EPO. In such a case it had, however, to be examined whether the actions taken effectively made it impossible for the applicant to continue the proceedings.

In **J 18/12** the Legal Board held that the correct interpretation of R. 142(1)(b) EPC required that there be a close relationship between the action taken against the property of the applicant and the condition that this action should be the cause of the applicant being prevented by legal reasons from continuing the proceedings. This requirement of causality would normally only be fulfilled if the "action" was a legal action and was directed against the property of the applicant as a whole, i.e. against the totality of the applicant's assets.

In **J 26/95** (OJ 1999, 668) the Legal Board held that, in the absence of specific circumstances, proceedings against the applicant under Chapter 11 of the US Bankruptcy Code did not interrupt proceedings before the EPO within the meaning of R. 90(1)(b) EPC 1973 (R. 142(1)(b) EPC) (see also **J 11/98**). Being placed under Chapter 11 of the US Bankruptcy Code was an action taken against the property of the debtor. It did not, however, constitute a case where, as a result of such action, it was impossible for the debtor to continue the proceedings before the EPO. On the contrary, it was the very nature of proceedings under Chapter 11 that it was the debtor who continued to act for his business. Chapter 11 bankruptcy proceedings were therefore not comparable to the cases which had been recognised in the case law of the boards of appeal as leading to interruption of proceedings, i.e. where parties had been placed under receivership under French law (**J 7/83**, OJ 1984, 211) or been declared bankrupt under German law (**J 9/90**). A situation which could be compared to the exceptional case underlying decisions **J 9/94** and **J 10/94** (see above) had also not been substantiated.

In **J 11/95** the applicant had continued the proceedings before the EPO even after it had gone bankrupt. In particular, it had filed a request for entry into the regional phase before the EPO and paid the corresponding fees. The Legal Board held that from these facts and since no evidence to the contrary had been filed it had to be concluded that the applicant (in bankruptcy) was not prevented by legal reasons from continuing the proceedings before the EPO.

In contrast, the Legal Board in **J 9/21** stated that the mere fact that there was no bankruptcy judgment and that the former patent proprietor entered voluntarily into external administration under the Australian Corporations Act did not speak against the application of R. 142(1)(b) EPC. Once the external administrator had been appointed, only the external administrator could deal with a company's property. As the disputed patent was part of the former patent proprietor's company property at the relevant point in time, the former patent proprietor was indeed "prevented by legal reasons from continuing the proceedings". Thus, the conditions for an interruption under R. 142(1)(b) EPC were fulfilled. The fact that an applicant or patent proprietor continued proceedings before the EPO did not allow any conclusions to be drawn as to whether they were legally prevented from doing so.

In **J 16/05** the Legal Board held that R. 90 EPC 1973 did not provide for any time limit within which the circumstances establishing an interruption of proceedings would have to be brought to the attention of the EPO. The ratio legis of R. 90(1)(b) EPC 1973 was to protect parties not able to act in the proceedings for the defined legal reasons against a loss of rights which would otherwise occur, until such time as the EPO could resume the proceedings under R. 90(2) EPC 1973. The Legal Board also pointed out that in the interest of legal certainty, R. 90(1)(b) EPC 1973 could not be applied without any time restriction at all. Parties had to act in good faith and in due time and could not have an interruption of the proceedings established years after they had become aware of the facts justifying an earlier interruption.

The board in **T 54/17** held that if a patent proprietor, despite being aware of circumstances justifying an interruption which were exclusively within their sphere of influence, continued

to act in proceedings for years after those circumstances had come to an end without ever invoking them, it would be unfair for them then to invoke an interruption at such a late stage, with the result that the proceedings conducted up to then, in which they had actively taken part, had to be conducted again. That would be at odds with the principle of good faith. See also **J 9/21.**

4.8. Consequences of interruption of proceedings (Rule 142(4) EPC)

Rule 142(4), first sentence, EPC (R. 90(4), first sentence, EPC 1973) states that the time limits in force as regards the applicant for or proprietor of the patent at the time of interruption of the proceedings shall begin again as from the day on which the proceedings are resumed. Rule 142(4) EPC includes two exceptions in this respect, namely the time limits for making a request for examination and for paying renewal fees. Rule 142(4) EPC does not, however, constitute an exception to the general principle that all time limits are interrupted. Its sole purpose is to specify how time limits are to be calculated when proceedings resume (**J 7/83**, OJ 1984, 211).

The board in **T 1389/18** (citing **J 9/06**) observed that proceedings could only be resumed with ex nunc effect.

In **J 10/19**, the Legal Board stated in its catchword that, whereas a finding that proceedings have been interrupted owing to the patent (co-)proprietor's insolvency was usually made retroactively, it could be reversed only with ex nunc effect. A retroactive reversal was out of the question, even in isolated individual cases after weighing up the interests concerned. It was instead a matter of law that had to be regulated generally. In the same vein, in **J 9/21** the Legal Board observed that it was not possible to set aside a declaration of interruption by the Legal Division with retroactive effect, not even if it was declared erroneously. The reasons invoked in the case law cited by the Legal Board included that otherwise time limits which had been declared by the Legal Division to be interrupted could, from the parties' perspectives, be shortened or expire retroactively (**J 10/19**) and that members of the public had legitimate expectations that the dates of interruption and resumption entered into the European Patent Register were correct (**J 10/19**).

In **J 7/83** (OJ 1984, 211) the Legal Board held that in the event of proceedings for grant of a European patent being interrupted because the applicant company has gone into receivership (R. 90(1)(b) EPC 1973), the period prescribed by Art. 94(2) EPC 1973 for payment of the **examination fee** is suspended as from the date on which payments were discontinued by court order up to the date on which proceedings for grant are resumed (R. 90(2) EPC 1973). The period then resumes for the part remaining to elapse, or for at least the two months prescribed by R. 90(4), second sentence, EPC 1973. In **J 902/87** (OJ 1988, 323) the Legal Board stated that such an interpretation could not be applied to **renewal fees**, for which the EPC did not prescribe a time limit for payment but simply dates on which they fell due. The only time limit affecting renewal fees that might be suspended was the six-month period for paying the renewal fee together with an additional fee referred to in Art. 86 EPC 1973. Rule 90(4) EPC 1973 had to be interpreted as deferring, until the date proceedings are resumed, the payment date for renewal fees which had fallen due during the period of the representative's or applicant's incapacity.

The board in **T 854/12** held that, if a board was satisfied that the proceedings had been interrupted, this meant not only that any periods running at the time were suspended (R. 142(4) EPC) but also that the board could not hold oral proceedings or issue a decision in written proceedings.

In **T 1389/18** the board came to the conclusion that any oral proceedings taking place during an interruption and any decision announced at them by the opposition division had to be retrospectively deemed non-existent. The appeals before the board were therefore also devoid of purpose, such that the appeal proceedings had to be ended without a decision on the merits of the case (see also **J 10/19**, point 6 of the Reasons). The board in **T 967/18** reiterated that where opposition proceedings have been interrupted under R. 142(1)(b) EPC, acts done by the parties or the competent body of the EPO during the period of interruption were considered invalid. Furthermore, an appeal against a decision taken during the interruption was inadmissible because it has no valid subject eligible for a judicial review.

Any EPO communications and decisions issued in the period between the date of interruption and the date of resumption are devoid of purpose and must be reissued once the proceedings have been resumed (**T 54/17**).

In **T 956/19** the Board emphasised that R. 142(4) EPC did not apply to time limits that neither the applicant nor patent proprietor were required to observe, such as the opposition period under Art. 99(1) EPC. The wording of R. 142 EPC alone supported this. Since other parties' inability to act in the proceedings did not constitute grounds for interruption, the time limits applicable to such parties were not taken into consideration when applying R. 142(4) EPC.

In **J 12/19** the Legal Board explained that the proceedings before the Legal Division relating to interruption and resumption of the opposition proceedings before the opposition division were intermediate proceedings in relation to the opposition proceedings. Where opposition proceedings were interrupted and the Legal Division intended to resume proceedings or where it refused to resume the proceedings, the outcome of the intermediate resumption proceedings had an immediate impact on the opponent's legal position. Any decision taken in such proceedings might (adversely) affect the opponent's legal position. The opponent could not be required to defend its rights only subsequently in the main (opposition) proceedings, after they had been resumed. Such a requirement would delay proceedings and might cause additional costs. Therefore, the Legal Board was of the view that the opponent (appellant) was party to the resumption proceedings.

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1. Introduction

Re-establishment of rights constitutes a legal remedy for curing a loss of rights in proceedings before the EPO. If the requirements of Art. 122 EPC and R. 136 EPC are fulfilled and the request for re-establishment is granted, the requester will be treated as if the loss of rights had not occurred (see Art. 122(3) EPC). After the revision of the EPC, further processing has become the standard legal remedy in cases of failure to observe time limits in the European patent grant procedure (see also chapter III.D.3. "Further processing under Article 121 EPC") and thus in some cases has replaced re-establishment (for a synopsis of the changes see CLB, 6th edn. 2010, VI.E.1, and OJ SE 4/2007).

The main requirements for a re-establishment of rights are that the requester has the right to file the request (see in this chapter III.E.2.), he was unable to observe a time limit within the meaning of Art. 122(1) EPC (which is not excluded under Art. 122(4) and R. 136(3) EPC) and this failure had the direct consequence of causing a loss of rights (chapter III.E.3.), the request was filed in time and in due form and the omitted act was made good within the time limit (chapter III.E.4.), and the substantive conditions were met, in particular all due care required by the circumstances had been taken (chapter III.E.5.).

2. Right to file request for re-establishment of rights

Under Art. 122(1) EPC re-establishment of rights may be granted to both the applicant and the proprietor of a European patent. Accordingly, it is a legal remedy that is, in general, not available to opponents.

2.1. Exception for opponent – time limit for filing statement of grounds of appeal

Opponents are not entitled to request re-establishment of rights in respect of the two-month time limit for filing an **appeal** under Art. 108, first sentence, EPC (see **T 210/89**, OJ 1991, 433; see also **T 323/87**, OJ 1989, 343; **T 128/87**, OJ 1989, 406; **T 314/01**; **T 2454/11**; **T 1946/15**); nor in respect of the nine-month time limit under Art. 99(1) EPC for filing the **notice of opposition** and paying the appropriate fee (**T 702/89**, OJ 1994, 472; **T 748/93**; **T 2254/11**).

In **G 1/86** (OJ 1987, 447) the Enlarged Board held, however, that an **opponent as appellant** might have his rights re-established under Art. 122 EPC if he had failed to observe the time limit for filing the statement of grounds of appeal under Art. 108, third sentence, EPC (established case law, see **T 335/06**; **T 1545/16**). The reasons justifying the exclusion of opponents from re-establishment of rights in respect of the time limit for appeal – in particular the patent proprietor's interest in no longer being left uncertain as to whether an appeal had been lodged once this time limit had expired – could not be extended to the time limit for filing the statement of grounds of appeal, because this uncertainty no longer existed. The Enlarged Board applied the general legal principle recognised in the contracting states of the EPC that all parties to proceedings before a court must be accorded the same procedural rights, as a principle deriving from the general principle of equality before the law. Under this principle an opponent must not be

treated differently from the patent proprietor as that would result in unjustifiable discrimination against him.

In **T 181/14**, the appellant (opponent), having filed notice of appeal and a statement of grounds of appeal but failed to pay the appeal fee in due time, was seeking re-establishment of its rights in respect of the time limit for payment. The board saw no reason to depart from the settled case law that Art. 122(1) EPC was applicable only where an appellant-opponent had failed to observe the time limit for filing its statement of grounds of appeal. When it came to re-establishment of rights, there was good reason to treat such a failure to file the statement of grounds of appeal differently from late payment of the appeal fee. Appellants-opponents who failed to observe the time limit for filing the statement of grounds of appeal could have their rights re-established because there was an appeal having legal effects; that is to say, appeal proceedings had been validly initiated. By contrast, if the appeal fee was not paid on time, there was no appeal. It made no difference, the board held, that, in this case, the patent proprietor had replied to the statement of grounds of appeal.

2.2. Re-establishment only in cases of failure to observe a time limit for which it was for the applicant to observe

In **J 3/80** (OJ 1980, 92) the Legal Board made it clear that if the **national industrial property office** concerned **failed to forward a European patent application** filed with that national office to the EPO **in time**, with the result that the application was deemed to be withdrawn (Art. 77(5) EPC 1973), the applicant could not claim restitution of rights, since the EPC provided only for restitution of rights where there had been a failure to observe a time limit which it was for the applicant to observe. See also **J 1/12**.

3. Non-observance of time limit directly causing a loss of right

3.1. The meaning of "time limit"

For re-establishment of rights to be possible, there must be a failure to meet a time limit vis-à-vis the EPO (Art. 122(1) EPC), i.e. a time limit given specifically to the applicant pursuant to the EPC or by an official of the EPO within which he must accomplish a certain act (consolidated cases **J 11/91** and **J 16/91**, OJ 1994, 28; **J 21/96**). Not every "time limit", "time limitation" or "time restriction" under the EPC is also a time limit pursuant to Art. 122 EPC (**J 10/01**).

Time limits in the EPC have **two conceptual elements**: (1) a period of time determined in years, months or days, and (2) a relevant date, which serves as the starting date of the time limit, and from which the period of time is counted. Time restrictions imposed on applicants by the EPC, but not having these conceptual elements cannot be regarded as time limits for the purposes of Art. 122 EPC 1973 (**J 18/04**, OJ 2006, 560).

3.1.1 Requirement of pendency when filing divisional application is not a time limit

According to the established case law (see **J 19/10**) of the boards of appeal, R. 36(1) EPC (and R. 25(1) EPC 1973 in its version since 2002) sets a condition, not a time limit, for filing a divisional application to any pending earlier European application, namely that the earlier European patent application is pending. In procedural law, the fact that a conditional act can only be accomplished before a particular set of circumstances foreseen by legal provisions occurs (condition), is conceptually different from a set period of time imposed for doing an act (time limit) (**J 24/03**, OJ 2004, 544; **J 3/04**; see also **J 10/01**; **J 18/04**, OJ 2006, 560; **G 1/09**, OJ 2011, 336; **J 19/10**; **J 10/12**). Rule 25(1) EPC 1973 in its version prior to 2002 also did not contain a time limit but identified a point in the grant procedure after which a divisional application could no longer be filed, namely the approval of the text according to R. 51(4) EPC 1973 (**J 21/96**, **J 4/02**).

3.1.2 Designation of States

In **J 3/83** the Legal Board explained that the concept of a time limit within Art. 122 EPC 1973 involved a period of time of a certain duration. In the case of designation of states, there was no such period. States had to be designated at a particular time, see Art. 79(1) EPC 1973. With the EPC 2000 this is no longer an issue, as under the current Art. 79(1) EPC all contracting states party to the EPC at the time when the application is filed are deemed to be designated in the request for grant of a European patent.

3.1.3 "Time limitation" condition for requests for correction

In **J 7/90** (OJ 1993, 133) the Legal Board found that the "time limitation" condition imposed under board of appeal case law, which required that, in general, a request for correction of the designation of a state or priority data had to be refused in the public interest if it was not made early enough to enable publication of a warning together with the European patent application, was not a "time limit" within the meaning of Art. 122(1) EPC 1973.

3.2. Time limits excluded from re-establishment under Article 122(4) EPC and Rule 136(3) EPC

Under Art. 122(4) EPC in conjunction with R. 136(3) EPC, re-establishment is ruled out in respect of time limits for which further processing is available under Art. 121 EPC, such as the time limits for paying the filing fee, search fee, designation fees and examination fee, and for the time limit for filing the request for examination, as well as any time limit set by the EPO (see also OJ SE 4/2007; for the situation under the EPC 1973, see **J 11/86**). See also III.E.1. in this chapter.

Re-establishment is also excluded in respect of the time limit for requesting re-establishment (R. 136(3) EPC; this was also the case under the EPC 1973, see **T 900/90**), but is possible for the time limit for requesting further processing (see Art. 121(4) EPC; this was also the case under the EPC 1973, see **J 12/92**; **J 902/87**, OJ 1988, 323; **J 29/94**, OJ 1998, 147).

In contrast to the situation under the EPC 1973, re-establishment in respect of the priority period (Art. 87(1) EPC) is possible under the EPC 2000. This change to the EPC has no implications for the interpretation of Art. 122(5) EPC 1973, which clearly rules out the time limit under Art. 87(1) EPC 1973 (see **J 9/07**). The case law which excluded the grace periods under R. 85a and R. 85b EPC 1973 from re-establishment is now obsolete as these provisions have been deleted. Issues concerning the exclusion of PCT time limits under Art. 122(5) EPC 1973 are no longer likely to arise since the coming into force of the EPC 2000; for a detailed summary of the case law (**G 3/91**, OJ 1993, 8; **G 5/92** and **G 6/92**, OJ 1994, 22 and 25; **G 5/93**, OJ 1994, 447; **J 1/03**; **T 227/97**, OJ 1999, 495) see CLB, 5th edn. 2006, VI.E.3; for a short summary see CLB, 6th edn. 2010, VI.E.4.

3.3. Time limits concerning the PCT proceedings

Article 48(2)(a) PCT states that any contracting state shall, as far as that state is concerned, excuse, for reasons admitted under its national law, any delay in meeting any time limit (see also R. 82*bis*.2 PCT). Consequently, a Euro-PCT applicant who has not carried out a certain procedural act within the time limit prescribed in the PCT can take advantage of the relevant provisions of the EPC concerning re-establishment of rights in all cases where the direct European applicant too may invoke them if he fails to observe the relevant time limit (see **G 3/91**, OJ 1993, 8; **G 5/93**, OJ 1994, 447; **J 13/16**).

In **J 13/16** the Legal Board held that it would be inconsistent with the well-established principle of equal treatment between direct European applicants and Euro-PCT applicants if Euro-PCT applicants could be re-established in respect of the period under R. 49*ter*.2(b)(i) PCT for filing a request for restoration of the right of priority when, for direct European applicants, re-establishment is ruled out in respect of the period for requesting re-establishment under Art. 122(4) and R. 136(3) EPC. Therefore, in proceedings before the EPO, re-establishment of rights under Art. 122 EPC is ruled out in respect of the period under R. 49*ter*.2(b)(i) PCT for filing a request for restoration of right of priority.

In **J 6/79** the Legal Board held that restitutio in integrum was not excluded, so far as the time limit for presentation of the request for examination is concerned, in the case of an international application transmitted to the EPO.

In **W 4/87** (OJ 1988, 425) the board decided that an application for restitutio in integrum could be submitted in cases where the statement of grounds supporting the protest under R. 40.2(c) PCT was submitted late, since Art. 122 EPC 1973 applied in conjunction with Art. 48(2) PCT.

In **T 227/97** (OJ 1999, 495), the board held that the provisions of Art. 122 EPC 1973 were applicable to the time limit set by R. 13*bis*.4 PCT. For re-establishment in respect of the time limit, set under former R. 40.3 PCT, for the protest against the invitation to pay an additional search fee, see **W 3/93** (OJ 1994, 931).

3.4. Loss of rights as a direct consequence by virtue of the EPC

Under Art. 122(1) EPC rights cannot be re-established unless they have previously been lost as a direct consequence of the non-observance of a time limit vis-à-vis the EPO.

In **J 1/80** (OJ 1980, 289) certified copies of priority documents had not been filed within the 16-month period provided for in R. 38(3) EPC 1973. The Legal Board found that, according to the Convention, there was a deficiency only if the priority documents had not been filed by the end of the period. It could only be said that there was a deficiency thereafter and the applicant should have been given an opportunity to remedy that deficiency within a further period (Art. 91(2), R. 41(1), 84 EPC 1973). There could only be a loss of rights if the applicant did not then take advantage of this opportunity.

In **J 23/14** the Legal Board held that, notwithstanding the wording of Art. 86(1) EPC 2000 and R. 51 EPC (in the version in force until 31 December 2016), and for the sake of the protection of legitimate expectations of the users of the European patent system, a patent application was deemed to be withdrawn only upon expiry of the six-month grace period for paying the renewal fee with additional fee under R. 51(2) EPC, in accordance with the case law that prevailed before decision **T 1402/13** of 31 May 2016. See also **J 7/16**.

In **T 1403/16** the board found that one of the basic preconditions for applying Art. 122(1) EPC was not fulfilled in the case in hand, namely that non-compliance with the time limit lead directly to a loss of rights. In opposition proceedings, in the event of a failure to reply in due time to a communication from the opposition division, there is no loss of rights which occurs automatically by operation of law. The board held that re-establishment of rights was not available in the event of non-compliance with a time limit set in a communication under Art. 101(1) EPC. This conclusion equally applied to the time limit under R. 84(1) EPC.

4. Admissibility of requests for re-establishment of rights

4.1. Time limits for filing a request for re-establishment (Rule 136(1) EPC)

The time limits for filing a request for re-establishment are set out in R. 136(1) EPC (see also Art. 122(2) EPC 1973). In principle, a request must be filed within two months of removal of the cause of non-compliance and, at the latest, within one year after expiry of the unobserved time limit; R. 136(1), second sentence, EPC provides for two exceptions: a request for re-establishment in respect of the periods specified in Art. 87(1) EPC (priority) and Art. 112a(4) EPC (petition for review by the Enlarged Board) must be filed within two months of expiry of the unobserved time limit. Hence the case law summarised in this chapter III.E.4.1.1 is not applicable to such cases, but the principles laid down in this chapter III.E.4.1.2 are likely to be transferable to the two-month period under R. 136(1), second sentence, EPC. Under R. 136(1), third sentence, EPC, the request for re-establishment of rights is not deemed to have been filed until the prescribed fee has been paid.

4.1.1 Two-month time limit from the removal of the cause of non-compliance

The one-year period is not an alternative to the two-month period; a request has to be filed within two months of the removal of the cause of non-compliance, and no request can be filed more than one year after expiry of the unobserved time limit (**J 11/17**).

The two-month time limit also applies if the time limits under Art. 102(4) and (5) EPC 1973 have been missed, even if no decision has yet been handed down concerning revocation (**G 1/90**, OJ 1991, 275). The omitted act must be completed within the same period. The fee for re-establishment of rights is also payable within the same time limit as that stipulated by Art. 122(2) EPC 1973 for the filing of an application for re-establishment (**J 18/03**). The mere payment of the fee does not meet the requirements of R. 136 EPC (**T 1465/08**).

a) Removal of the cause of non-compliance

In most cases the "cause of non-compliance with the time limit" involves some error in the carrying-out of the party's intention to comply with the time limit (**J 29/86**, OJ 1988, 84; regarding other possible causes of non-compliance see also in this chapter III.E.4.2. "Inability to observe a time limit").

The removal of the cause of non-compliance occurs on the date on which the person responsible for the application (the patent applicant or his professional representative) is made aware of the fact that a time limit has not been observed (see **T 191/82**, OJ 1985, 189; **T 287/84**, OJ 1985, 333; **J 29/86**, OJ 1988, 84; **J 27/88**, **J 27/90**, OJ 1993, 422).

(i) Date of the removal of the cause of non-compliance

In **J 1/20** the Legal Board set out that, in its view, to correctly assess admissibility of a request for re-establishment of rights, it must first be established: (i) who was the person responsible for the application; and (ii) when this person was actually made aware of the cause of non-compliance. Removal of the cause of non-compliance is a question of fact, the answer to which thus depends on the relevant person actually becoming aware that a time limit has not been observed, e.g. actual receipt of a communication under R. 112(1) EPC, rather than on a legal fiction of awareness, e.g. deemed notification of the communication pursuant to R. 126(2) EPC. Removal occurs on the date on which the person responsible for the application/patent (normally the authorised representative) becomes aware of an error.

According to earlier decisions, the decisive factor was the time when the person concerned ought to have noticed the error if they had taken all due care (see e.g. **J 27/88**, **J 5/94**, **T 315/90**, **T 840/94**, **J 24/97**, **J 27/01**, **T 1026/06**, **T 493/08**, **J 1/13**, **T 1588/15**). In **J 1/20** the Legal Board considered that this approach did not lead to a correct determination of the date of removal of the cause of non-compliance. In **J 27/90** (OJ 1993, 422), the Legal Board stated that the removal of the cause of non-compliance was a matter of fact which had to be determined in the individual circumstances of each case (see also **J 7/82**,

OJ 1982, 391; **J 16/93**; **T 900/90**; **T 832/99**; **J 21/10**; **T 387/11**; **T 1588/15**). In the case of an error of facts the removal occurred on the date on which any person responsible for a patent application should have discovered the error made. This was not necessarily the date of receipt of the communication under R. 112(1) EPC (R. 69(1) EPC 1973) (see **T 315/90**, **J 21/10**). If, however, such a communication had duly been served, it may, in the absence of circumstances to the contrary, be assumed that the removal was effected by this communication (see also **J 7/82**, OJ 1982, 391; **J 29/86**, OJ 1988, 84; **T 900/90**; **J 27/90**; **J 16/93**; **T 428/98**, OJ 2001, 494; **T 832/99**; **J 11/03**).

In **T 261/07**, relying on **T 949/94** of 24 March 1995, the patentee argued that it had only become aware of an oversight once it was established that the decision of the opposition division had indeed been received. The board however took the view that the cause of non-compliance was removed as soon as the patentee noticed via a file inspection "that something was amiss" (see **J 9/86**, **J 17/89**, **T 191/82**).

In **T 198/16** the board stated that the practice of applying the due-care requirement in the context of removal of the cause of non-compliance with a period within the meaning of R. 136(1) EPC could well be seen as extending the meaning of the due-care requirement in a way that enlarges the scope of the essentially substantive criterion by adding to it the function of an extraordinary preliminary admissibility/applicability hurdle. The board stated that this approach to the "removal" criterion, which could not be based on the letter of the law, was therefore doubtful. The board left open the question as to the approach to be followed.

(ii) Presumption as to date of the removal of the cause of non-compliance

If a loss-of-rights communication (R. 112(1) EPC) is served there is: (i) a presumption that removal occurs on the date of receipt of such communication; and (ii) an obligation for the recipient not to ignore it, and to take action. This presumption is, however, rebuttable, in the sense that it is valid unless, due to exceptional circumstances, the cause for non-compliance persisted (**J 1/20**; **T 1588/15**). In **J 29/86** (OJ 1988, 84) the Legal Board assumed a later date in view of the special circumstances of the case. In **T 900/90** the board emphasised that in all cases in which the receipt of the notification under R. 69(1) EPC 1973 (R. 112(1) EPC) could be regarded as the removal of the cause of non-compliance it had to be clearly established that neither the representative nor the applicant was aware that the application had been deemed to be withdrawn before the receipt of that notification. Other cases in which the boards agreed to a date different from that of the receipt of the communication under R. 69(1) EPC 1973 (R. 112(1) EPC) include **J 16/93**; **J 22/97**; **J 7/99**; **J 19/04**; **T 24/04** and **T 170/04**.

In **T 1570/20**, the cause of non-compliance was removed on the date the European professional representative became aware of the loss of rights, i.e. upon receipt of the loss-of-rights communication. Removal of the cause of non-compliance did not require any additional knowledge by the professional representative about possible reasons for the loss of rights, such as whether the non-payment of fees was intentional or not. Rather, it was sufficient that the professional representative became aware of the fact that a time limit, with regard to which re-establishment of rights was requested later on, had not been

complied with, which included awareness of the fact that nobody had taken care of the payment of fees. See also **T 1882/23**, **T 1278/23**.

In **J 7/16** the Legal Board held that the relevant cause of non-compliance with the two-month time limit of R. 136(1) EPC lay in the fact that the former representative was not in a position to act properly in the proceedings due to his state of health. Thus, the date of removal of the cause of non-compliance could only be the date on which the applicant had inspected the file and realised that its former representative had not acted properly.

In **T 1547/20**, the start of the two-month time limit was the appellant's receipt of a communication from the Registry. The board received the request for re-establishment two months and ten days after the Registry's communication was sent out. The appellant had submitted that it had filed the request for re-establishment within the time limit stipulated by R. 136(1) EPC but there was no evidence as to the date of receipt of the communication. In the absence of proof that the actual date of receipt of the communication was within nine days after it was sent out, the board was satisfied that the request for re-establishment was submitted in time.

(iii) Time limit not observed due to an error of law

In **T 493/08** the board considered that, where a time limit was not observed due to an error of law, the removal of the cause of non-compliance with that time limit occurs on the date on which the applicant actually became aware of the error of law (see also **J 1/20**). The board noted that, in an apparent contrast to this view, in **T 1026/06** the date when the applicant should have made investigations was considered to be critical, even though the applicant apparently failed to undertake such investigations as a consequence of what was considered to be an error of law.

b) Responsible person

In several decisions the boards considered the question of the responsible person who could or should have detected the omission.

In **T 812/04** the board held that the person to be taken into account for the purposes of establishing the point in time when the appellant was no longer prevented from carrying out an unperformed act was the duly appointed representative.

In **T 32/04** the board considered that in the absence of a duly registered transfer of the application, the person responsible for the purpose of the EPO remained the applicant or his representative. Hence an alleged assignment of the application to a third party in the absence of such a registration was "res inter alios acta", i.e. outside the ambit of the legal relationship between the applicant and the EPO.

In **T 191/82** (OJ 1985, 189) the board held that in a case in which non-compliance with a time limit was discovered by an employee of a representative, the cause of non-compliance, i.e. failure to appreciate that the time limit had not been complied with, could not be considered to have been removed until the representative concerned had himself

been made aware of the facts, since it had to be his responsibility to decide whether an application for re-establishment of rights should be made and, if it was to be made, to determine the grounds and supporting facts to be presented to the EPO (see also **J 7/82**, OJ 1982, 391; **J 9/86**; **T 381/93** of 12 August 1994).

In **J 1/13** the Legal Board considered that within a law or patent attorney's firm the relevant person was the representative and not his or her employee (**T 191/82**); however, it was not up to the representative to extend the time period of R. 136(1) EPC at will by keeping him- or herself intentionally uninformed (see **T 1985/11**, where the board found it irrelevant that the representative had not read the letter when acknowledging its receipt). In addition, although most cases regarding the removal of the cause of non-compliance deal with the point in time when a representative discovered (or ought to have discovered) the error, the Legal Board stated it was recognised that the person whose knowledge was relevant might also be the applicant himself (see **J 27/88**; **J 27/90**, OJ, 1993, 422; **T 840/94**, OJ 1996, 680; **T 32/04**).

In **T 840/94** (OJ 1996, 680) the board held that if a party instructed the authorised representative not to pass on any further communication from the EPO, it could not then rely on the fact that information notified to the representative and necessary for continuing the proceedings was lacking. See also **T 1908/09, T 1882/23**.

In **T 1588/15** the finding of the board differed from the line taken by **J 1/13**. The board saw no good reasons for the representative being uninformed and not taking immediate action in the knowledge (or merely belief) of being uninformed. It held that an applicant had a specific duty to positively inform its representative about an intended abandonment of an application. The board held that even when a representative was explicitly exempted from looking after a fee payment, at least he could be expected to be informed at all times about the applicant's intention as to whether or not the application was to be maintained. It decided that receipt of the noting of loss of rights by the representative triggered the time limit of two months foreseen in R. 136(1) EPC.

In **J 27/88** the Legal Board held that the responsible person in the case at issue was neither the appellant nor the European representative but the **US patent attorney** who was the authorised agent of the appellant and was duly empowered to take all necessary measures. The date of removal of the cause of non-compliance was the date on which the US patent attorney became aware of the omission.

In **J 27/90** (OJ 1993, 422) the applicant, a US company, properly appointed a European professional representative. For the payment of renewal fees it used a computerised service firm, a so-called **"renewal fee payment agency"**. The Legal Board held that in the absence of circumstances to the contrary a communication under R. 69(1) EPC 1973 to the professional representative removed the cause of non-compliance. This also applied when parties instructed the (European) professional representatives via their (national) patent attorney. The appointment of an independent service firm for the payment of renewal fees did not constitute circumstances to the contrary.

In **T 1908/09** the board observed that if there was more than one applicant the co-applicants had to name a common representative (Art. 133(4) and R. 151(1) EPC). If they failed to do so and one of the applicants was obliged to appoint a professional representative under Art. 133(2) EPC, this representative was deemed to be the common representative. In the case at issue, with the notification of the loss of rights (R. 126(2) EPC) to their common representative (R. 130(3) EPC) both applicants were made aware of the fact that the time limit had expired.

In **J 16/93** the Legal Board held that in the event of exceptional circumstances the cause of non-compliance with a time limit may persist even though the applicant's representatives were duly informed of the loss of rights resulting therefrom. This is the case when a combination of circumstances, which cannot be blamed on either the applicant or its representatives, and which arose in particular from the fact that they had both moved to new addresses and from the illness of a director of the company applying for a European patent, made it impossible for the professional representatives to contact the applicant in due time. This combination of circumstances prevented the representatives from performing the omitted act – i.e. paying the renewal fee for the third year – since they had not received any advance. A representative whose authorisation is silent in this respect and who has not received any funds for this purpose is not expected to advance moneys on behalf of his client out of his own pocket.

c) Legal fiction of deemed notification

In **J 7/82** (OJ 1982, 391) the Legal Board held that in a case in which the receipt of a notification was relevant to the question of when the cause of non-compliance with a time limit had been removed, the significant date was the **date of actual receipt** by the applicant. In **J 22/92** the Legal Board emphasised that the removal of the cause of non-compliance was a matter of fact and therefore had to be established beyond any reasonable doubt. This was not the case where under R. 78(2) EPC 1973 (in the version in force until 31 December 1998) the notification was only deemed to have been made when despatch had taken place and when the receipt of the letter could not be proved. Thus, the Legal Board considered the date on which the responsible representative of the appellant first became aware of the missed time limit to be the date on which the removal of the cause of non-compliance with the time limit had occurred (see **T 191/82**, OJ 1985, 189).

In **T 428/98** (OJ 2001, 485) it was stated that where a communication from the EPO notified an applicant that he had missed a time limit, the cause of failure to complete the omitted act within the meaning of Art. 122(2), first sentence, EPC 1973 was as a rule removed on the date when the applicant actually received the communication, provided that failure to complete the act was purely due to previous unawareness that the act had not been completed. The legal fiction of deemed notification under R. 78(3) EPC 1973 (in the version in force until 31 December 1998, now R. 126(2) EPC) had no effect on the date of removal of the cause of non-compliance, even if this worked against the applicant because the actual date of receipt of the communication preceded the date calculated according to R. 78(3) EPC 1973 (see also **T 1063/03**).

In **J 11/03**, however, the Legal Board agreed with the appellant that the removal of the cause of non-compliance had not taken place before deemed notification in accordance with R. 78(2) EPC 1973, since there was no indication that the communication concerning loss of rights had already been received before that date (see also **J 10/99**).

4.1.2 One-year time limit following the expiry of the unobserved time limit

A request for re-establishment of rights is only admissible within the year immediately following the expiry of the unobserved time limit (R. 136(1), first sentence, EPC; Art. 122(2), third sentence, EPC 1973). Under R. 136(1), third sentence, EPC, the request for re-establishment of rights is not deemed to have been filed until the prescribed fee has been paid.

In **J 16/86** the Legal Board ruled that a request for re-establishment filed over a year after expiry of the non-observed time limit was inadmissible whatever the reasons for its late submission (see also **J 2/87**, OJ 1988, 330; **J 34/92**). In **J 12/98** the Legal Board held that the words "within the year immediately following the expiry of the unobserved time limit" in Art. 122(2), third sentence, EPC 1973 could not be construed to mean "within one year of the applicant having knowledge of the unobserved time limit". This interpretation would make the starting point for calculating the two-month period referred to in Art. 122(2), first and second sentence, EPC 1973 the same as that for calculating the one-year time limit referred to in Art. 122(2), third sentence, EPC 1973, which would thus deprive Art. 122(2), third sentence, EPC 1973 of any function.

In **J 6/90** (OJ 1993, 714) the statement of grounds was not submitted until shortly after the end of the period of one year stipulated in Art. 122(2), first sentence, EPC 1973 but within the period of two months specified in Art. 122(2) EPC 1973, which in the case at issue expired later. The Legal Board pointed out that the one-year period served to provide legal certainty. If this period had elapsed, any party could confidently assume that a patent application or patent which had been rendered invalid by the non-observance of a time limit would not be revived. However, if on inspecting the file a third party noted that an application for re-establishment had been made within the one-year time limit, he would have adequate notice. Therefore, to make a valid request for re-establishment of rights within the year immediately following the expiry of the unobserved time limit, it was sufficient if the files contained a clearly documented statement of intent from which any third party could infer that the applicant was endeavouring to maintain the patent application. See also **T 270/91**, **T 493/95**, **J 6/98**.

In **J 6/08** the fee for re-establishment of rights was not paid until after the one-year period had expired. The Legal Board referred to the case law (**J 16/86**, **J 34/92**, **J 26/95**, OJ 1999, 668; **J 6/98**, **J 35/03**), under which the one-year period fulfils the function of a deadline whose purpose is to ensure legal certainty for the public and the completion of proceedings before the EPO within a sensible and appropriate period of time. In view of the particular circumstances of the case, however, the Legal Board considered that re-establishment was not ruled out since the fact that the conditions for re-establishment had not been met in due time – i.e. payment of the fee for re-establishment within the one-year period – was largely to be laid at the door of the EPO itself. Where the EPO has failed to

meet its obligation to provide clarifications or advice, a request for re-establishment filed within the period of one year can, when the principle of the protection of legitimate expectations is taken into account, be treated as valid even though the fee for re-establishment was not paid until after the period of one year had expired. In the case in hand, the requester's right to be treated as though the non-observance had not occurred took precedence over third parties' interest in legal certainty, which the one-year period in Art. 122(2), third sentence, EPC 1973 is intended to ensure.

4.2. Inability to observe a time limit

The word "unable" in Art. 122(1) EPC implies an objective fact or obstacle preventing the required action, e.g. a wrong date inadvertently being entered into a monitoring system (**T 413/91**, see also **T 1054/03**, **T 1026/06**, **T 493/08**, **T 1962/08**, **T 836/09** of 17 February 2010, **T 592/11**, **T 578/14**). Unawareness of the expiry of the time limit must be distinguished from a deliberate act on the part of the applicant (representative) which is, for example, attributable to tactical considerations (see in this chapter III.E.4.2.1). Persistent financial difficulties incurred by the persons concerned through no fault of their own have also been recognised as such an obstacle (see in this chapter III.E.4.2.2).

In **T 178/23**, the board observed that the facts relied on by the appellant did not relate to an error in the carrying out of a party's actual intention to meet a specific time limit, but only to an error in relation to the intention to use a legal remedy entailing a time limit. Therefore, the appellant was actually able to file an appeal in due time but failed to do so because of a previous error as to motive, i.e. because it was unaware of the need to file an appeal to rectify the absence of the drawings in the patent specification. According to the board, this situation differed from those governed by Art. 122 EPC where a party did intend to observe a time limit but failed to do so due to objective obstacles.

4.2.1 Deliberate act missing a time limit; tactical considerations

In **T 413/91** the appellant's reasons for not filing any statement of grounds were that he had expected an agreement with the proprietor, which, however, did not come about. The board stated that such a reason did not justify re-establishment of rights, pointing out that it was an extraordinary means of judicial remedy. A party who had deliberately chosen not to file a statement of grounds for the appeal could not achieve an appellate review through the back door of a request for re-establishment. See also **T 2331/14**, **T 578/14**.

In **J 2/02** the Legal Board stated that Art. 122 EPC 1973 did not imply for an applicant any right to have the final effect of an intentional action cancelled. Holding back the payment of the fee for a reason other than being unable to comply with the legal provisions – particularly as a matter of strategy in the circumstances and for tactical considerations – is outside the scope of Art. 122 EPC 1973, and deprives the applicant of the possibility to invoke this article.

In **T 1026/06** the board distinguished its case from the situation in **T 413/91** and **J 2/02**, in which the boards had not recognised the act of intentionally allowing a time limit to expire as an obstacle. These two cases differed from the current case, in so far as the parties

concerned had deliberately refrained, for motives extraneous to the proceedings, from performing the required actions, whereas the appellant in the current case had been unable to file an appeal because of a mistake of law.

In **J 11/09** the representative omitted to make payment of the third renewal fee because he was unwilling to advance the renewal fee on account of unpaid invoices. Accordingly, the renewal fee remained unpaid not inadvertently, but on purpose. Given that payment had been refused on purpose, it was not possible to say that a one-off error had occurred in an otherwise well-functioning system in the professional representative's office.

In **T 250/89** (OJ 1992, 355) the opponent claimed that he could not have filed the statement of grounds in due time because he would have needed to refer to documents withheld by a third party. The board confirmed the line taken in earlier decisions (see **G 1/86**, OJ 1987, 447; **T 287/84**, OJ 1985, 333). When determining whether all due care required by the circumstances had been taken, the word "all" was important and failure to observe a time limit had to be the result of an oversight, not a **culpable error**. The board rejected the application for re-establishment of rights on the ground that the opponent had had sufficient material at his disposal to be able to draw up the statement of grounds in due time in accordance with Art. 108, third sentence, EPC 1973 and R. 64 EPC 1973.

4.2.2 Financial difficulties

In **J 22/88** (OJ 1990, 244) the Legal Board held that financial difficulties experienced through no fault of one's own and leading to failure to observe time limits for the payment of fees could constitute grounds for granting re-establishment of rights. A prerequisite for granting the request was that the applicant should have tried with all due care to obtain financial support. The board also made it clear that for "all due care" to be proven, it had, of course, to be clear that the financial difficulties were genuine and were due to circumstances beyond the reasonable control of the applicant (see also **J 31/89**, **T 822/93**). In **J 9/89** the Legal Board noted that there was no evidence before the board of any effort having been made by or on behalf of the appellant to find financial support during the critical period. In **J 4/22**, the appellant had claimed that it was not clear to her what the examining division had meant when asking her about when she had gained "financial support". The Legal Board found that the question asked by the examining division was ambiguous and not precise enough in the circumstances. Indeed, it was not relevant when the appellant received "financial support", rather on which date the appellant received the monetary funds to pay the renewal fee for the thirteenth year.

In **J 11/98** the applicant requested re-establishment in respect of the time limit for paying the renewal fee, on the grounds that at the relevant times the appellant had been seeking protection under Chapter 11 of US bankruptcy law. The Legal Board confirmed the examining division's decision refusing the request. The applicant had not shown that at the relevant time it had been so lacking in funds as to be absolutely unable to make the payment (see also **J 26/95**, OJ 1999, 668, in chapter III.D.4.7. "Interruption of proceedings because of insolvency (Rule 142(1)(b) EPC)").

In **J 6/14** the Legal Board held that it was clear from the events described and from all the evidence adduced that the appellant, an individual applicant who had been faced with serious health problems, had been in a very difficult financial situation for several years. He had proven the genuine existence of his difficulties to justify his failure to pay the renewal fee plus additional fee. The board consequently found that he had satisfied the requirements of Art. 122 EPC.

4.3. Making good the omitted act

The omitted act must be performed within two months from removal of the cause of non-compliance (R. 136(2) EPC; Art. 122(2), second sentence, EPC 1973).

According to **T 167/97** (OJ 1999, 488), the requirement of Art. 122(2), second sentence, EPC 1973 implies that the completed act likewise must meet the requirements of the EPC - i.e. in the case at issue that the statement of grounds of appeal be admissible for the purpose of Art. 108, last sentence, EPC 1973. Where the statement of grounds filed with the request for re-establishment is insufficient for the appeal to be declared admissible, the request for re-establishment must itself be declared inadmissible.

4.4. Substantiation of the request for re-establishment

Under R. 136(2) EPC (Art. 122(3) EPC 1973) the request for re-establishment has to state the grounds on which it is based, and set out the facts on which it relies. The boards consider this requirement in relation either to the admissibility of the request or to the submissions that must be taken into account when analysing the merits of the request (see in this chapter III.E.5.1. "Submissions to be taken into account").

It is a condition for the admissibility of a request for re-establishment of rights that a duly substantiated statement of grounds be submitted within the time limit for filing the request (**J 15/10**, see also **J 19/05**). A request for re-establishment of rights complies with the requirement of R. 136(2), first sentence, EPC if a conclusive case is made, setting out and substantiating the grounds and facts on which the request relies (**J 15/10**; **T 13/82**, OJ 1983, 411). Thereby it is ascertained that the factual basis for the requested decision is not altered after the expiry of the time limit for the request (**J 15/10**, **J 19/05**, **T 585/08**, **T 479/10**). Therefore, the request for re-establishment of rights must set forth the precise cause of non-compliance with the time limit concerned, specify at what time and under which circumstances the cause occurred and was removed, and present the core facts making it possible to consider whether all due care required by the circumstances had been taken in order to comply with the time limit concerned (**J 15/10**, **T 479/10**, **T 178/23**, see also **J 18/98**). A request for re-establishment of rights which relies on general statements only and contains no specific facts does not satisfy the requirement for a duly substantiated request under R. 136(2), first sentence, EPC (**J 19/05**, **J 15/10**, **J 1/22**).

In **J 19/05** the Legal Board held that the request for re-establishment of rights was not sufficiently substantiated. The request was couched in purely general terms and contained no concrete facts identifying a reason for non-observance, the chronological sequence of

events or the causes underlying the action or inaction of the persons involved concerning non-payment of a renewal fee.

In **T 13/82** (OJ 1983, 411) the board held that a conclusive case must be made, setting out and substantiating the facts, for the probability - at least - that a wrongful act or omission on the part of an assistant was the cause of the failure to meet the time limit: the mere possibility was not sufficient to exculpate the applicant.

In **T 287/84** (OJ 1985, 333) the board decided that an application for re-establishment of rights could be considered as complying with the requirement that it had to set out the facts on which it relied (Art. 122(3) EPC 1973) if the initially filed application in writing, which did not contain such facts, could be read together with a further document, which contained them and was filed before the expiry of the period within which the application had to be filed.

In **T 324/90** (OJ 1993, 33) the board held that **evidence** proving the facts set out in the application could be filed after expiry of the two-month time limit laid down in Art. 122(2) EPC 1973. Only the grounds and a statement of the facts had to be filed within the two-month period. It was not necessary to indicate in an application for re-establishment the means (e.g. medical certificates, sworn statements and the like) by which the facts relied on would be proved. Such evidence could be submitted after the time limit, if so required (see also **T 667/92** of 10 March 1994, **T 261/07**, **T 1764/08**).

In **J 8/95** the appellants argued that the German-language version of Art. 122(3) EPC 1973 did not stipulate that the statement of grounds for an application for re-establishment of rights had to be filed within the time limit laid down in Art. 122(2) EPC 1973. The Legal Board decided that Art. 177(1) EPC 1973 assumed a uniform legislative intent, which could only be identified on the basis of all three texts of the EPC 1973 (see also **T 324/90**, OJ 1993, 33).

4.5. Number of re-establishment fees due where more than one time limit is missed

In **J 26/95** (OJ 1999, 668) the Legal Board held that where time limits expiring independently of one another have been missed by the applicant, each resulting in the application being deemed withdrawn, a request for re-establishment has to be filed in respect of each unobserved time limit. In accordance with Art. 122(3), second sentence, EPC 1973, a fee for re-establishment has to be paid in respect of each request. It is irrelevant whether the requests for re-establishment are filed in the same letter or in different letters and whether they are based on the same or different grounds.

In **T 2017/12** (OJ 2014, A76) the appellant had missed the time limits for filing the appeal and the statement of grounds of appeal. It had paid the fee for re-establishment of rights twice, once for each missed time limit. The board refused the request for refund of one of the fees. There were no explicit provisions in the EPC dealing with the case in which several time limits had been missed. This was an indication that each time limit had to be considered separately and that, in the absence of any hint to the contrary, for the number

of fees to be paid the number of missed time limits was decisive. In line with decision **J 26/95**, the board considered that the corresponding time limits expired independently of one another, notwithstanding the fact that they were triggered by the same event. In addition, the failure to meet either of these time limits individually results in a loss of the right to appeal. Failure to comply with either one of the two time limits would cause the appeal to be rejected as inadmissible, provided that the appeal fee was paid. Consequently, two fees for re-establishment were indeed due.

In **T 1823/16** despite missing both the time limit for filing the notice and the time limit for filing the statement of grounds of appeal, the applicant only paid one re-establishment fee. However, the board held that both periods were triggered by the same event, i.e. the notification of the decision, and the hindrance to complying with them was based on one unitary factual basis. The board stated that re-establishment in respect of both periods had to be examined together and that the result would inevitably be the same. In this situation, the board considered one re-establishment fee to be sufficient. See also **T 315/87** of 14 February 1989; **T 832/99**.

4.6. Correction of deficiencies in the request for re-establishment

If the request for re-establishment is deficient, the principle of legitimate expectation may oblige the EPO to draw attention to the deficiency if it is readily identifiable by the EPO and the party can still correct it within the absolute time limit under R. 136(1) EPC (Art. 122(2) EPC 1973) – see chapter III.A.4. "Obligation to draw attention to easily remediable deficiencies"; see e.g. **T 14/89**, OJ 1990, 432; **J 13/90**, OJ 1994, 456; **J 2/94**; see also **T 585/08**). If a warning can be expected but is not issued to the applicant within the relevant time limit, the EPO must set a period within which the applicant can correct the deficiency and perform the procedural act in due time (**J 13/90**, OJ 1994, 456). However, this obligation to set a new time limit does not apply to absolute time limits (such as the one-year time limit under R. 136(1) EPC, Art. 122(2), third sentence, EPC 1973), which by definition are non-extendable (**J 34/92**).

5. Merit of request for re-establishment of rights

Under Art. 122(1) EPC, for re-establishment to be allowed the requester must show that he missed the time limit despite taking all the due care required by the circumstances.

5.1. Submissions to be taken into account

In **J 5/94** it was decided that the grounds on which a request for re-establishment of rights was based could be elaborated on, provided this completed the submission that had been filed in due time and thus did not alter the basis on which the original request for re-establishment had been filed (see also **J 19/05**; **J 15/10**; **T 585/08**; **T 592/11**). In line with this, in **T 178/23** where the appellant went into detail for the first time with the letter of reply to the board's communication, the board found the appellant's submissions inadmissible. In **T 324/90** (OJ 1993, 33) the board held that evidence proving the facts set out in the application could be filed after expiry of the two-month time limit laid down in Art. 122(2) EPC 1973. Only the grounds and a statement of the facts had to be filed within

the two-month period. Likewise in **T 261/07** the board allowed the patentee, who had initially given an account of all the relevant facts to the best of its knowledge, to subsequently adduce further clarifying evidence supporting the case.

In **J 5/11** the Legal Board held that the applicant for re-establishment of rights who failed to substantiate his request adequately in the first-instance proceedings, in particular after being expressly invited to do so, could not normally make good that failure by submitting additional evidence with the grounds of appeal. While it was true that the primary function of the boards was to give a judicial decision on the correctness of a first-instance decision of the EPO (see **J 18/98**), that does not necessarily mean that new evidence submitted for the first time on appeal was automatically inadmissible. A rigid rule excluding all new evidence on appeal might lead to injustice and unfairness in some cases and would not be compatible with the principles of procedural law generally recognised in the contracting states (see Art. 125 EPC).

In **J 18/98** the examining division had refused the applicant's application for restitutio in integrum. An appeal was filed against that decision. From the established case law on Art. 122(3) EPC 1973 the Legal Board concluded that facts submitted only with the statement of grounds of appeal could not be taken into account, since the function of appeal proceedings was only to give a judicial decision upon the correctness of an earlier decision of the department of first instance (**T 34/90**, OJ 1992, 454).

In **T 257/07** the board stated that it had been only one year after the removal of the cause for non-compliance that the appellant qualified certain statements previously made and added new facts that previously went unmentioned, in particular regarding the system for managing files and deadlines. This omission could not be subsequently remedied by the addition of further facts, as case law would only allow the appellant to "submit further evidence which clarifies the facts which were set out in the application for re-establishment" (**J 2/86**, OJ 1987, 362; **T 261/07**; see also **J 6/14**; **T 742/11**; **T 2274/11**).

In **J 16/11** the Legal Board pointed out that the boards of appeal had consistently ruled that facts pleaded for the first time during the appeal proceedings should in principle not be taken into consideration (see **J 18/98**; **T 257/07**). In the case at issue, the board had, by its communication, informed the appellant that the evidence currently on file did not seem convincing enough and, exceptionally, gave the appellant an opportunity to improve its case at this late stage of the proceedings. However, the representative, instead of filing evidence, produced a "sworn statement" written by the appellant himself. Given that the new submission did not complement the already existing facts, but presented a new situation, these facts and evidence had to be disregarded.

5.2. General comments on due care

In numerous decisions the boards have ruled on whether "all due care required by the circumstances" had been taken. In considering this issue, the circumstances of each case must be looked at as a whole (**T 287/84**, OJ 1985, 333; **J 17/16**). The obligation to exercise due care must be considered in the light of the situation as it stood before the time limit expired. In other words, the steps the party took to comply with the time limit are to be

assessed solely on the basis of the circumstances applying at that time (see e.g. **T 667/92** of 10 March 1994; **T 381/93** of 12 August 1994; **T 743/05**; **J 1/07**; **T 1465/07**; **J 14/16**; **T 578/14**). The requirements of re-establishment, and in particular of due care, **must not be interpreted in an excessive manner** that unreasonably restricts access to the board and thus prevents the board from deciding on the merits of the case (**T 1465/07**).

In **T 30/90** the board held that the allowability of applications for re-establishment hinged on whether the conduct of the appellant and/or his representative, during the entire period after the relevant decision, was indicative of "all due care required by the circumstances". In this connection, "all due care" meant all appropriate care, i.e. as much as would be taken under the circumstances by the **average reasonably competent patentee/representative** (see also **J 11/09**). The board in **T 1289/10** held that as a general rule, a representative acting reasonably would at least take account of known problems and apply known solutions to avoid them.

For cases where the cause of non-compliance with a time limit involves some error in the carrying out of the party's intention to comply with the time limit, the case law has established the criterion that due care is considered to have been taken if non-compliance with the time limit results either from **exceptional circumstances** (see in this chapter III.E.5.3.) or from an **isolated mistake within a normally satisfactory monitoring system** (see in this chapter III.E.5.4.).

The party requesting re-establishment of rights bears the burden of making the case and proving that the requirements are met (**J 5/80**, OJ 1981, 343; **J 18/98**; **T 592/11**; **J 3/13**; **J 14/16**; **T 2016/16**; **T 2331/14**; **T 2406/16**).

5.3. Exceptional circumstances

5.3.1 Organisational restructuring

In **T 14/89** (OJ 1990, 432), due to internal reorganisation and removals, the R. 58(5) EPC 1973 communication did not reach the responsible department of the patent proprietor. The board found that this fact, which led to non-observance of the time limit, constituted an isolated mistake such as could not be ruled out despite careful company organisation.

In **T 3085/19** the staffing shortage in the law firm of the US representative did not constitute exceptional circumstances. The board noted that even if the appellant had indicated in time that certain attempts had been made to overcome the staff shortage, this would not have been apt to justify exceptional circumstances in view of the fact that the US law firm was working together with the European representatives as regards the application on file. The US law firm could and should have informed the European representatives about the staff shortage and asked for support.

5.3.2 Change to or withdrawal of representation

In **J 13/90** (OJ 1994, 456) the applicant, a small firm employing about 15 people, was in takeover negotiations with another company. In the course of the negotiations a change of attorney took place. As a result of the unforeseeable breakdown in negotiations plus the fact that action had already been taken to replace the previous attorney, payment of the fourth-year renewal fee had been overlooked. This isolated mistake in a special situation was, in the Legal Board's opinion, excusable.

In **J 11/06** the appellant submitted that, due to the removal and later change of the US representative, there was some confusion caused by this reorganisation. However, the Legal Board noted that no details at all had been given as to why this affected the payment of the renewal fee. Likewise in **J 4/07** the Legal Board did not recognise the presence of exceptional circumstances where the responsibility of the law firm for the payment of the renewal fee ceased to exist roughly one month before the end of the time limit. The board considered a period of about one month to be largely sufficient for effecting payment, even in the wake of an attorney's move from one firm to another. The representative's submissions were also inadequate.

In **T 1201/10** of 28 February 2018 the board was convinced that there were exceptional circumstances prior to the due date which could not reasonably have been foreseen by the appellant (applicant). In the period leading up to the due date the appellant was unrepresented, as the firm representing the firm had withdrawn from representation and with this withdrawal, the sub-authorisation for the person who eventually became the new representative also ceased. These circumstances, which were predominantly outside the appellant's control, directly resulted in the appellant being unable to observe the time limit for payment of the renewal fee.

5.3.3 Complex transfers of company ownership

In **T 469/93** the board found that even if all due care required by the circumstances were to be exercised, the occasional error during complex transfers of company ownership could not entirely be avoided. The error in this case being an exceptional one, the causes of which were remedied, the appellant's request for re-establishment of rights was allowed.

5.3.4 Monitoring or computer systems matters

In **J 21/92** and **J 24/92** the applicant and his representative (both Americans) had each changed their fee-monitoring system, independently of each other. The situation was further complicated by the fact that the representative was no longer responsible for paying the appellant's renewal fees.

In **T 369/91** (OJ 1993, 561) the relevant circumstances involved moving from a manual to a computerised time-limit monitoring system**.** Here "due care" meant ensuring that during the changeover period the representatives handling the various kinds of cases were told which system – manual or computerised – had generated the reminder in question. Only then could they reliably know if and when a further reminder was likely.

In **T 489/04** the board did not recognise the installation of a new computer system as an extraordinary circumstance. On the contrary, it considered the resulting burden on employees as foreseeable and containable, had appropriate measures been taken in good time. In **J 14/16** the Legal Board was not convinced that a computer-system breakdown and the ensuing substantial data loss and organisational disruption, qualified as exceptional circumstances.

In **J 6/18** a technical error occurred in server migration, which affected the US attorney's docketing database and email communication. This could be considered as an isolated mistake in a system which apparently had operated efficiently for several years. There was in the Legal Board's view no necessity for more redundancy in the attorney's system for monitoring time limits.

5.3.5 Sudden serious illness and severe psychological stress

In **T 525/91** of 25 March 1992 the board found it credible that the sudden and unforeseen diagnosis of illness and the announcement of the urgent need for a major operation caused the appellant's representative not only great physical weakness but also severe psychological stress. In those circumstances, and in view of the short period between diagnosis and hospital admission (two working days) and the proven absence of the secretary on one of those working days, it had to be acknowledged that even on the days between diagnosis and admission the representative had been in an exceptional situation which impeded him from devoting the necessary attention to the imminent time limit and from taking the precautions needed to ensure that it was observed. In the circumstances the board deemed the conditions for re-establishment to have been met. See also **T 558/02** of 9 August 2002.

In **T 387/11** the representative put forward a credible case that he had failed to observe the time limit for filing the statement of grounds because of severe psychological stress caused by a sudden and unexpected bereavement (see also **T 970/12**).

In **T 600/18** the board held that the stress of the situation, in which the representative was forced by the circumstances to act himself instead of his well trained and supervised staff, as a consequence of being under pressure to let his staff leave early due to extremely poor weather conditions, could not be equated with one where a patent attorney was incapable of taking sound decisions due to sudden serious illness or a sudden and unexpected bereavement, as in cases **T 525/91** or **T 387/11**.

In **J 17/16** the Legal Board was satisfied that the appellant's executive manager had been suffering from unusually severe psychological stress owing to the demands on her time and the emotional distress associated with caring for her seriously ill father-in-law and with her mother's death (more than six months before expiry of the time limit at issue) and so, despite having taken due care, had not been in a position to observe the time limit for claiming priority.

However, in this context, the case law also requires an **effective system of staff substitution in case of absence** (see in this chapter III.E.5.4.5 "All due care in making provisions for staff absences".

5.4. Isolated mistake within a satisfactory system for monitoring time limits or for processing mail

An isolated mistake by an assistant that happens in a normally satisfactory system is excusable; for cases in which such a mistake occurred and the request for re-establishment was granted see, for example, **T 462/02** of 11 February 2003, **T 221/04** of 5 May 2004, **T 836/09** of 17 February 2010, **T 1815/15**. The appellant or his representative must plausibly show that a normally effective system for monitoring time limits prescribed by the EPC was established at the relevant time in the office in question (**J 2/86**, **J 3/86**, OJ 1987, 362; **J 23/92**; **T 428/98**, OJ 2001, 494; **J 3/12**; **J 4/12**). In **T 1917/20**, the decisive question was whether, in the representative's office, any measures were foreseen to detect and correct errors made in the process of separating mail into "system mail" and "non-system mail". The board noted that even in small entities where sorting the mail and organising the filing system is done by one and the same person, all due care requires that a routine control of these critical and potential error-prone acts is performed.

5.4.1 "Isolated mistake" by representative

The case law on "an isolated mistake in an otherwise satisfactory system" cannot be relied on to ignore a failure to act by the professional representative himself, unless there are special circumstances (**T 1095/06**).

In **T 592/11** the board held that an isolated mistake by a professional representative in performing his check on the time limit once he has received the file to deal with was – as a rule at least – inexcusable (see also **R 18/13** with reference to the travaux préparatoires).

In **T 198/16** the representative did not notice that payment of the appeal fee had not been made. Different from an isolated mistake that an assistant may make, the board found that such a mistake was not excusable in a representative.

See also chapter III.E.5.5.4 e) "Ultimate responsibility of the representative".

5.4.2 A system operating efficiently for many years as evidence that it is normally satisfactory

The fact that a system had operated efficiently for many years has been put forward as evidence in many decisions that it was normally satisfactory (see **J 31/90**, **J 32/90**, **T 309/88** of 28 February 1990, **T 30/90**, **J 7/15**). In **T 130/83** of 8 May 1984 the board stated that if a proper reminder system was instituted by a representative in order to guard against the consequences of oversight in a busy office, this was itself strong prima facie evidence of the taking of care by the representative (see also **T 869/90** of 15 March 1991, **T 715/91**, **T 111/92** of 3 August 1992).

However, in **T 1465/07**, the board disagreed with the view that a monitoring system of time limits can be held to have been normally satisfactory because it worked without previous problems even though doubts existed. Evidence that such a monitoring system operated efficiently for many years will weigh in favour of a finding of a normally satisfactory character but will be counterbalanced by evidence that main features of such a satisfactory character, such as an independent cross-check, are missing. In that case a satisfactory character will be excluded (see also **J 14/16**; **J 9/16**; **T 1962/08**).

In **T 1764/08** the board considered that the mere allegation that the case at issue was the first instance of unintended failure in filing an appeal does not show that all due care was normally observed and does not prove that a satisfactory system was in place in the representative's office.

5.4.3 Cause of mistake remains unclear

In **T 529/09** the board allowed the request for re-establishment of rights. The board accepted that the representative's firm had a well-functioning and reliable system in place for processing incoming mail and monitoring time limits. The fact that in the case at issue the communication was apparently misplaced (since it did not reach the representative in charge and the time limit set in it was not entered in the computer system of the firm) had to be regarded as an isolated mistake in an otherwise satisfactory system. While the **precise circumstances of the mistake could not be elucidated any further**, this was not a sufficient reason for denying that all due care required by the circumstances had been observed in the present case. See also **T 580/06**, **T 1355/09**.

In **J 7/15** the Legal Board could not determine with any degree of certitude what caused the non-payment of the renewal fee. The applicant had used the services of an external company for paying the renewal fees, a system which had worked flawlessly for more than 15 years but failed in the case in hand. In the circumstances the board followed the reasoning of **T 529/09** and gave the benefit of the doubt to the appellant, granting the request for re-establishment of rights. In **T 1513/21** the appellant brought forward only that despite instructions to file the notice of appeal and pay the appeal fee, the responsible party had omitted the filing of the notice of appeal and that this failure resulted solely from an isolated mistake by an experienced patent administrator. The board found that no specific reasons were given as to why this failure occurred and why it could still be concluded that all due care was taken. No evidence at all was given of a normally satisfactory system of monitoring, and cross-checks, or explanation as to why the system did not work in this specific case. The request for re-establishment was refused.

5.4.4 Requirement for a cross-check

a) Cross-check should be independent in a large firm

In **J 9/86** the Legal Board was of the opinion that in a large firm where a large number of dates had to be monitored at any given time, it was normally to be expected that at least one effective cross-check was built into the system (**T 223/88**, **J 26/92**, **T 808/03** of 12 February 2004, **T 1149/11**).

In **T 828/94** the board held that given the size of the representative's office, a proper monitoring system should have contained some form of cross-check, for example that someone would be responsible for checking independently of the representative and the assistant whether any notice of appeal had been filed or was being prepared, and for raising the alarm if no data concerning such a notice – or a decision not to appeal – had been entered into the computer near the due date. In **T 257/07** the board emphasised that an independent cross-check must necessarily include either another person or an automated system alerting another person (see also **J 9/16** on the meaning of "independent"; **T 76/17**).

In **T 686/97** of 12 May 1998 the board held that the provision of a "redundant" or "failsafe system" was an essential component of a normally satisfactory reminder system in corporate patent departments. The failure to provide administrative reminders to the responsible patent attorneys of the time limits applying to the filing of statements of grounds of appeal was incompatible with the operation of a normally satisfactory system.

In **T 428/98** (OJ 2001, 494) the board stressed the exceptional nature of the ruling in **J 31/90** and **T 166/87** of 16 May 1988 (which concerned cross-check mechanisms in small offices; see in this chapter III.E.5.4.4 b) below) and said that according to the appellant's submission his representatives' office was staffed by two patent agents, two lawyers, a partly qualified patent lawyer ("Patentassessor") and a law graduate, i.e. six people dealing in their main professional capacity with cases relating to intellectual property rights. Such cases being commonly subject to time limits, with immediate negative legal consequences for the client if they were missed, time-limit monitoring in such an office was a major undertaking in terms of both significance and scale. The board therefore deemed a cross-checking mechanism to be essential. See also **T 1962/08**, **T 1726/08** (a firm with 40 attorneys at four locations is not small), **T 479/10**.

In **T 283/01** of 3 September 2002 the board pointed out that the applicant's system was not properly designed to handle the appeal in question, involving partial responsibility of an external representative. The deviation from the normal way of filing and prosecuting an appeal had been the applicant's deliberate decision in the particular circumstances of the case. Taking all due care required by the circumstances of the case should have implied installing an individual control mechanism, offering a realistic possibility of detecting and correcting the failure to note and calculate the time limit for filing the statement of grounds.

T 261/07 concerned a case in which an intermediary delivery service received and distributed mail within the patentee's premises. The board held that there had been no effective cross-check. Such a failsafe system would have required a regular comparison between the mail room database and the database of the Central Intellectual Property Department in order to discover discrepancies.

In **T 1962/08** the representative argued before the board that an independent cross-check in the system for monitoring time limits was not obligatory. The board confirmed what had been said in **T 428/98**, namely that the requirements to be met by a system for monitoring time limits in general included making sure that monitoring duties were not left to one person alone, but that the system incorporated an overall checking mechanism which was

independent of the person responsible for monitoring time limits. This checking mechanism could be provided within a single system for monitoring time limits. If the checking mechanism involved a second system for monitoring time limits, the latter had to be independent of the former ("redundant"). See also **T 1465/07** in which the board held that the additional burden of an independent cross-check was not disproportionate for a large firm, where the cross-check can be organised more economically than in a smaller one. In **T 1149/11** the board held that the duty of care concerning supervision of the assistant required that an effective cross-check was implemented, at least in a firm where a large number of time limits have to be monitored.

In **T 836/09** of 17 February 2010 there was an isolated mistake by an assistant within an otherwise satisfactory system of **processing outbound mail**. The board held that in such a situation, irrespective of whether or not a large firm was concerned, the duty of having at least one effective cross-check built into such a system was dispensed with. This applied even to important letters such as those whose improper treatment may entail the loss of a right or means of redress. The reason was that, in contrast to the monitoring of time limits, the risk of an error in the processing of outbound mail was low because such processing generally involved the execution of straightforward steps (with reference to **T 178/07**; see also **T 1171/13** and **T 2023/14** in relation to the sending of a fax by an assistant).

Concerning the need for an independent cross-checking mechanism and the form it should take, see also **T 1172/00**, **T 785/01** of 30 September 2003, **T 36/97**, **T 622/01**, **J 1/07**, **J 13/07**.

b) Control mechanisms in small firms

In relation to small firms and offices, the boards have at times dispensed with the requirement for a cross-check (see e.g. **J 31/90**, **T 166/87** of 16 May 1988, **J 11/03**, **T 1355/09**). As to the representative's own responsibility for performing an additional check when receiving the file to deal with, see **T 1561/05**, **T 592/11**, **R 18/13** as summarised in this chapter III.E.5.5.4 e) "Ultimate responsibility of the representative".

In **T 1355/09** the board held that no control mechanism had to be in place because the firm involved was very small and it had not overlooked a time limit, but rather the mistake had been made **during payment** of the appeal fee, i.e. whilst performing the act needed to observe the time limit. In these circumstances, no control mechanism was required, the likelihood of error being comparatively low. Insisting on one would in practice reduce the time limit: to be effective, any checks would have to be made after payment, but also within the time limit (see also **T 3029/18** of 3 June 2020).

In **T 166/87** the board held that in a relatively small office, normally working in an efficient and personal manner, employing normally reliable personnel, a cross-check mechanism, especially in relation to one-off payments such as an appeal fee, could fairly be regarded as superfluous.

In **J 31/90** the Legal Board took the view that the system used for observing the time limit, while far from perfect, could be considered in the special circumstances of the case to be normally satisfactory. The system combined the giving of specific oral instructions to the secretary on a case-by-case basis, with notations on the file to indicate which documents should be filed with the EPO. The board emphasised, however, that the system could only be so considered because of the particular conditions in which the representative and her secretary worked. Over a period of ten years, working together alone in a small office they had built up an excellent working relationship and mutual trust.

In **J 11/03** the Legal Board confirmed that the organisational requirements for a generally efficient time-limit monitoring system were subject to variation on account of the firm's size and nature and the number of time limits that had to be monitored. A cross-checking mechanism may in certain circumstances be regarded as superfluous in a small firm employing normally reliable personnel and normally working in an efficient and personal manner, but not in a large company with its own patent department (**T 166/87**). The appellant was a very small firm with a commercial division essentially comprising only the commercial manager and the book-keeper. In the circumstances additional checking that payments had actually been made might be deemed superfluous without impairing the functioning of the system.

5.4.5 All due care in making provisions for staff absences

In **T 324/90** (OJ 1993, 33) the board held that in a large firm, where a considerable number of deadlines had to be monitored at any given time, it had normally to be expected that at least **an effective system of staff substitution** in the case of illness and for absences in general was in operation in order to ensure that official documents such as decisions by the EPO, which started periods within which procedural steps had to be carried out, were properly complied with.

In **T 1401/05** of 20 September 2006 the board followed decisions **T 324/90**, **J 41/92** and **J 5/94** and deemed it necessary that reasonable provisions for absence due to the illness of a person who is in charge of monitoring time limits are made, unless in the particular circumstances of a case imposing such provisions would have to be considered as an undue burden. Only where any necessary provisions have been taken will it be possible to deem the monitoring system of time limits to be "normally satisfactory" (see **T 324/90**), and thus for considering illness to be an excuse for not meeting a deadline. Regarding the need for a back-up in the specific case, the board considered it of relevance that the number of time-limits to be complied with was small (the appellant filed only a few patent applications per year). Under these circumstances, the board accepted that it was not necessary for meeting the standard of due care to make specific provisions for the unforeseeable two-day illness of the sole employee in charge of monitoring of time limits; more specifically, no substitute for him had to be appointed.

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

In **J 41/92** (OJ 1995, 93) the Legal Board found that if a professional representative ran a one-person office, appropriate provisions needed to be made so that, in the case of an absence through illness, the observance of time limits could be ensured with the help of other persons. If there was no substitute or assistant at the representative's office, co-operation with colleagues or with a professional association could, for example, be sought for this purpose. See also **T 387/11**, in which the representative, who ran a one-person office, had taken precautions to ensure that another representative could cover for him if he were absent owing to illness, so that deadlines would normally be met. In taking such organisational measures, he had met the requisite standard of "all due care".

In **T 677/02** the board decided that a large enterprise had not exercised all due care required by the circumstances if, when the representative actually responsible was on short time working, **no deputy** had been designated to cross-check the input of time limits into the system for monitoring time limits.

In **T 2569/16** the board was of the view that in the circumstances, where the appellant (patent proprietor) was at the relevant time a company which formed part of a group of companies operating in several countries, and where the intellectual property work of all companies within the group was centralised, it could be expected that there would be a satisfactory system in place in the IP department which ensured that time limits were not missed when the IP manager was absent or the IP manager position was vacant.

5.4.6 Second mistake by responsible person

In **T 447/00** and **T 448/00** the board was not convinced that the approach taken by the department of first instance, that the admitted existence of four mistakes in respect of the same procedural act could not, by definition, be qualified as "isolated", took sufficient account of the issues to be considered in connection with Art. 122(1) EPC 1973. The board stated that the case law of the boards of appeal referring to an "isolated mistake within a normally satisfactory system" did not normally require that only a "single" error had occurred in relation to a case for which re-establishment of rights was sought. It was not excluded that, in certain circumstances, a chain of errors could well be qualified as "isolated".

In **T 808/03** of 12 February 2004 the board held that the condition of "an isolated mistake by a usually reliable person" was not met in the present case, as the responsible person had made a second mistake when processing the reminder of a system for monitoring time limits. See also **T 1149/11**, **T 1325/15**.

In **T 1325/15** the appellant argued that since a system with a cross-check would identify any single mistake, the term "an isolated mistake" had to be understood as encompassing more than one mistake. In the case in hand, the failure to file the notice of appeal in time had been caused by a combination of isolated mistakes and the appellant argued the requirement of all due care was therefore complied with. The board rejected the appellant's proposition; having a satisfactory system in place does not relieve a representative of his duty to take all due care required by the circumstances when performing procedural steps forming part of that system.

In **T 1815/15** the first employee (an attorney's clerk) made a mistake by mentioning the wrong paragraph of R. 82 EPC in the heading of the accompanying letter to the EPO, overlooking the surcharge required by R. 82(3) EPC. It appeared to the board that the firm of attorneys representing the patent proprietor was equipped with a monitoring system which would normally detect this kind of mistake. Therefore the mistake by the second employee when comparing the communication from the EPO with the actions performed by the first employee may be ascribed to an isolated error of the second employee, which the board ascribed to a personal and isolated error in a system which normally should prevent such deficiency.

In **T 1214/20** a series of misunderstandings and errors had occurred. The board found that at least three opportunities were missed, and for this reason alone, it was not possible to talk of an isolated mistake within a normally satisfactory monitoring system. The representative's ICT system also did not provide for independent cross-checks.

5.4.7 Deficiencies in computerised systems

In **T 473/07** the board held that the representative's practice of checking only the dates entered by his records clerks while relying on the resulting time limits calculated by the computerised system did not rule out errors. Modern real-world offices comprised computerised systems but **program deficiencies** were also a well-known part of that reality and could not be absolutely ruled out. Therefore, relying exclusively on a time limit generated by a computer program and refraining even from a plausibility check did not meet the all-due-care requirement.

In **T 902/05** the board held that whether the systems used in a particular firm to ensure that procedural acts were completed in due time fulfilled the requirement of the taking of "all due care" depended upon the individual circumstances of each case (see also **T 1663/12**). Where an applicant relied solely on electronic means to record and monitor time limits, the regular making of back-up copies, or some equivalent form of securing data, would generally be an elementary precaution.

For a case in which the computerised system was deemed satisfactory, see **T 1269/13** of 4 February 2015.

5.5. Persons required to exercise due care; requirements regarding due care

Primarily it is up to the applicant (patent proprietor) to show due care. The applicant has to accept the actions of his representative, including the actions of the attorney's assistants and employees, on his behalf (**J 5/13** with reference to **J 5/80**, OJ 1981, 343; **J 1/07**). The "due-care" obligation is assessed differently, depending on whether an applicant, his representative or an assistant is involved.

5.5.1 Due care on the part of the applicant

In **J 3/93** the Legal Board ruled that the duty to exercise all due care stipulated by Art. 122 EPC 1973 applied first and foremost to the applicant and then, by virtue of the delegation

implicit in his appointment, to the professional representative authorised to represent the applicant before the EPO. The fact that the representative had acted correctly did not exempt his client from suffering the consequences of his own mistakes, or even negligence (see also **J 16/93**; **J 17/03**; **J 1/07**; **J 1/13**).

a) Due care standard

In **T 1477/17** the board held that, in principle, a layperson was not expected to show the same attention to detail as was expected of a professional representative when dealing with correspondence in patent matters, since a layperson could not be expected to have the same level of knowledge. Depending on the circumstances, an error on the part of a layperson might therefore be excusable whereas the same error by a professional representative may not. Nevertheless, even a layperson is obliged to exercise all due care in matters for which they have taken responsibility and must take all steps that can be reasonably expected of a diligent person.

In **J 22/92** the Legal Board held that the applicant, who had appointed US attorneys for the purpose of the PCT application, was entitled to believe that a copy of a communication had been sent to the US attorneys as well. The board referred to the principle of proportionality and stated that the loss of the patent application as a result of what may be considered at most a minor procedural irregularity would otherwise appear an extremely severe result. The board held that, in the case in point, the due care to be considered was in fact not that which was expected from a professional representative but that which was expected from an applicant unaware of the proceedings.

In **T 2120/14** the board found the examining division's finding of lack of due care by the applicant to be justified in the circumstances, in which the observance of a time limit depended entirely on a single person who, in view of his impending extensive workload and travel, did not take the necessary precautions to ensure that the time limit could be met in case he was prevented from giving timely instructions. The board held that it was clear from the travaux préparatoires to Art. 122 EPC that the possibility of excusing the negligence of an employee who normally carries out his work in a satisfactory manner was not intended to be extended to the applicant or its professional representative (see **R 18/13**). In the case in hand it was an executive of the company who had failed to exercise all due care, who the board found was acting on behalf of the appellant.

b) Reliance on the professional representative

In **J 7/16** the Legal Board held that, for health reasons beyond his control, the former representative had not been capable of running the case in a proper way although he had taken every effort to fulfil his duties. This finding prevented the applicant from suffering from the inappropriate procedural conduct of its former representative as it had no reason to suspect that he could not be relied on.

In **T 381/93** of 12 August 1994 the board observed that the applicant was entitled to rely on his duly authorised professional representative to deal with the EPO. However, the board held that to the extent that he was on notice that a time limit had not been met and/or

that instructions were required in order to meet it, an applicant had a duty to take all due care in the circumstances to meet the time limit.

In **T 1954/13** the appellant (applicant) issued its US representative with an order to "stop work". It appeared to the board that the appellant could not expect that the "stop work" order would have no consequence at all, i.e. that work continued as usual. Yet, there was nothing on file which would suggest that measures had been taken by the appellant in order to somehow compensate for the issuance of the "stop work" order. If instructions had been given by the appellant to the effect that no information should be sent to it, the board found this would be an additional aspect for a finding that the appellant itself had not acted with all due care required by the circumstances.

c) Unrepresented individual applicant

In **J 5/94** the Legal Board made allowance for the fact that the appellant was an individual applicant who had not appointed a representative and who was neither familiar with the requirements of the EPC nor in possession of an established office organisation attuned to ensuring that procedural deadlines were met. The board pointed out that in such a case the **same standards** of care as those required of a professional representative or the patent department of a large firm **could not be applied**. See also **T 1201/10** of 28 February 2018.

At the same time, an individual applicant was also obliged to exercise due care in the course of the procedure. Accordingly, when not using the services of a professional representative, he must himself take all possible steps to ensure that he can do, properly and punctually, whatever is required during the grant procedure to prevent any loss of rights. He is not entitled either to invoke **general ignorance of the law** or to leave undone anything which may reasonably be expected of him with a view to observing time limits (**J 5/94**; **J 27/01**; **J 2/02**; **J 6/07**; **J 8/09**; **J 7/12**; **J 17/16**; **T 493/08**; **T 555/08**).

In **T 1444/15** the board held that an applicant who employed the services of a payment service provider for monitoring the time limits for renewal fees could not be considered to be an unrepresented individual (see also **T 1477/17**).

In **J 23/87** the Legal Board ruled that exercising due care under Art. 122 EPC 1973 meant that an applicant, when deciding whether to pursue his application, could not rely entirely on information provided voluntarily by PCT authorities and the EPO at various stages of the procedure, and instead had to ensure that he was normally able to comply with the basic PCT and EPC 1973 time limits even if he received this information late or not at all.

In **T 601/93** the appellant was not aware of the need to file a statement of grounds within the time limit. The board held that any **legal error** which might have led the appellant to believe that the requirement was not to be observed would exclude the application of due care, considering the unequivocal provision in Art. 108 EPC 1973.

With regard to re-establishment in respect of disciplinary proceedings and the European Qualifying Examination, the board ruled in **D 6/82** (OJ 1983, 337) that a mistake of law,

particularly one regarding the provisions on notification and calculation of time limits, did not, as a general rule, constitute grounds for re-establishment of rights. The obligation to take "all due care required by the circumstances" meant that persons engaged in proceedings before or involving the EPO had to acquaint themselves with the relevant procedural rules.

d) Choosing a sufficiently competent representative

In **J 23/87** the applicant failed to furnish a translation of an international application within the prescribed time limit. The appellant, a small Japanese firm with limited financial resources, submitted that a Japanese patent attorney without special knowledge of PCT matters had been consulted, and that this attorney had misinformed the appellant. The Legal Board held that for an applicant who lacked the necessary knowledge of the PCT and the EPC procedures, it was obviously necessary to consult a competent professional representative in order to cope with the procedures involved in such a patent application. Thus, the Legal Board was not satisfied that the appellant, being completely ignorant about the special procedure to be observed in this case, had chosen a sufficiently competent professional representative and let him properly advise the appellant on the matters involved having had an opportunity to study the details concerning the present application.

5.5.2 Due care on the part of the professional representative

When an applicant is represented by a professional representative, a request for restitutio in integrum cannot be acceded to unless the representative himself can show that he has taken all due care required of an applicant or proprietor by Art. 122(1) EPC (**J 5/80**, OJ 1981, 343). In other words, what Art. 122 EPC requires from an applicant also applies to an applicant's representative (**T 1149/11**).

The extensive case law on a professional representative's duty of care in **dealing with assistants** is dealt with below in this chapter III.E.5.5.4.

a) Communication between professional representatives and their clients, the EPO or other representatives

In **T 112/89** the board stated that, regarding the due care required by Art. 122(1) EPC 1973, the obligations of the applicant and those of his representative were clearly distinct and that the due care to be exercised by the representative might depend on the relationship which existed between him and his client. The board noted that it was clear that both the representative and the applicant had to exercise all due care in order to observe all the time limits during patent granting procedures. In the case at issue, the board was not convinced that the duty of the representative was fully discharged when he notified his client that a time limit was to be observed and was satisfied that the client had received the notification. On the contrary, when a representative has been instructed to lodge an appeal and has not received in due time from his client the necessary additional instructions needed to discharge his duty, he should take all necessary measures to try to obtain from his client these instructions.

In **T 1401/05** of 20 September 2006 the board stated that the communication between the representative and his client (applicant) had worked efficiently. The representative was therefore entitled to rely on his client's awareness of the expiry of the time limit. The representative was not required to issue a further reminder to meet his obligations of due care.

In **T 1289/10** the board held that if a European representative provided a contact email address for all kinds of mail, including mail that may require immediate action by the representative, it was **essential to perform a mail check** at least at the end of each business day. Given the known problem that legitimate mail from time to time was wrongly marked as a possible threat it was evident that this check must include the quarantine area of the email system.

In **T 1101/14** the board considered that the **signing of documents** was an act that required particular care on the representative's part, especially when the signature related to the last legal remedy against an adverse decision. A representative who had mistakenly signed a statement of grounds of appeal having most of its pages missing had, in the absence of special circumstances which could justify the representative's mistake, to be considered not to have taken all due care required by the circumstances.

In **J 15/14** the Legal Board held that in a proper workflow between two representatives' offices where one had the function to give instructions to the other, a confirmation from the other representative that a particular instruction had been received and followed was required; if no confirmation was received a follow-up e-mail should be sent in order to safeguard the rights of the client.

b) Payment of renewal fees

In **J 11/06** the Legal Board held that according to the established jurisprudence of the Legal Board following decision **J 27/90**, even if renewal fees were paid by someone else, the appointed professional representative remained responsible in the procedure before the EPO, and had to **take the necessary steps to ensure payment** if intended (likewise **J 1/07**, **J 4/07**, **J 12/10**, **J 5/13**).

In **J 4/07** the European representative had every reason to believe that it was the appellant's intention to continue prosecution of the application in suit. Under these circumstances the Legal Board did not consider that it was sufficient for the European representative only to send a single reminder more than four months prior to the expiry of the critical term.

In **J 12/10** the Legal Board confirmed that it was established jurisprudence of the boards of appeal that a representative, once appointed – even if the renewal fees were paid by someone else – remained otherwise fully responsible for the application, and that this included a continuing obligation to monitor time limits, send reminders to the applicant, etc.

In **J 5/13** the Legal Board considered that the extent of the duties of the representative depended on the agreement between the representative and his client. An appointed representative whose authorisation was silent concerning the payment of the renewal fees and who had not received any funds for this purpose was **not expected to pay the fee by advancing money** on behalf of the applicant out of his own pocket (**J 16/93**, **J 19/04**, **J 1/07**). Instead, he retained only a **"secondary responsibility"** (see **J 1/07**). Thus the representative's responsibility, above all, consists in finding out what his client really intends to do with respect to payment of the renewal fees (see **J 16/93**). The scope of duties of a representative who retains only such a "secondary responsibility" to inform and advise his client with respect to the due date for renewal fees cannot be the same as it would be if he were responsible for the payment itself. In the case in question, the representative had fulfilled his responsibility by sending repeated letters to the responsible person within the appellant's company.

In **J 19/04** the board held that the representative's conduct has to be assessed according to the extent to which he has done all that is necessary to ascertain the **client's true wishes** (see also **J 1/07**, **T 1426/14**). It is not the number of (unanswered) reminders that is decisive, but when those reminders were sent in relation to the date on which the time limit expired, how the reminders were formulated and what the representative's duties were in relation to the client.

In **T 942/12** the board held that if a European representative was **expressly instructed** that he was not required to monitor the payment of renewal fees, the duty of due care did not involve that he nevertheless monitored the payment. It could not be expected that the European representative monitors renewal fee payments at his own expense.

In **T 629/15**, the board distinguished the facts underlying it from **T 942/12**, as no express instruction to not monitor the payment of fees was given. In these circumstances, the board decided that the European representative remained responsible for ensuring the payment, despite the fact that the US applicant used a US representative as well as a service firm for the payment of renewal fees.

In **T 338/98** the appellant was first represented by professional representative A, but later asked him to transfer all files to a new representative B. One European patent application failed to be transmitted. Although the representatives were aware that the renewal fee was due for this application, they did not reach clear agreement about paying it, with the result that the fee was not paid and the application was deemed to be withdrawn. The board held that in these circumstances it did not appear appropriate formally to delimit the individual responsibilities of each of the representatives during a transfer of cases requiring, by its very nature, close co-operation between the persons involved and naturally leading to overlapping responsibilities. The fact that in these circumstances the representatives had been unable to reach agreement about the way to proceed and that the appellant had not been informed of the outstanding renewal fee and of the disappearance of the file in question was not an indication that all due care required by the circumstances had been taken at that moment.

In **T 1426/14** the representative had been informed about the applicant's intentions to pay the renewal fee and could be sure that the applicant was aware of the running time limit. The board held that once the applicant had clearly indicated that he had taken note and that he would pay, the representative had fulfilled his obligations and the responsibility shifted to the applicant.

c) Ignorance of or erroneous interpretation of a provision of the EPC

(i) Error of law or erroneous interpretation cannot be excused

In **J 3/88** the Legal Board noted that account should be taken of the fact that under Art. 134(1) EPC 1973 the contracting states had in principle confined representation of applicants before the EPO to "professional representatives" who, by virtue of their qualification should guarantee the best possible representation. The Legal Board stated that it followed that a representative could not relieve himself of responsibility for carrying out tasks which, by reason of his qualification, fell upon him personally, such as, for example, the interpretation of laws and treaties. If he delegated such tasks to an employee and if the latter made an error in the course of that work which resulted in the failure to observe a time limit, the representative could not claim that he had taken all due care required by the circumstances (see also **J 33/90**).

In **J 31/89** the Legal Board confirmed that erroneous interpretation of the EPC owing to a mistake of law on the part of the duly authorised representative with regard to the rules for calculating time limits (in the case in point, regarding the late payment of a renewal fee together with the additional fee) could not be excused. The appellant and the representative failed to determine correctly the last date for valid payment of the renewal fee (see **J 42/89**, **T 853/90**, **T 493/95**, **T 881/98**, **T 578/14**).

In **T 516/91** the board considered that by mistakenly believing that an extension of the time limits set by Art. 108 EPC 1973 was possible, the representative had failed to exercise due care (see also **T 248/91**, **T 853/90**, **T 316/13**).

According to **T 316/13**, a European patent attorney is expected to know the EPC provisions concerning the legal remedies available in the event of failure to observe time limits, even if he has never been faced with the problem before, without waiting for the board of appeal to tell him exactly what he needs to do.

(ii) Exceptions to the rule that an error of law or erroneous interpretation cannot be excused

In **T 624/96** the board expressed doubts about the nature of the original mistake, which concerned calculation of the time limit for filing the statement of grounds of appeal. This was possibly a "mistake of law" caused by ignorance or misinterpretation of the provisions of the EPC, as in e.g. **J 31/89** or **T 853/90**. The board found that in the circumstances of the case at issue, however, the agent had not made a "mistake of law" of this kind. The agent cited an earlier appeal in which he had represented the same applicant, showing that he indeed had some familiarity with the appeals procedure. He also submitted

programmes of training courses, at which he had given talks on European patents and EPO proceedings. It could be therefore be ruled out that a legal error in calculating the period for lodging the statement of grounds of appeal might have arisen from his ignorance of the EPC.

In **J 28/92** the Legal Board held that the misinterpretation of a provision of the EPC by a representative was not without basis or unreasonable and considered that there was no basis for penalising the representative for having arrived at a **not unreasonable interpretation** of a rule of the EPC, which subsequently turned out to be wrong. The representative's interpretation of a legal provision of the EPC was not the result of, and did not lead to, a failure to exercise all due care required by the circumstances. In **T 493/08** the board shared the view expressed in **J 28/92** and stated that there might be exceptions to the rule that an error of law could not be excused, which, however, could be acknowledged only under rigorous criteria.

In **J 13/13** the Legal Board confirmed that an error of law could be excused if rigorous criteria were met, namely where there were genuine doubts and differences of opinion as to how a provision was to be interpreted. Such doubts and differences of opinion could be considered legitimate only if, after scrupulous attempts to clarify the matter, including by reference to the boards' case law, the right interpretation remained objectively unclear and the view later found to be erroneous was reasonable.

d) Requesting and acting on information from the EPO

In **T 460/95** of 16 July 1996 the representative requested an extension of the time limit, although, in his professional capacity, he should have known that time limits under Art. 108 EPC 1973 could not be extended. The board noted that representatives were expected to be acquainted with the provisions of the EPC regarding time limits, and that the representatives in question had not been as vigilant as the situation demanded. In this specific case, however, the representative had taken the precaution of contacting the Registry of the Boards of Appeal beforehand, and had received information from that body which had led him to take action prejudicial to his interests. The board held that appellants should not suffer injury merely because they had relied on **information received from the EPO** which later proved to be mistaken or likely to have been misunderstood.

In **T 881/98** the appellant's professional representative had written to the Registry of the Boards of Appeal requesting a two-month extension to a time limit, without giving reasons or indicating that the time limit in question was for submitting the statement of grounds of appeal. He added that if not notified to the contrary he would assume his request was allowed. The board refused the request for re-establishment. The Registry had not fallen short of legitimate expectations, as in this case (in contrast to **T 460/95**) the appellant had not been misled to his detriment by wrong information from the Registry but had himself made the mistake of thinking that the time limit could be extended.

In **T 733/98** the board informed the appellants that the statement setting out the grounds of appeal did not comply with Art. 108, third sentence, EPC 1973. The appellants requested re-establishment in respect of the time limit for filing the statement of grounds,

arguing that they had relied on Legal Advice No. 15/84 of the EPO, which had still been in force when they had received the communication under R. 51(4) EPC 1973. The board held that the appellants had misinterpreted the legal advice in question, having failed to realise that the procedure for handling main and auxiliary requests which it described no longer applied once amended R. 51 EPC 1973 entered into force. The board decided that the requirement of all due care required by the circumstances was not met in this case.

In **T 744/11** the statement setting out the grounds of appeal was received in electronic form three minutes after expiry of the four-month time limit. The representative argued that his office was based in Cambridge and that, since the clocks in the United Kingdom were one hour behind Central European Time (CET), he had sent the statement of grounds within the time limit. The board could not accept this argument for the simple reason that the relevant time for the purpose of the law was the time at the EPO (i.e. the time at Munich or The Hague) and not the time in the United Kingdom. However, the board considered the appellant's request allowable, in particular because the appellant had shown that the non-observance of the time limit was not caused by lack of due care but rather by a justifiable human error on the part of the representative.

In **T 2012/20** the board found that the appellant knew how to file an appeal but had paid the reduced appeal fee. The communication by the EPO for the correction of the appeal fee had been sent by registered mail. The board referred to the FAQ section of the EPO's home page as well as the fact that the EPO was holding oral proceedings by videoconference, and found that it was very surprising that appropriate electronic means were not used to warn applicants. In addition, the change in format of oral proceedings before the examining division to videoconference was announced by telephone to the appellant and this was promptly confirmed via email by the appellant. Registered mail was not used in either case. The fact that the representative specifically indicated in her email to the assistant that the appeal should be filed some time before expiry of the time limit to allow possible shortcomings to be overcome indicated that the representative probably relied on the information provided by the EPO. The exceptional circumstances led to a finding that all due care had been taken, justifying re-establishment of rights.

e) Starting work on a case close to the expiry of the time limit

In **J 16/92** the Legal Board made it clear that anyone getting himself into a situation where he could not be sure of being able to complete the omitted act ran the risk of his request for further processing being ruled inadmissible for failure to complete the omitted act in good time. In the case in hand the representative had not started working on the file until four days before expiry of the time limit for further processing and hence had discovered too late that he was unable to find the first communication to which he was to respond. See also **J 7/12** (where a payment order was transmitted late in the afternoon of the last day of the grace period for paying a renewal fee plus additional fee).

f) Designation of receiving offices

In **J 1/03** the Legal Board emphasised the paramount importance of the designation of receiving Offices and the difficulty or even impossibility, in many cases, of correcting wrong

or missing designations. Consequently, the benchmark for what "all due care" meant in those cases, was very high. Likewise the check of the content of the international application on the basis of the "Notification of Receipt of Record Copy" issued by the International Bureau had to be made very carefully.

g) Abandonment of application

In **T 1022/14** the board observed that abandonment of an application was a final action with serious consequences if misapplied. Thus for a decision to close a file and to abandon an application the utmost care had to be taken to establish whether the client had without any doubt issued instructions to that effect. The decision to abandon an application had to be taken by the representative himself, on the basis of his own observations and knowledge. This responsibility could not be delegated to employees, as decisions of this kind required the special knowledge of the representative for which he had to assume personal responsibility as a professional.

5.5.3 Due care on the part of a non-authorised representative

In determining whether all due care has been taken, the acts of all those persons the appellant has asked to act on its behalf must be considered, which also applies to non-authorised representatives instructed by the appellant (**T 2274/11** with reference to **J 4/07**; see also **J 5/80**).

In **J 25/96** the Legal Board held that where a US applicant availed himself of the services of a US patent attorney for matters which in relation to the EPO fell within the applicant's responsibility, the **US patent attorney** had to be regarded as the agent of the applicant. Thus, to meet the "all due care" requirement, the US patent attorney had to show he had taken the due care required of an applicant (see also **J 3/88**, **T 1401/05** of 20 September 2006).

In **J 4/07** the Legal Board pointed out that a non-European representative can be held responsible for meeting the obligations of any representative whose duty it is to care for his client's interests, irrespective of whether such representative is entitled to represent before the EPO or any other patent office (see **J 25/96**, **J 5/18**). The monitoring of specific time limits that were set expressly does not depend on knowledge of EPC law. Thus a non-European representative must also establish a reliable monitoring system for such time limits. Furthermore, any representative, whether European or non-European, moving from one law firm to another must take provisions upon entry in that firm that those filed that he carries over are integrated into a time limit monitoring system.

In **J 3/08** the Legal Board held that according to the established jurisprudence, if an agent was appointed, the agent had also to observe all due care and if he did not act accordingly this was imputed to the applicant. In the case at issue, it was clear that the agent, by not acting as instructed, had not properly handled the case. According to the Legal Board, if **fraud by an agent** were to be accepted as a reason for re-establishment of rights, by derogation from the general principle that an agent's behaviour was imputed to the

applicant, the evidence presented must be so conclusive as to convince the board that a fraud took place as opposed to just unprofessional behaviour.

In **T 742/11** the board held that the actions of an agent, who acted as an intermediary between the appellant and the professional representative, must be imputed to the party he is acting for, and the same level of care is expected from the agent as from a professional representative, or at least as from the party itself. Indeed, requiring a certain level of care from a professional representative and a party using his services would become utterly pointless if an intermediary acting between the party and the professional representative were not required to show the same level of care.

In **T 1954/13** after the applicant (appellant) issued the US attorney with an order to "stop work", communication between the appellant and the US attorney was "reduced to a minimum". In the absence of evidence that the appellant had explicitly instructed the US attorney not to pass on any information about the status of the application to the appellant, the board could not establish that, by remaining inactive with respect to the application in suit, albeit having received relevant information from the European representative, the US attorney had complied with the requirement of "all due care". Although the appellant asserted an email had been sent by the US attorney to inform the applicant about the final deadline for filing an appeal shortly before the date both the US attorney and European representative considered to be the last date for filing an appeal, the mere sending of a single e-mail to the applicant without seeking confirmation of receipt or a follow-up enquiry, did not, in the board's view, meet the standard of all due care required by the circumstances (see also **J 19/04**; **J 15/14**; **T 2274/11**).

In **J 6/22**, in claiming that all parties had exercised all due care for the payment of the fees in question, the appellant had overlooked that all acts of its "US agent", an intermediary between it and the European professional representatives, tasked "to supervise the procedure and communicate with the agent empowered to act before the EPO", were also fully attributed to it. The Legal Board found that no reasons had been given to conclude that the US agent had exercised all due care. To the contrary, from the appellant's own arguments, it was apparent that the US agent, by not monitoring the time limits properly, not proactively reaching out to the appellant, not responding to a large number of emails and not making provisions for staff losses, had not exercised all due care. The Legal Board noted that for these reasons alone, there would also have been no need to look further into the appellant's own or its European professional representatives' behaviour.

5.5.4 Due care in dealing with assistants

a) Introduction

According to the case law of the boards of appeal, where an assistant has been entrusted with carrying out routine tasks, such as typing dictated documents, posting letters and parcels and noting time limits, the same rigorous standard of care is not expected as is demanded of an applicant or his professional representative (**J 5/80**, OJ 1981, 343; see also **J 33/90**, **J 26/92**, **T 43/96** of 5 July 1996, **T 221/04** of 5 May 2004, **T 1465/07**, **T 1663/12**).

J 5/80 (OJ 1981, 343) is the key ruling in this regard. It established that a request for re-establishment of rights can be acceded to in the event of a culpable error on the part of the assistant, if the professional representative is able to show that he has **chosen** for the work a suitable person **properly instructed in the tasks to be performed**, and that he has himself exercised reasonable supervision over the work (see also **T 191/82**, OJ 1985, 189; **T 105/85**; **T 110/85** of 10 September 1987; **T 11/87** of 14 April 1988; **T 176/91** of 8 April 1991; **T 949/94** of 24 March 1995; **T 221/04** of 5 May 2004; **T 1149/11**; **T 1171/13**).

The Legal Board further stated in **J 5/80** that a representative cannot relieve himself of responsibility for carrying out tasks which, by reason of his qualification, fall upon him personally, such as, for example, the interpretation of laws and treaties. If a representative delegates such tasks to an employee and if the latter makes an error in the course of that work which results in the failure to observe a time limit, the representative cannot establish that he took all due care required by the circumstances (see also **J 33/90** and **T 715/91**).

More recent decisions stress that responsibility in every respect passes to the representative as soon as he is presented with the file for processing, and that to that extent he is not justified in relying on an assistant's calculation of a time limit (see in this chapter III.E.5.5.4 e) "Ultimate responsibility of the representative"). For a case where an unrepresented individual applicant entrusted a third person with the payment of renewal fees and other administrative tasks, see **T 555/08**.

Regarding the **burden of proof** in the form of an adequately detailed statement in connection with the duty of care in the selection, instruction and supervision of assistants, see **J 18/98**.

b) Selection, instruction and supervision

It is incumbent upon the representative to choose for the work a suitable person, properly instructed in the tasks to be performed, and to exercise reasonable supervision over the work (**J 5/80**, OJ 1981, 343; **J 16/82**, OJ 1983, 262; **J 26/92**; **T 2016/16**). An "assistant" within the meaning of **J 5/80** (OJ 1981, 343) includes a **substitute replacing an assistant** who is on leave, ill or absent for some other reason. The same standard of care must be exercised as regards the choice, instruction and supervision of the substitute as of the assistant himself (**J 16/82**, OJ 1983, 262). New assistants must be supervised on a regular basis for a period of at least some months (see **J 3/88**, **T 715/91**).

The case law cited above applies equally to a **patent attorney residing in the USA** (or his assistants) if he acts in collaboration with the duly appointed professional representative. In **J 3/88** the US patent attorney of a "non-resident" applicant acted in collaboration with the duly appointed professional representative. The "docket clerks" (assistants of the US patent attorney) were entrusted with the performance of routine tasks such as noting time limits and checking due dates. The Legal Board stated that in order to be able to carry out these admittedly rather simple tasks properly, they needed nevertheless some **basic knowledge**. The Legal Board concluded that, although no special qualifications were required, it was fairly impossible for a docket clerk to perform

these routine tasks satisfactorily without having previously been given appropriate instruction and being supervised closely until he was familiar with the job. A reasonable **supervision** of the activity of a newly engaged docket clerk implied that his work be periodically checked. In order to be effective and avoid culpable errors, these periodic checks should be performed systematically, at least during an initial training period of several months.

(i) Routine tasks

In **T 1062/96** of 11 December 1997 the board found that the **posting of a letter** prepared and signed by the representative was a typical routine task which the representative could entrust to an assistant (see also **T 335/06**). In the case in question the assistant was expressly instructed to send the letter by fax on the same day. In a properly organised office the representative could rely on the correct execution of such an instruction. The sending of the fax did not require any specialised knowledge or qualification. Therefore, the assistant, here a secretary, who had proven to be reliable in the daily work of the representative's office, could have been expected to do this job within her own responsibility. Since the order was to be carried out more or less immediately, a later check whether the fax had actually been despatched was not necessary. See also **T 2023/14**.

In **T 2253/13** the representative tasked an assistant with sending the statement of grounds of appeal to the EPO by fax on the final date of the relevant time limit, however the assistant overlooked that the fax transmission had not been successful. The board was satisfied that the appellant was unable to observe a time limit in spite of all due care. The representative was entitled to transfer such a routine task to an assistant without infringing all due care in dealing with the filing of the grounds of appeal, and there had been an excusable isolated mistake by the assistant.

In **T 2450/16** the board held that, at least in the case in hand, the preparation of a notice of appeal by the representative's assistant could not be considered to constitute a routine task that could rightfully be entrusted to her by the representative.

In **T 3029/18** of 3 June 2020 the board concluded that, once a representative had decided what fee had to be paid on what day, acting on the instruction was a routine task that could be left to an experienced and reliable assistant. In the board's view, it would be going too far and out of proportion to require another check of whether the instruction had been properly carried out. On this point, it endorsed the finding of the board in **T 1355/09** that a very small firm was not required to have a system of checks in place.

(ii) Choosing a suitable person for the task

In **T 191/82** (OJ 1985, 189) the non-payment in due time of an additional fee was found to be clearly attributable to an unfortunate concatenation of errors by nevertheless properly selected and experienced employees.

In **J 12/84** (OJ 1985, 108) the due care required in the circumstances was not observed when the **employees of another company** were instructed to sign for registered mail

addressed to the representative, as he was not able to supervise the work of such persons not employed by his firm.

In **T 309/88** of 28 February 1990 the board stated that even **employees without formal training** as patent attorney's assistants could perform the task of recording and monitoring time limits. This was routine work which did not require specialised knowledge and professional qualifications. However, the assistant had to be properly instructed in the tasks to be performed and a trained employee had to be on hand to give advice.

(iii) Properly instructing the assistant

In **T 1764/08** the board held that **filing an admissible appeal was not a routine task**, but rather a complicated task which needed clear instructions from the professional representative to his assistant.

In **T 2336/10** the board held that the representative did not appear to have issued proper instructions as regards the correct way to deal with the time limit for **filing a statement of grounds of appeal**. An assistant to whom that task was entrusted had to be instructed to work on the assumption that, once the notice of appeal had been filed and the appeal fee paid, a statement of grounds of appeal would in principle have to be filed within the four-month time limit laid down in Art. 108 EPC.

In **T 198/16** the board held that a representative must give express and clear instructions to an assistant to the effect that the **appeal fee** had to be paid. It was not enough to rely on the assistant's deducing the duty to file the payment form from the notice of appeal.

In **T 2450/16** the board noted that *epoline*® mainly dealt with the **electronic filing** of documents with the EPO. In the board's understanding, it was not an electronic guide supposed to convey knowledge about the right document(s) to file in a given situation. Rather the use of *epoline*® presupposed such knowledge. In other words, the assistant's use of *epoline*® could by no means replace the need for proper instructions from the representative.

(iv) Reasonable supervision

In **T 949/94** of 24 March 1995 the board stated that a representative was expected to exercise reasonable supervision over the work delegated. This did not mean that he had to supervise the posting of every letter. Once he had signed a letter and ordered his secretary to post it, he was entitled to assume that it had been posted. In the light of that, the board was satisfied that the representative had exercised due care in dealing with his secretary (**J 31/90**, **T 1171/13**).

In **T 1465/07** the secretary of the representative had previously worked for another partner and after her taking up her new job the instructions given in relation to the back-up check consisted of little more than the order to continue to perform that check in the same way as she had done in her former position. The board considered that this was insufficient and that she required supervision at shorter intervals during the period immediately

following her taking up the new job. Requiring such supervision was not only appropriate and necessary but also not disproportionate, as supervision does not require a substantial amount of time.

In **T 1149/11** the board held that the duty of care concerning supervision of the assistant required that an effective cross-check was implemented, at least in a firm where a large number of time limits have to be monitored. This was particularly so in the case at issue because the time limit for filing a notice of appeal and paying the appeal fee pursuant to Art. 108 EPC was absolutely critical; if the time limit was missed, there was no further ordinary remedy and the contested decision had legal effect (see also **T 439/06**, OJ 2007, 491).

In **T 555/08** the board found that the requisite **standard of due care was not met by uncritically accepting the accuracy of an assistant's oral statements** although they must have been open to doubt (see **T 602/94**). Failure to query or check such statements had to be viewed in the context of the obligation to supervise assistants. Especially where there were signs that mistakes might have been made, it was essential to check whether assistants were correctly performing the duties assigned to them.

In **T 2016/16** the board observed that the representative was not discharged from his or her duty to properly instruct and supervise the assistant, even if the time limits entered by the assistant in the docketing system were normally double-checked by a patent attorney.

c) Technically qualified assistants

In **T 715/91** the board held that the consequences of an error by a technically qualified assistant (an engineer training for the European qualifying examination) imputed to the representative would also have to be borne by the appellants. The task of writing, or at least supervising, the despatch of important submissions, such as grounds of appeal, would normally fall to the representative himself. Furthermore, given that the assistant had only recently been taken on, the representative could not be expected to have been able to ascertain in such a short time to what degree the assistant did know the rules and regulations of the EPC.

In **T 828/94** the board found inter alia that the technical assistant in charge was not supervised well enough and had not been properly instructed.

In **T 832/99** the board, referring to the required standard in exercising due care, decided that a technical employee working in a firm of patent attorneys was not an assistant but was carrying out de facto the work of a patent attorney. This meant that the **same strict requirements** for due care would have to be applied to the technical employee as were applied to the appellant and the appellant's representative.

d) Substitutes replacing assistants

In **J 16/82** (OJ 1983, 262) the Legal Board stated that the conditions relating to assistants also applied in the case of a substitute replacing an assistant who was on holiday, ill or

otherwise absent. Where a qualified assistant was absent, therefore, the applicant or representative had either to be able to call on a similarly qualified substitute or else must himself take over the work assigned to the assistant. The **same standard of care** had to be exercised as regards the choice, instruction and supervision of the substitute as of the assistant himself (see also **T 105/85**).

e) Ultimate responsibility of the representative

In **J 25/96** the statement of grounds for the request for re-establishment of rights explained inter alia that non-observance of the time limit had been caused by the assistant entrusted with monitoring time limits. The Legal Board held that the case law according to which a representative could entrust suitably qualified and supervised personnel with monitoring time limits had been developed for routine tasks and normal cases. It did not mean that a representative could also entirely leave such staff to monitor cases which (i) were **particularly urgent**, (ii) needed **particular attention** and further steps by the representative himself to ensure that the necessary acts were still performed in time, and (iii) could result in an **irrevocable loss of rights** if any error or delay occurred.

In **T 719/03** the board did not accept the appellant's argument that the failure to comply with the time limit had been an isolated mistake by the qualified secretary who had noted on the cover page of the revocation decision only the time limit for appeal but not the time limit for filing the statement of grounds of appeal. The board held that the appellant's representative had himself failed to exercise due care, since the contested decision had been shown to him twice without his noticing the incompleteness of the note concerning the mandatory time limit that had to be monitored. The board took the view that, with the **careful handling** of a dossier involving statutory time limits, a representative was so often faced with the time limits to be observed that **compliance with the time limit was ensured**.

In **T 439/06** (OJ 2007, 491), the board emphasised that fulfilling the requirements of proper selection, instruction and supervision only meant that the assistant's error in dealing with the delegated task could not be imputed to the representative. It did not mean that the representative's responsibility ended once and for all with the proper selection, instruction and supervision of the assistant, and that he need not take further care with respect to the delegated task (see also **T 1149/11**). Once the representative gets the file on his desk for his own action, in order to comply with the relevant time limit, **responsibility** passes over to him **in all respects**. All due care under these circumstances requires the representative to verify the time limit calculated by his records department when he receives the file for dealing with it. He cannot simply rely on having delegated this task once and for all to his records department (see also **J 1/07**, **T 719/03**, **T 473/07**).

Likewise in **T 1561/05** the board held that the representative was personally at fault in failing, when signing the statement of grounds for appeal, to check the calculation of the time limits by his support staff and therefore to notice that the calculation was wrong. A task forming part of the representative's **core duties**, such as performing a **final check** when signing a submission which is subject to a time limit, cannot be delegated in a way that absolves the representative of responsibility.

In **T 1095/06** the board stated that if the professional representative failed to act because he had not received a reminder due to some error of a properly chosen, properly instructed, and reasonably supervised assistant this could be regarded as "an isolated error in an otherwise satisfactory system" which would still allow re-establishment to be granted. However, a professional representative must be presumed to be **supervising his own work continuously**. The case law on "an isolated mistake in an otherwise satisfactory system" could not be relied on to ignore a failure to act by the professional representative himself, unless there were special circumstances which made the failure to act compatible with taking all due care.

In **T 592/11** the board held that, where a double check was carried out by the representative and an assistant, the former was liable for any negligence in performing his own part of this check. This was because, where double checks were carried out by assistants only, the representative had to perform an additional, third check (see **T 439/06**, **T 1561/05**). If, however, they were carried out by an assistant and the representative himself, the latter had to be subject to the same standard of care with respect to his part of the check. An isolated mistake by a professional representative in performing his check was then – as a rule at least – inexcusable.

In **R 18/13** two "isolated" mistakes had been made, one by the professional representative, the other by his assistant. The Enlarged Board considered the travaux préparatoires and found that an "isolated mistake", such as assistants might make, was not excusable in a representative. If he was given a file to deal with, he could not simply assume that his assistants had reliably done all their work on it so far; he had to make sure, through appropriate control mechanisms before the file reached him, that time limits arising were complied with, or – at the latest when he was given the file to deal with – check for any time limits himself. The request for re-establishment was refused.

In **T 600/18** the board held that Art. 122 EPC and the relevant case law (with reference to **T 1095/06**, **T 592/11**, **R 18/13**) did not excuse mistakes by the representative, even if the representative did not normally perform the duty of paying fees himself or herself.

5.5.5 Due care in using mail delivery services

In **T 667/92** of 10 March 1994 the board considered whether the appellant could be said to have taken all the due care required by the circumstances when allowing only two days for delivery from the UK to Germany and whether, in these circumstances, the choice of using a special carrier for the delivery was **i**n keeping with the due care requirement. The board pointed out that a party who missed a time limit had also to show due care in its **choice of method of delivery** and that the use of outside agents might be held against the applicant under Art. 122 EPC 1973 owing to a lack of proper safeguards. The board added that in parallel situations telefaxing should preferably be used, but accepted the explanation of the appellant why this means was not used. The board took into account the very extraordinary circumstances regarding the withholding of the item by the customs in Munich for 36 hours, an incident which could not reasonably be foreseen, and allowed the request.

In **T 381/93** of 12 August 1994 the problem arose from the failure of the private courier service to deliver the package containing the corresponding documents to the EPO as instructed. Referring to **T 667/92** of 10 March 1994 the board held that once a reliable carrier had been chosen and commissioned for the delivery, a party was entitled to rely on them, provided that the party had given all the necessary and proper instructions to the carrier.

In **T 777/98** (OJ 2001, 509) the board held (see headnote) that if a party to proceedings requested re-establishment of rights on the basis that a document missed an EPO time limit because it did not arrive within the **standard delivery time**, that party would have to prove that the form of postage used would normally have ensured that the document would reach the EPO on time. The board left open the question whether a party who relies on the usual delivery time has exercised all due care with regard to the time limit.

6. Procedural treatment of requests for re-establishment

6.1. Department competent to decide upon the request

The department competent to decide on the omitted act shall decide upon the application (R. 136(4) EPC, Art. 122(4) EPC 1973).

The boards of appeal are competent to decide on the request for re-establishment in respect of the **time limit for filing a notice of appeal** (Art. 108 EPC), since the department competent to decide whether the appeal was inadmissible for non-compliance with Art. 108 EPC is, under R. 101(1) EPC, the board of appeal (**T 1973/09**; **T 808/03** of 12 February 2004; **T 949/94** of 24 March 1995; **T 473/91**, OJ 1993, 630). The boards of appeal are also competent to decide on the request for re-establishment in respect of the time limit for filing the written **statement setting out the grounds of appeal** (**T 624/96**).

While this competence in relation to admissibility of an appeal is subject to the exception of Art. 109(1) EPC (interlocutory revision), this provision confers only the limited power to set aside the department's own decision if the appeal was considered admissible **and** well founded (**T 808/03**, **T 1973/09**). The admissibility of an appeal under Art. 109 EPC only falls under the jurisdiction of the department of first instance when this question can be decided immediately on the basis of the appeal submissions themselves (notice of appeal and statement of grounds, date of payment of the appeal fee). The boards of appeal have exclusive jurisdiction over a request for restitutio in respect of a time limit relating to the appeal itself (**T 473/91**, **T 949/94**, **T 65/11**).

In **T 1482/21**, the request for re-establishment of rights in relation to the priority period fell within the competence of the Receiving Section. The board considered that a positive decision by the Receiving Section on such a request was valid and final, in that it could not be appealed. A decision by the Receiving Section could only be reviewed by the Legal Board if it adversely affected the party involved (Art. 21, 107 EPC). As such, a positive decision was not only binding on the Receiving Section itself but also barred other departments of the EPO, such as an opposition division and a technical board of appeal, from reassessing the request in any way.

In **W 3/93** (OJ 1994, 931) the board held that as the board had to decide on the protest, it was also competent to examine the request for re-establishment of rights (Art. 122(4) EPC 1973).

In **T 555/08** loss of rights (deemed withdrawal of the application due to **non-payment of a renewal fee**) occurred **while appeal proceedings were pending**. When appeal proceedings start, responsibility for the case passes from the department of first instance to the boards of appeal (the devolutive effect, see **T 473/91**, OJ 1993, 630). Hence in the case in point jurisdiction to decide on the request for re-establishment lay with the board hearing the pending appeal (see **T 191/82**, OJ 1985, 189; **T 936/90** of 22 July 1993; **T 708/08**; **T 1935/08**; **T 1426/14**).

In **T 1381/11** the board referred to **T 555/08** and held that a loss of rights due to the non-payment of renewal fees automatically terminated the appeal proceedings. The issue of whether or not an appeal was pending was therefore directly linked to a request for re-establishment of rights regarding failure to pay the renewal fee made at the appeal stage. The formalities officer should therefore have acted on behalf of the board of appeal rather than the examining division, before which the case was no longer pending. The board thus took the view that it had jurisdiction to decide over the request for re-establishment of rights according to Art. 111(1), second sentence, EPC (see also **T 649/13**).

In **T 1815/15** the appellant (patent proprietor) filed a request for re-establishment of rights with respect to the non-observation of the time limit according to R. 82(3) EPC. In line with the reasoning in **G 1/90** and by making use of the discretion provided by Art. 111(1) EPC, the board stated it would decide on the request for re-establishment of rights filed while the appeal was pending.

In **J 22/86** (OJ 1987, 280) the Legal Board stated in relation to the **failure to pay grant and printing fees** and to file translations that the examining division was in the first instance competent to decide upon such omitted act. However, in view of the special circumstances of this case, the Legal Board decided, pursuant to Art. 111(1) EPC 1973, to exercise the power of the examining division to decide upon the application for restitutio (see also **J 9/86**).

In **T 26/88** (OJ 1991, 30) the appellant failed to comply with the request (pursuant to R. 58(5) EPC 1973) to pay the printing fee and to file translations of the claims within three months of notification of the request. The board found that the circumstances of decision **J 22/86** were quite different from the case at issue and justified the exceptional exercise of the power of the examining division to decide on the application for re-establishment. In the case before the board the **opposition division's formalities officer** was responsible (see also **T 522/88**).

In **J 10/93** (OJ 1997, 91) the Legal Division not only decided on the request for recording the transfer of a patent application, for which it was competent according to Art. 20(1) EPC 1973, but also dealt with the appellants' application for re-establishment of rights which it rejected as inadmissible. Since the omitted act was the applicant's **failure to reply to a communication of the examining division** issued pursuant to Art. 96(2) EPC 1973,

the department competent to decide on the application for restitutio was the **examining division** (Art. 122(4) EPC 1973). The Legal Board set aside the decision finding that the Legal Division had exceeded its powers. It stated that this could not be justified by any need to decide on the request for restitutio as a preliminary issue to be answered before examining the request for registering the transfer.

6.2. Request for re-establishment as auxiliary request

In **J 23/96** the applicant had applied for a decision under R. 69(2) EPC 1973 (R. 112(2) EPC) and, as an **auxiliary request**, asked for re-establishment of rights. The examining division issued a brief communication saying that the request for re-establishment would be decided once the decision under R. 69(2) EPC 1973 was final, or during any ensuing appeal. The Legal Board held that the examining division had been wrong not to decide on this auxiliary request. It noted that auxiliary requests were filed in case the main request was refused; they then took its place and had to be dealt with in the **same decision**. The course taken by the examining division was at odds with procedural economy, and might also oblige the applicant to appeal twice. This amounted to a substantial procedural violation (see also **J 1/80**). The Legal Board referred the matter back, without considering the merits, for the division to decide on the two requests together, the examining division being the "competent department" within the meaning of Art. 122(4) EPC 1973.

6.3. Parties to re-establishment proceedings and the right to be heard

In **T 552/02** the board held that the response to be given to the application for re-establishment was of the utmost importance for the respondents, as it affected the actual admissibility of the appeal and hence the reviewability of the opposition division's decision to revoke the patent in suit. From this the board deduced that it would be a breach of Art. 113(1) EPC 1973 to take a decision concerning the interests not only of the appellants but also of the respondents without giving the latter an opportunity to present comments (see also **T 1561/05**).

6.4. Concurrent request for interruption of proceedings

In **J 902/87** (OJ 1988, 323) the Legal Board decided that, in accordance with R. 90 EPC 1973 (R. 142 EPC), which the EPO must apply of its own motion, the legal incapacity of an applicant or his representative has the effect of interrupting proceedings and, where appropriate, the one-year time limit referred to in Art. 122(2) EPC 1973 (now R. 136(1) EPC).

In **T 315/87** of 14 February 1989 the board stated that, in case a request for interruption was filed together with a request for re-establishment, preference should be given to the application of Art. 122 EPC 1973, under which less severe impairment could also be grounds for re-establishment of rights. The question of any interruption of proceedings under R. 90 EPC 1973 could be left open provided that all the losses of rights which had occurred could be overcome by restitutio in integrum.

In **J 9/90** the Legal Board held that for R. 90(1)(b) EPC 1973 (interruption of proceedings because of insolvency) to be applied in the light of Art. 60(3) EPC 1973 (unchanged) and R. 20(3) EPC 1973 (R. 22(3) EPC), the applicant entered in the European Patent Register and the insolvent person (here, a limited company) had to be **legally identical**. However, the fact that the persons involved were not identical did not necessarily rule out re-establishment of rights under Art. 122 EPC 1973. Someone who was only indirectly affected by an event, such as insolvency, could be "unable" within the meaning of Art. 122(1) EPC 1973. In such a case however the persons so affected had to prove that they had exercised all the due care that could have been expected of them in the circumstances of such an insolvency.

6.5. Re-establishment in the context of the President's extension of time limits during general disruption

In **T 192/84** (OJ 1985, 39) it was held that if the President of the EPO extended time limits expiring during a period of general interruption in the delivery of mail in a contracting state (R. 85(2) EPC 1973; now R. 134 EPC, reworded), a pending application for re-establishment of rights considered to have been lost during that period, which had been filed by a representative having his place of business within that state, had to be deemed to have been made without purpose ab initio, even though the non-observance of the time limit was due to causes other than the interruption in the delivery of mail. Accordingly, it could be declared that no rights were lost and the fee for re-establishment of rights could be refunded.

6.6. Redundant request for re-establishment

In **T 1198/03** the respondent (opponent) sent his reply to the appellant's statement of grounds of appeal one day late and requested that, if the board did not otherwise consider the reply, he be re-established into the time limit for filing the reply. The board decided to consider the respondent's reply. The request for re-establishment was therefore redundant.

In **T 2317/13** the board held that the re-establishment request was redundant since the delay in filing the statement of grounds of appeal had been only of minutes and the **lateness of the filing was truly minimal** (the first four pages of the statement of grounds were in fact received before the time limit expired). According to the board, the discretion given to the board by Art. 13(1) RPBA 2007 to admit and consider late-filed submissions which amended a party's previously filed written case extended to the late admission and consideration of the written case itself (see **T 1198/03**).

7. Rights of use under Article 122(5) EPC

In **J 5/79** (OJ 1980, 71) the Legal Board stated that according to Art. 122(6) EPC 1973 (Art. 122(5) EPC), third-party rights of use arose only where the restoration of rights related to an already published European patent application or a European patent; those whose commercial interests were at stake should be entitled to be sure that protection, the existence of which was public knowledge, and which had fallen into the public domain,

no longer had effect. Third party rights to continue use of an invention where an applicant's rights have been lost and restored cannot arise if the loss and restoration of the applicant's rights occur before publication of the European patent application.

8. Principle of proportionality

In **T 111/92** of 3 August 1992 the statement of grounds of appeal were filed two days late due to an error of calculation of the due date on the part of the representative. The board held that the mistake in calculating the ten-day period due to human error at a time when the person in question was under pressure was an isolated mistake in an otherwise satisfactory system. The board referred to the principle of proportionality and stated that, in accordance with general principles of law, as applied in the context of administrative law, a procedural means used to achieve a given end (e.g. a sanction following a procedural non-compliance) should be no more than that which is appropriate and necessary to achieve that end. Bearing the principle of proportionality in mind, the loss of the patent application because of the procedural irregularity which had occurred in the case at issue would be a severe result. Moreover, the interests of any third party misled within the meaning of Art. 122(6) EPC 1973 by the fact that the statement of grounds of appeal was filed two days late would be protected by Art. 122(6) EPC 1973. The board allowed thus the application for re-establishment (see also **J 22/92**, **T 869/90** of 15 March 1991, **T 635/94** of 25 April 1995, **T 804/95**, **T 27/98** of 7 May 1999).

In **J 44/92** and **J 48/92** the Legal Board noted that the principle of proportionality only applied in borderline cases, **in support of other grounds** already substantiating to a certain extent the allowance of the appeal. Usually it had been applied where a time limit had been missed by one or two days due to some miscalculation (see below). The Legal Board considered that the principle of proportionality did not assist the appellant as there had been a major system fault, which could not be excused by reliance on the principle of proportionality.

In decision **T 971/99** and **T 1070/97** the boards stated that Art. 122(1) EPC 1973 did not leave any room for the application of the principle of proportionality, so that the number of days by which a time limit had been missed was irrelevant for deciding whether all due care was applied or not. Only the character of the conduct before the time limit expires was decisive for the consideration of the issue of due care, not the length of the ensuing delay (see also **T 439/06**, OJ 2007, 491; **T 1561/05**; **T 1465/07**).

In **T 1465/07** the board interpreted Art. 122 EPC 1973 in the context of the right of access to a court taking into account the case law of the ECtHR and the European Court of Justice. The board was of the opinion that the European Court of Justice's interpretation of the general principle of proportionality could be applied to limitations of the right of access to the boards of appeal, such as rules on time limits, by legislative measures or their application. This means that those measures or their application must not exceed the limits of what is appropriate and necessary in order to attain the objectives legitimately pursued by the legislation in question; when there is a choice among several appropriate measures or ways of applying them recourse must be had to the least onerous, and the disadvantages caused must not be disproportionate to the aims pursued. As for the

application of Art. 108 EPC 1973 in conjunction with Art. 122 EPC 1973, the board stated that the principle of proportionality had the consequence that the interpretation of those provisions must not impose means that are inappropriate, unnecessary or disproportionate in relation to the aim to be achieved, namely legal certainty and the proper administration of justice by avoiding any discrimination or arbitrary treatment. Correspondingly, the **conditions for granting re-establishment**, in particular the requirement of due care, **must not be interpreted in an excessive manner** that unreasonably restricts access to the board and thus prevents the board from deciding on the merits of the case. See also **T 578/14** and **T 1022/14**.

In **J 8/09** the appellant had failed to pay a renewal fee and requested re-establishment of rights. He put forward the principle of proportionality, citing the fact that a company was already producing the system to which the application related and that the consequence of a single late payment of the renewal fee would be disproportionate. The Legal Board rejected this argument. The principle of proportionality could be defined as a duty for a court or an administration to find a balance between a party's error and the legally ensuing consequences when a margin of weighing the importance of the circumstances existed (see **J 5/97**). However, when the boards of appeal referred to the principle of proportionality in the case law, it was never as a main ground but in support of other grounds already substantiating, to a certain extent, the allowability of the appeal especially when a reliable system for managing the time limits and an isolated mistake within such a system could be assessed (see **J 44/92** and **J 48/92**).

In **J 13/11** the Legal Board stated that the time limits in the EPC aim to serve legal certainty and the proper administration of justice by avoiding any discrimination or arbitrary treatment (see also **T 1465/07**, **T 592/11**). The severe consequence of a loss of a patent application in the case at issue could not be considered in isolation but had to be assessed against the values of legal certainty and proper administration of justice that are embodied by the time limits appropriate to Art. 122 EPC. The application of the principle of proportionality would empty the time limits of Art. 122 EPC of any content and would make the provisions of this article uncertain. In addition, the boards of appeal do not have the power to apply provisions of the EPC contra legem, that is contrary to their unambiguous meaning and purpose.

9. Reimbursement of the fee for re-establishment

9.1. Legal reason for payment of fee

In **T 46/07**, the board found that, if the fee for re-establishment of rights is paid after expiry of the two-month period laid down in Art. 122(2) EPC 1973, the application for re-establishment of rights does not come into existence and therefore the fee must be refunded even without a respective request.

In **T 2454/11**, the board observed that, in earlier board decisions taken in the light of **G 1/86**, requests from an **appealing opponent** for re-establishment of rights had been regarded as "devoid of purpose" or "not validly filed" and the fee refunded (see e.g. **T 520/89**, **T 266/97**). In the case in hand the board endorsed the view taken more recently

in **T 1026/06** that the fee was not refundable. It could only be reimbursed if it had been paid for no legal reason or if a refund was required by a legislative provision. Under Art. 122(3) EPC, a request for re-establishment of rights was not deemed to be filed until the fee had been paid, so payment was required for the request to have effect. There had therefore been a legal reason for its payment and there was no provision requiring a refund.

9.2. Reimbursement where request for re-establishment found to be redundant

In both **T 1198/03** and **T 2317/13** the respective requests for re-establishment of rights were found to be redundant (see also in this chapter III.E.6.6. above for details on these cases).

In **T 1198/03**, distinguishing the case in hand from other cases where an application for re-establishment of rights was equally redundant but the boards did reimburse the corresponding fee, the board stated that, in the case in hand, restitutio was not, as a matter of principle, applicable as a remedy, and that a party should not be able to reap cost benefits from the redundancy of a restitutio request filed on an auxiliary basis. Otherwise, parties might be encouraged to file such inapplicable requests.

In **T 2317/13** the board decided to reimburse the fee for re-establishment. It compared the case with the one in **T 152/82** (OJ 1984, 301), in which the fee had been reimbursed after it became apparent that the re-establishment request would not have become effective.

9.3. Request for re-establishment due to mistakes made by EPO

In **J 7/93** the EPO did not tell the appellant to ignore its previous communications issued in connection with a time limit supposed to have been missed; this would have enabled the appellant to recognise that its request for re-establishment was unnecessary. Instead, the EPO continued the proceedings for re-establishment of rights and finally refused restitutio without taking into account the fact that these proceedings had been unnecessary from the very beginning. The Legal Board found that this amounted to a substantial procedural violation within the meaning of R. 67 EPC 1973. The Legal Board held that it was equitable to order reimbursement of the appeal fee, even though the appellant had not applied for this (**J 7/82**, OJ 1982, 391). The Legal Board held that since there was no longer any legal ground to request re-establishment of rights, the fee for re-establishment was wrongly accepted by the EPO and, therefore, had to be refunded to the appellant (confirming **J 1/80** and **T 522/88**).

In **T 971/06** as the appealed decision of the examining division did not comply with Art. 97(2) EPC 1973, it was considered invalid by the board. The examination should therefore have been re-opened without an appeal. Furthermore, the appellant was misled by the examining division for several months as to the procedure for remedying the mistake. When the examining division finally issued a communication refusing its request to correct the decision, the appellant filed an appeal, a statement of grounds of appeal and requests for re-establishment. The board considered these requests unnecessary, but an

understandable reaction. It found that the fees paid in respect of these requests had to be refunded.

9.4. Reimbursement where more than one fee for re-establishment has been paid

In **T 315/87** of 14 February 1989, the appellant's former representative had paid two fees for re-establishment of rights, one in respect of the time limit for filing notice of appeal and the other in respect of the time limit for filing the statement of grounds. The board, however, considered that the case involved a single event because the two time limits had been missed for the same reason and therefore held that one of the fees had to be reimbursed.

In **T 2017/12** (OJ 2014, A76) the appellant had missed the time limits for filing the appeal and the statement of grounds of appeal. It had **paid the fee** for re-establishment of rights **twice**, once for each missed time limit. The board refused the request for refund of one of the fees. In line with decision **J 26/95**, the board considered that the corresponding time limits expired independently of one another, notwithstanding the fact that they were triggered by the same event. Consequently, two fees for re-establishment were indeed due and hence a refund of one of those fees was not possible.

See also in this chapter III.E.4.5. "Number of re-establishment fees due where more than one time limit is missed".

F. Languages

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The central provisions of the language regime of the EPC are to be found in Art. 14 EPC and R. 3 to 7 EPC.

Attention is also drawn to the Guidelines, A-VII and E-V – April 2025 version.

1. Language of filing and date of filing of a European patent application

Art. 14(2) EPC requires that a European patent application is filed in one of the official languages of the EPO – i.e. English, French or German (Art. 14(1) EPC) – or, if filed in any other language, translated into one of the official languages. It is therefore possible to file an application in any language, in compliance with Art. 5 PLT, which states that, for the purpose of obtaining a filing date, a description of the invention in a language of the applicant's choice must be accepted (see also R. 40(1)(c) EPC). If a required translation is not filed in due time (see R. 6(1), 36(2), 40(3), 57(a), 58 EPC), the application shall be deemed to be withdrawn (Art. 14(2) EPC; cf. Art. 90(3) EPC 1973 and **J 18/01**).

Under the former law, a European patent application could only be filed in an official EPO language (Art. 14(1) EPC 1973) or, by persons benefiting from the "language privilege", in an official language of a contracting state other than English, French or German ("admissible non-EPO language"), with a translation to be filed in an official EPO language (Art. 14(2) EPC 1973; see also **J 15/98**, OJ 2001, 183; **J 6/05** and **J 9/01**). To be accorded a date of filing, an application had to contain one or more claims, in addition to a description, in one of the languages referred to in Art. 14(1) and (2) EPC 1973 (Art. 80(d) EPC 1973; see also **J 18/96**, OJ 1998, 403 and **J 22/03**). For the current scope of the "language privilege" see Art. 14(4) EPC and R. 7a and 7b EPC and also in this chapter III.F.4.

In **J 7/80** (OJ 1981, 137) the Legal Board held that where documents making up an application were partly in an official language of the EPO, and partly in another language which was an official language of a contracting state, then, for the purposes of deciding whether the application complied with Art. 14(1) or (2) EPC 1973, in accordance with Art. 80(d) EPC 1973, the significant language was that used for the description and claims.

Other documents making up the application should normally be corrected by translation into that language.

In **T 382/94** (OJ 1998, 24) the board held that if the drawings were filed in full on the date of filing, they formed part of the application as filed, even if they contained text matter in an official language other than the language of the proceedings. There was nothing to prevent the application being amended on the basis of a translation of this text matter into the language of the proceedings.

For a case concerning an application which was filed as a European divisional application but not in the language of the proceedings of the earlier application (cf. R. 36(2), first sentence, EPC), see **J 13/14**, reported in chapter II.F.3.3.

2. Language of the proceedings

The official language in which the application is filed or into which it is translated is the language of the proceedings in all proceedings before the Office, unless the Implementing Regulations provide otherwise (Art. 14(3) EPC).

In **G 4/08** (OJ 2010, 572) the Enlarged Board ruled that if an international application has been filed and published under the PCT in one official language of the EPO, it is not possible, on entry into the European phase, to file a translation of the application into one of the other two EPO official languages.

3. Derogations from the language of the proceedings in written proceedings and in oral proceedings

Under R. 3(1) EPC (R. 1(1) EPC 1973) any party may use any EPO official language in written proceedings.

In **T 706/91** the appeal had been drawn up in accordance with R. 1(1) EPC 1973 in one of the official languages, namely German. The appellant had therefore cited passages from the disputed European patent's claims and description in that language, even though they had been drawn up in French as the language of the proceedings. The board decided that these references were admissible.

In **G 4/08** (OJ 2010, 572) the Enlarged Board clarified that EPO departments cannot use, in written proceedings on a European patent application or an international application in the regional phase, an EPO official language other than the language of the proceedings used for the application under Art. 14(3) EPC (thereby overruling **J 18/90**, OJ 1992, 511). Referring to the principle that proceedings before the EPO are to be conducted in a single language (**G 4/08**), the board in **T 1787/16** observed that only the language of the proceedings was to be used for the written decision. Only a decision in that single language of proceedings was in keeping with the R. 111(2) EPC requirements as to reasoning. R. 4(1) EPC (cf. R. 2(1) EPC 1973) allows any party to oral proceedings to use an official language of the EPO other than the language of the proceedings, provided he either gives the EPO at least one month's notice or arranges for interpreting into the language of the

proceedings. Under R. 4(5) EPC the EPO must, if necessary, provide at its own expense interpretation into the language of the proceedings, or, where appropriate, into its other official languages, unless such interpretation is the responsibility of one of the parties.

In **T 34/90** (OJ 1992, 454) the board reiterated the principle that appeal proceedings are not a mere continuation of first-instance proceedings, but are, for the purpose of deciding the permissibility of using an alternative official language under R. 2(1) EPC 1973 (R. 4(1) EPC), as for other procedural purposes, wholly separate and independent from those. Accordingly, it rejected the respondent's attempt to use the other official language already used by it in the oral proceedings before the opposition division, without fulfilling the requirements of R. 2(1) EPC 1973 as they applied to the pending appeal proceedings.

See also the communication from the Vice-President of DG 3, OJ SE 3/2007, 118.

In **T 774/05** the board stated that R. 2(1) EPC 1973 (R. 4(1) EPC) implied that a party could choose to use one of the official languages set out in Art. 14(1) EPC 1973 and was entitled to speak and hear that language. However, a party had to be clear as to which official language it wished to use. The party then had a right to both speak and hear in that language, so long as the conditions of R. 2(1) EPC 1973 were fulfilled. The party did not, however, have a right to have a language in which it would speak and a different language in which it would listen.

In **T 418/07** the respondent announced that it would use German at the oral proceedings (language of the proceedings being English) and requested the board to provide translation from German into English for the benefit of one of its employees who would attend the oral proceedings and who did not speak German. The board stated that a party's right to interpreting from either of the two other official languages was circumscribed by R. 4 EPC. A party which elected to use a language which was not understood by one of its own representatives or employees could not for that reason request a free translation. The board could not provide translation merely to suit the convenience of a party.

In **T 2422/10** the board rejected the respondent's argument that it had an absolute right to interpreting into English as the language of the proceedings. The general rule needed to be set against the principle of efficiency of the proceedings and the duty of all services of the EPO, including the boards of appeal, to observe the finances of the EPO. The wording of R. 4(5) EPC allowed the board to assess the necessity of such interpreting (cf. **T 131/07**). It was evident that the respondent's representative was quite capable of understanding any oral submissions of the appellant in German without interpretation. See also **T 2696/16**.

In **T 1895/13** the appellant complained that the oral proceedings at first instance had been held without interpreters although it had requested simultaneous translation in time. It argued that the examining division had no discretion to refuse interpretation in such a situation (R. 4(1) EPC) and had also infringed the appellant's right to be heard (Art. 113(1) EPC).The board referred to case **T 2249/13**, concerning a comparable situation, in which the board had stated in its communication that even if a procedural violation might have occurred, it did not appear to have substantially affected the

appellant's right to be heard, and that the appellant had addressed only hypothetical problems that might occur in general if the right to exchange arguments in a desired language was restricted. The current board added that indicating a potential problem did not mean that the problem had actually occurred. The burden of proof lay with the appellant, who had not satisfied its obligation to submit facts allowing an assessment of whether there had been a substantial violation of rights.

In **T 2109/15**, the board pointed out that the EPC did not impose any requirements as regards a party's hiring of interpreters beyond those in R. 4(1) and (5) EPC and, in particular, did not contain any provision requiring that the parties agree on the choice of interpreter. According to the opponent, it had hired professional interpreters regularly working at oral proceedings before the EPO. The board could see no reason to doubt that the oral proceedings had been conducted fairly and that the parties' right to be heard had been observed.

In **T 2422/10** (see above) the respondent was also accompanied by an expert, whom the board decided not to hear following the criteria of **G 4/95** (OJ 1996, 412). In these circumstances the board considered that interpretation into English for the expert at the expense of the EPO would not be justified. Accompanying persons did not have an automatic right to it.

The matter of the language arrangements in oral proceedings in relation to an accompanying person also arose in **T 131/07** and **R 3/08** (for the latter see chapter V.B.4.3.20).

For a case which concerns the discretion given to the EPO under R. 4(1), last sentence, EPC to derogate from the provisions of this Rule, see **T 982/08**.On the costs of interpreting in oral proceedings see also chapter III.C.9.2. and **T 2109/15**.

4. Language privilege

According to Art. 14(4) EPC, natural or legal persons having their residence or principal place of business within the territory of a contracting state having a language other than English, French or German as an official language, and nationals of that state who are resident abroad, may file documents which have to be submitted within a given time limit in an official language of that state (these languages are sometimes referred to as "admissible non-EPO languages"). A translation in an official EPO language must also be filed (see R. 6(2) EPC). The scope of the fee reductions available in respect of documents filed in accordance with Art. 14(4) EPC has been amended with effect from 1 April 2024 (see in this chapter III.F.6.). For the language provisions with respect to the filing of the European patent application itself, see in this chapter III.F.1.

The board in **T 149/85** (OJ 1986, 103) decided that it is inadmissible for a German opponent to file an opposition in Dutch even if represented by a Dutch patent attorney.

In **T 1152/05** the notice of appeal was filed in Dutch by a company which had its principal place of business in the US and thus could not benefit from the provisions of

Art. 14(4) EPC. A translation into French was filed on the same day. The notice of appeal was deemed not to have been filed. Following **G 6/91** (OJ 1992, 491), if the translation was filed at the same time as the original, the EPO could not take it as the "official" notice of appeal and ignore the original as superfluous. See also **T 41/09**.

5. Translations

Concerning the filing of a required translation of a European patent application, see this chapter III.F.1.

Under Art. 14(4) EPC, if any required translation of a document filed in accordance with that provision is not supplied in due time (see R. 6(2) EPC), the document is deemed not to have been filed (cf. Art. 14(5) EPC 1973).

In **T 323/87** (OJ 1989, 343), the translation of the notice of appeal required under Art. 14(4) EPC 1973 was not filed in due time in accordance with R. 6(2) EPC 1973. The notice of appeal was therefore deemed not to have been received (Art. 14(5) EPC 1973), and the appeal was held not to have been filed. See also **T 193/87** (OJ 1993, 207), which concerned a notice of opposition.

However, in **T 126/04** the board did not follow **T 323/87** with respect to the legal consequence of failure to comply with the time limit. It held that the only possible interpretation of the reference in R. 65(1) EPC 1973 to R. 1(1) EPC 1973, which itself referred to Art. 14(4) EPC 1973, was that R. 65(1) EPC 1973 determined the legal consequence of failure to file a translation of the notice of appeal as required by Art. 14(4) EPC 1973. The legal consequence was therefore the **inadmissibility of the appeal**. It was not a case of conflict within the meaning of Art. 164(2) EPC 1973, since R. 65(1) EPC 1973 was a lex specialis. The provisions of R. 65(1) EPC 1973 are now to be found in R. 101(1) EPC, which does not refer to R. 3(1) EPC, the equivalent to R. 1(1) EPC 1973.

In **T 170/83** (OJ 1984, 605) a debit order was filed in error in Dutch. The board held that Art. 14 EPC 1973 did not apply – a debit order did not have to contain text in a language at all, whilst remaining quite clear. The question whether a debit order in a non-official language was effective therefore did not arise.

In **T 700/05**, the board found that, taking into account that Euro-PCT applications were deemed by Art. 153(2) EPC to be European applications and the principle that they thus had to be treated as favourably as applications made in a contracting state, a PCT application originally filed in Japanese had to be treated in the same way as an application filed in the language of a contracting state which was not an official language of the EPC. Art. 14(2) EPC 1973 had thus to be applied by analogy to allow also the translation into English of an original PCT application in Japanese to be brought into conformity with the original Japanese text of the application throughout the proceedings before the EPO, i.e. including opposition and appeal proceedings. See also **T 1483/10**, **T 2410/11**, **T 2202/19**.

Shortly before the oral proceedings before the board in case **T 265/11**, the appellant (opponent) filed an uncertified translation of the claims of the international application underlying the patent. It argued that it was evident from this translation that certain features were different in the originally filed claims with respect to the English translation filed on entry into the European phase (Art. 158(2) EPC 1973), and requested that the newly filed translation be used as a basis for the analysis under Art. 123(2) EPC. The board affirmed that an international application for which the EPO is a designated or elected Office, and which has been accorded an international date of filing, is equivalent to a regular European application (Art. 150(3) EPC 1973; now Art. 153(2) EPC). R. 7 EPC 1973 applied mutatis mutandis to the translation filed under Art. 158(2) EPC 1973. As no evidence had been provided that the translation already on file was not in conformity with the original text of the application, the board, in accordance with R. 7 EPC 1973, assumed that translation to be in conformity with the original text of the application for the aforementioned purpose.

In **T 1332/12**, the board applied the same reasoning to admit a corrected (machine) translation, submitted by the patent proprietor, of a Japanese prior art document which the opposing party had filed along with a – now contested – translation, as evidence of lack of inventive step. As to the provision of a translation of a crucial prior art document in examination proceedings, see **T 1343/12** and **T 655/13**.

Concerning translation points in relation to amendments see chapter II.E.1.2.3.

6. Language-related fee reductions

Under R. 7a and 7b EPC (as in force from 1 April 2024 – see decision of the Administrative Council of 14 December 2023, OJ 2024, A3) certain categories of applicants fulfilling the requirements of Art. 14(4) EPC are eligible for a fee reduction when filing a European patent application or request for examination (see also notice from the EPO of 25 January 2024, OJ 2024, A8). Only one of multiple such applicants need fulfil the Art. 14(4) EPC requirements (**J 4/18**) (see R. 7a(5) EPC, formerly R. 6(7) EPC). A corresponding language-related fee reduction is no longer available for oppositions, appeals, requests for limitation or for revocation, or petitions for review (for earlier decisions concerning the former reduction of the opposition and appeal fees, see CLB, 7th edn. 2013, III.F.5).

In **G 6/91** (OJ 1992, 491) the Enlarged Board ruled that the persons concerned were only entitled to the fee reduction under R. 6(3) EPC 1973 if they filed the **essential item of the first act** in filing, examination, opposition or appeal proceedings (note: the last two cases are no longer relevant – see previous paragraph) in an official language of the state concerned other than English, French or German, and supplied the necessary translation **no earlier than simultaneously** with the original. According to **T 905/90** (OJ 1994, 306, Corr. 556), neither a request for a fee reduction, nor a notification that only a reduced fee had been paid, was an essential part of the first act of the relevant proceedings (see also **J 4/88**, OJ 1989, 483).

6.1. European patent application

Under the EPC 1973, an application could be filed in an official EPO language (Art. 14(1) EPC 1973) or, by persons benefiting from the "language privilege", in an official language of a contracting state other than English, French or German (Art. 14(2) EPC 1973).

According to **J 4/88** (OJ 1989, 483, see headnote), for the purposes of Art. 14(2) EPC 1973 and R. 6(3) EPC 1973 it was sufficient if the description and claims were filed in an official language of a contracting state other than English, French or German; it was not significant for this purpose that other parts of the European patent application were filed in one of the official languages of the EPO only (further to **J 7/80**, OJ 1981, 137 – see in this chapter III.F.1.). If the applicant availed himself of the option provided in Art. 14(2) EPC 1973 both the filing fee and the examination fee were reduced (R. 6(3) EPC 1973).

6.2. Request for examination

J 4/88 (OJ 1989, 483) (see in this chapter III.F.6.1.) deals with the reduction of both the filing fee and the examination fee.

In **J 21/98** (OJ 2000, 406) the applicant, who had filed a request for examination in Italian within the time limit of Art. 94(2) EPC 1973 (see now R. 70(1) EPC), and simultaneously an English translation, had been refused the reduction in the examination fee. According to the Receiving Section, the written request for examination in Italian should have been filed together with the request for grant. However, according to the board, Art. 94(2) EPC 1973, in conjunction with Art. 75, 92 94(1) , was to be interpreted such that, within the grant procedure, the request for examination constituted an **autonomous step** quite separate from the (previous) step of filing the patent application, enabling the applicant to consider whether to continue the grant procedure in the light of the search report. Since the EPC 1973 gave the applicant the right to file the request for examination after the publication of the search report, it followed that the same right had to be owed to the applicant who wanted to avail himself of the option provided for in Art. 14(2) and (4) EPC 1973 (see also **J 22/98**, **J 6/99**, **J 14/99** and **J 15/99**).

In **J 36/03** the board held that the examination fee should be reduced if the request for examination was filed in an authorised non-official language, even in cases where the **application was transferred, before the examination fee was paid**, to an applicant who was not one of the persons referred to in Art. 14(2) EPC 1973.

J 4/18 concerned the application of the examination fee reduction (R. 7a and 7b EPC, formerly R. 6(3)–(7) EPC, Art. 14(1) RFees) to multiple applicants (see also in this chapter III.F.6.).

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1. Introduction

The main provisions governing evidence, the means and taking of evidence and the conservation of evidence are Art. 117, 131(2) EPC, R. 117 EPC (R. 117 and 118 EPC were amended by decision CA/D 12/20 of the Administrative Council of 15 December 2020, OJ 2020, A132, which entered into force on 1 January 2021) to 124 EPC (the last rule as amended by decision CA/D 6/14 of the Administrative Council (OJ 2015, A17), which entered into force on 1 April 2015) and R. 150 EPC. Rule 117 and 118 EPC as amended in 2020 relate to means of taking evidence by videoconference (decision **T 423/22** dealt explicitly with a witness hearing by videoconference before the opposition division – more recently **T 1604/22**, witness hearing and visual inspection of a

CD); compare with new Art. 15a RPBA, which entered into force in 2021 (OJ 2021, A19), and **G 1/21** of 16 July 2021 (OJ 2022, A49).

In the revised EPC 2000, the content of Art. 117(2) to (6) EPC 1973 was rephrased in the new Art. 117(2) EPC. The procedural aspects concerning the taking of evidence were transferred to the Implementing Regulations (see OJ SE 5/2007, Part II, pp. 176-192). Furthermore, the revised Art. 117(1) EPC no longer lists the EPO departments which may take evidence; it now includes a general reference to "proceedings before the European Patent Office".

Article 117 EPC, entitled "Means and taking of evidence", provides for the submission of evidence before all EPO departments, including the Receiving Section, examining divisions, opposition divisions, the Legal Division and the boards of appeal.

Beyond the letter of the EPC, the boards of appeal have addressed multiple issues of admissibility and taking of evidence in their case law. In addition, they have elaborated specific principles governing the evaluation of evidence and the allocation of the burden of proof in order to ensure that EPO proceedings are conducted in a fair and consistent manner.

Decisions **G 2/21** (OJ 2023, A85) and **T 1138/20** summarise and confirm these principles established by the boards' case law as applying to the handling of evidence in both first-instance and appeal proceedings before the EPO, setting them out much more clearly than ever before.

G 2/21 (OJ 2023, A85) includes detailed findings on the principle of free evaluation of evidence (in particular in points 27 to 46, 55 and 56 of the Reasons) and also confirms that submitted evidence **may not be disregarded solely on the ground** that such evidence had not been public before the filing date of the patent in suit and was **filed after** that date (point 56 of the Reasons).

T 1138/20, which cites **G 2/21**, is devoted almost entirely to matters of evidence and elaborates on a number of concepts and the interplay between them. These include the applicable standard of proof, the principle of free evaluation of evidence and its consequences, the reviewing findings of facts on appeal, the scope of reasoning, the burden of proof on appeal and the extent of the boards' powers. **T 1138/20** also clearly lays out certain principles, with the main findings being recapitulated in the Catchword.

As **G 2/21** and **T 1138/20** are therefore reported extensively in this chapter, it is worthwhile reading the decisions issued in those in full.

However, this introduction also covers a number of principles deriving above all from older other decisions of the boards.

In **T 2037/18** the board explained that in most legal systems and in proceedings before the EPO (beyond the area open to examination by the EPO of its own motion), the **burden of presentation and the burden of proof** were allocated such that each party had to

present and prove the facts that were favourable to them, i.e. the facts that supported their own assertions (**T 219/83**, **T 270/90**). According to the board, the principle of "*negativa non sunt probanda*", recognised in the boards' case law (see **R 15/11**, **R 4/17**), was a clear expression of this allocation of the burden of proof. In other words, a party to the proceedings was not required to prove a negative fact, but rather it was incumbent on the opposing side to prove any positive fact favourable to them. As a general rule, the burden of presentation followed the burden of proof. See also **T 1076/21**.

In accordance with the principle of free evaluation of evidence, any kind of evidence, regardless of its nature, is admissible (**T 482/89**, OJ 1992, 646). Parties can freely choose the evidence they wish to submit – the kinds listed in Art. 117(1) EPC are merely examples (**T 543/95**, **T 142/97**, OJ 2000, 358). This principle of free evaluation of evidence was reaffirmed in **G 2/21**, points 40 and 41 of the Reasons, while the freedom to produce evidence of one's own choosing was reiterated in **T 1138/20** (points 1.3.4(a) and (b) of the Reasons).

That proceedings before the EPO are conducted in accordance with the **principle of free evaluation of evidence** was reiterated by the Enlarged Board (**G 1/12**, OJ 2014, A114, and confirmed and elaborated on in **G 2/21**, OJ 2023, A85, points 27 to 46 of the Reasons).

Article 117(1) and 113(1) EPC embody a basic procedural right, viz. the right to give evidence in appropriate form and the **right to have that evidence heard** (**T 1110/03**, OJ 2005, 302). A decision should discuss the facts, evidence and arguments which are essential to the decision in detail (see for example **T 278/00**, OJ 2003, 546, in chapter III.K.3.4.4 b)). This too was reaffirmed in **G 2/21**, points 41 and 42 of the Reasons, and similarly recapitulated in **T 1738/21**, point 2.1.11 of the Reasons.

Whether or not a fact can be regarded as proven has to be assessed by the department hearing the case having taken all the relevant evidence into consideration (**T 474/04**, OJ 2006, 129 and **T 545/08** citing **G 3/97**, OJ 1999, 245, point 5 of the Reasons; as reiterated in **G 2/21**, in particular points 30-32, 34 of the Reasons, and even more recently in **T 1138/20**, point 1.2.2 of the Reasons and the Catchword). As with any other findings of a deciding body, a finding of fact must be reasoned (**T 1138/20**, with reference to **G 2/21**, point 31 of the Reasons). This is particularly important if there was contradictory evidence on file. Then, the process of weighing the different pieces of evidence must be properly reflected in the reasoning of the final decision (**T 1138/20**, point 1.2.3 of the Reasons – on the scope of the required reasoning, see also the findings on a "plausible alternative" in points 1.3.4(c) and 1.3.8 of the Reasons and on the duty to provide reasons in point 1.2.6 of the Reasons). Likewise on the scope of the reasoning, see **G 2/21** (points 31 and 41 of the Reasons) and **T 42/19** (point 3.5 of the Reasons); on refusing an offer of evidence, see **T 1647/15** and **T 1738/21**.

If the evidence offered as proof of contested facts essential to the settlement of the dispute is decisive, the department hearing the case must, as a rule, **order that it be taken** (**T 474/04**, OJ 2006, 129; about witnesses, see also **T 2659/17**). All appropriate offers of

evidence made by the parties should be taken up (**T 329/02**). See also **G 2/21**, point 32 of the Reasons.

The principle of unfettered consideration of the evidence does not apply until after it has been taken and cannot be used to justify not taking evidence offered (**T 2238/15**, alleged prior use – offer of witnesses; see also the principles laid down in **T 1363/14**). This principle was reaffirmed in **G 2/21**, points 44 and 56 of the Reasons.

As regards the handling on appeal of evidence that was admitted in the first-instance proceedings, the EPC does not provide a legal basis for excluding, in appeal proceedings, documents which were correctly admitted into the first-instance proceedings, in particular when the impugned decision is based on them (**T 1201/14**, **T 26/13**, **T 931/14**, **T 564/12**; see also **T 95/07**, point 4.2.12 of the Reasons, **T 1277/12** of 7 April 2017, and more recently **T 110/18**, **T 617/16**, **T 3234/19**, **T 487/16** (with reference to the RPBA 2007 and the RPBA (2020)), **T 1884/19**, **T 2049/16**, with detailed reasons (cited more recently in **T 1983/19**, which took the same approach), **T 1634/17**, **T 1738/21** (and decisions cited there) **T 1604/22** (similar case to **T 479/22**), **T 205/22**, detailed, confirms the lack of legal basis, for the issue in general, see in particular chapter V.A.3.4.3 "Submissions admitted at first instance are part of the appeal proceedings"). Compare with the nuanced approach taken recently in **T 960/15** (cited in **T 2035/16, T 2742/18** and **T 1193/21**; not followed in **T 1206/19**; case **T 960/15** considered to be of no assistance in **T 2036/22** since the document at issue in **T 960/15** was not actually excluded). And on the question of the admissibility of evidence submitted by the intervener, including the reintroduction of certain evidence originally submitted by a party but not admitted as late, see **T 2951/18**.

T 1138/20 ("Reviewing findings of fact") clarified that the boards have the **power, at any stage** of the appeal proceedings, **to establish the relevant facts** of the case before them and thereby substitute the findings of fact made by the departments of first instance. However, the boards have no obligation to establish **de novo** facts already established by the departments of first instance (**T 1138/20**, Catchword 2 and point 1.2.4 of the Reasons, which refers to **T 42/19**). The review of findings of fact simply has nothing to do with the review of discretionary decisions. Discretionary decisions can only be reviewed for a particular type of error (**G 7/93**, point 2.6 of the Reasons), while a review of findings of fact has no such limitation (**T 1138/20**, point 1.2.4 of the Reasons). In this chapter III.G.4.2.2b), **reviewing findings of fact** is dealt with in the context of witnesses, but it is also relevant for **documents** (see, inter alia, **T 1138/20**, point 1.2.4(c) of the Reasons).

As for the **standard of proof**, the EPO generally applies the "balance of probabilities" (see **J 20/85**, OJ 1987, 102, point 4 of the Reasons). The balance of probabilities standard is met if, after evaluating the evidence, the boards are persuaded one way or the other (**T 286/10**). However, especially in cases where only one party – the opponent – had access to information about an alleged public prior use, the case law has tended toward expecting that the public prior use be proved beyond any reasonable doubt or "up to the hilt" (see e.g. **T 55/01**, point 4.1 of the Reasons; and **T 472/92**, OJ 1998, 161, point 3.1 of the Reasons; **T 2451/13**, Catchword). A summary of the case law concerning the standard of proof can be found e.g. in the following cases: **T 738/04**, point 3.4 of the Reasons; **T 286/10**, point 2.2 of the Reasons; **T 918/11**, point 3.3 of the Reasons; **T 2054/11**,

points 2.2 and 2.3 of the Reasons; **T 2227/11**, point 2 of the Reasons; **T 274/12**, point 4.2.1 of the Reasons; **T 202/13**, point 15.6.1 of the Reasons; **T 2451/13**, point 3.2 of the Reasons; **T 545/08**, points 7-11 of the Reasons; **T 832/22** (point 3.2 of the Reasons).

More recently, the board in **T 1138/20**, having considered the past case law, clearly stated that there was **only one standard of proof** in the proceedings before the EPO: the deciding body, taking into account the circumstances of the case and the relevant evidence before it, had to be **convinced** that the alleged fact had occurred. If only the opponent had had access to the relevant evidence, this fact had to be given due consideration in the deciding body's assessment as to what weight and importance to attach to such evidence. According to the board in **T 1138/20**, this was not the same as saying that a different standard of proof should apply. See also **T 832/22**, even more recent, which looked at the meaning of standards, reaffirming the importance of the deciding body's conviction with particular reference to **T 1138/20**, and in which the board stated that "beyond reasonable doubt" did not require absolute certainty and that if this higher standard was met, which standard applied could be left open.

The standard of proof for **internet citations** seems to have been established by the decisions in **T 286/10** and **T 2227/11**, which were endorsed in **T 1711/11**, **T 353/14** and **T 545/08**. The appropriate standard of proof for internet citations is the **"balance of probabilities"**. The conclusion reached in the earlier decision **T 1134/06** (followed by **T 19/05** and **T 1875/06**) that the stricter standard of proof "beyond reasonable doubt" had to be applied to internet disclosures has been refuted.

Examining the evidence a board took into account would amount to revisiting the substance of the case and so falls outside the ambit of the review procedure (**R 21/09**, **R 6/12**). A reversal of the burden of proof is not covered by the exhaustive list of possible grounds for a petition for review (**R 21/10**).

Rule 3(3) EPC provides that documentary evidence may be filed in any language. The EPO may, however, require that a translation in one of its official languages be filed within a specified period. If the required translation is not filed in due time, the EPO may disregard the document in question, as for example in **T 276/07** (see **T 2437/13** for another example). The language to be used for taking evidence and writing the minutes is governed by Art. 14(3) EPC (language of the proceedings) and R. 4 EPC (derogations from the provisions on use of the language of the proceedings in oral proceedings) (Guidelines E-IV, 1.3 "Taking of evidence" – April 2025 version; chapter III.F.2. "Language of the proceedings"). Compare with **T 1787/16**, which touches upon the language of the proceedings and the wording of decisions in its detailed reasons while also making a number of references to the language of evidence.

Lastly, see **T 2165/18** for a case involving a – highly unusual – request for a transcription of a witness's testimony in the language he had spoken (Polish), the minutes of the hearing being in the language of the proceedings (French). The board refused the request for transcription – and a request for correction of the minutes – as unfounded.

Cross-references: evidential matters permeate all aspects of patent law; it is thus recommended to refer also to the following chapters, which deal specifically with these matters: I.C.2.8.5 "Proof of common general knowledge"; I.C.3.2.2 "Lectures and oral disclosure"; I.C.3.2.3 "Internet disclosures"; I.C.3.5. "Evidence"; I.C.3.5.1 "Burden of proof"; I.C.3.5.2 "Standard of proof"; I.C.3.5.2c) "Internet – proof of the date of availability"; I.D.4.3. "Solving the technical problem"; II.A.2.2.2 "Burden of proof"; II.C.6.6.7 "Experiments"; II.C.6.8 "Post-published documents"; II.C.9. "Evidence"; II.D.2.4. "Rebuttable presumption of entitlement to claim priority"; II.E.5. "Evidence and standard of proof for allowing amendments and corrections"; III.A.2.3. "Causal link and the requirement of proof"; III.B.2.4. "Surprising grounds or evidence"; III.B.2.5. "Consideration of the parties' arguments, submissions and evidence"; III.B.2.5.5 "Failure to consider evidence"; III.B.2.7.4 "Hearing witnesses"; III.B.2.8.1 "Facts and evidence put forward for the first time during oral proceedings"; III.C.7.3. "Final date for written submissions in the preparation for oral proceedings and late submission of new facts and evidence – Rule 116 EPC"; III.E.4.4. "Substantiation of the request for re-establishment"; III.O.2.6. "Evidence for and effect of a transfer"; III.O.2.6.2 "What kind of evidence suffices"; IV.B.2.6.5 "Fresh argument based on grounds and evidence communicated beforehand"; IV.C.2.2.8 "Substantiation of grounds for opposition: indication of facts, evidence and arguments"; IV.C.2.2.8i) "Alleged public prior use"; IV.C.3.4.5 "Examination of fresh facts and evidence related to a fresh ground"; IV.C.4.6.2 "No legal basis for disregarding late-filed arguments in opposition proceedings"; V.A.4.4.6a)(xi) "Public prior use"; V.A.4.5.5 "Admittance of new facts, objections, arguments and evidence"; V.A.9.8. "Remittal for hearing of witnesses"; V.B.3.7.5 "Minutes as evidence that the objection was raised". See also Guidelines E-IV "Taking and conservation of evidence" – April 2025 version.

2. Admissible evidence

2.1. Non-exhaustive list of admissible means of evidence

Article 117(1) EPC does not contain an exhaustive list of admissible evidence, only mere examples. Parties to the proceedings are thus free in their choice of evidence. **Any kind of evidence** is admissible during proceedings before the EPO (**T 482/89**, OJ 1992, 646). Recently confirmed again in **G 2/21** (OJ 2023, A85), point 40 of the Reasons.

The EPC does not provide that certain questions of fact may only be proved by certain forms of evidence. Questions of fact must be settled on the basis of any credible information available (see e.g. **J 11/88**, OJ 1989, 433).

In **T 1199/22** the patent proprietor had requested that the opponents be ordered to provide the patent proprietor with samples for measurement. Concerning this request for provision of evidence, the board found correct the finding of the opposition division that there was no legal basis in the EPC for such orders. The board specified that no legal basis could derive solely from the fact that Art. 117(1) EPC did not contain an exhaustive list of means of giving or obtaining evidence.

2.2. Distinction between the admissibility of evidence and its probative value

The admissibility of evidence should be clearly **distinguished** from the weight of evidence: whereas admissibility involves the question whether a piece of evidence should be considered at all, the probative value of evidence refers to the question whether the evidence to be considered provides sufficient proof of the alleged facts (see e.g. **T 1698/08** with regard to a document, **T 1363/14** and **T 838/92** with regard to witnesses).

The principle of free evaluation of evidence applies only once evidence has been taken and cannot be used to justify not taking evidence offered (**T 2238/15**) – confirmed by **G 2/21**, points 44 and 56 of the Reasons (with reference to **T 1363/14** and **T 2238/15**).

Assessing the evidence is part of the process of ascertaining whether the opposition is well founded in substance (**T 234/86**; along the same lines **T 353/06**, **T 1194/07**). No EPC provision requires that an alleged prior use must actually be proven within the opposition period in order to substantiate the allegation (**T 1363/14**, **T 2238/15**).

The allegation that a witness might be biased does not itself render the testimony inadmissible; rather, suspicion of bias is a matter to be considered during the evaluation of evidence (**T 838/92**).

In **T 104/23** the appellant (patent proprietor) submitted that the opponent had spoken with the witness just before the witness was heard, ignoring the instructions of the opposition division to refrain from doing so. The board was not aware of any procedural rule that would require a division or a board to reject evidence out of hand because instructions were not properly complied with. Neither did there seem to exist a basis for a bar to using a witness statement under these circumstances. The correct approach in these circumstances appeared to the board to be to consider the witness's disregard of the division's instructions in the evaluation of evidence, namely the witness's credibility. Contact between the opponent and witness during an interruption of oral proceedings might potentially raise doubts about the witness's impartiality and therefore diminish the probative value of their testimony. However, these were merely factors to consider when assessing the witness's credibility, especially considering the – undisputed – link between the witness and the opponent.

In **T 2892/19** the appellant (patent proprietor) alleged that K was an unreliable witness because they had an interest in the invalidation of the patent and was involved in criminal proceedings. The board considered that the considerations about K's status and interests had to be considered in the evaluation of the submitted evidence; such considerations did not render evidence or witness statements automatically inadmissible or unreliable in proceedings before the EPO. Rather, it is not exceptional in opposition proceedings that a piece of evidence or a witness statement stems from an interested person or even a party to the proceedings.

The board in **T 885/02** observed that the opinion of an expert does not necessarily reflect the view of the skilled reader for various reasons. Those **experts** who were in the case at issue **eminent scientists** had their own experience which was not necessarily common

general knowledge. Those observations did not mean that those declarations were to be disregarded.

In **T 1551/14** after the first oral proceedings the patent proprietor had filed a new auxiliary request in which the subject-matter of the two independent claims had been limited by a new feature. After the summons to a second round of oral proceedings, and within the period fixed under R. 116 EPC, the opponent had filed a statutory declaration from a witness who had already been heard and that this witness be heard again. Among other things, the board held that not even **contradictions with previous submissions** – which it did see in the case in hand – could justify refusing from the outset to admit submissions that were a legitimate reaction to a change in the counterparty's case.

2.3. Freedom of choice when selecting evidence

In accordance with the principle of free evaluation of evidence, any kind of evidence, regardless of its nature, is admissible (see **T 482/89** and **T 558/95**). Under Art. 117(1) EPC, parties are free to choose what kind of evidence they present. In particular, they can make use of any of the means of evidence listed in that article (see **T 543/95** and **T 142/97**, OJ 2000, 358); principle summarised in **G 2/21** (OJ 2023, A85), point 40 of the Reasons – in relation with the right to be heard and that a decision should discuss the facts, evidence and arguments which are essential to the decision in detail (point 41 of the Reasons).

In **T 1710/12**, in the board's view, Art. 117(1) EPC gives **no order of preference** regarding the means of giving or obtaining evidence in proceedings before the EPO and it remains the **free choice of a party** to rely on the hearing of a witness (Art. 117(1)(d) EPC) or on production of a sworn statement in writing (Art. 117(1)(g) EPC). For other findings that witness testimony does not necessarily carry less weight than documentary evidence, see also **T 918/11**, **T 2565/11** and **T 441/04** (in which, however, the board first observed that documentary evidence was generally preferable to witness testimony for proving long-ago events).

Contrary to the appellant's (patent proprietor's) allegation, the board in **T 1138/20** stated that the standard "beyond reasonable doubt", or for that matter any other standard, did not necessarily require a party to submit all documents at its disposal; it did not even necessarily require that a party submit documentary evidence at all. The evidence a party choses to adduce was at its discretion. That no documentary evidence was on file for a specific allegation of fact did not, as such, demonstrate an error in the finding of that fact. The appellant had to rather show, for example, that there was no evidence on file corroborating the finding of fact made by the opposition division. (points 1.3.4(a), (b) of the Reasons).

In **T 329/02** the board found that it was not in keeping with good procedural practice for an opposition division not to take up an opportunity to hear a witness in evidence on a disputed matter that was highly relevant to the legal validity of the contested patent, and instead to require written declarations in place of the oral evidence.

See also chapter III.G.3.3 "Right to be heard" below.

2.4. Witness testimonies and expert opinions

2.4.1 Hearing witnesses

By way of introduction to this topic, the following sets out some of the principles that have emerged from the case law reported in the sub-sections below. The EPC requires **clear requests** with regard to testimonies which a party wishes witnesses to give. A party who wishes to adduce witness evidence should indicate what **factual details** it wishes to prove by this means. The function of a witness is to corroborate what has been alleged and not to fill in the gaps in facts. Additional clarifications provided by a witness to close a potential gap in the documentary evidence on file cannot be considered per se new facts; hearing a witness would otherwise be futile. The parties must be given an opportunity to comment on the results of the witness hearing. The EPC does not preclude the parties to the proceedings from offering their employees as witnesses. An allegation that a witness might be biased does not in itself render their testimony inadmissible; rather, suspicion of bias is a matter to be considered when evaluating the evidence. All the means of giving or taking evidence covered by Art. 117 EPC are subject to the discretion of the department concerned but if the evidence offered is decisive for proving contested facts on which the case turns, the department must, as a rule, order that it be taken.

a) Role of witnesses and wording of request

It is the function of a witness to corroborate what has been alleged (**T 543/95**) and not to fill in the gaps in facts brought forward to support the case (**T 374/02**; confirmed more recently in e.g. **T 1100/07**, **T 1028/11** and **T 2054/11**). It is necessary that a party who wishes to adduce evidence by means of a witness should indicate what **factual details** it wishes to prove by this means (**T 374/02**). The principle of free evaluation of evidence also applies to the hearing of witnesses under Art. 117(1)(d) EPC (**T 482/89**, OJ 1992, 646).

The EPC requires **clear requests** with regard to testimonies a party wishes witnesses to give, since the responsible department of the EPO must issue a decision regarding the taking of oral evidence (see Art. 117(1)(d) and R. 72(1) EPC). The board in **T 374/02** was of the opinion that the "implicit offer of witnesses" did not specify what should be able to persuade the board to evaluate the evidence already existing in the file differently. Witnesses were meant to corroborate the facts, not to fill in gaps in the facts and arguments. The lack of an indication of the facts which were to be proven by testimonies of the three persons mentioned meant that the necessary conditions for the hearing of witnesses did not exist in the case before the board (other examples: **T 2054/11**; **T 703/12**, general reference to the party's submissions in opposition; **T 1570/14**, implicit request and requirements of Art. 12(2) RPBA 2007). **T 1028/11**, cited below, deals with a – justified – refusal to hear a witness and an alleged infringement of the right to be heard; **T 30/12** deals with a refusal to rehear a witness.

Additional clarifications provided by a witness to close a potential gap in the documentary evidence on file cannot be considered per se new facts; hearing a witness would otherwise be futile (**T 2565/11**, **T 660/16**, solution confirmed again in **T 1738/21**).

The boards in **T 1363/14** and **T 2238/15**, ruling on alleged prior use, held that the opposition division should have ordered the hearing of the witnesses requested by the opponent to substantiate the facts set out in detail in the notice of opposition (see also **T 1553/07** and chapter IV.C.2.2.8i) "Alleged public prior use").

In **T 348/18** in relation to the first-instance department's refusal of a request to hear the EPO examiners as witnesses, the board found that the opposition division, absent any indication of the facts to be proven by the witness testimony offered, had rightly decided that the conditions for hearing witnesses had not been met.

b) Relationship between witness and party

The EPC does not preclude the parties to the proceedings from offering their **employees** (see e.g. **T 482/89**, OJ 1992, 646; **T 830/90**, OJ 1994, 713; **T 443/93**, **T 937/93**, **T 505/15** on assessing credibility in view of a bonus element in an employee's remuneration, and **T 523/14** on written statements) or **clients** (**T 575/94**) as witnesses. See also **T 327/91** (general manager of one party), **T 558/95**, **T 64/13** and **T 508/00** in chapter III.G.3.2.8 on when evidence should be submitted. The credibility of witnesses cannot be impugned merely because they had a **business relationship** with a party (**J 10/04**, referring to several other decisions). The allegation that a witness might be biased does not itself render the testimony inadmissible; suspicion of bias is rather a matter to be considered during the evaluation of evidence. The parties must be given an **opportunity to comment** on the results of the witness hearing (**T 838/92**; on this point also **T 582/90**).

In the context of an alleged oral disclosure (lecture), evidence from the lecturer and a member of the audience, provided by them in the form of both affidavits and oral testimony, was not considered by the board in **T 2003/08** of 31 October 2012 to prove beyond reasonable doubt that the subject-matter of the claim was disclosed during the lecture; the board also observed that relations with the appellant-opponent's company could possibly have influenced their objectivity. In contrast to the opposition division the board considered it appropriate to hear the witnesses because their testimony **could affect the outcome of the proceedings**. The transcript of the witness hearing contained a point concerning their relationship to the appellant-opponent.

See also in this chapter III.G.2.5.2 "Relationship between witness and party" and III.G.4.2.2a) "Credibility of allegedly linked witnesses".

c) Statutory declarations and hearing witnesses

One object of producing written statements – which are an admissible form of evidence – is to avoid having to call those who made them as witnesses (**T 674/91**; see, however, **T 474/04**, in which it was held that the department of first instance ought to have heard the person who had made the written declaration in question, infra in this chapter III.G.2.5.3).

If the Receiving Section had considered the circumstances described in the witness statement very unlikely, it ought to have heard the witness personally in order to evaluate her credibility (**J 10/04**).

d) Ranking of means of evidence

The board in **T 918/11** (prior use – long-ago events) considered that the opposition division's approach, that documents are of a more conclusive evidentiary value than witnesses, had no basis in the EPC, Art. 117 EPC containing **no ranking** of the means of evidence listed in it. The board was also of the opinion that the application of the standard of proof "beyond reasonable doubt" did not justify disregarding the testimonies. Position confirmed more recently by **T 464/20**, according to which, contrary to the appellant's (patent proprietor's) view, the evidential value of the witness testimony was not diminished by the absence of a document or receipt.

See also **T 1138/20** (point 1.2.2 of the Reasons) and **T 1710/12** in chapter III.G.2.3; see also in this chapter III.G.4.2.1.

e) Hearing a witness before a national court

Under R. 120 EPC, any party, witness or expert summoned to appear before the EPO can request authorisation to be heard by a competent court in the state in which they are resident (see, for example, **T 582/90** and, by contrast, **T 827/99**, in which the witness's hearing by a national court was considered unnecessary).

In **T 1043/93** a notarial statement by Italian witnesses duly summoned but not present was produced on the day of the oral proceedings before the board, with their age cited as the excuse for their failing to appear. The board observed that their age had already been known to the party and that the witnesses had not requested to be heard by the competent court of their country of residence (R. 72(2)(c) EPC 1973, now R. 118(2)(d) EPC).

In **T 1551/14** the issue of the credibility of the witness, one of the appellant's employees, was critical since the points made by the witness in a statutory declaration regarding the new auxiliary request were of major importance for its patentability and had previously only been supported by that statutory declaration. For the board, this issue could only be settled by hearing the witness again, if necessary, under oath before a national court (R. 119 and 120(2) EPC). The case was remitted with an order to hear the witness in question.

In **T 1117/16** during the opposition proceedings the witnesses had rejected the second invitation to give evidence, stating that they were not (or no longer) willing to do so. The appellant (opponent ~~1~~) claimed that the opposition division had committed a substantial procedural violation in deciding not to order that the witnesses offered as evidence in relation to the asserted public prior uses oV1 and oV2 be heard before a competent national court, even though it had deemed these public prior uses relevant and the witnesses would have been **compelled to give evidence** before that court. In the board's opinion, the wording of R. 120(1), second sentence, EPC did not create any legal obligation on the EPO to request that the competent court in a witness's country of

residence as per Art. 131(2) EPC 1973 hears that witness – it merely gave the EPO discretion in this regard. Rule 120(1) EPC was not applicable in the case at issue, and under the provisions of the EPC nobody could be compelled to give evidence in proceedings before the EPO. The statement by the appellant's witnesses that they did not wish to give evidence might have been relevant for the evaluation of evidence, but it was immaterial for the issue of whether these witnesses needed to be heard before their competent national court. An advance for the expenses was also an issue.

Article 131(2) EPC provides the basis for evidence to be taken by national courts or other competent authorities of contracting states (see also R. 118(2)(d) EPC, R. 120 EPC, R. 150 EPC, and Guidelines E-IV, 3 – April 2025 version).

f) References

See also in this chapter: **T 703/12** (timing of a request that a witness be heard – generic reference to submissions in opposition); **T 480/11** (late witness); **T 838/92** (impartiality of a witness); **T 267/06** (need to order the hearing of a witness); **T 716/06** (whether the evidence offered was useful); **T 1096/08** and **T 225/03** (first-instance department wrongly decided not to hear the witnesses); **T 1100/07** (department of first instance's decision not to order hearing of witnesses justified in one case but not in the other); **T 190/05** (citing **T 474/04** extensively and specifying how the department of first instance should have proceeded); **T 361/00** (unnecessary to hear author of unsworn written statements as a witness because statements irrelevant to outcome of the decision); **T 1210/05** (conclusions based exclusively on the testimony of a witness); **T 832/13** (serious doubts due to the general nature of the statement); **R 6/12** (hearing witnesses/experts not ordered by the board).

2.4.2 Difference between witnesses and experts

The boards of appeal have drawn a distinction between the hearing of witnesses and the hearing of **opinions by experts**: a witness is put forward to substantiate facts of which they have personal knowledge. In **T 311/01** the appellant (opponent) offered witness testimony on the skilled person's knowledge and understanding of the cited prior art. However, the testimony was offered as evidence not of specific facts but of the knowledge and ideas of skilled persons in the technical field concerned, so that the appellant was in fact offering experts, not witnesses. Regarding itself expert enough with regard to the features and advantages described in the prior art, the board refused to hear the proposed "witnesses" (see also **T 1511/06**, **T 1676/08** and **T 32/10**).

In **T 480/11** the subject on which the proposed technical expert Mr J. intended to speak according to the appellant's request was not simply a technical issue but an event in the past, namely the performance of experiments and the results obtained thereby, which had taken place at the appellant's laboratory. So, the appellant's request was actually directed to hearing Mr J. as a witness rather than as a technical expert. The board decided not to hear Mr J, as the respondent would have had to be given sufficient opportunity to challenge the witness statement and it would have been necessary to adjourn the oral proceedings.

2.4.3 Expert opinions (Article 117(1)(e) EPC)

The decisions reported below concern requests that the board take evidence from an independent expert under Art. 117(1)(e) EPC and R. 121 EPC (the case law shows that the boards refused those requests). Such cases are to be distinguished from those where opinions of a party's expert are submitted as evidence (which are more common).

T 753/09 stated that an **expert declaration** had to be regarded **not just as an argument**, but as evidence pursuant to Art. 117(1)(e) EPC.

Under the established case law of the boards of appeal, obtaining an expert opinion as per Art. 117(1)(e) EPC and R. 121 EPC is essentially to be considered only when a board is unable to decide on an issue without advice from a technical expert, since it is first and foremost down to the parties to find the necessary evidence (**T 1906/17**). In **T 1906/17** the respondent (patent proprietor) had not set out why an independent expert needed to be heard for the decision.

In **T 375/00** the board, ruling on the opponent's request that it order an expert opinion under Art. 117(1)(e) EPC, held that actively seeking experts to help the case of one of the parties could leave it open to an accusation of partiality and that it was for the parties to find the evidence they needed. **Only if** the board did not consider itself in a position to decide upon a matter without technical assistance would expert evidence within the meaning of Art. 117(1)(e) EPC become appropriate (**T 1676/08**, citing also **T 395/91**, **T 230/92**, **T 375/00**, **T 311/01** and **T 1907/06**). Other cases rejecting a request for an expert opinion: **T 1548/08**, **T 1763/06**, **T 38/15**, **T 377/17** (independent expert opinion on Art. 83 EPC requested and refused; point of law), **T 471/16**.

In **T 443/93** too the board refused a request for such an expert opinion made at the oral proceedings after a witness had been heard, noting that the appellant had neither filed the request on time, nor supplied specific grounds justifying such a request at that stage in the proceedings. See also **T 8/13**.

In **T 392/06** during oral proceedings the respondent (opponent) requested the appointment of an independent technical expert in view of the contradictory experimental results of the appellant (proprietor) and the respondents (opponents). The board had no reason to substitute for the respondents **to compensate for their deficiency** in the provision of the evidence which supported their objection of lack of novelty in allowing an independent expert. Furthermore, commissioning of an independent expert would have made postponement of the oral proceedings necessary, which was contrary to Art. 13(3) RPBA 2007 (see also the obiter dictum in **T 998/04**, reported in this chapter III.G.5.1.1, on the burden of proof).

In case **T 1841/18**, concerning an alleged prior use, the existence of an NDA and whether or not Mr G was a member of the public, the patent proprietor requested that a decision on taking of evidence (Art. 117(2) EPC, R. 117 EPC) be issued to commission an independent expert (Art. 117(1)(e) EPC) on Italian law on the questions and issues already discussed in D1u (a legal opinion analysing a final national decision) in relation to national

litigation proceedings and its binding effect. The board did not allow the request since the board had already examined the arguments submitted with D1u and found that they were not convincing, and the patent proprietor did not explain how a second expert opinion on the same issues could have an impact in this respect.

See also infra **T 765/21** as to the consequence in this case that no request had been made to summon a technical expert under Art. 117(1)(e) EPC.

2.4.4 Expert opinion submitted by a party

Following on from the section on expert opinions ordered by a board (Art. 117(1)(e) EPC), this section relates to expert opinions the parties themselves furnish as evidence (as occurs most often in practice).

In **G 1/22** (OJ 2024, A50) the Enlarged Board noted in point 66 of the Reasons that parties are regularly requested to file evidence (such as a legal opinion from an independent law expert) concerning the effects of the applicable national law.

In **T 517/14** (priority right, Israeli law) with regard to an expert opinion submitted by the appellant the board noted that, while an opinion by an expert who has represented a party "in numerous proceedings" may, upon free evaluation of the evidence, have carried less weight than a court decision, another independent authority under the national law or an expert commissioned by the board under Art. 117(1)(e) EPC together with R. 117, first sentence, EPC, an opinion of a party's expert was a **means of evidence** under Art. 117(1) EPC.

In **T 1117/16** the appellant had presented two pieces of written evidence, which it referred to as "affidavits". In the board's view, since the list in Art. 117(1) EPC was not exhaustive, there was no cause to decide whether the submitted pieces of written evidence were indeed affidavits. The issue of what type of statement this evidence was may, at best, be important for the probative value of those statements. However, the board held that Mr D's "**expert opinion**" was not an opinion by an expert as per Art. 117(1)(e) EPC but a "party opinion" that was to be regarded as nothing more than a written statement by a third party not involved in the proceedings. The available documents were prima facie unsuitable for proving up to the hilt that the subject of prior use oV3 had been sold and delivered as alleged. Ultimately, oV3 was not admitted into the proceedings (Art. 13(1) RPBA).

In the following cases, the boards likewise dealt with expert opinions offered by a party: **T 1676/08**, **T 658/04**, **T 885/02**, **T 276/07** (expert opinion not translated from Italian), **T 74/00** (legal expert opinion, Japanese law), **R 18/09** (external legal opinion on the admissibility of the petition), **T 156/15** (opinion of a former board member submitted as expert evidence), **T 2132/16** (opinion of different technical experts and a transcript of their cross-examination in a UK court case).

In **T 765/21**, by submission shortly (two weeks) before the oral proceedings, the proprietor indicated that Mr X, an employee of the proprietor, would attend the oral proceedings and requested that he be allowed to make oral contributions as a technical expert at the

hearing. In view also of the fact that no request had been made to summon Mr X under Art. 117(1)(e) EPC and R. 118 EPC, the board concluded that Mr X should be considered as an accompanying person within the meaning of decision **G 4/95**. As indicated in **G 4/95**, oral submissions by persons accompanying professional representatives but not covered by Art. 117 EPC cannot be made as a matter of right, but only at the discretion of the board. Without any indication of his qualification or the nature of his intended contribution, the request did not meet the criteria in **G 4/95**. Furthermore, the opponent did not agree.

See also **T 335/15**, in which two months before the oral proceedings the opponent had filed a request that a technical expert be heard but did not specify on what point that expert would be speaking until the oral proceedings. The board ruled on the issue with reference to the findings in **G 4/95** on oral submissions by an accompanying person. More generally, this issue is discussed in chapter III.V "Representation".

2.5. Statements in writing

2.5.1 Sworn statements and affidavits

Article 117(1)(g) EPC provides for sworn statements in writing as a means of evidence (rare in practice). However, since any kind of evidence is admissible in proceedings before the EPO (long-standing principle confirmed many times, most recently in **G 2/21**), less solemn types of written statement (common in practice), e.g. statutory declarations, are also accepted. It is for the decision-making departments then to assess their probative value on a case-by-case basis. Such declarations consist of a witness's written statement, the main purpose of which is to avoid the need to hear that witness. The various departments may, however, decide to order such a hearing, for example if a party so requests. The terminology used in the case law of the boards of appeal includes "affidavits", "statutory declarations" and "unsworn statements" (French: "déclarations écrites", "déclarations sur l'honneur" and "attestations"; German: "eidesstattliche Versicherungen" and "eidesstattliche Erklärungen").

For further decisions dealing with unsworn declarations, see **T 443/93**, **T 563/02**. The board in French-language case **T 2338/13** explicitly referred to affidavits as "attestations". The board in **T 474/04** (OJ 2006, 129), which had English as the language of the proceedings, referred to a document entitled "eidesstattliche Versicherung" as a "declaration in lieu of an oath" and an "unsworn witness declaration". In **T 703/12**, the board called a document of this kind entitled "eidesstattliche Versicherung" a "statutory declaration" and in **T 1231/11** an "affidavit". In proceedings before the EPO even a simple declaration can be an admissible means of evidence within the meaning of Art. 117(1) EPC (**T 474/04**, OJ 2006, 129).

The board in **T 939/14** also held that the objection that affidavits did not meet the requirements of Art. 117(1)(g) EPC failed on the whole because standard board of appeal practice was to handle witness declarations, in whatever form or manner they are made, pursuant to the principle of free evaluation of the evidence. See also **T 1117/16** above and **T 41/19** below.

In **R 3/10** the Enlarged Board took signed declarations of persons who had attended the oral proceedings into account.

In **T 915/12** the board considered that there was not sufficient evidence to prove that D16 – an extract from the encyclopaedia – was made available to the public before the priority date (5 February 2001). The printing (2000) and copyright (1999) years indicated in D16 could **not alone** prove accessibility before early 2001. The hand-written annotation made by Ms S. – Head of Collections Department University – on the cover page did not fulfil the requirements of form and content which usually apply for affidavits or similar documents. However, see also **T 649/20** regarding proof of the publication date of a scientific journal article. In this decision, it was discussed whether D1 (printouts of a journal database entry that only stated the year) should be considered prior art (available before the priority date – yes), particularly on the basis of a database extract from a medical library (document D14) submitted to establish the date the journal was received. Other evidence had been provided, including emails with the senior managing editor and the senior publisher; these two independent witness statements both gave the same date for the official publication date and the day the article went live. The board decided that D14 was already considered to provide sufficient evidence; the librarian that received and registered the journal in the database was a member of the public (see also **T 834/09**).

2.5.2 Relationship between witness and party

The board may consider an affidavit to be admissible evidence even if it is signed by the general manager of the appellant (see **T 327/91**). In **T 2003/08** of 31 October 2012 (reported in this chapter) the board observed that relations with the appellant's (opponent's) company could possibly have influenced Dr W's and Dr K's objectivity concerning their declarations ("eidesstattliche Versicherung"). The board considered that its reservations concerning declarations E1 (declaration of Dr W, lecturer) and E2 (declaration of Dr K, member of the audience) could possibly be dispelled by hearing the authors of declarations E1 and E2 themselves.

In **T 523/14** the appellant (patent proprietor) objected to the credibility of statements written by two **employees** of the respondents concerning alleged prior publication D11 (an advertising newsletter sent by e-mail). In the board's view, while the written statements of independent persons would tend to carry more weight, the statements of employees of parties to the proceedings were not objectionable per se.

In **T 558/95** the board held that the fact that the statutory declarations produced by the opponent partly used the same wording and had been drawn up by employees of the opponent did not necessarily mean they should be excluded as inadmissible. The opposition division had discretion to decide whether to examine them, and to **determine whether or not** the evidence in them was **sufficient**.

See also in this chapter III.G.2.4.1b) "Relationship between witness and party" and III.G.4.2.2a) "Credibility of allegedly linked witnesses"; see **T 423/22** and **T 1604/22** for the outcome when a witness is heard by videoconference. See also in this chapter III.G.2.2 "Distinction between the admissibility of evidence and its probative value" and **T 104/23**.

2.5.3 Statutory declarations and hearing witnesses

In **T 674/91** the board pointed out that according to the practice of the boards of appeal, affidavits or statutory declarations, whether in original or copy form, are considered as possible means of providing evidence. One purpose of written declarations is to avoid the need to hear the undersigning person as a witness. Where such declarations consist of answers to questions put forward by legal experts several declarations may have certain **stereotyped formulations** in common.

In **T 41/19** the appellant (patent proprietor) asserted that an affidavit should only be taken into account if the person who provided the affidavit could also be called as a witness. The board did not agree, stating among other things that affidavits were one possible form of evidence in the non-exhaustive list in Art. 117 EPC and so could be taken into consideration as stand-alone evidence as per the principle of free evaluation of the evidence.

In **T 474/04** (OJ 2006, 129) where one party invoked **T 674/91** to justify not having to hear the author of an unsworn witness declaration ("eidesstattliche Versicherung") as a witness, the board pointed out that the case before it was different in that the fundamental assertions made in the declaration were **contested**, the author had been offered as a witness, and the appellant had consistently demanded that he be heard. The opposition division's decision not to summon him as a witness although he was available had handicapped the appellant in its defence against what turned out to be the **decisive piece of evidence**. It was observed that this piece of evidence largely lay "within the power and knowledge of the opponent". Compare with **T 2659/17** (see infra, ranking of means of evidence), which cites various sections of **T 474/04** and concludes, on the basis that the evidence of an alleged prior use was in the opponent's hands, that the opposition division **should have heard** the author of the pivotal, contested declaration as a witness so as not to deprive the patent proprietor, who had made the request that the witness be heard, of its right to be heard under Art. 113(1) EPC. Decision **T 778/21**, which refers in particular to **T 474/04**, sets out the instances in which offers of evidence have to be accepted (hearing as witnesses authors of written statements, visual inspections; see in this chapter III.G.3.1.2).

As to whether, when offered, the author of a declaration should be heard as a witness in addition to their declaration, see, in addition to **T 41/19,** the chapter III.G.3.3 "Right to be heard"; as to when a declaration alone can be adequate proof, see chapter III.G.4 "Evaluation of evidence".

2.5.4 Ranking of means of evidence

See in this chapter III.G.4.2.1.

2.6. Other documents

As the EPC neither defines the term "documents" (Art. 117(1) EPC) nor gives any indication of the probative value of such documents, the principle of free evaluation of

evidence applies. **Any kind of document**, regardless of its nature, is **admissible** during proceedings before the EPO, including appeal proceedings (**T 482/89**, OJ 1992, 646). See also, for example, **G 2/21** (OJ 2023, A85), point 40 of the Reasons.

In **T 1698/08** the respondent (patentee) objected to the admission of an (**internet**) extract from the Zürich Commercial Register as it stated at the end that the information was provided without warranty and had no legal effect whatsoever, which in its opinion had the consequence that the extract could not be considered as a means of evidence within the meaning of Art. 117(1) EPC. The board stated that a refusal to admit such a piece of evidence (an uncertified extract from a commercial register) could therefore not be based on Art. 117(1) EPC. The board decided that there was no reason to exercise its discretion to refuse to admit the evidence, as it could neither be said that it was irrelevant nor that it was unnecessary. A **refusal** to admit it could in any case **not be based** on statements in the document with respect to the **accuracy of the facts** it contained. Such statements relate to the probative value of a document.

In **T 71/99** the minutes of the proceedings as taken by the opposition division did not provide a full account of the conduct of the oral proceedings. To show the board what had actually happened, the respondent submitted part of a copy of **a report of the opposition proceedings** which had been dictated by his representative in the course of those proceedings. The appellant argued that this document should not be admitted, albeit without disputing the facts set out in it. Since the submitted part of the report was significantly more precise and not difficult to understand, the board saw no reason to disregard the evidence. In **R 3/08** the Enlarged Board, having taken private minutes into account, considered that there was no indication that the petitioner had raised any objection.

In **T 2274/22**, in relation to concerns about bias before the department of first instance after one of the opponent's representatives joined the breakout room intended for the interpreters' briefing, the board found that the sequence of events at the oral proceedings before the opposition division could be pieced together on the basis of the minutes, its annexes and the parties' submissions. The parties confirmed that the minutes were a true representation of the facts and the general order of proceedings. The parties also agreed on the other events; these were not immediately discernible from the record, but the participants were able to provide an objective account of them.

On **minutes** of oral proceedings as evidence of the course of the proceedings, see also chapters III.C.8.10., V.B.3.7.5. and **R 7/11**. See also in this chapter: **T 361/00** (minutes not contested), and **T 2301/12**, in which, the accuracy of the minutes of the oral proceedings having never been challenged, the board started from the position that they represented a faithful account of events. Similarly, in **R 6/17** the petitioner had neither objected to nor requested a correction of the minutes. Likewise, in **T 1604/22**, although the proprietor challenged the holding of first-instance proceedings by videoconference for the visual inspection of a CD and the hearing of two authors of written statements, none of the parties commented on what the draft minutes said about the taking of evidence during the hearing, presented to the parties at the oral proceedings. To dismiss the objections that videoconference was unsuitable for consideration of the CD, the board pointed out that

the minutes of the oral proceedings included screenshots of the visual inspection. In **T 246/22**, in relation to the application of Art. 12(4) RPBA and the issue of maintaining requests, the board held that the maintenance of the requests was self-evident from the minutes of the oral proceedings before the opposition division.

In various cases concerning prior use, **photographs** were submitted as evidence (see e.g. **T 833/99** (photos considered too unclear); **T 1410/14**; **T 564/12**; **T 453/02** (photos as annexes to affidavits); **T 973/10**; **T 1647/15**; **T 1127/97**; **T 544/14**; **T 1604/16**; **T 1202/20** and **T 778/21**).

T 523/14 concerned an advertising newsletter as an alleged prior publication. Of the evidence produced by the opponents, the appellant (patent proprietor) argued that D61 – a **screenshot** of Microsoft Outlook documenting the forwarding of the email – might be a forged document. However, the appellant did not indicate, and the board could not find, any inconsistency or discrepancy in D61 which could suggest that this document was a forgery. The mere fact that it was a screenshot of Microsoft Outlook was insufficient to warrant the conclusion that it had been forged. See also **T 649/20**, in which at issue was whether D1, a printout of an online entry of a scientific journal, was prior art – printouts of emails were also provided as evidence – D14 an extract from a public database from a central library was considered as sufficient evidence; **T 884/18**, in which on the balance of probabilities, date stamps on evidence (screenshots of an internet page) from the Wayback Machine established availability to the public. Compare however with **T 3000/19**, in which the screenshot of a video that was no longer available was found to be insufficient for judicial review.

Where there is no evidence of forgery, it is not necessary to submit the originals of instruments of transfer. Failure to submit originals is not sufficient by itself to raise reasonable doubt as to the validity of the transfer (**T 2466/13**, which concerned a transfer of priority right).

The board in **T 41/19** dealt, among other things, with the probative value of an email in light of a witness statement as to an alleged novelty-destroying prior use (it was considered to be weak in the context of the case in hand).

In **T 518/10** (concerning a transfer of opponent status), opponent 2 had filed a copy of an extract from the Norwegian companies register from which it was clear that its name had changed following a merger. The board considered this evidence sufficient to demonstrate who was opponent 2's universal successor in law. See also **T 347/15** (two extracts from the commercial register).

In **T 2220/14** the opponent submitted a decision of a US District Court in relation to the appellant's US patent. Ultimately, pursuant to Art. 13(1) and (3) RPBA 2007, the board decided not to admit this document into the proceedings. It recalled the relationship between national decisions and procedures before the boards of appeal (point 16 of the Reasons) and considered the document to be irrelevant to the issues before it. For a list of board decisions on evidence in relation to national proceedings, see in this chapter III.G.4.2.2e).

In **T 301/94** a report by a "huissier de justice" (court bailiff) concerning champagne bottles had been submitted as evidence of alleged prior use. The evidential value of such official reports drawn up by a "huissier de justice" was no longer questioned at the appeal stage (see also **T 838/92**).

In **T 801/98** lock designs had been deposited, under seal, with a court bailiff and submitted by the appellant during the oral proceedings before the board.

In **T 1332/12** the respondent (opponent) filed a copy of Japanese application D7 as evidence of the prior art and a JPO **machine translation** into English (D7T). The appellant (patent proprietor) filed later D7JPO, in its view a more accurate machine translation of D7. The board pointed out that there was nothing in the EPC to prevent a party from filing a **corrected translation of a document filed as evidence**, even if the evidence and/or translation was filed by the other party to the proceedings. This also applied if the document was a patent application. (**T 1332/12** cited by **T 1968/18).** See also chapter III.F.5. "Translations".

For **internet publications**, see in particular **T 286/10** and **T 2227/11**, reported in this chapter.

3. Taking of evidence

Mirroring the holding of oral proceedings by videoconference, R. 117 and 118 EPC were amended with effect from 1 January 2021 to allow for means of taking evidence by videoconference (see OJ 2020, A132).

Article 117 EPC entitled "Means and taking of evidence" is applicable before all EPO departments, including the Receiving Section, examining divisions, opposition divisions, the Legal Division and the boards of appeal.

3.1. Relevance of the evidence

3.1.1 Basic principles

The EPO departments must ascertain the **relevance of evidence submitted to them** before deciding whether to admit or reject it. EPO departments do indeed have some **discretion** in admitting evidence offered, for example where (i) it is no longer needed because the fact at issue is **not contested** by the other party, (ii) where the decision will in any case go in favour of the party offering it, (iii) where it is submitted very late in the proceedings and is considered immaterial, or (iv) where for some other reason it cannot affect the outcome (e.g. evidence offered in an inadmissibly late-filed opposition) (**T 142/97**, OJ 2000, 358).

Decision **G 2/21** (OJ 2023, A85) summarises in point 42 of the Reasons the key points in case law, i.e. that all means of giving or obtaining evidence set out in Art. 117(1) EPC are at the discretion of the deciding body and ordered only if that body deems them to be necessary (**T 798/93**).

In **T 798/93** (OJ 1997, 363) the board observed that the only specific means requested was a sworn statement in writing but, in the absence of any legitimate doubt as to the opponent's identity, the board considered that this was neither useful nor necessary.

If the evidence offered as proof of contested facts essential to the settlement of the dispute is decisive, the body hearing the case must, as a rule, order that it be taken (**T 474/04**, OJ 2006, 129, about witnesses, also cited in **G 2/21** point 42 of the Reasons, **T 778/21** point 3.4.4 of the Reasons, **T 2659/17**).

All appropriate offers of evidence made by the parties should be taken up. As a rule, it cannot be considered to be in keeping with good procedural practice for an opposition division not to take up an opportunity to hear a witness or party in evidence (**T 329/02**; see **T 860/01** on the extent of the discretionary power of the first-instance department and **T 1738/21** for a summary of the applicable principles from the case law).

All the cases cited below relate first and foremost to requests to hear witnesses. The sub-headings are aimed at guiding readers to more specific aspects. Since the reasons for a decision may touch on several aspects, the abstracts may also deal with points not alluded to in the heading.

3.1.2 Offering evidence – effect on the outcome of the dispute – refusal to hear a witness

See the introduction above with reference to **T 329/02**, **T 860/01**, and **T 474/04** (OJ 2006, 129).

The reported cases primarily concern witness testimonies. However, reference is also made to other forms of evidence offered such as visual inspection.

According to **T 716/06**, it is true that where **oral evidence of a witness** is requested by a party the competent EPO department should grant this request only if it considers this oral evidence necessary, i.e. when it is required to clarify matters that are decisive for the decision to be taken. If a request is made by an opponent to hear a witness on an alleged public prior use and on the disclosure of a certain feature by this prior use, the competent department of the EPO must as a rule grant this request before deciding that the alleged public prior use is neither established nor a novelty-destroying part of the state of the art because the feature in question is not found to be disclosed therein. In **T 2003/08** of 31 October 2012 the board – in contrast to the opposition division – considered it appropriate to hear the witnesses because their testimony **could affect the outcome** of the proceedings.

In **T 246/17** the opposition division had declined to hear the witnesses offered in relation to prior use and considered the public prior use to be adequately proven by the documentary evidence. However, the board came to the conclusion that it could not be ruled out that hearing the witnesses, alongside evaluating the documentary evidence, could have led to a different assessment of novelty and inventive step and thus to a different outcome. The disclosures of documents O1 (manual) and O2 (brochure) left open whether certain features were present in the instrument described, but the instrument had

actually been made and sold and might itself have disclosed them even though O1 and O2 did not, and this was a matter which witness testimony could resolve. Not hearing the witnesses was therefore a fundamental procedural violation that justified setting the decision aside (see e.g. **T 716/06**, **T 1363/14** and **T 314/18**, and for a more recent, very detailed example on this topic, **T 1738/21**, summarised below in this chapter III.G.3.3.4).

In **T 1100/07** (alleged prior use, sale of a vehicle with a given feature) the department of first instance had refused to hear two witnesses. The board held that it had been right to refuse to hear one of them, as he would merely have confirmed what he had said in his written statement about documents that anyway spoke for themselves and hearing him would have had no impact on the final decision. It should, however, have heard the other witness. It was true that the request that he be heard had been filed late and that granting it would have meant adjourning the oral proceedings, but the opposition division had based its final decision on a failure to establish the prior existence of a single given feature and the witness would allegedly have been able to give evidence on that very point. Thus, the refusal to hear him was wrong and might have affected the outcome of the decision.

In **T 273/16** during the opposition proceedings the appellant-opponent had, on multiple occasions, requested that two witnesses be heard on the alleged prior use of a commercial dishwasher. The opposition division had opted not to invite the witnesses. Its decision appeared to be based primarily on the fact that no production or sale of the dishwasher had been demonstrated. Yet the opponent had offered the two witnesses in relation to that very issue. The decision not to hear the witnesses was therefore incorrect and might have influenced the outcome of the proceedings.

In **T 2386/19** the opposition division of its own motion cast doubts for the first time at oral proceedings on whether or not feature M6 was disclosed by the prior use. The appellant/opponent reacted by requesting to hear a witness to corroborate an alleged fact which was relevant. The opposition division did not grant the request for the hearing of a witness even though it had been made at the first available opportunity and the opposition division had considered the outcome of the hearing to be relevant to the outcome of the case. The board decided that the refusal to hear the witness violated the appellant/opponent's right to be heard under Art. 113(1) EPC and might have affected the outcome of the appealed decision.

In **T 778/21** (laundry appliance), concerning the general principles for assessing an alleged prior use, the board set out four steps that should generally be made (set out in detail in the Reasons). Steps 1 to 3 comprised the examination of the substantiation of the prior use, establishing the evidence offered by the opponent as bearing the burden of proof and the evaluation of the entire evidence offered by the opponent. Depending on the outcome of this evaluation, step 4 could entail one of three variants, depending on whether or not the opponent's evidence on file confirmed the alleged facts, or if doubts remained, and whether the opponent did (first variant) or did not (second variant) request an inspection or hearing of witnesses (see the detailed Reasons as to the consequences). If, in the third variant, the opponent's evidence confirmed the prior use, the (counter) evidence offered by the patent proprietor would become relevant and would need to be considered. If assertions made in an affidavit or in any other witness declaration remained contested, a

request from a party to hear the (available) witness would have to be granted. The board made reference to **G 2/21** (points 41, 42, 44 of the Reasons) and to **T 474/04**. In **T 778/21** the board applied these general principles for assessing the alleged prior use. Steps 1 to 3 of the assessment were fulfilled. Step 4 concerned the third variant, therefore the proprietor's request for an inspection of the washing machine and for hearing the authors of the affidavits as witnesses needed to be granted. Based on the submissions and evidence on file, the board found that the opponent had substantiated that the machine of the prior use had been made available to the public and had provided evidence confirming the related facts. Based on the evidence on file, all features of claim 1 were seen to be known from the prior use. Therefore, the patent proprietor's request for taking (counter) evidence (step 4, third variant) needed to be considered. A **final conclusion** on whether all relevant aspects of the prior use, including public availability, were **proven beyond reasonable doubt**, could **only** be drawn **after** considering the evidence requested to be considered by the proprietor, i.e. after **inspecting the machine and hearing the witnesses**. The case was remitted to first instance for further prosecution.

3.1.3 Taking evidence (hearing of a witness) deemed unnecessary

In **T 361/00** the board explained in detail why, given the circumstances of the case before it, hearing the witness would be unnecessary because it would in no way affect the outcome of its decision. (In the same vein, see **T 377/17** regarding witnesses offered for carrying out the furnished tests.)

As per **T 41/19**, an affidavit was one possible form of evidence and could therefore be taken into account as stand-alone evidence. This being the case, a written statement carried no less weight than hearing the author of the statement as a witness.

In **T 1410/14** (prior use – train – test drive) the board remarked in particular that, since the witness whose hearing the opponent had requested would not have been able to testify as to the decisive material facts, such a hearing would serve no purpose.

In **T 1307/17** in the context of assessing sufficiency of disclosure, the appellant/opponent offered a witness to support the assertion that the selective absorption (in the context of pure chemistry) of fluoroketone decomposition products was impossible. The board held that since the witness would be giving evidence in relation to an interpretation of the expression "absorption" in the context of pure chemistry rather than in relation to switchgear, the testimony would not alter the board's conclusions. There was therefore no need to hear the witness.

3.1.4 Hearing the witness introduces new facts into the proceedings

In **T 1231/11** the board refused the request to hear a witness in support of an allegation of prior use. The witness had been offered to confirm the contents of his statutory declaration, but the board concluded that since he had not made any written statement regarding the decisive issue, any information provided on this matter would amount to introducing new facts into the proceedings. In addition, the board concluded that there had been no substantial procedural violation by the department of first instance since hearing the

witness had not been considered relevant for the outcome of the case. The board found the circumstances to be different from those ruled on in three other cases, where the request to hear witnesses related to facts already on file: **T 267/06** (essential details referred to in the affidavit); **T 25/08** (hearing necessary in order to confirm what had been brought forward in writing); **T 448/07** (need to clarify inconsistencies in a written statement).

3.1.5 Hearing the patent proprietor

In **T 753/14** the opponent (appellant) requested that the board hear the proprietor of the patent in suit (respondent) under Art. 117(1)(a) EPC to clarify the scope of the disclosure in another of its patents (A10), which the opponent had cited as novelty-destroying prior art. In other words, the proprietor was to be heard with a view to obtaining information that had not been specified in A10 but, in the opponent's eyes, had to be known to the proprietor. The board did not order the requested hearing; it considered it unnecessary as it would provide new information that had not been publicly available on the basis of A10 at the time of filing of the patent in suit.

3.1.6 Re-hearing a witness

In case **T 30/12**, as evidence adduced for proving the invoked public prior use in opposition proceedings, the appellant (opponent) relied upon the drawing A9 and the testimony of Mr H, made before the opposition division. As regards the request for a renewed hearing of the witness Mr H before the board, the board noted that the appellant did not request that the witness be heard again to supplement his testimony by corroborating facts but only to clarify the statements made before the opposition division. However, the statements made by the witness as to whether document A9 was handed over to a member of the public were clear and unambiguous. The request to **rehear** Mr H was eventually rejected by the board.

In **T 544/14** re-hearing the witness was necessary. In view of the complication and the subsequent delay in the proceedings, the board decided first to clarify whether the alleged public prior use was novelty-destroying (without any doubt, no).

The board in **T 1138/20** stated that when the findings of fact of the departments of first instance rely on documents, the boards regularly make an own assessment of the evidence. In case of oral evidence given by a party, a witness or an expert (Art. 117(1)(a), (d) and (e) EPC) or an inspection (Art. 117(1)(f) EPC), the boards do not normally assess the evidence de novo by, for example, re-hearing the witness. In such a situation, the board stated the department having heard the witness was better placed to determine the probative value of the evidence given, in particular, the credibility of the witness (i.e. the witness' truthfulness and honesty) and the reliability of the testimony (i.e. its accuracy, e.g. how accurately the witness remembers and recounts the events). The boards could then defer to the first-instance department's evaluation of evidence. (On this point, see also **T 423/22** above.)

3.1.7 Example procedure for hearing a witness

Decision **T 401/12** of 8 November 2017, in which the taking of evidence requested by both parties was considered necessary, is an example of an interlocutory decision ordering that evidence be taken by hearing witnesses at a future date (R. 117 EPC) and dealing with the associated costs (R. 122(1) EPC) and the language issue (R. 4(3) EPC). The witnesses were given permission to bring any relevant documents. See also, in case **T 738/04** the decision of 22 August 2008 ordering the hearing of a witness under R. 117 EPC at the oral proceedings on 11 December 2008, at the end of which the final decision was taken. **T 660/16** addresses the issue regarding the nature of a decision – in this case, before the opposition division – ordering the hearing of a witness (case-management measure), and the deposit of an advance payment.

Decision **T 104/23** concerns the holding of the witness hearing in a case where the proprietor alleged that the opponent had had contact with the witness before their hearing on the day of the oral proceedings, a violation of the opposition division's instructions. The board did not accept the proprietor's allegation of a fundamental procedural violation, considering it to be unfounded, and pointed out that it regarded the correct approach in these circumstances to be to consider the witness's disregard of the division's instructions in the evaluation of evidence, namely the witness's credibility. The board made reference to the Guidelines (version of November 2017), chapters IV.E.1.6 "Hearing of parties, witnesses and experts" and IV.E.1.6.4 "Separate hearings". The board also observed that it would also appear as manifestly unrealistic to expect from parties to wholly refrain from contacting witnesses before their hearing, in particular to refrain from consulting them before a hearing. Otherwise, it would be plainly impossible for the attorney to select the appropriate persons, possibly out of a larger circle of people, very often all the employees of the party.

3.1.8 Means of taking evidence by videoconference

In **T 423/22** the opposition division had heard witness M by videoconference without the consent of the appellant (patent proprietor). The board considered that Art. 117(1)(d) EPC and R. 117 EPC provided a legal basis for hearing a witness by videoconference. The board furthermore emphasised that hearing the witness by videoconference in the case in hand had not infringed the appellant's right to be heard and it had not substantially limited the interaction between the opposition division, the parties and the witness compared to hearing a witness in the courtroom. As to the appellant's argument that it had not been able to observe the witness's body language during their testimony, and therefore it had been deprived of the opportunity to objectively judge their credibility, the board noted the following: Firstly, it was the deciding body's responsibility, not the parties', to judge the personal credibility of a witness and the plausibility of a witness's statement. It was up to the relevant department to decide which possible way to hear a witness. The parties did not play a central role in this process. They did have, according to R. 119(3) EPC, the right to attend an investigation and they could put relevant questions to the testifying witness. Secondly, the credibility of a witness was not determined largely by their body language. On the contrary, the credibility of a witness depended primarily on the plausibility and conclusiveness of their testimony and the absence of contradictions (see also Catchword).

Further, the board also considered that whether **G 1/21** required a general emergency in order to hear a witness by videoconference did not have to be addressed since **G 1/21** did not concern oral proceedings in opposition proceedings nor the taking of evidence, but instead was limited to oral proceedings in appeal proceedings. Finally, the board in **T 423/22** held that neither the "importance" of the prior use nor the fact that the outcome of the case hinged on the question of whether this prior use was public could constitute such a "serious reason". The appellant had further alleged at the appeal stage that the witness being an employee of the opponent and being located in the opponent's office during their hearing constituted a special reason. However, this had not been raised during the opposition proceedings. Furthermore, the minutes of the taking of evidence showed that the opposition division had made sure that the witness was sitting alone in the room. The mere fact that the witness was an employee of the opponent did not necessarily cast any doubts on the witness's reliability that were serious enough for a hearing by videoconference to be ruled out.

In **T 1604/22**, with regard to a prior use, the appellant (patent proprietor) objected that it had been inappropriate to inspect the CD and to hear the two witnesses in oral proceedings held by videoconference before the opposition division. The board stated that the fact that the inspection of the CD was carried out by videoconference did not prejudice the proper inspection of that content. The minutes showed that the parties were able to follow the inspection in real time during the videoconference. The fact that some of the files were corrupted and therefore could not be opened was not related to the format of the oral proceedings. Also, the hearings of the two witnesses were not compromised by the videoconference format. The minutes of both hearings showed that precautions were taken to ensure that the witnesses were alone in front of the camera and that they had no document in front of them from which to read their statements. Furthermore, according to the minutes, the parties were provided with the draft minutes of the taking of evidence and were given the opportunity to comment on them already during the oral proceedings. The board concluded that the taking of evidence by videoconference was not inappropriate and did not diminish the probative value of the evidence taken.

In **T 2011/21** the child safety seat prior use was inspected remotely by the opposition division; Screenshots were attached to the protocol of inspection. The appellant (opponent) contested the correctness of the inspection per videoconference. The board considered that the opposition division erred in not granting the opponent's request for giving of evidence by inspection be made in-presence, in particular because the object to be inspected was a complex three-dimensional item. This error, however, did not constitute a substantial procedural violation, but an error of judgment resulting from an erroneous interpretation of a term of claim 1 by the division; an in-person inspection would not have led to a different result.

3.2. Time frame for submitting evidence and ordering the taking of evidence

This section concerns when the parties should submit evidence and when the taking of evidence should be requested or ordered.

While it has been accepted in the jurisprudence of the boards of appeal that EPO departments have some discretion in admitting evidence, e.g. where the evidence is unnecessary or of no relevance (cf. **T 142/97**, OJ 2000, 358, point 2.2 of the Reasons), the **main legal basis for refusing the admission of evidence** is, as stated by the board in **T 1698/08**, the provisions dealing with the late filing of evidence (see Art. 114(2) EPC, R. 116 EPC, Art. 12(4) and 13 RPBA 2007 (now Art. 12 and 13 RPBA), for the boards). As regards the basic principles for assessing late-filed evidence, see primarily chapter IV.C.4 "Late submission of documents, lines of attack and arguments" for the procedure before an opposition division and chapter V.A.4. for the procedure before the boards. Below are a number of examples specifically related to issues of late-filed evidence, but when the RPBA are involved, please see chapter V.A.4.

The sub-headings are aimed at guiding readers to more specific aspects. Since the reasons for a decision may touch on several aspects, the abstracts may also deal with points not alluded to in the heading.

3.2.1 Evidence wrongly rejected by the examining division as late-filed

In ex parte case **T 545/08** when exercising its discretion, the examining division should have been aware that, although it had cited document D1 (internet publication from a commercial website) at the beginning of the examination proceedings, it had never provided any further explanations or evidence as to the document's public availability before the priority date, so that the objections based on this document had not been properly raised. Moreover, the arguments provided by the examining division for the exercise of its discretion were not persuasive. Under these circumstances, it was not permissible for the examining division to reject the appellant's further evidence as late filed and to continue to rely on document D1 as prior art. It had thereby infringed the appellant's right to be heard (Art. 113(1) EPC in conjunction with Art. 117(1) EPC).

3.2.2 Evidence wrongly rejected by the opposition division as late-filed

The board in **T 1100/07** held that, although the opponent's request that a witness be heard had been filed late and unsatisfactorily presented, the opposition division ought to have heard the witness, particularly since he could have provided testimony on a **crucial point** it had ultimately relied on in its decision.

In **T 190/05** the board found that the opposition division had been wrong to base its finding that an alleged prior use had destroyed a patent's novelty solely on a statutory declaration, because the patent proprietor had expressly **disputed** both the allegations made by the opponent and those in the declaration, which represented, besides, a piece of evidence and not in itself prior art. That it would have been impossible to give the witness named by the opponent the minimum two months' advance notice of the already scheduled oral proceedings was not, in the board's view, an exceptional circumstance justifying the failure to invite him.

3.2.3 Late-filed evidence before the board of appeal - rejected

In **T 100/97** the board discussed in detail the criteria to be applied to late-filed evidence. Since a UK infringement action had been stayed pending the outcome of the EPO appeal, a swift settlement of the case was especially desirable, and admitting facts and evidence submitted at a late stage might have resulted in a remittal protracting the already lengthy proceedings and thus further delaying the UK proceedings. Moreover, for the contents of the statements to be considered sufficiently credible, they had to be **corroborated by documents of a definite date**. Taking into account the very late stage in the proceedings and in the absence of any such documents, it could not be established with a sufficient degree of certainty what had been made available to the public before the priority date of the opposed patent; the board therefore decided to disregard the late-filed evidence (Art. 114(2) EPC). Compare with **T 1057/09** (point 5.9 of the Reasons) concerning remaining doubts as to the authenticity of a late evidence.

3.2.4 Comparative tests to demonstrate a technical effect achieved by the claimed invention

As regards taking account of plausibility as part of the inventive-step assessment, and the possibility of considering post-published documents, see chapters I.D.4.3.3, II.C.6.8 and especially **G 2/21** (OJ 2023, A85), which summarises the applicable existing case law while also distancing itself from the notion of plausibility used in earlier case law.

3.2.5 Evidence rejected as prima facie irrelevant

In **T 39/14**, which concerned a method for improving foaming properties, comparative tests filed by the appellant (opponent) with its notice of appeal were considered **prima facie irrelevant** to inventive step and therefore not admitted (Art. 114(2) EPC and Art. 12(4) RPBA 2007). They could possibly have been used to support an objection under Art. 100(b) EPC but that ground for opposition had not been admitted either.

In **T 973/10** the board decided not to admit late-filed evidence of prior use. The board held inter alia that the evidence was anyway not prima facie relevant. The **photographs** produced were not sufficiently compelling evidence because they did not enable it to reach any objective conclusion as to the nature and structural details of the device allegedly disclosed at a meeting (Art. 114(2) EPC in conjunction with Art. 12(4) RPBA 2007).

See also **T 1680/15** on how the late filing of various means of evidence in the opponent's possession (including an offer of witnesses, affidavits, invoices) affected the board's decision on whether to consider them.

See also merely as recent examples about in general the relevance prima facie : **T 1042/18**, **T 1876/18**, **T 778/21**, **T 1305/21**, **T 1766/21**, **T 856/22**, **T 469/22**, **T 1401/22**, **T 1891/22**.

For information on the concepts and provisions that are now applicable, please see the chapter V.A.4.2.

3.2.6 Evidence submitted "in due time"

In **T 1830/11** the board observed that there are **no provisions** in the EPC **obliging** opponents to provide evidence against every possible fallback position defined in the dependent claims. Thus, if amendments were made to the claims during oral proceedings before the opposition division, the obligation to submit evidence "in due time" under Art. 114(2) EPC might, depending on the circumstances, arise first at the stage of filing the statement of grounds of appeal. See also **T 998/17**.

The board in **T 574/02** found that documents could not be considered late-filed simply because they had only been submitted on appeal, and any board faced with a request that it refuse to admit a document or evidence as late-filed first of all had to verify whether it really was late or whether, in the particular circumstances of the case, it had been submitted **in due time**. Finding that the filing party had at all times acted and reacted promptly and with good judgment, the board held that the documents had been submitted in due time within the meaning of Art. 114 EPC. See also **T 1647/15** in chapter III.G.3.3.4.

See also merely as examples : **T 1904/16**, **T 571/22**, **T 1445/22**.

3.2.7 Parties' responsibilities

When a party seeks to prove potentially relevant facts by means of the statement of a witness, it is particularly important that this statement be furnished early in the opposition phase so as to enable the witness to give oral evidence in accordance with Art. 117 EPC 1973, in the event that the statement is challenged or the EPO deems it necessary (**T 953/90**).

In appeal proceedings both parties are under a duty to submit all relevant facts in due time. In **T 106/15** the appellant did not at any point in opposition (or opposition appeal) proceedings request that the author of the statutory declaration be heard (see also **T 2010/08**, cf. **T 41/19)**.

In **T 753/09** an expert declaration had been late filed by the appellant (opponent). Having said that it would allow such belated evidence only if it were sufficiently relevant and if the other party could reasonably react to the late filing, the board ultimately refused to admit it into the proceedings. The board pointed out, inter alia, that as an **expert declaration** had to be considered **not just as an argument**, but as evidence pursuant to Art. 117(1)(e) EPC, the other party should be given the possibility to have such an expert declaration verified or possibly refuted by another expert with the same qualifications (as requested by the respondent as an auxiliary measure). Indeed, in the particular case, such a defence against the expert declaration required quite some time.

In case **T 703/12** the board stated that, in accordance with Art. 12(2) RPBA 2007, the appellant's statement of grounds of appeal **should contain its complete case**, inter alia it should specify expressly all the evidence relied on. The appellant (opponent) was aware from the impugned decision that it was questionable whether the alleged prior use had been proven beyond any reasonable doubt. There was no justification for waiting until the

oral proceedings to request that the witness be heard. Furthermore, consistent with established jurisprudence, the **generic reference** to the appellant's submissions in opposition in the notice of appeal could not be interpreted as expressly specifying the offer of a witness. Accordingly, the witness offer made for the first time during the oral proceedings constituted an **amendment to the appellant's case** in accordance with Art. 13(1) RPBA 2007 and could only have been dealt with by an adjournment of the oral proceedings. In accordance with Art. 13(3) RPBA 2007, the board decided not to hear the witness. As regards the duty to present a complete case, see **T 30/15** and **T 1949/09** (late-filed tests). See also the case law applying new Art. 12(3) RPBA in chapter V.A.4 below.

3.2.8 Large volume of evidence

It is clear from the provisions of Art. 13 RPBA 2007 that, in spite of the principle of the right to be heard under Art. 113(1) EPC, a party does not have the right to have evidence which they filed or offered during appeal proceedings, in particular during inter partes proceedings, admitted into these proceedings (**T 1676/08**). In **T 1676/08** the patent proprietor had submitted as evidence – allegedly in response to expert opinions submitted by the opponent – a large volume of documents comprising more than a thousand pages and containing expert opinions only one month ahead of the oral proceedings, which the board had already postponed once at the proprietor's request. The board refused to admit one of those expert opinions (D100), finding that D100 was not identifiable as of particular relevance among submissions of over a thousand pages. It also refused to order at such a late stage an opinion by an expert pursuant Art. 117(1)(e) EPC or to hear the party's expert at the oral proceedings in the capacity of an accompanying person (application of **G 4/95**).

The board in **T 508/00** (allegation of prior use) refused to admit **documents** (**large in number** and including technical drawings) submitted by the opponent. By contrast, it admitted written statements produced by the opponent because they related to the alleged prior use, had been submitted relatively early in the appeal proceedings, giving the patent proprietor time to respond to them, and constituted a response to the opposition division's decision and to employee statements produced by the proprietor a month prior to the oral proceedings before the opposition division.

3.2.9 Strategic procedural approaches of parties to presenting evidence

In **T 1096/08**, notwithstanding that both witnesses were offered at a very late stage, the board could not share the view of the opposition division. Exercising its discretion under Art. 12(4) and 13(1) RPBA 2007, the board considered it appropriate to take evidence from the two witnesses offered by the respondent (opponent) during the first oral proceedings. However, the **piecemeal** approach taken by the respondent in asserting another alleged prior use shortly before the second oral proceedings clearly could not have been dealt with by the appellant or the board without yet another adjournment of the oral proceedings. Therefore, regardless of its relevance, the board decided not to admit this allegation of prior use into the proceedings and not to hear the witness offered as to such use.

In **T 245/10** the board held that the respondent (opponent) had had sufficient time to consider the results of comparative tests filed with the statement of the grounds of appeal and admitted them into the appeal proceedings. The respondent had announced in 2010 that it would comment on those tests and in filing its own comparative tests only a month before the oral proceedings in 2012, the respondent had taken the risk of compromising the admissibility of its own tests, the board observing that a **piecemeal strategy** resulting in multiple rounds of oral proceedings devoted solely to the admissibility of late-filed evidence ran counter to **procedural economy** (Art. 15(6) RPBA 2007; citing **T 270/90**, OJ 1993, 725, point 2.2 of the Reasons – **tactical abuse of procedure**). See also **T 2010/08**.

3.2.10 Parties treated equally (or not)

In case **T 712/97** the opposition division did not allow the appellant's experimental report **in response** to the respondent-patentee's experimental report into the proceedings. To admit the experimental report of one party, but not the response of the other party gave the appearance of **discriminatory treatment**. The opposition division had committed a procedural violation.

The board in **T 523/14** considered that it was contrary to the principles of **procedural fairness** and of **equal treatment** of the parties to admit late-filed D55 (written statement submitted by the opponent), while disregarding late-filed D54 (results of a search with internet wayback machine submitted two days later by the patent proprietor) because it lacked prima facie relevance for establishing the publication date of D11. In the board's opinion, D54 could serve to cast reasonable doubt on opponent's allegation that D11 was available on the Glasstech website in November 2007 or before and could thus have been admitted. However, in light of the opposition division's detailed consideration of D54, the board tended to conclude that its admission would not have altered the outcome. Nevertheless, in view of its potential impact on the most contentious issue in the proceedings, namely the public availability of D11, the board decided to consider D54 (see also **T 1551/14**).

In **T 435/20** documents D81 to D90 were filed as a direct and immediate response to new evidence submitted by the appellant (patent proprietor) on the last day for making written submissions under R. 116 EPC. In admitting the late-filed documents D80 and its supporting documents D64 to D79 into the proceedings but not admitting documents D81 to D90 filed by the respondents in direct response, the opposition division had not respected the principles of procedural fairness and of equal treatment of parties. The fact that the opposition division's preliminary opinion was negative for the appellant but positive for the respondents could not justify a different treatment of the parties, since a preliminary opinion was neither binding nor definitive.

3.2.11 When to order the taking of evidence and hearing of witnesses at oral proceedings

In **J 20/85** (OJ 1987, 102) the Legal Board held that evidence should be taken as soon as an issue arises. In a dispute between the appellant and the Receiving Section as to whether a particular document had been filed on a particular day, the post room staff could

not have been expected to have a clear recollection of what had happened more than a year after the events in question. See also in this chapter: **T 1028/11** (late-filed request for a witness hearing); **T 2003/08** of 31 October 2012 (hearing of a duly summoned witness who had failed to confirm attendance but was present on the appointed day).

Decision **T 1505/16** (slide mechanism of vehicle seat) is an example of a case where, in relation to an alleged prior use, the board decided at the oral proceedings to take evidence by **visual inspection** – of the slide mechanism of the seat brought along by the appellant (opponent) to those oral proceedings – pursuant to Art. 117(1)(f) EPC and R. 117 EPC. This taking of evidence was performed during the oral proceedings before the board. See **T 144/17** for a visual inspection by the opposition division.

3.2.12 When to submit supporting evidence – specific examples

In **T 7/07** the respondent (patent proprietor) disputed the admissibility of the appeal due to the question of the identification of the appellant (opponent) (R. 64(a) EPC 1973 / R. 99(1)(a) EPC). The board observed that the universal successor to the opponent automatically acquires party status in proceedings pending before the EPO on the date on which a merger becomes effective, irrespective of when supporting evidence is filed (see also **T 6/05**).

In **J 14/19** the board held that evidence that the requirements for a stay of the proceedings as per R. 14(1) EPC had been meet needed to be provided while the proceedings for grant were still pending and thus before the mention of the grant was published in the European Patent Bulletin. Any evidence not submitted by then should not be taken into account by the EPO.

3.2.13 Late offer of a replacement for a deceased witness – admitted

In **T 1760/10**, a replacement witness, Mr S, was offered due to the death of the first witness proposed. During oral proceedings the board decided to hear Mr S as a witness. The respondent (patentee) objected to the hearing of the witness: the nomination of Mr S as a witness was **late** (March 2013 / notice of appeal 2010 / oral proceedings October 2013) and the appellant (opponent) had not indicated the matters on which he should testify. In the board's view, nothing should have surprised the respondent in this regard.

3.2.14 Hearing the party without their attorney

A party may be heard in the absence of his patent attorney if the latter has been duly informed (cf. **T 451/89** and **T 883/90**, ex parte cases – taking of evidence ordered at oral proceedings).

3.3. Right to be heard

3.3.1 General

G 2/21 (OJ 2023, A85), point 32 of the Reasons summarises the earlier case law as follows: "The principle of free evaluation of evidence may not be used to disregard evidence per se insofar as it is admissibly submitted and relied upon by a party in support of an inference which is challenged and is decisive for the final decision. Disregarding it as a matter of principle would deprive the party submitting and relying on such evidence of a basic legal procedural right generally recognised in the EPC contracting states and enshrined in Art. 113(1) and 117(1) EPC (see also **T 1110/03**, point 2 of the Reasons, **T 1797/09**, point 2.9 of the Reasons, **T 419/12**, point 2.1.3 of the Reasons, and **T 2294/12**, point 1.1.3 of the Reasons)".

In **T 1110/03** (OJ 2005, 302) the board had observed that Art. 117(1) and 113(1) EPC embody a basic procedural right generally recognised in the EPC contracting states, viz. the right to give evidence in appropriate form (specifically by producing documents under Art. 117(1)(c) EPC) and the right to **have that evidence heard** (**T 1110/03**) to the extent that it has not been expressly excluded from the debate (**T 2294/12**).

EPO departments must ascertain the relevance of evidence submitted to them before deciding to admit or reject it. Only in exceptional circumstances need they not to do so (**T 142/97**, Catchword). An opposition division's refusal to consider evidence filed **in due time** infringes a party's fundamental right to free choice of evidence and the right to be heard (**T 142/97**, OJ 2000, 358). See also **T 1231/11** (citing **T 267/06**, **T 448/07**, **T 25/08**), according to which the offered witness has to be summoned should any doubt remain.

Furthermore, pursuant to Art. 113(1) EPC each party must be allowed to comment on any evidence legitimately submitted in the proceedings. Allowing one party, even the party that originally submitted the evidence, to require unilaterally and arbitrarily that the evidence be withdrawn or **excluded** from consideration would infringe this right (**T 95/07**; cf. the case in **T 760/89**, OJ 1994, 797, concerning a return of documents filed as evidence).

As a rule, if assertions made in an unsworn witness declaration ("eidesstattliche Versicherung") remain **contested**, a request from a party to hear the witness must be **granted** before these assertions are made the basis of a decision against the contesting party. In **T 474/04** (OJ 2006, 129) the opposition division had revoked the patent in suit because the invention did not involve an inventive step over the prior use evidenced in the declaration in lieu of an oath. Since fundamental assertions made in the declaration had been contested, the author was offered as a witness. Although the appellant (patentee) had consistently demanded that the author be heard, the opposition division decided not to summon him as a witness, even though he was available. In the board's view, the appellant had effectively been prevented from making use of a **decisive piece of evidence** (decision **T 474/04** extensively cited in **T 190/05**, which in turn is frequently cited, including more recently in **T 2659/17**, **G 2/21** and **T 778/21**, for example).

Failure to consider evidence will normally constitute a substantial procedural violation in that it deprives a party of basic rights enshrined in Art. 117(1) and 113(1) EPC (**T 1098/07**). In **T 135/96** (point 3 of the Reasons), ignoring documents (and arguments) relevant to inventive step was found to violate the party's right to be heard. The board in **T 1110/03** (OJ 2005, 302) made a similar finding where indirect evidence substantiating an allegation of fact relevant to novelty was disregarded. In **T 1536/08** the opposition division had infringed the opponent's right to be heard by completely ignoring the unambiguous offer in its notice of opposition to provide the original printed versions of crucial prior art documents (see also chapter III.B.2.5.5 "Failure to consider evidence").

For an overview of the case law, see **T 1738/21** (particularly points 2.1.5 and 2.1.11 of the Reasons), summarised in chapter III.G.3.3.4; see also chapter III.G.3.1.2.

3.3.2 Parties' right to comment

In **T 838/92** the board observed that in applying the principle of free evaluation of evidence, the opposition division or the board of appeal must exercise caution when evaluating the testimony of a witness whose impartiality is in doubt, with the parties of course being given an opportunity to comment on that testimony (Art. 113(1) EPC 1973). The board was not minded to sustain the appellant's objection to consideration of court bailiffs' reports on the basis that they had been established unilaterally. Such documents recording findings of fact were merely pieces of information which could be added to the file as evidence once they had been **submitted to the parties for comment**.

In **T 909/03**, where one of the appellants had objected to the manner in which a witness had been heard, the board held that it was not necessary for a party to be given a copy of the minuted testimony before questioning a witness. During the oral proceedings the party had been given sufficient opportunity to comment on the testimony of the witness.

In **R 15/21** the Enlarged Board stated that although the right to be heard implied that the decision could only be based on grounds on which the parties had been able to comment and therefore also covered factual and legal aspects taken into consideration for the decision, that right did not extend to the stance the board ultimately planned to take. Therefore, the right to be heard laid down in Art. 113(1) EPC did not mean a board had to inform the parties in advance of the reasons it was considering in reaching its decision (see **R 8/15**, **R 19/11**). As this principle applies to reasons in general, it is also applicable to the evaluation of evidence, including a board's interpretation of a document or passage, such as the disputed passage of statement E33 relied on by the appellant in the review.

3.3.3 Parties' responsibilities

In **R 6/12** (case **T 928/10**) the Enlarged Board considered unfounded the assertion made by the petitioner (opponent) that it had been surprised by the board's failure to order that expert witnesses be heard. The petitioner could and should have taken an **active part in the proceedings** and, in particular, it was up to it to inform the board during the debate of any need to hear witness to support its line of argument. The petitioner's claim to have been denied its right to be heard was not established. The board was **not obliged to**

address in detail each and every argument presented by the party. The Enlarged Board had already found in **R 21/09** that, on the pretext of an alleged infringement of the right to be heard, it was actually being asked to review the substance of the decision. This clearly fell outside the ambit of review proceedings, it being solely a matter for the board to decide whether to take a piece of evidence into account and, if so, to determine its probative value. See also **T 361/00**, in which the board found that the opposition division had not (as alleged) committed any substantial procedural violation in disregarding an offer of evidence, since the minutes showed that no request that a witness be heard had been made.

The appellant in **T 1028/11** alleged that the opposition division had infringed its right to be heard, and so committed a procedural violation, by refusing to hear the witness it had offered. According to the board, a witness's function was **simply to corroborate** the alleged facts on which they were heard and not to fill in gaps in those facts. Parties therefore had to specify what legally relevant facts the witness's testimony was intended to prove. Based on the evidence available, the opposition division had taken the view that the public prior use was not prejudicial to patentability. The board found that there would have been little point in hearing the witness at that stage. Cited in **T 444/09**. See also above chapter III.G.2.4.1a) "Role of witnesses and wording of request".

3.3.4 Improper reasons for rejection of evidence offered

If a **disputed point** is **highly relevant** to the validity of the contested patent, it is, as a rule, not in keeping with good procedural practice for an opposition division not to take up an opportunity to hear a witness or party in evidence and instead to require written statements and make do with their typically lower probative value. The board in **T 329/02** could not identify any extraordinary circumstances that might have justified an exception to this rule in the case in point.

In **T 1363/14** the board pointed out that no EPC provision required that the facts adduced in support of alleged prior use actually be proven within the opposition period in order to substantiate the allegation; rather the requirement was for opponents to submit all the relevant facts and, should the other party **dispute** them, as a precaution offer suitable evidence. It was in the nature of offering witnesses to state that they would corroborate the facts (already) alleged. It was not permitted to speculate about what a witness would be able to remember and what not, thereby pre-empting the evidence's evaluation. The principle of unfettered consideration of the evidence did not apply until after it had been taken and could not be used to justify not taking evidence offered. Thus, the opposition division's refusal to summon the witnesses had arbitrarily ruled out the possibility that they would be able to corroborate the opponent's allegations. Pre-empting the evidence's evaluation in this manner had been unjustified. See also **T 2238/15**.

Similarly, in **T 906/98** the board found that the opposition division had applied the wrong criteria when exercising its discretion (not to order the hearing of witnesses on a prior use) by speculating instead of investigating before refusing to take the evidence on offer, which related to the aspect of the prior use in dispute, namely what had been used and so made available to the public.

In **T 314/18** (alleged public prior use – several sales) a witness had been offered but not heard. Contrary to the view of the opposition division, the appellant (opponent) had offered the witness solely to corroborate the facts already submitted in support of the alleged prior use. No provision of the EPC required an alleged prior use to be conclusively proven within the opposition period. In referring to the Guidelines and arguing that the lack of adequate substantiation of the prior use in the notice of opposition could not be overcome by hearing the witness, the opposition division had mixed up the submission of facts and the proof required to establish them. By refusing to hear the proposed witness, the opposition division had in fact proceeded to assess evidence that had not yet been established, although it had appeared to be prima facie relevant for the decision to be taken. This was procedurally incorrect and the opposition division had thus infringed the appellant's right to be heard under Art. 117(1) and 113(1) EPC.

According to the case law of the boards of appeal and as mentioned in decision **T 142/97**, a deciding body must ascertain the relevance of evidence submitted to it before deciding to admit or reject it. When relevant features of the prior art trailers as asserted by the opponents were questionable and remained contested, a request by the opponents **for the evidence to be secured**, e.g. by hearing witnesses proposed by the opponents or by inspection of the trailer in accordance with **Art. 117(1)(f) EPC**, could not be rejected without justification. In case **T 1647/15** the opposition division had rejected the evidence on the basis of mere suppositions, making no real attempt to definitely assess it or its relevance. This refusal to consider evidence filed **in due time** infringed a party's fundamental rights to a free choice of evidence and to be heard (Art. 117(1) and 113(1) EPC).

More recently, the board in **T 1738/21** decided that by not hearing the witnesses offered, the opposition division had violated the appellant's basic procedural rights under Art. 117(1) and 113(1) EPC, namely that a party can give evidence in an appropriate form and have that evidence heard. The board noted that it was established case law that an opposition division violates an opponent's right to be heard under Art. 113(1) EPC if witnesses have been offered in connection with the disclosure of certain features of an alleged public prior use considered as adequately substantiated, but the opposition division decides that the alleged public prior use does not constitute novelty-destroying state of the art without hearing the witnesses. Therefore, if witnesses have been offered to corroborate alleged facts which were **decisive** for the decision to be taken, then the opposition division should hear the witnesses regarding the alleged facts in order to be in a position to take a decision on the basis of **all the available evidence**. The board considered therefore which alleged facts the appellants intended the witnesses to corroborate and if these facts were decisive for the outcome of the decision under appeal and the board came to the conclusion that the witnesses who had been offered, were in a position to corroborate the alleged facts which were found not convincing by the opposition division. The board could find **no** mention in the decision under appeal of the appellant's offer of witnesses nor any indication of the **opposition division's reasons for not hearing** those witnesses. The opposition division's failure to hear at least three witnesses amounted to a serious procedural violation.

In **T 2517/22** appellant 2 had offered Mr R as a witness already in the notice of opposition and again in their reply, after the patentee had questioned the probative value of the affidavit D2a (affidavit of an employee of appellant 2). In the annex to the first summons, the opposition division considered D2a to be sufficient evidence for public availability of D2 (operating manual) and did not summon Mr R as a witness. The opposition division changed its mind however and announced that D2 was not part of the prior art, albeit without taking into account the previous offer to hear a witness on the topic. In the board's view, the statements in the affidavit D2a represented facts which were a priori of high relevance for establishing whether or not D2 was part of the prior art, and therefore of high relevance for the outcome of the opposition proceedings. An offer to hear the undersigned of the affidavit D2a as a witness represented a further relevant and appropriate offer of evidence for the facts. The board stated it was a party's choice to present whatever means of evidence it considered to be suitable and it was an opposition division's duty to take its decision on the basis of all the relevant evidence available rather than to expect the presentation of more preferred pieces of documentary evidence, and to speculate on the reasons for and draw conclusions from their absence. The opposition division was of course free to evaluate any evidence provided by a party, but this freedom could not be used to disregard evidence that had been offered, and which might turn out to be decisive for a case, in particular not with the argument that some better evidence would have been expected. Instead of accepting the evidence offered by appellant 2, the opposition division appeared to have based its decision on general assumptions made on the capability of persons to recollect events after a certain time period (15 years) and specific assumptions made on the witness's personal capability, knowledge and experience. By making these assumptions without hearing the offered witness, the opposition division had in fact assessed evidence without examining it. A sufficiently exact recollection of various events 15 years later should not have been denied beforehand. The board concluded that the failure to consider appellants 2's offer to hear a witness on the public availability of D2 constituted a substantial procedural violation of the right to be heard. Reference was made to **T 906/98** and **T 474/04**.

In **T 267/06** the witness hearing offered as further evidence should not have been disregarded for the purposes of assessing the claimed public prior use as per D12 (drawing without a date). This amounted to a fundamental procedural violation (Art. 113(1) EPC). This decision was cited in **T 1231/11**, but the board there held that the two cases differed. See also **T 660/16**.

3.3.5 Witnesses at oral proceedings despite not confirming attendance in advance

In **T 2003/08** of 31 October 2012 witnesses were summoned in accordance with R. 118 EPC and they were invited to confirm their attendance. Neither witness replied at all. But both witnesses were present. The appellant (patentee) requested the board to refrain from hearing them. The failure to react to the invitation in the summonses did not have any influence on the board's view that the witness evidence was necessary.

3.3.6 No violation where evidence irrelevant to the outcome of the case

In **T 361/00** the board ruled that there was no point hearing the author of statutory declarations as a witness at oral proceedings because, in view of the other aspects on file that had been discussed, it would not change its decision.

3.3.7 No violation of right to be heard where evidence of limited probative value

In **T 103/15** the appellant (opponent) invoked the right to be heard to challenge the opposition division's disregarding the test report (D9) it had submitted as evidence. It argued that the reliability of D9 and the fact that its author had not been disclosed had not been an issue during the written phase of the opposition proceedings, not being raised by the opposition division until the oral proceedings, and alleged that it had thus been taken by surprise when the opposition division announced that D9 would not be taken into account. On evaluation of the evidence, the board held that, with respect to the probative value of test evidence, it was important not only to indicate the conditions under which those tests had been conducted, but also to specify the names of the testers and their employers so that the relationship between the testers and the party could be established if necessary. The appellant had been given the opportunity to provide the relevant information about the authorship of the test report D9 during the oral proceedings, but had refused to do so. In view of the test report's limited probative value, the board did not take it into account when reviewing the opposition division's decision (see also chapter III.G.4.2.2a) below).

For another case where the board accepted the opposition division's decision to disregard evidence, see **T 1680/15**.

3.3.8 Violation of the right to defend a case

In **T 1872/08** the board decided that in not admitting the additional comparative tests offered by the patentee, the opposition division had not taken into account that the patentee deemed further comparative data to be absolutely necessary in order to overcome its objections as to inventive step. The opposition division had thus **deprived** the patentee **of the possibility to defend its case effectively**. See also **T 2294/12**, in which the examining division had disregarded comparative tests.

3.3.9 Third-party observations

While it is well-established by case law that **third-party observations** (and accompanying evidence) can be considered, both at first instance and on appeal, there is no obligation on the board beyond such consideration and no right of a third party to be heard (**T 390/07**). As a rule, third parties have none of the procedural rights associated with status as a party to the proceedings, in particular the right to be heard (**T 1756/11**). Conversely, parties to the proceedings can comment **at any stage** on new facts and evidence emerging from third-party observations filed after expiry of the opposition period, if they think that these could influence the decision (**T 1756/11**, more recent example in **T 972/22** ; see also chapter III.N. "Observations by third parties").

3.3.10 Failure of a party to attend oral proceedings

In **G 4/92**, concerning the case of a decision taken against a party who has been duly summoned but fails to appear at oral proceedings, the Enlarged Board established that **new evidence** may not be considered unless it has been previously notified and merely supports the assertions of the party who submits it, whereas **new arguments** may in principle be used to support the reasons for the decision (**G 4/92**, OJ 1994, 149, Headnote 2). For more on non-attendance at oral proceedings, see chapter III.C.6.

4. Evaluation of evidence

4.1. Principle of free evaluation of evidence

Neither in the EPC nor in the case law of the board of appeal are formal rules laid down for the evaluation of evidence (reaffirmed in **G 2/21**, OJ 2023, A85, point 47 of the Reasons, before analysis of the law of the contracting states under Art. 125 EPC). The Enlarged Board has recalled many times that proceedings before the EPO are conducted in accordance with the principle of the free evaluation of evidence (**G 1/12**, OJ 2014, A114, citing **G 3/97**, OJ 1999, 245, point 5 of the Reasons; and **G 4/97**, OJ 1999, 270, point 5 of the Reasons), which it reaffirmed in the more recent **G 2/21** (point 29 of the Reasons). The decision being largely devoted to this point, the principles set out and confirmed there are reported below in a separate subsection.

The EPO departments have the power to assess whether the alleged facts are sufficiently established on a case-by-case basis. Under the principle of free evaluation of evidence, the respective body takes its decision on the basis of all of the evidence available in the proceedings, and in the light of its conviction arrived at freely on the evaluation whether an alleged fact has occurred or not (see e.g. **T 482/89**, OJ 1992, 646; **T 592/98**, **T 972/02**; see also e.g. **T 838/92**, in which the board found there was a detailed and consistent body of evidence establishing that a device had been on sale before the patent application was filed). See also **G 2/21**, point 34 and **T 1138/20** point 1.2.2 of the Reasons.

However, the principle of free evaluation of evidence in EPO proceedings cannot go so far as to justify the **refusal of a relevant and appropriate offer of evidence**. Free evaluation of evidence means that there are no firm rules according to which certain types of evidence are, or are not, convincing. The deciding body must take all the relevant evidence before deciding whether or not a fact can be regarded as proven (**T 474/04**, OJ 2006, 129, citing **G 3/97**, OJ 1999, 245, point 5 of the Reasons – see also **G 2/21**, point 34 and **T 1138/20** point 1.2.2 of the Reasons, which talk of a "decision on the basis of all the relevant evidence available in the proceedings"). On the other hand, failure to submit evidence despite a board's request to do so may be viewed as a sign that the evidence would perhaps not confirm what has been claimed (see **T 428/98**, OJ 2001, 494).

Ruling on a refusal to hear witnesses, the board in **T 1363/14** held that the principle of free evaluation of the evidence did not apply until after it had been taken and could not be used to justify not taking evidence offered. This was confirmed in **G 2/21**, point 44 of the Reasons, which also cites **T 2238/15**; see also in this chapter III.G.2.2. For a recent

application of this principle, see also **T 2517/22** in this chapter III.G.3.3.4 "Improper reasons for rejection of evidence offered".

According to the board in **T 1285/21**, the EPO departments have the power to assess whether the alleged facts are sufficiently established on a case-by-case basis. Under the principle of free evaluation of evidence, the body in question takes its decision on the basis of all of the evidence available in the proceedings and in the light of its conviction arrived at freely on the evaluation whether an alleged fact has occurred or not.

In **J 14/19** (stay of the proceedings) the board explained that the EPO did not have any discretion when deciding on a stay of proceedings under R. 14(1) EPC. If a third party demonstrated that the requirements in R. 14(1) EPC were met, the proceedings for grant had to be stayed. This was not the same as deciding whether the factual requirements for a stay under R. 14(1) EPC were indeed met, which was not a matter of discretion but a question of evaluating the evidence. The latter saw the decision-making body examine the evidence to decide whether it was satisfied that the claimed facts were correct (see **G 1/12**, OJ 2014, A114). If it considered that a pivotal fact had not been established, it could order that more evidence be submitted under Art. 114(1) EPC.

4.1.1 G 2/21: reasserting and refining the principle of free assessment of evidence

G 2/21 (OJ 2023, A85) addressed this principle and its consequences in detail, especially in points 27 to 46 of the Reasons, ruling on a referral that primarily concerned whether or not post-published evidence in support of the technical effect of an invention could be considered when examining inventive step.

G 2/21 provided an opportunity to explore once more how the principle operates, summarise the applicable case law and confirm certain aspects. Of particular note are the following findings from **G 2/21**, which are mainly to be found in points 27-46 and 55-56 of the Reasons:

The principle of free evaluation of evidence can be **defined** in abstract and general terms as allowing and, by the same token, requiring judicial bodies, such as the boards of appeal, to decide, at their own discretion and according to their own conviction, by taking account of the entire content of the parties' submissions and, where appropriate, any evidence admissibly submitted or taken, and without observing formal rules, whether a contested factual assertion is to be regarded as true or false.

This does not mean that the evaluation of the evidence can be arbitrary; rather, the evidence must be assessed comprehensively and dutifully. The only decisive factor is whether the judge is personally **convinced** of the truth of the factual allegation, i.e. how credible the judge classifies a piece of evidence. To do this, the judge must put all the arguments for and against a factual statement in relation to the required standard of proof. In doing so, the judge remains bound by the laws of logic and by probability based on experience. The **reasons** that led the judge to be convinced of the correctness or incorrectness of a contested allegation as to fact are to be set out in the decision.

The principle of free evaluation of evidence **cannot** be used to **disregard evidence** per se where it has been **admissibly submitted** and relied upon by a party in support of a disputed inference and is decisive for the final decision. Disregarding it as a matter of principle would deprive the party submitting and relying on it of a basic legal procedural right generally recognised in the EPC contracting states and enshrined in Articles 113(1) and 117(1) EPC (see also **T 1110/03**, point 2 of the Reasons; **T 1797/09**, point 2.9 of the Reasons; **T 419/12**, point 2.1.3 of the Reasons; and **T 2294/12**, point 1.1.3 of the Reasons).

This definition likewise applies to decisions taken by the **administrative departments** of the EPO in patent granting procedures.

The deciding bodies under the EPC have the power and the duty to assess on a case-by-case basis whether the alleged facts are sufficiently established. By virtue of the principle of free evaluation of evidence, each body takes its **decision on the basis of all the relevant evidence** available in the proceedings, and **in the light of the conviction** that it has freely formed when evaluating whether an alleged fact is or is not to be regarded as true and proven. Free evaluation of admissibly filed evidence relevant for deciding the case in hand means that there are **no firm rules** according to which certain types of evidence are, or are not, **convincing**.

The Enlarged Board in **G 2/21** recalled the boards' existing case law on the evaluation of evidence in points 38 to 46 of the Reasons.

It concluded from this case law that the principle of free evaluation of evidence qualified as a principle universally applicable to the assessment of any means of evidence by a board of appeal.

Turning more specifically to the referred points of law, the Enlarged Board in this respect held in **G 2/21** that evidence submitted by a patent applicant or proprietor to prove a technical effect relied upon for acknowledgement of inventive step of the claimed subject-matter **cannot be disregarded solely on the ground** that this evidence, on which the effect rests, had **not been public before the filing date** of the patent in suit and was filed after that date.

The Enlarged Board acknowledged a need to provide guidance on the application of the principle of free evaluation of evidence in respect of such post-published evidence relied on in support of a purported but contested technical effect.

4.2. Probative value of evidence on a case-by-case basis

According to the principle of free evaluation of evidence, each piece of evidence is given an appropriate weighting according to its probative value. As the Enlarged Board pointed out in **G 3/97** (OJ 1999, 245, point 5 of the Reasons) and **G 4/97** (OJ 1999, 270, point 5 of the Reasons), "(t)he principle of free evaluation would be contradicted by laying down firm rules of evidence defining the extent to which certain types of evidence were, or were not, convincing" (cited in **G 1/12**, OJ 2014, A114). Also confirmed in **G 2/21** (OJ 2023, A85),

according to which: "Free evaluation of admissibly filed evidence relevant for deciding the case at hand means that there are no firm rules according to which certain types of evidence are, or are not, convincing" (point 34 of the Reasons).

With regard to the boards' review of the evaluation of evidence at first instance, the applicable law appears to be established by **T 1138/20**, which largely endorsed the principles set out in **T 42/19** (see in this chapter III.G.4.2.2b)); the issue had indeed already been debated in **T 1418/17**, **T 1604/16** and **T 42/19**.

The following cases illustrate how the boards have evaluated various pieces of evidence in the light of the specific circumstances.

4.2.1 Ranking of means of evidence

In recent decision **T 1138/20** the board stated that evidence was assessed in accordance with the principle of the free evaluation of evidence, which also meant that the means of taking evidence listed in Art. 117 EPC was not set out hierarchically. **T 1138/20** brings together various developments to the principles deriving from the law of evidence (largely by reference to earlier case law). In its detailed reasons, however, it also applies them to the case at issue and, in doing so, illustrates the consequences of not ranking evidence. The board considered that the allegation that the opposition division had given more weight to the witnesses' testimonies than to the documentary evidence on file was, as such, insufficient for reversing the opposition division's findings of fact. It could generally not be considered an error if more weight is given to a witness testimony than to the documentary evidence on file. The mere fact that the opposition division decided that a fact was corroborated by the witness testimony, and was thus proven, even though the documentary evidence on file was actually not sufficient to prove that fact or was even contrary to the witness testimony, did not mean that there had been an error in the assessment of the evidence. See also point 1.2.3 of the Reasons for the decision on the scope of the required reasoning where there is contradictory evidence.

The board in **T 2659/17** observed (with reference to **T 474/04**) that an affidavit carried less weight than testimony. It found, therefore, that decisions should not be based solely on an affidavit, but rather the person who had made it should be heard as a witness **whenever** offered by a party. This applied all the more in the case in hand since the patent proprietor had challenged the content of the affidavits and demanded that the offered witnesses be heard. Denying it the opportunity to question those witnesses had prevented it from rebutting the ultimately crucial evidence. This was even more serious given that evidence for the prior use lay largely within the power and knowledge of the opponent (violation of Art. 113(1) EPC). See also **T 329/02** in this chapter III.G.3.3.4. See also **T 1604/22** on the probative value of affidavits considered by the board, bearing in mind that the witnesses in the case were heard at first instance (by videoconference).

In **T 918/11**, the board held that a mere reference to the fact that testimonies B1 and B2 concerned facts which had occurred at least 14 years ago and that other documentary evidence might possibly exist did not suffice in the case in hand to dismiss the testimonies as insufficient. It went against the general rules concerning the consideration of evidence

to distinguish dogmatically between the evidentiary value of a witness testimony on the one hand and a document on the other hand. The opposition division had apparently considered documents to be of a more conclusive evidentiary value than witnesses. Such an approach had no basis in the EPC, Art. 117 EPC containing no ranking of the means of evidence it listed (see also **T 2565/11**, in which it was similarly found that witness testimony and documents were not ranked in this way).

See also in this chapter III.G.2.4.1d) and III.G.2.5.4.

4.2.2 Witness testimony and written statements

See also in this chapter III.G.2.4. and III.G.2.5.

Witness testimony may be given in writing (written witness statements/statutory declarations) or orally (hearing of witness).

a) Credibility of allegedly linked witnesses

The probative value of the declarations of a witness depends on the circumstances of the particular case (**T 937/93**, cited in **T 190/05**). The **credibility of witnesses** cannot be impugned merely because they are related to one another and have a business relationship with one of the parties (**T 363/90**). An allegation based solely on suspicion cannot reasonably be expected to form a valid ground for casting doubt on the credibility of the evidence (see **T 970/93** involving allegations of falsified evidence). The statements of employees of one of the parties were regarded as sufficient evidence in a series of appeal cases, e.g. **T 162/87** and **T 627/88**; **T 124/88**; **T 482/89**, OJ 1992, 646; **T 363/90**; **T 830/90**, OJ 1994, 713; **T 838/92** and **T 327/91** (general manager of one party); **T 190/05**; **J 10/04** (employee of representative's law firm).

While the written statements of independent persons would tend to carry more weight, the statements of employees of parties to the proceedings are not objectionable per se. In this respect, case **T 523/14** was not comparable with **T 1257/04**, in which an **employee** statement was the sole piece of evidence filed to prove the public availability of a brochure. In **T 523/14**, the content of written statements by two employees of the opponents was considered sufficiently credible (public availability of an advertising newsletter sent by e-mail) because it was corroborated on its crucial points by other documents. Concerning the probative value of two expert reports submitted, one being from an employee of the opponent, see **T 129/12**.

A board may admit a statutory declaration as evidence even if it is signed by an opponent's senior manager. It is then to be considered in accordance with the principle of free evaluation of evidence (**T 64/13**).

In **T 2057/13** the affidavit in respect of the contents of priority document P1, filed for the first time by the patent proprietor in reply to the board's communication under Art. 15(1) RPBA 2007, was not admitted. The affidavit was written by one of the inventors named in P1 and an employee of the appellant-patent proprietor. The board had to assess

the contents of P1 in an impartial manner from the perspective of an independent skilled person.

In **T 505/15** the opposition division had considered the witness to be credible and the board had no reason to depart from this assessment. The appellant (patent proprietor) attempted to cast doubt on the witness's credibility by referring to the fact that she was an employee of the appellant (opponent) and that there was a bonus element to her remuneration. The board took the view that bonus payments were not unusual and, according to the witness, had for years not related to a project concerning the alleged public prior use. In the board's view the **discrepancies** pointed out by the appellant (proprietor) did not call into question the reliability of the overall assertions made by the witness.

In **J 10/04** the Receiving Section had doubted the credibility of sworn statements given by a legal assistant. It had not invited her to be heard in person as a witness because this would not have led to a different evaluation of the evidence. The Legal Board held, first of all, that a sworn statement was a form of evidence with a high probative value, especially if it was given, as in the case in point, in the knowledge that wilfully false statements were punishable under the applicable law. Strong reasons were therefore needed to disregard this kind of evidence, for example a set of circumstances making the statement very unlikely. If the Receiving Section had considered the circumstances described in the statement very unlikely, it ought to have heard the witness personally in order to evaluate her credibility (ruling applied in e.g. **T 1100/07**).

See also **T 2338/13**, a special case in which the doubt about the relationship between the opponent and a witness had implications for the applicable standard of proof; conversely, in **T 734/18** (in which the supplier had business ties to the patent proprietor and the opponent) the board could not see the similarities with **T 2338/13** cited by the patent proprietor in support of its request for a higher standard of proof to be applied on appeal than the opposition division applied (see in this chapter, III.G.4.3.2 "Public prior use").

In case **T 127/22** the respondent (opponent) submitted declaration D7, in which an expert working for the opponent had given the opinion about the determination of the gas flow factor. The board stated that declaration D7, as opinion of an expert, was admissible evidence under Art. 117(1)(e) EPC. No circumstances have been presented that would question the credibility or qualification of the expert. The mere fact that the **expert** is **an employee** of the respondent did not in itself cast doubt on the value of the opinion. The board recalled that statements of employees of parties to the proceedings are not objectionable per se.

See also **T 2892/19** in the present chapter III.G.4.2.2d) "Contradictory or consistent testimony" about allegedly unreliable witness having an interest in the invalidation of the patent.

b) Evaluation of evidence by the department of first instance – review

(i) Applicable law and recent discussion in the case law

Questions arise especially with regard to witness testimonies because the boards do not necessarily rehear witnesses. This has led to questions about the scope of the boards' power to review facts established at first instance, particularly those arrived at after hearing witnesses. That is why these questions are addressed under the present section.

The applicable law now seems to have been established by **T 1138/20** (especially points 1.2.4 and 1.2.6 of the Reasons), which largely endorsed the principles set out in **T 42/19** and which dealt not only with evidence given by witnesses but with documentary evidence too (see, for example, point 1.3.4(c) of the Reasons).

On the boards' competence, **T 1138/20** states, in particular, that the boards of appeal constitute the first and final judicial instance and thus the only judicial body to **establish both facts and law** in proceedings before the EPO. As such, the boards have the power, at any stage of the appeal proceedings, to establish the relevant facts of the case before them and thereby substitute the findings of fact made by the departments of first instance. However, the boards have no obligation to establish de novo facts already established by the departments of first instance (see **T 42/19**, point 3.3 of the Reasons). Indeed, neither the EPC nor any decision of the Enlarged Board limits the boards' competence to establish the facts. And the boards' power to establish the relevant facts of the case before them is not limited to what the parties have provided or what the first-instance department has established.

As earlier case law shows, the scope of the boards' competence had already begun to be expressly discussed in a series of still relatively recent decisions, starting with **T 1418/17**, which the board in **T 1604/16** then cited but did not follow, holding instead that boards had the power to review contested decisions in full, including **not only the points of law but also the facts**. The later decision in **T 42/19** not only confirmed the principles set out in **T 1604/16** but appeared also to reconcile them with those in **T 1418/17**, which was considered to provide valuable guidance (namely a list of "typical scenarios"). **T 423/22** (witness hearing by videoconference) endorsed the approach taken in **T 42/19**.

The board in **T 1138/20** held that the list in **T 1418/17** was not exhaustive: since the boards had full competence to review findings of fact, there was no reason a board should be limited to those criteria in its review. It observed that there were other situations too, noting, for instance, that a finding of fact could also be reversed if it was not corroborated by the evidence on file.

(ii) Reporting more about the reasons regarding different decisions from **T 42/19**

The board in **T 42/19** considered the list drawn up by the board in **T 1418/17** of when to review evidence to be valuable guidance, while the board in **T 1138/20** likewise found the three typical scenarios identified there to be helpful. However, as this list was reused, for example in **T 42/19**, there is no need to report **T 1418/17** and its reasoning below. As

already found in **T 1138/20**, the list is not exhaustive (point 1.2.6 of the Reasons, referring to **T 1604/16** and **T 42/19**).

The board in **T 42/19** summarised the scope of the boards' power to review a first-instance decision as regards the evaluation of evidence as follows in the Catchword:

"1. A board's power to review appealed decisions is not limited to points of law but extends to points of facts (in agreement with **T 1604/16**).

2. However, it is settled case law that a board is not obliged to take all the evidence anew and that parties do not have the right to have the taking of evidence repeated at their request before the board.

3. The principle of free evaluation of evidence, meaning that there are no firm rules on the probative value of the various types of evidence but that the deciding body is entrusted with weighing up all the evidence and basing its decision on what it is then satisfied has been established, implies a degree of freedom comparable to the one referred to by the Enlarged Board in decision **G 7/93**, Reasons 2.6."

(On the obiter dictum from **G 7/93** cited in **T 42/19**, see, however, **T 1138/20**, point 1.2.4(a) of the Reasons, which states that a board's review of a fact-finding process should not be conflated with the review of discretionary decisions within the meaning of **G 7/93**, Reasons 2.6)

"4. Thus, it is wise to similarly respect this freedom, especially when taking into account that a board, except when only reviewing documentary evidence, does not have the same first-hand impression of the probative value of a means of evidence as a department of first instance that has itself heard a witness or expert or inspected an object.

5. Although the board is not limited in its decision, it normally seems **useful to apply the test set out in** decision **T 1418/17**, Reasons 1.3: Unless the law has been misapplied (e.g. application of the wrong standard of proof), a board of appeal should overrule a department of first instance's evaluation of evidence and replace it with its own only if it is apparent from that department's evaluation that it: (i) disregarded essential points, (ii) also considered irrelevant matters or (iii) violated the laws of thought, for instance in the form of logical errors and contradictions in its reasoning.

6. The evaluation of evidence only refers to establishing whether an alleged fact has been proven to the satisfaction of the deciding body. The discretion-like freedom is restricted to this question and does not extend to the further question of how the established facts are to be interpreted and what the legal consequences are (see Reasons 3.2 to 3.6)."

In **T 42/19** the appellant (opponent) had requested a reversal of the opposition division's decision that an alleged public prior use of an insulin injection device marked named GensuPen had not been sufficiently proven. In its reasons, the board recalled the principles set out in the Catchword quoted above and stated that the boards usually just reviewed the way in which the evidence had been taken by the departments of first

instance and, where they did not find any deficiencies, applied the law on the basis of the facts found in the decisions. A board, being a deciding body as well, was also entrusted with weighing up evidence under the principle of free evaluation of evidence. As a consequence, it could not be excluded that a board might come to a different conclusion than the body that had issued the impugned decision. But being under the obligation to give reasons for its decision, the board had to be able to convincingly demonstrate where the competent division had erred. The test set out in **T 1418/17** gave **valuable guidance** in this respect. In the case in hand, none of the circumstances which would justify a review could be identified in the department of first instance's reasoning. In particular, the balance of probabilities had been the correct standard of proof. As regards the witness Ms S., relevant information was completely missing (for example, in what capacity she had accessed the consultation room of the medical centre, the precise circumstances under which she had obtained the GensuPen, whether she was a member of the public and why she had on the same day written a declaration that was used six years later). This cast a shadow on the plausibility of her statement and justified the opposition division's finding that, even under the lower standard of proof of the balance of probabilities, the public prior use had not been sufficiently proven, because the circumstances had not been fully and clearly specified. This lack of factual basis had not substantially changed with the new submissions in the appeal proceedings. And without this fundamental information, it was irrelevant whether the respondent (proprietor) bore the burden of proving that certain persons, such as hospital personnel or patients in a study, had been bound by a confidentiality agreement. The board did not see any reason to overrule the decision concerning the alleged prior use of GensuPen and therefore confirmed the opposition division's conclusion. In exercise of the discretion provided by Art. 12(4) RPBA 2007, the board further decided to disregard the request submitted by the appellant on appeal that another witness be heard to fill in the gaps identified by the opposition division, since doubts and objections in this respect had already been raised by the respondent (proprietor) during the written opposition proceedings.

Details of the decision in **T 1138/20** have already been reported above, and so this passage deals with just a few additional aspects. The board in **T 1138/20** stated that if the findings of fact of the departments of first instance relied on documents, the boards regularly made their own assessment of the evidence. In the case of oral evidence given by a party, a witness or an expert (Art. 117(1)(a), (d), (e) EPC) or an inspection (Art. 117(1)(f) EPC), the boards would normally not assess the evidence de novo by, for example, rehearing the witness. In such a situation, the department that had heard the witness was better placed to determine the probative value of the evidence given, in particular the credibility of the witness and the reliability of the testimony (i.e. its accuracy, e.g. how accurately the witness remembered and recounted the events). The boards could then defer to the first-instance department's evaluation of evidence. The board also stated that for demonstrating an error in the fact-finding process (point 1.2.6 of the Reasons), it would generally not be sufficient to argue on appeal that the evidence on file would have allowed a different conclusion and that this conclusion was equally likely, plausible or reasonable. Rather, in order to show an error, the party had to demonstrate that no body competent to establish the facts and acting in a reasonable way could have come to that conclusion. In such a situation, the contesting party could successfully allege on appeal that the first-instance department had not fulfilled its duty to give reasons for its finding of

fact. The party challenging the factual finding could claim an error in the opposition division's reasoning. The board also acknowledged (point 1.3.7 of the Reasons) that a finding of fact could be reversed if the findings of fact of the opposition division were not corroborated by the evidence on file. An example would be that the opposition division relied solely on witness evidence for a fact that the witness could not, or did not claim to, have witnessed. However, that was not what had happened in the case in hand.

(iii) Examples of how reviewing findings of fact has been dealt with in other case law

As is illustrated by the decisions reported below the issue of reviewing findings of fact had already arisen in the case law prior to **T 42/19**.

The board in **T 2565/11** overturned the evaluation of evidence made by the department of first instance because the opposition division had erred as regards the underlying facts and failed to give an evaluation that was free of contradictions. The board gave its own evaluation of the evidence regarding the relevant facts. The board also noted that further explanations given by a witness, in order to close a potential gap in the documentary evidence on file, could **not** be considered per se as **new facts**. Otherwise, hearing a witness would be meaningless, and evidence provided on the basis of documents would be given a higher evidentiary value than a witness testimony, for which no basis could be found in the EPC. **T 2565/11** is cited in **T 2398/12** in the context of an object submitted as evidence in support of an allegation of public prior use which had gone missing during the appeal but had already been examined by the opposition division.

The board in **T 1476/14** held there was no ground in the case in hand to overturn the opposition division's assessment of the testimony of two witnesses. The credibility of witnesses cannot be impugned because of **differences** in testimonies relating not to the essentials but to less important aspects of prior use.

In **T 1798/14** the opposition division had considered the witness reliable and his answers detailed, credible and consistent overall. The respondent (patent proprietor) had not voiced any concerns either; it had merely disputed that the machine witnesses may have seen comprised all the features of the claim. The board saw no reason to depart from this assessment and to doubt the accuracy of the witness's statements. In **T 544/14** the question of evaluating the evidence was again discussed in detail by the board (rehearing the witness necessary but eventually not decisive – alleged public prior use not novelty-destroying).

According to the board in **T 621/14,** appeal proceedings were not intended as a second opportunity to have evidence heard unless sufficiently substantiated grounds for appeal gave some reason for it. The mere desire for evidence to be evaluated differently did not result in a re-opening before the board of the procedure for taking evidence. The board saw no reason to deviate from the prior art identified by the opposition division through the hearing of witnesses.

In **T 1107/12** the board pointed out that the opposition division's evaluation of the testimony had left it in no doubt as to its reliability or the witness's credibility as a person. Its

evaluation of the evidence was not otherwise vitiated by any error in law. It was based on the right criteria, could be followed in all respects and did not contain any logical mistakes. It was therefore not open to the board to overrule its findings and re-evaluate the evidence in its place.

In **T 804/92** (OJ 1994, 862) the opposition division had, in a communication to the parties, suggested in detail the content of a statement under oath. Such a practice was firmly rejected by the board because it involved the risk of leading witnesses and could seriously undermine the probative value of such statements. This applied to departments at any instance in proceedings before the EPO.

T 1604/16 is a significant decision that both **T 42/19** and **T 1138/20** cited and endorsed while also reconciling it with **T 1418/17**. Given that **T 42/19** and **T 1138/20** have already been reported above, there is no need here to go into the principles and reasoning in **T 1604/16** (in particular the reference to Art. 12(2) RPBA), and instead what follows simply reports how the facts of the case were evaluated. The invention in **T 1604/16** related to a foldable ramp for loading a wheelchair into a vehicle. The opposition division had based its assessment on E1, E1/1 (with photographs) and the testimony given by a witness (buyer of the vehicle equipped with the ramp). The evidence adduced before the board included documents E1, E1/1 and the minutes of the hearing of the witness at first instance. There were no issues in terms of the witness's credibility (see in general **T 474/04**). The board did not see any reason why it should limit its review by applying the criteria set out in decision **T 1418/17**. In the case in hand, in view of several remaining doubts which arose from the content of the minutes, the board held that the evidence produced was insufficient and hence that the opposition division had erred in concluding that the ramp shown in E1/1 formed part of the prior art. See also chapter V.A.3.2.1. "Primary object of the appeal proceedings – Article 12(2) RPBA ".

T 1634/17 concerned an ephemeral disclosure (D11). The board could not agree with the opposition division, which had taken "into account the amount and quality of all evidence produced, particularly the reliability of the witness recollections and the high relevance of D11". Neither the amount nor the quality of all this evidence, nor, for that matter, the reliability of the witness recollection at the oral proceedings at first instance, needed to be assessed by the board. Whilst all this evidence might have been used to support, complement, interpret or explain the content of a contemporary written note, none of it was as reliable as such a contemporary note. The fact that none of the declarations on file was a contemporary written note taken at Dr M.'s presentation needed to be taken into account, but the opposition division had not done so. D11 was found not to form part of the state of the art.

c) Events long past

In **T 1191/97** the appellant's criticism of the evaluation of evidence by the department of first instance did not pose a serious threat to the witness's credibility. The fact that the events at issue had taken place a long time ago could readily explain certain imprecisions in the witness's testimony. The board saw no indication that the witness had been in breach of his obligation to testify to the best of his recollection.

In **T 61/07** the board made clear that the doubts cast by the respondent on the witness's memory about events which had happened 23 years ago concerned not the witness's credibility but the **credibility of the testimony**. However, it saw no reason to doubt that his testimony was credible. Just because the witnesses had each independently met a third witness before being heard did not automatically mean that their recollections had been influenced. Shortly before a party alleges prior use, witnesses are normally sounded out about what they actually remember. Such a **discussion with a potential witness** did not automatically imply that during it the party or one of its staff had influenced what the party remembered.

In the circumstances of case **T 918/11**, the board considered that the reasoning of the impugned decision that "... the mere declaration of one witness in connection with facts which occurred between 1992 and 1997, i.e. at least 14 years ago, is not sufficient to prove the details of prior use" was not well founded.

In **T 905/94** the board held that the fact that one witness had made his declaration three years earlier than other witnesses was not sufficient reason to make his testimony more credible.

In **T 1604/22**, in the board's view, D6a and D6d were affidavits, i.e. statements sworn under oath, which should be given a high probative value, unless other evidence casts doubt on them. The fact that the affidavits might have been written by someone else, e.g. the respondent's representative, was immaterial since by signing them the authors endorsed the statements made in the affidavits. The board was satisfied that this evidence was therefore sufficient and the alleged inconsistencies and doubts raised by the appellant were not convincing. The fact that the events in question took place a long time ago could easily explain some imprecisions in the witnesses' testimonies, without calling into question the overall credibility of their statements. The appellants also did not explicitly question the witnesses' credibility.

With regard to the credibility of witnesses, the board observed in **T 1210/05** that even a person who was not being dishonest might make untrue statements. A person can be honestly mistaken in his recollection of an event, particularly if the event took place sometime previously.

In **T 2217/19**, with regard to novelty, the appellant (opponent) submitted HE2, a statement by an inventor of HE1 (European patent) made 25 years after the priority date of HE1. The board agreed that the time passed might be a relevant criterion for the evaluation of the credibility and the precision of said declaration, even if made in good faith. The board considered that the mere recollection of the values (without written evidence) was not sufficient as clear and unambiguous proof that the compositions of HE1 and in particular the one of its example 1 were characterised by the features (i) and (ii) as defined in claim 1. Even assuming that the recollections were based on archival documents, it would at least have been necessary to state this fact in the declaration by explaining the nature of the respective documents. In the absence of such an explanation about the source of the data indicated in the declaration and in the absence of any supportive evidence, they could not be considered as sufficiently proven. This conclusion was reached after also taking into

account the fact that the value reported (for the gel content) was at the upper limit of the range recited in claim 1. Thus, even a small error in the recollection of this value could have the consequence that the gel content was within or outside the range defined in claim 1. The subject-matter of claim 1 was novel over HE1.

In **T 2517/22** the opposition division did not take into account the offer to hear as a witness the undersigned of the affidavit D2a on the issue whether or not D2 was part of the prior art. Instead of accepting the evidence offered, the opposition division appeared to have based its decision on general assumptions made on the capability of persons to recollect events after a certain time period (15 years). By making such assumptions without hearing the offered witness, the opposition division had in fact assessed evidence without examining it. A sufficiently exact recollection of various events 15 years later should not have been denied beforehand. (See also this decision under present chapter III.G.3.3.4 "Improper reasons for rejection of evidence offered").

In **T 483/17** (prior use – up to the hilt) the respondent (patent proprietor) doubted that the witness had been able, in his declaration on oath, to reproduce all the details about the delivery, which had taken place more than 10 years earlier, and pointed out that the appellant, who had obviously pre-drafted this declaration, must have had more information and documents than it was willing to submit in these proceedings. However, since the declaration was not needed to convince the board of the delivery, any "inconsistency" in it was irrelevant.

T 2165/18 (see also the abstract below, under chapter III.G.4.3.4c) "Archives and internet publications") turned on an undated user manual that had been published online. The board ultimately found that the statements made by a witness were not enough on their own to fill in the gaps in the evidence as to its date of publication and the software version it had been supplied with. It was unlikely that a witness, even if the manual's author, would still be able to remember the whole text nine years later. The opponent cited the decisions in **T 1798/14**, **T 2565/11** and **T 918/11** in support of its contention that a **single witness's testimony** could in fact be enough to prove prior use and that a witness could also fill in gaps in the alleged facts, but the board rejected this position, ruling that they did not apply in the evidential situation in the case in hand. See also **T 939/14** below.

d) Contradictory or consistent testimony

In **T 361/00**, as to the two **statutory declarations** (relating to visits to a cement works), the board had no doubt that they had been made in good faith but found them to be **contradictory**. Having found that the appellant's (opponent's) submissions at the oral proceedings had not clarified the contradictions, it concluded that the appellant had failed to furnish conclusive proof of the alleged prior use. Lastly, it held that there was no need to hear the witness, giving reasons for this finding (on contradictory statements, see also **T 833/99** and **T 832/13**, serious doubts due to the general nature of the statement).

In **T 1266/16** the board stated that, notwithstanding that the two declarations submitted were **"word-for-word identical"**, they did not contain any specific detail with respect to the suppliers they referred to, let alone any data regarding purchase or analysis performed.

As such, these statements, **unsupported by any corroborating evidence**, could not be considered as proof of the appellant's argument. Compare with **T 1604/22**, where the board stated the fact that the affidavits might have been written by someone else, e.g. the respondent's representative, was immaterial, since by signing them the authors endorsed the statements made therein.

In **T 1914/08** the board – like the opposition division at first instance – regarded two witnesses' testimonies as the decisive evidence proving without any gaps the alleged prior public use. Each testimony, considered in isolation, gave a consistent and full picture of the process in question.

In **T 1293/13**, to overcome an objection of insufficient disclosure based on a reference to a machine that was no longer in existence, the proprietor had submitted a statement from the president of the company that manufactured machines of this kind attesting that the results would be the same irrespective of the machine used. The board was not persuaded by the statement as it was not based on any verifiable data.

On an alleged prior use, the board in **T 453/02**, disagreeing with the patent proprietor (respondent), held the content of three statements to be consistent and convincing. Furthermore, the impartiality of the first statement could not be doubted as it had been made by the patent proprietor itself. In any event, the proprietor could not plausibly argue that the alleged public prior use had been based solely on testimony given after the date of filing of the contested European patent application. That testimony had been corroborated by other evidence (original trade fair catalogue bearing a date).

In **T 1043/93** the deposition of the witnesses (who did not bring documents as requested by the board) contained unclear answers, inconsistencies, and were in conflict with another, so that the board found that the related alleged public prior use was not proven and could not be considered to belong to the prior art (Art. 54(2) EPC)

In **T 100/97**, without casting doubt on the good faith of the submitted declaration, the board stated that for the content of such statements to be considered sufficiently credible, it had to be **corroborated by documents of a definite date**. In the absence of any such documents, the board decided that it could not be established with a sufficient degree of certainty what had been made available to the public before the priority date of the opposed patent.

In **T 2546/17** the board found that contradictions between the information in documents D7 and D9 (internet citation) when compared with document D11 cast general doubt on the reliability of document D11 (an email written nine years after the last date mentioned on document D7 by a person (librarian) not mentioned in document D7). D7 did not belong to the relevant state of the art.

In **T 473/93** the board decided that the appellant's surmise that he had been in error in making his statutory declaration was not sufficient to allow orally presented facts which deviated from the declaration to appear more credible. The fact alleged orally therefore had to be regarded as not proven.

An **unsigned statement** by an unknown and unnamed person should in principle be given minimal weight (**T 750/94**, OJ 1998, 32; **T 1818/12**). In **T 212/97** the board could not regard the citation of facts based on **hearsay** and not accompanied by a witness testimony as adequate evidence for the alleged prior uses.

In **T 939/14** the patent proprietor complained that the opposition division had ruled after having heard **just one witness**. Addressing its objection that, as per the decision in **T 1210/05**, a single item of testimony was insufficient to rule on the facts beyond any reasonable doubt, the board held that no such general principle could be gathered from that decision or, for that matter, from the case law of the boards of appeal in general. Cf. **T 2165/18** (point 1.9 of the Reasons) and **T 1057/15** (public prior use of a USB stick in a training session for customer service engineers).

Decision **T 464/20** provides a very detailed example of a board's evaluation of testimony contested by the patent proprietor. In this case, the board reviewed the patent proprietor's arguments with particular focus on alleged inconsistencies in the testimony. The board also ruled on the standard of proof in relation to convincing the department of first instance and on the consequences of not ranking the evidence when evaluating said testimony. In very detailed reasons, the board ultimately agrees with the evaluation at first instance, namely that the public prior use had been sufficiently proven.

In **T 1171/16** the board stated in relation to Art. 83 EPC that the respondent (patent proprietor) had argued that the declaration D7 by an employee of the respondent made in 2016 attested to the knowledge of the skilled person in 2004. The board, however, did not find the declaration to be a reliable source for establishing this. First, the declaration did not contain any particular information about the declarant's qualifications, occupation, knowledge nor indeed any other particular reason that would convince the board that the declarant could reliably attest to the knowledge of a skilled person in 2004.

In **T 34/18**, a case involving prior use and the examination of whether there existed an obligation to maintain confidentiality, the board held that the statements provided by a witness for the patent proprietor, as per the affidavit and the minutes of their hearing before a department of the Austrian Patent Office, were vague and did not cast any doubt on the credibility of testimony given in support of the opponent's assertions regarding a lack of any such obligation. The patent proprietor's witness had stated that there was indeed a written confidentiality agreement, but no such document could be produced. Overall, the impression the board took from this witness' statements was that he could not properly recall the events and had speculated on some points. He did not appear to specifically remember such an agreement but had assumed there would be one since that was normal practice. The statements by another witness offered by the patent proprietor were also too vague to refute the detailed statements provided by the opponent's witnesses. Decision highlighted by way of example due to its detailed reasoning on these points.

In **R 15/21** before the Enlarged Board, the appellant (opponent-respondent) criticised the board for having disregarded relevant evidence regarding written statement E33 in relation to the publication date of E1 (user manual), evidence which, according to the appellant, would have led the board to revoke the patent. In the written decision, the board had not

made any reference to the passage discussed by the petitioner in its oral arguments. The board decided that a gap such as the lack of a date in the user manual E1 could not be filled in by statements and testimony from a single person. Among other things, the appellant made reference to board decisions in which the testimony of just one witness had been enough to prove the asserted facts. The Enlarged Board did not agree with the appellant's analysis, holding that it was clear from the written reasons that the board had acknowledged – and indeed considered – the opponent's oral arguments. The Enlarged Board explained why in the case at issue the gaps in relation to E1 had not been filled in by a (single) witness and ultimately rejected the appellant's arguments. If the Enlarged Board were to assess whether the alleged facts, evidence and arguments presented by the appellant had been properly evaluated, this would require a review as to the substance, which was not within the Enlarged Board's competence (established case law since **R 1/08**).

In **T 2892/19** the appellant patent proprietor alleged that K was an unreliable witness since it had an interest in the invalidation of the patent and was involved in criminal proceedings. The board considered that such considerations did not render evidence or witness statements automatically inadmissible or unreliable; it had to be considered in the evaluation of the submitted evidence. In view of the strong documentary evidence provided in addition to K's witness statements and the fact that the appellant had not pointed to any substantial contradictions in these witness statements, the board was convinced, on the balance of probabilities, that Regen kits according to D127 and instructions for their use according to D129 were delivered to Levi Medical and clinicians in Italy before the priority date of the patent.

See also **T 649/20** which concerned the status of D1 – a scientific article from a journal – as prior art, of which the exact publication date was not available, as well as two printouts of emails (D15, D16) in which the managing editor and the senior publisher of the journal independently indicated the same date as date of publication for the issue of the journal in question (high degree of certainty). The board anyway considered that D14 (extract from public database from Central Library for Medicine) provided sufficient evidence that D1 was in fact publicly available before the priority date. Also relating to an issue as to when a journal was available to library users, in **T 1050/12**, meeting abstracts published in a supplement to a regular volume of a scientific journal were found to be publicly available before the priority date of the patent on the basis of library date-stamps and accompanying declarations of the librarians. Indeed the board stated inter alia there was evidence on file from three different libraries around the world (Germany, USA and UK) that copies of the journal were publicly available; there was corroborating evidence in the form of date-stamped copies for the dates of receipt and/or cataloguing, and the board had no reason to doubt that what the librarians described as being the usual routines in their libraries would indeed have been followed as regards the journal at issue. The board considered that regardless of whether or not the librarian was considered to be a member of the public (as was at stake in decision **T 834/09**), that there was persuasive evidence that documents D3 and D7 had been made available to the public before the priority date of the present patent. In **T 649/20** the board decided that the librarian that received the journal issue and registered it in the database was a member of the public.

See also **T 1138/20**, point 1.2.3 of the Reasons (obligation to provide reasons).

e) Witness testimony and national proceedings

In **national proceedings** before the Dutch District Court and Court of Appeal, several witnesses had been heard, and written statements had been introduced by both parties. The Dutch Court of Appeal could not establish an uninterrupted chain of proof that the alleged public prior uses had indeed taken place before the priority date of the contested patent. After evaluating the Dutch Appeal Court's findings, the board's judgment in **T 665/95** was that no further investigations were necessary and that the conclusion of the Dutch Appeal Court could be followed, with the consequence that the subject-matter of the granted claim 1, contrary to the impugned decision of the opposition division, was considered to be novel. Other examples of cases dealing more generally with national proceedings and issues of evidence include **T 760/89**, OJ 1994, 797 (USA); **T 582/90** (FR), **T 1043/93** (IT), **T 885/02** (NL); **T 276/07** (IT); **R 21/09** (UK); **T 1904/12** (DE), **T 202/13** (NO) and **T 2220/14** (USA); **T 34/18** (AT); **T 1841/18** (IT); **T 2892/19** (UK); **T 526/21** (UK).

In **T 407/08** the appellant (patent proprietor) filed a copy of an expert opinion which was ordered by a German Court in a patent dispute. A statement according to general experience in this expert opinion was taken into account by the board to conclude that a given feature was not implicit to a skilled person (Art. 100(c) EPC).

f) Obligation to raise objections under Rule 106 EPC

In case **R 8/17** the Enlarged Board recalled that an objection under R. 106 EPC must be expressed and specific. The petitioner claimed that it raised the objection in the oral proceedings but neither the minutes – it had not been requested that they be corrected because incomplete – nor the written reasons contained any indication of such an objection. Furthermore, the affidavit of the petitioner's representative submitted with the petition did not assist the petitioner on this crucial point.

4.2.3 Test and experimental evidence

a) Test methodology and probative value

In **T 702/99** the board made extensive remarks with regard to the probative value of test evidence. It noted that it was essential that **comparative tests** conducted by a number of persons as evidence for or against qualities such as an improved "feel" of a product (e.g. cosmetics) be made under conditions of maximum objectivity on the part of those conducting the tests. Parties to proceedings should adopt the same standards in the preparation of such test evidence as they should in the preparation of experimental evidence. While the use of independent persons would naturally tend to carry more weight, the use of employees might not be objectionable per se as long as the test conditions were designed to ensure that the employees were not biased by prior knowledge of either the tested products or of their employer's expectation of the test result. The presentation of test evidence also had to be accurate, but the format of the presentation was of secondary

importance; a carefully prepared report and/or table might convey as much information as a large number of statements from the testers.

In **T 275/11** (bleaching/highlighting composition for hair) in order to demonstrate that the problem was successfully solved, the appellant (patentee) referred to two comparative examples. The board cited **T 702/99** and recalled that it was desirable to show that the tests had been **carried out under "blind" conditions** to avoid any suspicion of bias. The board found that there was no indication of the conditions under which these tests had been conducted. Therefore, any effects referred to by the appellant had to be disregarded.

In **T 103/15**, on the matter of test reports ("*rapports d'essai*") filed by the opponent (appellant), the board, with reference to **T 702/99**, stated that, with respect to the probative value of test evidence, it was important not only to indicate the conditions under which those tests had been conducted, but also to specify the names of the testers and their employers so that the relationship between the testers and the party could be established if necessary. This also applied in cases where the opponent was acting as a **straw man** on behalf of a company, because then the relationship between that company and the testers could be a factor in deciding on the probative value of the test evidence filed by the straw man. A neutral institute could have been assigned to perform the tests. The appellant had been given the **opportunity to provide the relevant information** about the authorship of the test report D9 during the oral proceedings, but had **refused** to do so (see minutes). Lastly, the reasons for not considering document D9 during the first-instance opposition proceedings still applied at the appeal stage. In view of the test report's limited probative value, the board did not take it into account when reviewing the opposition division's decision.

In **T 301/94**, on the issue of novelty, the board stated that analyses produced by the opponent (Saint-Gobain Emballage) showed that the results obtained by two laboratories (the laboratories of the Institut National du Verre in Belgium and of Saint-Gobain Recherche) for the compositions and the optical properties of the glass bottles all fell within the ranges defined in claim 1 of the patent in suit and that the results of the analyses were in sufficient agreement with each other to be reliable.

In case **T 1863/21**, concerning an objection under Art. 100(b) EPC (see abstract in chapter II.C.9.3) the appellant (opponent) alleged that the result was not achieved over the entire scope of claims 1 and 2. The appellant's only line of argument was based on a **statistical analysis** of the results shown in the figure of D15 filed by the patent proprietor. The board observed that statistical significance was not and should not be the sole criterion for considering experimental results, let alone for excluding them from consideration (having analysed the contributions of **T 884/06** and **T 299/18**). A patent didn't have to fulfil the standards that a **peer-reviewed scientific publication** might have to comply with. Further the board, with reference to **T 2036/21**, stated that the deciding body decides in the light of its own conviction, taking into account the evidence available in the proceedings. In proceedings before the EPO, it is thus not a prerequisite to perform a statistical analysis of the results and to determine a specific confidence interval in order to consider a certain piece of evidence convincing, as it is most often required in biomedical research and by health authorities granting marketing authorisations for medicinal products. Statistical

significance quantifies the probability that an observed difference in data is not a random occurrence. Hence, the allegation of lack of statistical significance did not in itself prove the hypothesis that there was no difference between groups, or no effect of a treatment (explained in detail in D21, "Retire statistical significance", Nature, 567, 2019, a document that discussed the relevance of statistical significance when reporting on crucial effects in scientific publications).

In **T 956/21**, the appellant (patent proprietor) raised several objections against the probative value of the experiments reported in D7, questioning the conditions under which the tests in that document had been carried out. The board did not share this view and stated that the minor deviations from the very specific examples of the patent in suit regarding optional, non-essential features could not be considered as a critical deviation which rendered the experiments of D7 irrelevant or non-credible. Contrary to the view of the appellant, it was not required to repeat each and every detail of the examples of the patent in order to challenge sufficiency of disclosure (**T 226/85**, **T 2242/16**). Moreover, the board stated the requirement of sufficiency of disclosure implied that the skilled person had to be able to rework the invention over the whole scope and not only when following a very specific and detailed embodiment. The board therefore concluded that although the experiments of D7 deviated slightly from the specific example of the patent, they nevertheless represented the teaching of the patent and were an appropriate repetition of the teaching of the patent which can be considered for assessing sufficiency of disclosure.

b) Evaluation of tests cited to prove that problem solved (Article 56 EPC)

For cases where the tests and evidence filed are post-published evidence, see **G 2/21** (OJ 2023, A85), which lays down the rules in this regard; **G 2/21** largely reported in this respect in chapters inventive step at first place, and sufficiency of disclosure. The Enlarged Board departed from the concept of "plausibility".

In **T 1872/08** which concerned inventive step and the non-obvious solution of a problem based on an advantageous effect demonstrated by means of comparative tests, the opposition division had not deemed the tests provided by the applicant (appellant) to be relevant because the tests had been made with one specific printer on one specific paper, both different from the paper and the printer used in example 18 of document (D9). The board stated that, according to the established jurisprudence of the boards of appeal, "in the case where comparative tests are chosen to demonstrate an inventive step with an improved effect over a claimed area, the nature of the comparison with the closest state of the art must be such that **the effect** is convincingly shown to have its **origin in the distinguishing feature of the invention**. For this purpose it may be necessary to modify the elements of comparison so that they differ only by such a distinguishing feature ..." (**T 197/86**, OJ 1989, 371, point 6.1.3 of the Reasons). The board concluded in **T 1872/08** that the comparative tests provided sufficient evidence that the problem was solved.

In **T 479/06** the board found that tests results cited by the proprietor to show that the problem was solved by the claimed solution and so established inventive step were **not conclusive**. It could not conclude on that basis that the technical problem had actually been solved, so the technical problem had to be redefined. (For another example, see

T 1177/17, in which, because the respondent had not substantiated its submissions with any evidence other than the data reported in example 1 of the patent, a study in mice vaccinated with Influvac, the technical effect was not plausible, and so the effects were not taken into account in the formulation of the objective technical problem.)

In **T 568/11** the board stated that the technical problem needed to be reformulated. One of the arguments of the patent proprietor was that the additional differences between the compositions to be compared were so minimal that they would have no influence on the properties of the composition.

Concerning also an effect not **attributable to** the distinguishing of feature, in **T 71/09**, the mere comparison of the two compositions was insufficient to demonstrate that the alleged effect had been caused by the claimed solution or that this effect had been produced across the entire claimed area. Indeed, the improved resistance of hair dye to shampoos might **be caused by other factors**. Improved durability of hair dye had not been established for all the claimed compositions.

In **T 1127/10** (hair treatment), since there was no experimental data in any of the examples in the patent, the appellant had submitted a document reporting on two series of comparative tests. The board, however, found that the document's description of the test procedure and analysis of the results were deficient and insufficiently informative to demonstrate plausibly that such an improvement had been achieved (see also **T 1962/12** and **T 383/13**: comparative examples deficient – improvement not plausibly demonstrated).

In **T 488/16** the board agreed with the appellant that it is not always required to include experimental data or results in an application (see **T 578/06**). It is, however, a conditio sine qua non that it is shown that the technical problem underlying the invention was at least plausibly solved at the filing date. If, as in the present case, the nature of the invention was such that it relied on a technical effect which was neither self-evident nor predictable nor based on a conclusive theoretical concept at least some technical evidence was required to show that a technical problem had indeed been solved (for a case where there was no need to file experimental evidence in relation to Art. 83 EPC, see for example **T 416/14**).

The Enlarged Board stated in **R 9/14** that the petitioner was mistaken in believing that the deciding board had committed a serious procedural violation by not informing it of the correct sequence to be followed in the problem-solution approach and in the way it had applied the substantive law. The submission of comparative test results to prove an effect or improvement was part of the problem-solution approach when establishing the problem over the closest prior art that is effectively solved by the claimed subject-matter. The petitioner's specialist knowledge of patent law should have told it that. There could thus be no question of a "surprise" or infringement of the right to be heard.

In **R 16/13** the board – ex officio – questioned the probative value of comparative examples relied upon by the patent proprietor although their conclusiveness for demonstrating a technical effect of the claimed invention had not been disputed by the opponent. The decision of the board under review was set aside.

c) Evaluation – other tests

In ex parte case **T 2340/12** the application related to a space energy implosion unit. In relation to sufficiency of disclosure, the appellant (applicant) claimed without citing a specific internet citation that over 40 000 internet citations could be found concerning "Space Energy", and it only referred to "indirect" measurements carried out on white rats or patients, but did not elaborate on the nature of these experiments or on their relevance for the claimed invention, despite having been invited to do so in the provisional opinion issued by the board. The criticisms raised by the examining division regarding the absence of a control group for the patients treated, the doubts regarding the statistical relevance of the experiments carried out, the absence of details as to the circumstances and the way the experiments were controlled, were justified.

In **T 453/04** the board found the **experimental evidence** advanced by the appellant (opponent) to be defective for two reasons. Firstly, the teachings of the patent in suit were not accurately replicated. Secondly, the product presented as representative of the prior art had not been shown to belong to the prior art. Thus, the experimental evidence of the appellant did not demonstrate that the process steps set out in claim 1 of the main request resulted in products indistinguishable from those of the prior art.

In **T 1248/08**, in the application as filed, a number pertaining to a value used in example 1 was illegible and indecipherable. It was not clear whether it should read "0.08" or "0.09", or even "0.05". The board held that the arguments of the appellant adopting proof "on the balance of probability", in particular **a survey** in favour of the value of "0.09", had to fail. According to the survey conducted amongst partners and staff at the firm of the appellant's representative these results demonstrated that the value in question could not be considered to be "0.09" with a certainty "beyond reasonable doubt", as required by the established jurisprudence. In any event, a question of accuracy and disclosure could not be decided by a **poll** (see also chapter II.E.5. "Evidence and standard of proof for allowing amendments and corrections").

4.2.4 Archives and internet publications

In **T 649/20**, in which the board was concerned with the status a scientific article from a journal (D1) as prior art, of which the exact publication date was not available, different pieces of evidence were submitted. The board considered that D14 (extract from public database from the Central Library for Medicine) already provided sufficient evidence that D1 was in fact publicly available before the priority date; the librarian that had received the issue and registered it in the database from which D14 had been obtained was a member of the public in any case for the purposes of Art. 54(2) EPC (see also **T 834/09**, and cf. **T 1050/12**). Recent decision **T 649/20** contrasts with older case **T 314/99**. See also **T 364/20**.

In older decision **T 314/99** concerning the availability to the public of a diploma degree paper ("Diplomarbeit"), the board took the view that the paper had not become publicly available by its mere arrival in the archive of the Chemistry Department **Library** of the University. The **logbook** produced in evidence was a handwritten notebook in which the

diploma degree papers received in the archive were entered by the librarians. The logbook itself was not an official publication of the library but essentially an internal document of the library staff. After closer examination of the annotations in the logbook, the board said that it could not be concluded with certainty that the relevant entries had actually been made before the relevant priority date and it could not be ruled out that they had been added at a later time, when for one reason or another the time frame had become relevant.

In **T 91/98** the respondent (opponent) had challenged inventive step on the basis of document (8) which was an **entry from the Lexis-Nexis database**. The document did not, however, provide any evidence as to when this information had been entered into the database, i.e. as to when it had been made available to the public. Nor could the date of availability be taken as the date mentioned in the heading of the entry ("September 3, 1985") as this latter date could not be equated to the distribution date of the information and was not even necessarily correct. After detailed evaluation of the declarations and affidavits filed by the respondent the board arrived at the conclusion that the date on which the information contained in document (8) had been made available to the public could not be unambiguously defined.

T 2284/13 (Wayback machine as prior art) the board accepted a combination of D5, an incomplete archive version of a web page (on the Wayback Machine *web.archive.org*; publicly available on 2004 with only small images) and D5', a recent download (2009) of the webpage (with full images) as evidence of a prior art publication. Accordingly, when considering the prior art disclosure of D5, the expanded figure "the MRTT fuel system" shown in D5' also had to be regarded as forming part of that disclosure.

In **T 1698/08** there was no reason for the board to exercise its discretion to refuse to admit the evidence, as it could neither be said that it was irrelevant nor that it was unnecessary. A refusal to admit could in any case not be based on statements in the document with respect to the **accuracy of the facts** it contained. Such statements related to the probative value of a document. Based on the principle of the free evaluation of evidence (**G 3/97**, OJ 1999, 245, point 5 of the Reasons), the board is free in assessing to what extent the information in a document is credible, whereby such a statement may play a role. Case **T 1698/08**, in respect of the disputed validity of an authorisation related to an (internet) **uncertified extract** from a commercial register.

In **T 286/10** the board held that a merely general allegation that **digital libraries** were unreliable was not enough to cast doubt on the date on which a document stored with Internet Archive (*www.archive.org*) had become publicly available. It applied the usual standard of proof on the balance of probabilities (confirmed in **T 2227/11**, **T 1711/11**, **T 353/14**, **T 545/08**, **T 1066/13**). See also chapter I.C.3.2.3 "Internet disclosures".

In ex parte case **T 3000/19** concerning the use of electronic evidence in proceedings, the refusal decision was based on a YouTube video as prior art, which was no longer accessible as of the date of the board decision. According to the board, examining divisions should make sure that an internet disclosure used as state of the art is reliable in terms of both the publication date-and continued accessibility to its content in the version made publicly accessible on that date. Due account should be taken of the rights of third

parties and the public to inspect the file under Art. 128 EPC. Since the content on the internet changes over time, when electronic evidence such as an internet document or a video is used as prior-art disclosure against the patentability of an application, appropriate measures should be taken for collecting, storing and preserving such evidence and making it accessible under suitable conditions for the judiciary, or interested parties such as the applicant, an opponent, their respective representatives or a member of the public. See chapter III.K.3.4.4 and III.W.3. See also **T 3071/19**.

See also in this chapter III.G.4.3.4c).

4.2.5 Other written evidence

In **T 332/87** a dated **internal paper**, marked as being confidential and not signed, was – together with an undated leaflet – not considered sufficient evidence. In **T 595/89** the board decided that the opponent's in-house documents relating to the installation of a device in an aeroplane and to the sale thereof were not sufficient to prove public prior use.

In **T 204/88** a **letter of tender** was not sufficient to prove public prior use because it was not discernible when and to whom the device was to be delivered and because the device was described in terms too general for anyone to identify whether it corresponded to the invention. In **T 725/89** too, a dated tender was not regarded as sufficient evidence, as it was not proven when the tender had actually been presented, and the date of the tender was only one week prior to the priority date. By contrast, the board took the view in **T 482/89** (OJ 1992, 646) that an **unsigned delivery note**, together with other documents, could constitute sufficient evidence of delivery.

In **T 505/15** the board stated that the appellant's (opponent's) argument was credible that the **original** printed document was no longer available about 14 years after its creation, given that there was no obligation to keep the original paper version for more than 10 years. However, the board did not regard the lack of a signature as casting doubt on the content of the document. Firstly, the allegation of a legal requirement for signing such documents had not been substantiated. Secondly, even if the printed document was originally signed, it was unlikely that the electronically stored version of the document would contain such a signature. See also **T 2466/13**, which deals with both a failure to provide the originals of contracts assigning the right of priority and a mere allegation that a signature might have been forged.

In **T 48/96** the board decided not to accept copies of pages from a **catalogue** bearing a date as sufficient proof of availability to the public. In order to prove the allegation that a particular apparatus described in a catalogue had been available to the public before the priority date, it was not sufficient to show that the catalogue had been published on time, because a mere indication in a catalogue did not constitute absolute proof that the described product had in fact been available to anybody; for example, there could have been a delay (see in this chapter III.G.4.3.4a) for examples of cases concerning catalogues and commercial brochures, including **T 1710/12**, in which the board addressed the implications for the standard of proof where such a catalogue has not been produced in support of alleged prior use).

In **T 905/94** the patent proprietor had exhibited a blind at an exhibition. After having considered the evidence regarding the exhibition the board looked at the question of whether use of the same **trade name** for different models could constitute evidence of the fact that the patent proprietor had marketed or described the blinds according to the patent at issue before the date of priority. In the board's opinion, such use could not constitute sufficient evidence since it was common practice in industry for the same name to be used and retained for a product, the technical characteristics of which changed over time as improvements were made. See also **T 2020/13** on a change of trade name for prior-art products defined by that trade name. See also the case law cited in chapter II.C.6.6.10 "Chemical compounds" after **T 842/14**.

In **T 2357/12**, concerning the transfer of opponent status and the concept of "universal succession", the board commented on the evaluation of evidence. The proprietor questioned the probative force of **private documents**, as submitted in this case, rather than public registration documents, as evidence of the transfer of opponent status in inter partes proceedings. The board stated that whereas **public registers** often enjoyed public trust regarding the facts registered and other public documents might be more conclusive on formal questions, the identity of the issuer and the date and place of creation of a private document could be more easily contested. However, neither kind of document provided irrefutable evidence of the correctness of a document's content. Citing examples of the different types of documents accepted in individual cases, the board pointed out that the boards had always accepted public and/or private documents as evidence of the transfer of rights, whether by way of universal succession or a single transfer of assets. The level of proof required was credibility of the facts for which evidence was given, in the light of all circumstances. (Decision **T 2357/12** cited for example by **T 854/12** and **T 1575/17**.)

The opponent having died, in **T 74/00** in the board's view, the best evidence which could be provided was evidence of the relevant law of succession (here, Japanese law) by way of **legal opinion** from a Japanese attorney-at-law; the mere filing of copies of a party's correspondence with his instructing Japanese attorneys could not serve as substitute. In **T 205/14** (and **T 517/14**) Israeli law (applicable) was proved to the satisfaction of the board by an expert opinion provided by the party (right of priority – assignment). In **T 1201/14**, which also concerned transfer of priority, legal opinions were provided but did not satisfy the board on their merits (on this point, see the presumption now laid down by **G 1/22** and **G 2/22** (OJ 2024, A50), see also point 133 of the Reasons).

In case **T 1720/20** the board, as a consequence of the principle of free evaluation of evidence, decided that a photographic comparison of non-Latin characters (here Chinese) submitted to determine an applicant's identity for a priority claim was permitted and rejected the question formulated for a referral jointly requested by the parties.

4.3. Standard of proof

Even though different concepts as to the standard of proof have developed in the case law of the boards, they all have in common that a judgement is to be made on the basis of the application of the principle of free evaluation of evidence (confirmed by **G 2/21**, point 46 of the Reasons).

The board in **T 1138/20**, a case that turned on issues of proof, clearly stated (see point 1 of the Catchword) that there is **only one standard of proof** in the proceedings before the EPO: the deciding body, taking into account the circumstances of the case and the relevant evidence before it, must be **convinced** that the alleged fact has occurred. (See also **T 1138/20** point 1.2.3 of the Reasons, on the obligation to give reasons).

Compare **G 2/21** (OJ 2023, A85), which contains the following passage: "The only decisive factor is whether the judge is personally convinced of the truth of the factual allegation, i.e. how credible the judge classifies a piece of evidence. To do this, the judge must put all the arguments for and against a factual statement in relation to the required standard of proof. (…) The reasons that led the judge to be convinced of the correctness or incorrectness of a contested allegation as to fact are to be set out in the decision." (see point 31 of the Reasons, and also point 46 of the Reasons cited above). **T 832/22** analyses decisions including **G 1/12**, **G 2/21** (points 30-31 of the Reasons) and **T 1138/20** with regard to the relationship between the principle of free and unfettered consideration of evidence, conviction of the deciding body and standard of proof.

When a standard is applied, the EPO standard of proof is generally the balance of probabilities. By way of exception, the standard of proof of the balance of probabilities is shifted to a standard of proof beyond reasonable doubt mainly in opposition where only the opponent has access to information (evidence) concerning, for example, an alleged public prior use.

The board in **T 1138/20** stated that if, for example, only the opponent had access to the relevant evidence, this fact must be given due consideration in the deciding body's assessment as to what weight and importance are to be attached to such evidence. This was not the same as to say that a different standard of proof should apply.

In **T 778/21** the board firstly noted that the prior use occurred within the knowledge and control of the opponent and concerned the use of a specific machine. Even if the machine type was publicly available for sale, the alleged instance of prior use concerned the one specific machine to which the proprietor had no access. In such cases, the board stated that it is established case law that the required standard of proof was either "beyond all reasonable doubt" (**T 97/94**) or that the deciding body had to be convinced with a sufficient degree of certainty (**T 1138/20**, **T 545/08**).

Of note are some other, earlier decisions containing lengthy observations on the standard of proof and the previous case law on this, namely: **T 2451/13** on the meaning of "beyond reasonable doubt" and **T 545/08** on the meaning of "balance of probabilities" in the boards' case law; in the latter decision, the board considered the matter in the general context of the law of evidence, concluding that a probability as low as 51% would not suffice.

T 1138/20 contains very detailed reasoning on the standard of proof applicable before the EPO, identifying decisions (**T 545/08**, **T 768/20**, **T 660/16**, **T 1634/17**) where it was not deemed necessary to explicitly decide on the applicable standard and it was instead emphasised that what mattered was whether the board was convinced. And the board in

T 1138/20 considered that making a distinction between the above-mentioned standards was neither necessary nor mandated by case law.

Indeed, several decisions have not considered it necessary to decide explicitly which standard of proof applied: see **T 2466/13**, in which it was found that there was no need to decide on the applicable standard of proof. In the same vein, see **T 768/20**, **T 660/16** citing in particular **T 545/08** (points 8 and 11 of the Reasons). In **T 464/20**, the appellant challenged the standard of proof (balance of probabilities) used at first instance to conclude that prior use had been proven. However, the board held that the opposition division had linked its application of the standard to whether it was persuaded that the alleged facts were true. The board was thus not convinced that it had been wrong to apply the standard of the balance of probabilities, especially as the opposition division had been persuaded of the truth of the alleged facts (**T 768/20** being concurred with). **T 34/08** was another case where the board concluded that it was convinced without referring to a standard of proof. **T 1634/17** (point 19 of the Reasons) stated that there was no need to take a stand; what was decisive was that, in view of the evidence before the first-instance department or the board in an individual case, the deciding body was persuaded that a particular oral disclosure had taken place and particular information had been conveyed to the audience or not.

The board in **T 1311/21** agreed with **T 1634/17** and **T 1138/20**, and decided that the two standards of proof in the jurisprudence of the boards of appeal – "balance of probabilities" and "beyond reasonable doubt" – may well be used as a yardstick in straightforward cases. However, this binary approach to standards of proof could turn out to be overly formalistic and simplistic. If evidence whose public availability prior to the priority date of the patent was at issue was neither within the sphere of control of the opponent nor within a neutral sphere of control to which both parties had access, neither standard of proof was exclusively applicable; rather, what mattered was the deciding body's conviction of the occurrence of an alleged fact, taking into account the particular circumstances of the case and the relevant evidence before it.

The board in **T 832/22**, with reference to the case law and the principle of free evaluation of evidence (**G 1/12**, **G 2/21** points 30-31 of the Reasons), stressed that the standard of proof referred to the nature or degree of personal conviction that the members of the deciding body had to have in order to be satisfied that an alleged fact had occurred. If the applicable standard of proof was that which has been termed "the balance of probabilities", an alleged fact was proven as soon as the members of the deciding body were convinced that the occurrence of that fact was more likely than not. If the applicable standard of proof was that which has been termed "beyond reasonable doubt", the required degree of personal conviction of the members of the deciding body was higher. The board explained that it was difficult to quantify the difference in the required degree of conviction between the "balance of probabilities" and "beyond reasonable doubt" standards. In fact, attempting to describe this difference in the form of numerical thresholds, for example as a certain **percentage** of likelihood that an alleged fact occurred, could even be misleading. The **"beyond reasonable doubt"** standard did **not require absolute certainty**, and it was sufficient if the (majority of the) members of the deciding body had no reasonable doubt than an alleged fact had occurred. In other words, even if there was some **remaining**

doubt, the "beyond reasonable doubt" standard of proof could be met as long as the remaining doubt was not reasonable. In any case, the board stated that **if the higher** of two disputed **standards of proof** has been **met**, it could be **left open which of these standards must be applied** when assessing the evidence in question. Hence, if the deciding body is convinced beyond a reasonable doubt that an alleged fact occurred, there is no need to decide which standard of proof is applicable.

In **T 1808/21**, on the question of whether appellant 1 had circumvented the law by allegedly lowering the standard of proof required for the public availability of D5 due to its role as a "straw man", the board was convinced that a distinction between the "balance of probabilities" standard and the "beyond any reasonable doubt" standard was not decisive in that case. In line with **T 768/20** and **T 660/16**, the board agreed that the relevant point was instead whether the deciding body was ultimately persuaded in view of all the available facts that the relevant evidence, which had been duly presented by appellant 1 when it filed its opposition, had indeed been made publicly available.

4.3.1 General on the two standards of evidence

The EPO departments decide on the issues that arise before them on the basis of the evidence adduced by the parties. Their decisions need not, and in most cases cannot, be based on absolute conviction, but instead are to be arrived at on the basis of the overall balance of probabilities, in other words on the footing that one set of facts is more likely to be true than the other. If the result of the boards' evaluation of the evidence is such as to persuade them one way or another, then the **balance of probabilities** standard is met. This standard applies particularly in opposition appeal proceedings where the boards of appeal are called upon to reach a conclusion on the basis of the overall balance of probabilities, as distinct from "beyond all reasonable doubt" or "absolute conviction" (on the latter concept, refer to the more recent case **T 2451/13**). Each of the parties must therefore seek to prove facts alleged by it to that degree of proof (see e.g. **T 182/89**, OJ 1991, 391; **T 270/90**, OJ 1993, 725; **T 859/90**; **T 109/91**; **T 409/91**, OJ 1994, 653; **T 1054/92** of 20 June 1996; **T 296/93**, OJ 1995, 627; **T 326/93**; **T 343/95**; **T 363/96**). The standard of balance of probabilities applies also in decisions issued in ex parte proceedings (**T 381/87**, OJ 1990, 213; **T 69/86**; **T 128/87**, OJ 1989, 406; **T 939/92**, OJ 1996, 309; **T 545/08** on internet publications).

When an issue of fact is being examined and decided by the EPO on the balance of probabilities, **the more serious the issue** the more convincing must the evidence be to support it. If a decision on such an issue may result in refusal or revocation of a European patent, for example, in a case concerning alleged prior publication or prior use, the available evidence in relation to that issue must be very critically and strictly examined. A European patent should not be refused or revoked unless the grounds for refusal or revocation (that is, the legal and factual reasons) are fully and properly proved (**T 750/94**, OJ 1998, 32; **T 329/02**; **T 750/94** was cited and considered in the context of evidence by the board in **T 545/08**). See Guidelines G-IV, 1 – November 2015 version): "If the applicant shows sound reasons for doubting whether the document forms part of the 'state of the art' in relation to his application and any further investigation does not produce evidence

sufficient to remove that doubt, the examiner should not pursue the matter further." See also Guidelines G-IV, 1 – April 2025 version.

The board in **T 286/10**, citing **T 472/92**, observed that it is settled case law that evidence is generally assessed in terms of what seems most probable; it made an **exception** only for public prior use objections where practically all the supporting evidence lay within the power and knowledge of the opponent (see in this chapter III.G.4.3.2 "Public prior use"). It considered the balance of probabilities standard to be met if, after evaluating the evidence, a board was **persuaded** one way or the other.

For **internet publications**, the standard of proof is the balance of probabilities (**T 286/10**, **T 2227/11**, **T 1711/11**, **T 353/14**, **T 545/08**. See also chapters I.C.3.2.3 "Internet disclosures" and I.C.3.5.2c) "Internet – proof of the date of availability" with reference to the Guidelines and OJ 2009, 456-462).

The board in **T 1403/19** stated with regard to Art. 123(3) EPC that the very rigorous standard of "beyond reasonable doubt" was to be applied when checking the allowability of amendments under Art. 123(3) EPC (see **T 307/05**, **T 2285/09**, **T 2275/17**), such that the **slightest doubt** that the scope of the patent as amended could cover embodiments not covered by the unamended patent would preclude the allowability of the amendment.

In the board's judgment in **T 658/04**, an expert's declaration which is not supported by verifiable facts but which merely constructs some hypotheses, cannot reflect the **common general knowledge** to be considered for assessing the sufficiency of disclosure within the meaning of Art. 83 EPC. For this reason, document (12) – declaration of U.K Pandit submitted by the appellant (patent proprietor) as an expert opinion – did not form part of the common general knowledge. **T 658/04** also summarised what is part of the common general knowledge according to the case law of the boards of appeal.

For cases dealing with requests for re-establishment of rights, see chapter III.E.4.4.

– Distinction between standard of disclosure and standard of proof

In **T 1708/18** the argument of the patent proprietor (appellant I) in relation to novelty was that the correct standard for the assessment of novelty was "beyond reasonable doubt", i.e. it had to be beyond doubt, and not merely probable, that the claimed subject-matter was directly and unambiguously derivable from the prior art. The board stated that the question of whether or not a given known antibody bound to a particular polypeptide was a question of fact; the standard of proof generally applied at the EPO for deciding on an issue of fact was the balance of probabilities. This standard also applies when examining factual issues in the context of novelty. The board was not persuaded by the arguments of the opposition division and the patent proprietor that, by way of exception, a higher standard must apply in the present case. In its reasoning, the opposition division appeared to mix up two issues which were distinct and unrelated. Indeed, under point 1 of its Catchword the board stated that: "the issue of which standard of disclosure applies when assessing the legal question of novelty and the issue of which standard of proof applies when assessing evidence and factual questions are distinct and unrelated. The fact that

the standard of disclosure required for a finding of lack of novelty (or for allowing an amendment to the application under Art. 123(2) EPC) is the standard of a direct and unambiguous disclosure is immaterial for the question of what standard of proof applies when considering evidence and factual issues in the context of novelty (or inventive step)."

In ex parte case **T 1624/21** the board did not address explicitly the distinction between the two standards of proof but stated that it was a question of fact whether or not an antibody which was disclosed in a cited document binds to a particular antigen or epitope. According to established case law of the boards of appeal, the applicable standard of proof to assess whether a specific statement of fact is true or not is the balance of probabilities. This standard of proof also applies to facts relevant to the assessment of novelty. Absolute certainty, as stipulated by the examining division, was not required.

4.3.2 Public prior use

Although the standard of proof is the same for all objections covered by Art. 100 EPC (cf. **T 270/90**, OJ 1993, 725), the case law identifies two levels or standards of proof to be applied with regard to disputes around public prior use – either the "balance of probabilities" or "up to the hilt". The board in **T 1138/20** provides qualification in this regard.

Decision **T 1311/21** endorsed **T 1138/20** and stated that the binary approach to proof standards could turn out to be overly formalistic and simplistic. What mattered was the **deciding body's conviction** on the occurrence of an alleged fact, taking into account the particular circumstances of the case and the relevant evidence before it. In the case in hand, the board was of the opinion that neither standard of proof was applicable. See also **T 832/22**.

In **T 778/21**, the board considered the standard of proof "beyond all reasonable doubt", stating that the applicable standard of proof was either "beyond all reasonable doubt" (**T 97/94**) or that the deciding body had to be convinced with a sufficient degree of certainty (**T 1138/20**, **T 545/08**).

About burden of proof, see decision **T 2037/18**, which sets out detailed reasons on the issue (prior use; distinction between the admissibility and the substantive merits of the opposition; burden of presentation and burden of proof; principle of "*negativa non sunt probanda*" (aspect also mentioned in **R 1/20**); non-confidentiality clause; shifting of the burden of proof) and cites numerous other decisions.

For the distinction between evidence of prior use and evidence of oral disclosures, see **T 1023/20** (point 1.1.3 of the Reasons), also dealt with under present chapter III.G.4.3.3.

a) Both parties have access to the evidence: balance of probabilities

With consideration taken of the recent decisions already cited, including **T 1138/20** and **T 832/22** on convincing the deciding body, this section focuses in particular on case law dealt with in cases involving the balance of probabilities.

The balance of probabilities standard is applicable only if the patent proprietor and the opponent had equal access to the material allegedly in public prior use (**T 1776/14**).

The standard of the **balance of probabilities** is applicable when both the patent proprietor and the opponent had access to the material of which public prior use is alleged (see e.g. **T 363/96**, **T 12/00**, **T 1105/00**, **T 2043/07**, **T 1464/05**, point 4.3 of the Reasons; **T 202/13**, point 15.6.2 of the Reasons; **T 1170/13**, point 2.3 of the Reasons). In **T 1984/14**, the board held that since practically all the supporting evidence lay within the power and knowledge of the patent proprietor, the balance of probabilities standard applied to the evidence (provided by witnesses) regarding the public availability of D28a (software).

In the following cases, it was decided that the evidence did not lie within the sphere of the opponent and therefore that the **balance of probabilities** was the applicable standard of proof: **T 918/11** (selling of containers outside the sphere of the opponent – mass production); **T 55/01** (mass-produced goods offered for sale to customers – see also **T 574/17** on the standard of proof taken into account); **T 1170/13** (circumstances in relation with prior use showed that opponent did not easily dispose over all the necessary evidence); **T 12/00** (in a case involving third parties, both parties could collect evidence); **T 1464/05** (no relationship between the opponent and the third party involved in the prior use – sale for test); **T 64/13** (prior use based on a purchase agreement between two companies neither of which, according to the respondent (opponent), had a business relationship with it – prior use originally cited by a third company before the German Federal Patent Court).

In **T 1311/21** since the user manual E7, whose public availability prior to the priority date of the patent was at issue, was neither within the sphere of control of the opponent **nor within a neutral sphere of control** to which both parties had access (E7 was written by a company in business relationship with the opponent), the board was of the opinion that neither standard of proof was applicable. What mattered, in plain language and as concluded in **T 1138/20**, was the deciding body's conviction on the occurrence of an alleged fact, taking into account the particular circumstances of the case and the relevant evidence before it.

There is no need to prove an actual sale of a product made for the **mass market**, because simply putting it on the market already makes it publicly available (see **T 55/01**, point 4.1 of the Reasons, which was summarised and discussed in **T 2165/18** and **T 574/17**).

In **T 1505/16** (slide mechanism of vehicle seat) the board, contrary to the opposition division, which had decided that the standard of proof to be applied was "beyond reasonable doubt" (or "absolute conviction"), held that according to established case law (citing **T 184/07** and **T 55/01** by way of example) the "balance of probabilities" standard of proof was usually applied to evaluate an alleged prior use relating to mass-produced consumer products.

See also **T 563/18**, in which the board likewise disagreed with the higher standard applied by the opposition division. Whilst the specific prior-use vehicle had indeed been within the

opponent's control, the prior-use turbocharger had been sold as a component of a Golf IV vehicle produced and sold on a mass scale in 2003.

In case **T 473/13** the alleged public prior used was by the respondent and patent proprietor, who had initially to prove a confidentiality agreement (burden of proof). The board considered that the much cited "up to the hilt" criterion did not apply in the present circumstances, since the case law in this respect had been developed for the situation in which a prior use was by the opponent, which was not the case here.

In **T 12/00**, **T 254/98** and **T 729/91** the opponent alleging the public prior use was not involved in the circumstances relating to it (**T 202/13**).

In **T 734/18** the appellant-proprietor contended that Company E, an independent supplier of coffee-machines having business relations with both it and opponent 1, had assisted opponent 1 in proving its case of prior use (witness employed by Company E). It therefore asked the board to apply a different standard of proof from the one applied by the opposition division (namely "beyond reasonable doubt" instead of the "balance of probabilities"). The board was unconvinced and found that whenever an opponent wished to prove a prior use and the evidence of this was in the possession of a third party, a certain level of co-operation with that third party was normally required. The appellant-proprietor's second line of argument (company E and opponent 1 were jointly infringing the patent at issue) was an incomplete set of infringement allegations and supporting evidence from which no conclusions could be drawn. The board held that the appellant-proprietor had not substantiated its case for the board to treat company E as being in any different position from that found by the opposition division, namely that of an independent supplier outside the sphere of opponent 1.

b) Evidence within the sphere of the opponent: beyond any reasonable doubt

By contrast, in cases where all **evidence** in support of an alleged public prior use lies **within the power and knowledge of the opponent**, while the patentee has barely any or no access to it at all, it is incumbent upon the opponent to prove the alleged prior use **up to the hilt** (**T 472/92**, OJ 1998, 161; cf. **T 782/92** referring to proof "beyond any reasonable doubt"). **T 1138/20**, cited in the introduction to this section, states that if, for example, only the opponent had access to the relevant evidence, this fact must be given due consideration in the deciding body's assessment as to what weight and importance was to be attached to such evidence. This was not the same as saying that a different standard of proof should apply (see **T 1138/20**, point 1.2.1 of the Reasons).

In **T 1138/20** the appellant also alleged that the existence of a plausible alternative explanation had the inevitable consequence that the opponent's explanation had not been proven to the required standard. On this point, the board stated that the appellant's argument did not demonstrate that the standard "beyond reasonable doubt", or any other standard, has not been met or was wrongly applied. A "plausible alternative explanation" was, by itself, unlikely to succeed on appeal if a specific finding of fact were challenged. This argument was also not convincing for showing more generally that the standard of proof had not been met or was not correctly applied. See also point 1.3.8 of the Reasons

as to the duty to give reasons, in which the board, in applying the stated principles, notes that the opposition division had indeed evidence at its disposal which confirmed their findings of fact. Decisively, the opposition division had addressed, as it was obliged to do, the "plausible alternative explanation" submitted by the appellant and the fact that other evidence existed which did not corroborate the findings and rather pointed in the opposite direction.

The boards decided that the evidence lied within the **sphere of the opponent**: **T 2451/13** and **T 703/12** (prior use originating from a subsidiary of the opponent); **T 202/13** (the opponent was the successor of the company directly involved in the alleged public prior disclosure); **T 2338/13** (opponent bore consequences of lack of information on relationship between him, the witness whose testimony he was relying on and the person who had contacted the witness); **T 703/12** (product presented at the Ambiente trade fair in Frankfurt); **T 274/12** (subsidiary – talks between firms); **T 544/14** (subsidiary); **T 1262/15** (subsidiary of the opponent); **T 1469/08** (evidence presented involved opponent's company's sale); **T 441/04** (witness testimony measured according to the high standard of proof beyond reasonable doubt); **T 1682/09** ((the opponent's) packing system delivered to and mounted at a client's premises); **T 1914/08**, **T 738/04**, **T 1776/14** (the two parties did not have equal access to evidence); **T 2659/17** (since the alleged prior use took the form of sales of machines by the opponent, the patent proprietor's request to hear the author of a contested declaration as a witness should not have been refused).

In **T 778/21**, since the alleged instance of prior use concerned a specific machine to which the proprietor had no access, the applicable standard of proof was either "beyond all reasonable doubt" (**T 97/94**) or that the deciding body had to be convinced with a sufficient degree of certainty (**T 1138/20**, **T 545/08**).

In **T 1311/21** the user manual E7, whose public availability prior to the priority date of the patent was at issue, was **neither within the sphere of control of the opponent** nor within a neutral sphere of control to which both parties had access (E7 written by a third party company in a business relationship with the opponent). The board was of the opinion that neither standard of proof was applicable.

Decision **T 918/11** (point 3.3 of the Reasons) summarised the case law on standards of proof and the conclusion drawn in **T 750/94** (OJ 1998, 32), with the board also emphasising the need to take into consideration that the application of the strict standard of proof referred to in the impugned decision was not justified in view of the fact that the actual production and the selling of the containers was clearly outside the sphere of the opponent. The board was also of the opinion that the application of the standard of proof "beyond reasonable doubt" did not justify disregarding the witness testimony (regarding facts which had occurred a long time ago). **T 2451/13** summarised the principles governing the standard of proof in case of public prior use and specified the meaning of the standard of "up to the hilt" (see Catchword) used in **T 472/92**, which is to prove beyond reasonable doubt. All the evidence about the publication date of a brochure was essentially in the hands of the opponent (brochure originated from a subsidiary of the opponent, on this latter point see also **T 738/04**).

In **T 2010/08**, the board pointed out that the requirement to prove prior use beyond reasonable doubt could not be circumvented by overstretching the principle of ex officio investigation and so shifting the burden of proof from the opponent to the opposition division or the board of appeal. (On the opponent's burden of proof in a case in which, by contrast, the balance of probabilities was applied as regards a prior use, see **T 72/16** point 19 of the Reasons.)

The board in **T 703/12** stated that all the evidence in support of the alleged public prior use (of a water filter jug, presented at the Ambiente trade fair in Frankfurt) lay within the power and knowledge of the appellant (opponent). The respondent (patent proprietor) disputed that the "what" was disclosed and that the "circumstances" of the prior use were proven beyond any reasonable doubt. The board was not convinced that either what was disclosed or the circumstances of the alleged disclosure had been proven to the required degree of certainty, namely beyond any reasonable doubt.

In **T 348/18** the opponent challenged the application of the highest standard of proof to the prior use "Open House 2007", asserting that the patent proprietor merely had to speak to the attendees of the "Open House 2007" days (list of attendees). The board rejected the opponent's arguments and upheld the opposition division's decision since the evidence available to the patent proprietor had been in the opponent's sphere.

In **T 483/17**, since the sale and delivery of five roller bearings from the appellant (opponent) to a third party was completely outside the sphere of the respondent (patent proprietor), proof had to be provided "up to the hilt". Determining that the prior use had occurred thus required that the facts giving rise to the prior use be established without any gaps (see **T 472/92**, OJ 1998, 161, point 3.1 of the Reasons). However, this did not mean that the opponent had to provide each and every theoretically possible piece of evidence. Instead, it was sufficient that the evidence put forward convinced the board. On the other hand, a prior use was not considered to have been sufficiently proven if the proprietor had successfully pointed out any inconsistencies or drawn attention to any gaps in the opponent's chain of proof (see **T 472/92**). In the case in hand, the board considered it established that the alleged prior use had taken place, finding that neither doubts about the prior use expressed by the opposition division nor the arguments provided by the respondent (patent proprietor) pointed to any gap in the opponent's chain of proof.

T 274/12 dealt with an alleged prior use (talks between firms), all the evidence being in the hands of the opponent. In this case the board had to also decide whether there was an implicit obligation to maintain secrecy.

In **T 202/13** several public prior disclosures were alleged by the respondents (opponents). The board agreed with the appellant that the standard "up to the hilt", or "beyond reasonable doubt", was appropriate in the present case. One of the joint respondents 2 was the successor of the company directly involved in the alleged public prior disclosure. Respondent 2, as successor, had full knowledge of the actions alleged to constitute the public prior disclosure and full access to the sources of evidence.

In **T 1469/08** the appellant (opponent) alleged a public prior use in the form of the sale of composite "PARP PU" prostheses before the patent's priority date. Although the public prior use stemmed from the opponent itself, it had provided only **sales records** to substantiate the prostheses' availability. In such circumstances, there were **serious doubts** that documents actually existed establishing the prostheses' availability to the public before the priority date. See also **T 71/09**, setting out the case law and citing **T 750/94** and **T 97/94**. The respondent (opponent) alleged public prior use prejudicial to the novelty and inventive step of the subject-matter claimed. Here too, the prior use was its own: the evidence presented involved its company's sale of a certain product. The board held that the evidence submitted failed to establish the product's composition beyond any reasonable doubt.

T 606/22 (device for sealing a package) exemplifies the reasoning in a case that turns on the standard of proof "beyond all reasonable doubt" used when there are doubts regarding the public availability of the prior use; it is also important to note that the opponent had withdrawn its opposition in this case. The department of first instance had ruled that the prior use was publicly available in particular in view of testimony provided by Mr T, who could not recall any applicable obligations to maintain confidentiality on the site in question. Additionally, the witness explained that he had had to declare in writing at the admittance desk that he had complied with all health and security measures. The board first explained its reasoning in relation to the standard of proof taken into account, namely that all the evidence in relation to the allegedly public prior use asserted was in the sphere of the (former) opponent, since the opponent had relied on a video recorded during a visit by one of its employees, the witness Mr T, to the company S. The patent proprietor submitted document A38, which, contrary to the witness' vague statement, specified clear confidentiality rules and prohibited video recordings on the premises without the consent of company S. The submission of document A38 cast significant doubt on the opposition division's finding that company S was not concerned with maintaining confidentiality. Quite the contrary, it appeared to be standard practice that visitors had to maintain confidentiality. These doubts could no longer be verified. The doubts were sufficient and justified. Therefore, the standard of proof used was not met.

In **T 1776/14** the opponent stated that disclosure had been in its interest and implied that it was very likely the prior use had been public; in view of the circumstances, however, the board rejected its position and concluded that the balance of probabilities was not applicable because the two parties had not had equal access to the evidence.

In **T 624/14** the analysis of the specific prior-use products, on which the determination of the content (internal structure) and hence the line of argument put forward by the appellant (opponent) relied entirely, had been performed by an employee of the appellant, and thus lay solely in the appellant's sphere. During the opposition proceedings, the respondent had voiced doubts about the credibility of the appellant's measurements and asked to be provided with the specific prior-use products used for the measurements in order to perform its own analysis. The opposition division had voiced similar doubts, stating that a simple visual inspection (e.g. during oral proceedings) would not suffice to determine the internal structure. It had then been up to the appellant to dispel these doubts by providing the samples. As the appellant had not provided these samples, there remained reasonable

doubt as to the correctness and content of the analysis performed by its employee. The alleged prior use had thus not been proven beyond any reasonable doubt.

c) Miscellaneous – evaluation in the case law

In **T 674/91** the board stated that all the assertions (affidavits or declarations) made by different witnesses of the alleged prior use and which were in agreement with one another already provided **sufficient evidence** of the commercial nature of the tests mentioned. An obligation of confidentiality could not have existed, since the access to the new tool was not restricted to a particular group of persons. The board concluded that the prior use was prior art within the meaning of Art. 54(2) EPC 1973.

The board in **T 1682/09** held that evidence from an independent source corroborating an alleged prior use would have constituted strong evidence in support of the allegation, but the mere absence of such independent evidence was not a sufficient reason to dismiss it.

In **T 1452/16** the alleged prior use concerned a product which was commercially available as agreed by all parties. It was thus possible for the patent proprietor to simply obtain samples and test them. Even if the present case did fall into the category of "balance of probabilities", the board did not merely form its opinion on the basis of whether the alleged facts were just slightly more likely to have occurred than not, but on the basis of whether it was convinced that they had occurred.

In **T 225/03** the opposition division had not taken evidence by hearing the witness before revoking the patent because it had considered the allegation of public prior use to be adequately proven by the documentary evidence. The board found that level of proof to be insufficient, and held that the respondent's (opponent's) request – that the **documentary evidence be complemented by hearing the witness** – had to be granted, as only the witness could confirm the links between the individual pieces of evidence and the circumstances of use as explained in his statutory declaration. It therefore sent the case back to the department of first instance for further prosecution.

In **T 441/04** the board agreed with the respondent (patent proprietor) that evidence in document form was normally preferable to witness testimony about long-ago events. But that did not mean that in the case in point such testimony was necessarily excluded per se or less convincing than documentary evidence. Applying the (high) standard of proof beyond doubt, the board considered that it had taken due account of the fact that the alleged public prior use – proven by witness testimony – was attributable to the appellant. The evidence submitted (mainly witness testimony) had measured up to that standard, and therefore no new or additional proof (such as drawings) was needed.

In **T 1914/08** the board – like the opposition division at first instance – regarded two witnesses' testimonies as the decisive evidence proving without any gaps the alleged prior public use. Each testimony, considered in isolation, gave a consistent and full picture of the process in question. Accordingly, it endorsed the opposition division's evaluation of the evidence, the standard of proof applied by it ("beyond all reasonable doubt") and the result of its analysis. It held, moreover, that the patent proprietor's (appellant's) request for

additional evidence had to be refused. Since the opposition division had, in the course of its unfettered consideration of the evidence, concluded that the alleged prior public use had, essentially, been established by the two witnesses' testimonies and since the appellant had been unable to cast doubt on the probative value of those testimonies, there was no need for the opponent (respondent) to adduce further evidence in either the opposition or the appeal proceedings.

In **T 833/99** the opponent (appellant) had raised a novelty objection, claiming that prior use had occurred following public disclosure of an identical process: grooved-rail frogs for tramlines had been sold and installed in various German towns over a specified period. The opposition division had found this disclosure to be insufficiently proven, and had duly dismissed the objection. In support of its contention that the manufacturing process lacked novelty, the opponent relied on two photos (showing the grooved-rail frogs) measuring 6 cm by 6 cm and appearing inside a **prospectus**. The **photos** were **not clear enough** to say that the edges could not have been the result of flame-cutting. Lastly, during **invitations to tender**, the municipal employees had been required to observe confidentiality. The appellant said they might have breached that confidentiality, e.g. by informing repair workers of certain steps in the process, but **did not back this up with firm facts** such as dates, circumstances, etc., or with other evidence. Mere suppositions could not be entertained; they were not proof, and the onus was on the appellant to show that its **allegations were well founded** (**T 782/92**; **T 472/92**, OJ 1998, 161). Lastly, the board observed that there was no law to the effect that the confidentiality governing **tender procedures** ends when they do.

Features of subject-matter that was visible only briefly can be considered to have been made publicly available only if it can be shown beyond doubt that they were clearly and directly apparent to the skilled person for that short time (**T 1410/14**: train – test drive, see also **T 1551/14).**

In **T 2565/11** the invention concerned a method of operating a ventilator and air conditioner for vehicles. It was not contested that the trains which were the subject of a prior use allegation were indeed delivered to DB Regio AG and operated in a public manner. However, it was disputed that information concerning the ventilation and air conditioning system of those trains was published in the sense of Art. 54 EPC by the delivery and operation of the trains and further that the structure and operation of the ventilation and air conditioning system had been adequately proved by the opponent. In its decision the opposition division held that the alleged public prior use had not been proven beyond reasonable doubt. The board, in the case at hand, overturned the evaluation of evidence made by the department of first instance because the opposition division erred as regards the underlying facts and failed to give an evaluation that was free of contradictions. The board gave its own evaluation of the evidence regarding the relevant facts. Even applying a high standard of proof ("beyond any reasonable doubt"), the board found that the basic facts presented by the witness could not be questioned.

Decisions applying the boards' case law on the strict standard of proof – initially established for public prior use – to other matters include **T 1107/12**, on the accessibility of documents, and **T 1201/14**, on proof of the transfer of priority right.

See also chapter V.A.4.4.6a)(xi) "Public prior use".

4.3.3 Posters and ephemeral presentations

Decision **T 421/14** recalled that, according to the case law of the boards of appeal, the usual standard of proof was the overall balance of probabilities. The stricter standard of proof "beyond all reasonable doubt" had been used, exceptionally, in cases of public prior use where all the supporting evidence lay within the power and knowledge of the opponent. The issue of public prior presentation of posters or slides had, as a rule, been assessed in line with the requirements for public prior use. However, in the case of documents C30 (poster) and C31 (slide presentation), whose public availability was at issue in **T 421/14**, they were the patent proprietor's own documents.

Similarly, the board in **T 1023/20** was not convinced by the argument of the respondent (patent proprietor) that the standard of proof "beyond any reasonable doubt" had to be applied since the evidence was under the exclusive control of the appellant (opponent). The board observed that the respondent referred to a standard of proof which the case law considered to be applicable in the context of public prior use. This was not the case here. E9, E10 and E11 were evidence of oral disclosures (three presentations), and the discussion hinged on the public availability of their contents. The three events at which E9, E10 and E11 were presented were organised and controlled not by the appellant but by third parties. in contrast to a public prior use in which all the evidence lay in the hands of one party. In this case the respondent could have approached third parties to verify whether E9, E10 and E11 were presented during the corresponding events. Accordingly, in the case in hand there was no reason to deviate from the regular standard of proof, i.e. the balance of probabilities. After detailed reasons, the board was convinced that the contents of E9, E10 and E11 were publicly available.

In **T 1210/05** the board concluded that the contested prior disclosure via the public display of a **poster** identical to document (1) at an Edinburgh congress had not been sufficiently established, i.e. beyond all reasonable doubt, based on the following considerations: the fact that the various means of evidence, namely the submitted documents, the affidavits of the witnesses as well as their oral testimony, did not contradict each other was not sufficient to meet the required standard of proof. Furthermore, the finding of the opposition division rested **exclusively on the testimony of one of the witnesses**. No independent evidence (in writing or by other persons) was available to support it. This did not mean that the written and oral testimony of the witness was per se insufficient. However, the board stated that there had to be good reasons for treating this evidence alone as having established the facts beyond any reasonable doubt. See also **T 729/05**, in which evidence in support of disclosure of a poster was found to fall within the patent proprietor's sphere of influence.

In **T 2338/13**, which likewise concerned information disclosed on a **poster** displayed at a conference, the primary evidence of the alleged prior use (A3, a copy of a PowerPoint presentation) was in the possession of a witness who had been contacted by an **anonymous friend** referred to by the appellant (opponent) as a third party. The appellant was unable to specify how the witness, this third party and he were connected and the

board held that he had to bear the consequences of this lack of information and that A3 thus had to be deemed to lie within his power and knowledge. The witness being likewise considered to fall within his sphere of influence, he also bore the burden of proving that A3's content had been made publicly available beyond any reasonable doubt. The board concluded that A3's content had indeed been disclosed in the form of a poster, but discrepancies between the witness's statutory declarations and his oral testimony cast doubt on the reliability of his evidence. The appellant not having proved his case beyond reasonable doubt, the board disregarded A3 when assessing patentability.

In **T 1212/97** the opponent had submitted that the invention had been made available to the public at a lecture given some days before the priority date to an audience of some 100 to 200 persons. The question to resolve was whether there was any safe and satisfactory evidence regarding the content of what had been made available to the public at the lecture. The board did not consider **evidence from the lecturer alone** to be satisfactory evidence as to what had been made available to the public at the lecture. Even an audio or video tape recording made of the lecture, unless publicly available, would have to be treated with caution, if several hearings or viewings were necessary to extract all the information (see also **T 428/13** and **T 2003/08** of 31 October 2012 below).

In **T 2003/08** of 31 October 2012 the board observed that, in contrast to a written document the contents of which are fixed and can be read again and again, an **oral presentation** is ephemeral. Therefore, the standard of proof for ascertaining the contents of an oral disclosure is high. **T 1212/97** could not be interpreted as setting an absolute standard for the amount of evidence necessary to prove the contents of an oral disclosure. In the present case evidence from the lecturer and a member of the audience, provided by them in the form of both affidavits and oral testimony, was not considered by the board to prove beyond reasonable doubt that the subject-matter of the claim was disclosed during the lecture (see also **T 12/01** about oral presentations; **T 667/01** about declaration of the presenter as to the content of his oral presentation usually not sufficient and **T 1057/09** about the alleged availability of a "diploma thesis" whose content was allegedly disclosed inter alia during an oral presentation before the priority date of the patent in suit).

Decision **T 1212/97** was also cited in **T 421/14**, with the respondent (patent proprietor) arguing that both the poster C30 and slide presentation C31 involved "ephemeral" oral presentations, which meant that the standard of proof for ascertaining the content of the oral disclosure had to be higher as per **T 1212/97**. The board in **T 421/14** found this argument unconvincing, at least for the poster (printed and therefore fixed content), since **T 1212/97** dealt with the alleged information content of an orally delivered lecture without a written complement in the form of a script, handout or later publication. The respondent's own statement left little room for doubt that C30 had been disclosed to the public; it was therefore down to it to show that this was not the case. The respondent did not provide any first-hand evidence, and its argument was speculative and not persuasive. On the overall balance of probability, the poster C30 was considered to form part of the prior art. The situation was different for the slide presentation C31; there was no evidence on file from which it could be inferred that C31 had been handed out in printed form at the conference, or that all of the slides had been shown to an audience (no evidence regarding

the manner or speed of the oral presentation). Irrespective of the standard of proof applied, the content of C31 could not be considered to be prior art.

The contributions of decisions **T 1212/97** and **T 2003/08** to the status of oral/ephemeral disclosures were also considered in depth in more the recent case **T 1634/17**. The board in **T 1634/17** considered that the relevant question was not what was presented or shown to the audience but what was actually conveyed to the public, i.e. what the audience took away from Dr M's presentation. In line with the examples in the case law, providing (at least) a contemporary written note from a member of the audience present at this presentation might be an important and decisive element in the evaluation of evidence (cf. **T 1212/97**, point 7 of the Reasons; **T 2003/08**, point 42 of the Reasons). The board also explained why there was no room for a referral.

The board in **T 843/15** held that a copy of a PowerPoint presentation could establish a presumption as to the presentation's content but was not enough on its own to guarantee that the content had been presented in full and, if so, comprehensibly. It was therefore generally necessary to submit further evidence such as affidavits or written notes from attendees or a handout distributed to the audience.

In decision **T 335/15**, it was concluded that the content of document E10.2 (PowerPoint presentation) had been made available to the public. The board held that, while **T 843/15** dealt with issues similar to those in the case in hand, the circumstances had been different. The presenter here had confirmed that they had shown every page, which had not been the case in **T 843/15**. Moreover, the PowerPoint presentation at issue here related to rather simple technical subject-matter, and the content of the photographs presented was immediately clear. As to the likewise cited decision **T 1553/06**, the board found it was irrelevant because it related to online publications (whether a document with a specific URL had remained accessible for enough time) and not to a presentation to a professional audience. On the issue of evidence, the patent proprietor had raised various doubts about how the presentation had been given, but the board, noting that it could have filed additional evidence to support its assertions, held it was not enough merely to dispute the evidence already on file

In **T 1625/17**, having reviewed all the facts and evidence, the board was convinced that it had been proven beyond reasonable doubt that handouts of the presentation slides had been made available to the audience and thus to the public, as supported by the declaration (affidavit) of the presenter. The case was different from **T 1212/97** and **T 667/01**, referred to by the parties, since those cases concerned the issue of ascertaining the contents of an oral presentation in the absence of a handout distributed to the audience.

In **T 348/18** the standard of proof for a prior use was contested; the board agreed with the opposition division's analysis. The opposition division had selected the stricter standard of proof regarding the disclosure D16.7 – the public display of posters which were supposedly identical to the pages of document D16.2 (disclosure by public display) during the "Open House" event. The board endorsed the opposition division's selection because this evidence had been entirely within the opponent's sphere. The board noted, however, that

the difference between the two standard of proof criteria should not be exaggerated (**T 545/08**, **T 660/16**, **T 464/20**, **T 768/20**). Decision in which various arguments raised by the opponent, deriving in particular from testimony, were examined and rejected.

T 1057/09 related to the alleged disclosure of an invention when defending a thesis (ephemeral – beyond all reasonable doubt).

4.3.4 Public availability of prior art documents

a) Commercial brochures

With regard to the public availability of commercial brochures, some boards adopt the less strict standard of the "balance of probabilities" (see e.g. **T 743/89** (brochure produced by the patentee) and **T 804/05** (prospectus issued by a third party)). Concerning a commercial brochure (prospectus) of a product produced by the opponent, in **T 1748/10** the board considered it more appropriate to assess public availability on "the balance of probabilities" citing **T 743/89** and **T 1140/09** and not the standard "up to the hilt" as alleged by the patentee, in view of the fact that the brochure originated from the opponent. In the board's view, although D1 originated from the opponent, it was distributed to the public. Therefore, both parties were able to access and adduce evidence relating to the availability of document D1. The board in **T 1140/09** considered the "balance of probabilities" to be the proper standard of proof to be applied for the question of the public availability of document E3, a brochure that had been distributed by the appellant (opponent) to visitors at CeBIT and had therefore been made available to the public before the priority date. In the particular case, **however**, the evidence presented by the appellant was such that it also met the stricter standard of proof as proposed by the respondent. Given the importance of large industrial fairs such as CeBIT for doing business and the strong interest of the appellant in making its brochure as widely available as possible, the board found that the public availability of document E3 was proven beyond reasonable doubt.

In **T 184/11** the board first had to decide whether the document was an advertising brochure or a product data sheet. It contained no detailed technical data, merely general technical information. After a detailed review of the case law on standards of proof and the public availability of advertising brochures, the board decided that nothing in the reasons given for the contested decision indicated that the opposition division, in assessing probability, had not critically and precisely evaluated the evidence before it.

In **T 146/13** the proprietor maintained that it had not been proven beyond any doubt that an advertising brochure had been distributed before the patent's priority date. The board, citing settled case law on commercial brochures as prior art and in particular **T 743/89** and **T 804/05**, held that enough time (two years) had elapsed between printing and the priority date to conclude that the brochure really had been made available to the public. Adding that in practice the whole point of printing advertising brochures was to attract the attention of potential clients, it therefore decided that the brochure was prior art within the meaning of Art. 54(2) EPC (cf. **T 738/04**, point 4.1.1 of the Reasons).

In **T 743/89** it had been proved that a **leaflet** disclosing the invention had been printed seven months before the priority date, but it was uncertain when the leaflet had been distributed. Based on the balance of probabilities, the board concluded that the leaflet was available to the public before the priority date of the patent in suit and was, consequently, comprised in the state of the art. Although the date of distribution could no longer, i.e. 10 years on, be ascertained, it could reasonably be assumed that it had taken place within less than 7 months and had thus been completed well before the priority date of the patent in suit. The opposite assumption that the brochure had been kept confidential was not very plausible since it was in the patentee's own interest to ensure wide-spread distribution of the brochure in order to inform as many potential customers as possible of this latest development in a highly competitive field. Hence, the onus of proof was incumbent on the patentee who, incidentally, being the originator of the pamphlet, should be in the possession of the necessary information.

In **T 2451/13** the board applied the standard "up to the hilt" as meaning beyond reasonable doubt concerning the publication date of a brochure (brochure originated from a subsidiary of the opponent – all evidence essentially in the hands of the opponent). See also **T 1262/15** (instruction manual).

The board in **T 1710/12** agreed that the rigorous standard of "up to the hilt" is typically applied in cases where a prior use is involved. However, in the case before it, catalogue E1 had **not** been **provided in support of an alleged prior use**, but as written evidence on its own. The board thus deemed it appropriate to judge the public availability of E1 using the "balance of probabilities" approach. Document E1 (catalogue published by a company not being a party) was considered prior art under Art. 54(2) EPC.

b) Convincing the board and discussion on the standard of proof

Even though different concepts as to the standard of proof have developed in the case law of the boards, they all have in common that a judgement is to be made on the basis of the application of the principle of free evaluation of evidence (principle confirmed in **G 2/21** (OJ 2023, A85), point 46 of the Reasons). See also the statements in **T 1138/20** and **T 832/22**, summarised in particular in the introduction to this chapter III.G.4.3.

In the case of published documents, the standard of proof for public availability is usually the less strict one of the "balance of probabilities" (**T 1140/09**, point 3.2 of the Reasons). But even though the present case (date of availability in a public library of journal supplement disclosing meeting abstracts for a future conference) fell under the "balance of probabilities" standard for burden of proof, the board did not form its opinion solely on the basis of whether the alleged facts were just slightly more likely to have occurred than not, but on the basis of whether it was convinced that they had indeed occurred (**T 1050/12**).

The board in **T 1107/12** found there was no indication that the opposition division had applied the wrong standard of proof, even if it had not explicitly discussed whether the strict standard of "beyond reasonable doubt" or the usual "balance of probabilities" standard should be applied. The case law requiring absolute certainty or proof beyond all

reasonable doubt, which the respondent had cited in support of its position, was concerned with alleged public prior use (see **T 441/04**, **T 472/92** and **T 2451/13**) and had applied that standard because, in such cases, the supporting evidence was almost always in the opponent's possession. The case in hand, however, turned on whether a document originating from one of the opponents had been publicly available on a particular date. Its availability was supported by witness testimony, the probative value of which was to be evaluated freely. Ultimately, there was no need to decide whether the stricter standard of proof had to be applied in such circumstances too, since, in view of the evaluation of the evidence by the department of first instance, the board didn't have to re-evaluate the evidence in its place (on this specific aspect of reassessing the evaluation of evidence at first instance, see **T 1138/20** in this chapter III.G.4.2.2b)). See also **T 2466/13** below, in which it was likewise found that there was no need to decide on the applicable standard of proof. In the same vein, see **T 768/20** and **T 660/16** citing in particular to **T 545/08** (points 8 and 11 of the Reasons).

c) Archives and internet publications

In **T 151/99** the board regarded it as **highly plausible** in the light of the available evidence that a **master's thesis** had become available to at least one member of the public. If the reference was in a document published before the priority date of the patent in suit, then it could be assumed that the thesis had also been made available to the public before the said date. This decision is analysed more recently in **T 538/09** (master's thesis of the first examiner as prior art) and **T 582/18** (master's thesis from Carnegie Mellon University in Pittsburgh stating June 2011 on its cover, the priority date being July 2012 – standard of proof: balance of probabilities). Note that **T 538/09** also cites **T 1134/06** and **T 750/94** in that an important criterion in evaluating evidence is the reliability of the source: fulfilled for University of Utah.

In addition, note that the strict standard of proof (beyond reasonable doubt) laid down as the rule for **internet publications** in **T 1134/06** no longer applies since **T 286/10** and **T 2227/11**, both found the balance of probabilities to be the usually applicable standard. Confirmed, for example, by **T 884/18**, in which availability to the public was considered to be established on the balance of probabilities by the date stamps on evidence (screenshots of internet page) from the Wayback Machine, and **T 3257/19.**

In **T 2165/18** the opposition division had found there was a lack of novelty over the undated user manual E1, which had been published online (*www.janserwis.pl*). The board observed that dates obtained from reputable and trusted editors or archives, which included *www.archive.org* in particular, were accepted by the boards as reliable. Janserwis, however, was not a known reputable editor or archive, so the board considered the probative value of a witness statement made by two of its company members to be insufficient. The opponent had also invoked the prior use of the mass-market software product the user manual was for, but this was unsuccessful as it did not answer the crucial question what version of the manual had been supplied then. Finding that a witness's testimony alone was not enough to fill in the gaps in the evidence as to when user manual E1 had been published and which software version it had accompanied, the board held that its date of public availability had not been established. This decision was subject to a

petition for review particularly on the issue of testimony; the petition was rejected by **R 15/21**.

In **T 1469/10** the board held that the publication dates indicated on the documents published by the ETSI 3GPP organisation, which was regarded as a reputable standardisation body having clear and reliable rules for their publications, were of a high probative value and thus might serve as prima facie evidence that a document was published on the date indicated, and regarded the documents at issue thus as representing the state of the art under Art. 54(2) EPC.

In ex parte case **T 3257/19**, concerning the publication date of document D11, the appellant seemed to argue that the examining division had failed to establish beyond reasonable doubt the exact earliest date of public availability. However, according to the established case law (see **T 884/18**), this was no longer the applicable standard of proof required for assessing whether or not documents downloaded from the internet or standard preparatory documents belonged to the state of the art. In view of the available evidence and arguments, the board was sufficiently convinced that D11 was indeed made available by file upload to a public 3GPP server before the Meeting at issue took place, i.e., at any rate well before the relevant date so that D11 was to be considered prior art under Art. 54(2) EPC.

In **T 832/22** the question at issue was to establish the publication date of D9, a user manual published on the internet and issued by the opponent. The board stated that if the deciding body was convinced beyond a reasonable doubt that an alleged fact had occurred, there was no need to decide which standard of proof was applicable. This was the situation in the present case in which the board considered with reference to D39 (Digital forensics technical report) that D9 was part of the state of the art under Art. 54(2) EPC. Indeed, the board saw no reason to question the conclusions in the report D39 with respect to the upload date. The credibility of the report D39 and the methodology applied was as such not challenged by the respondent (patent proprietor) either. The fact that D39 had been commissioned by the appellant (opponent) and was based on digital evidence from the appellant had, in the absence of any inconsistencies or other counter-evidence, no negative impact on its credibility. The further evidence did not contradict the conclusions based on the publication date based on D39. Even if – for the sake of the argument – it had to be decided which of the contradicting publication dates in D39 or D9', two independent pieces of evidence, was the correct one, both of them were well before the priority date.

As a matter of principle, if an **adverse decision** of an organ of the EPO is to rely on a certain fact that fact should be proven beyond any reasonable doubt. In ex parte **T 826/03** the board applied this principle when attempting to establish the publication date of a Canadian patent application, and whether it was prior art. It found that in view of the contradictory evidence on file and in the absence of any further clarifying information from the Canadian Intellectual Property Office, it was virtually impossible for the board to establish with certainty that the public had access to the application according to document D3 before the priority date claimed by the application in suit. It therefore considered document D3 as not belonging to the prior art within the meaning of Art. 54(2) EPC.

4.3.5 Claiming a valid priority

See also chapter II.D.2. "Right of priority of the applicant or its successor in title".

4.3.6 Abusive conduct

In **G 3/97** and **G 4/97** (OJ 1999, 245 and 270) the Enlarged Board held that if the person named as opponent according to R. 76(2)(a) EPC (former R. 55(a) EPC 1973) was acting on behalf of a third party, such an opposition was inadmissible only if the involvement of the opponent was to be regarded as circumventing the law by abuse of process. The deciding body had to be satisfied on the basis of clear and convincing evidence that the law had been circumvented by abuse of process (cited by **G 2/21** (OJ 2023, A85), point 36 of the Reasons, from the perspective of the law of evidence and the principle of the free evaluation of evidence).

In **T 291/97** the appellant had contended in the statement of grounds of appeal that the publication of document (1) had occurred in consequence of an evident abuse within the meaning of Art. 55(1)(a) EPC, and thus did not constitute prior art citable against the claims at issue. The board decided that the above publication was to be taken into consideration for the application of Art. 54 EPC. It observed in its decision that the finding of an **evident abuse** under Art. 55(1)(a) EPC was a serious matter. An abuse was not lightly to be presumed. The standard of proof was identified by the words "evident abuse" (German: "offensichtlicher Missbrauch"; French: "un abus évident") as being high: the case had to be clear-cut, and a doubtful case would not be resolved in favour of the applicant. The evidence filed in the case at issue did not meet this standard (see also **T 41/02**).

In **J 14/19** (stay of the proceedings) the appellant (applicant) asserted that the respondent was committing an abuse of law in delaying the proceedings for grant. The Legal Board held that improperly asserting a right could amount to an abuse of law in some cases, for instance if the right was exerted predominantly with a view to causing damage, ahead of other, legitimate aims. The abuse of law had to be established beyond any doubt; that meant carefully examining and weighing up the circumstances of the individual case, with the burden of proof falling on whoever alleged abuse. As to the alleged abuse of rights, the board noted that the burden of proof for an abuse of rights lay with the party claiming the abuse of rights, and that such an abuse had to be established beyond doubt (**J 9/21,** interruption of proceedings, quoting **J 14/19**). (Same standard of proof in **T 2951/18** regarding an intervener). See also **T 1808/21**, which concerned the allegation that appellant 1 (opponent) by acting as a straw man had circumvented the law by lowering the standard of proof, the board was convinced the distinction between the "balance of probabilities" standard and the "beyond any reasonable doubt" standard was not decisive in the present case. In line with **T 768/20** and **T 660/16**, the board agreed that, also in the present case, the relevant point was rather whether the deciding body was ultimately persuaded in view of all available facts that the relevant evidence duly presented by appellant 1 when forming its opposition, had indeed been made publicly available.

In **D 5/86** (OJ 1989, 210) the board held that an infringement of the rules of professional conduct had to be established to the satisfaction of the disciplinary body before it could impose a disciplinary measure. Absolute certainty was not required, but a **higher degree of probability** which in human experience verged on certainty. A disciplinary measure could not be imposed if there was reasonable doubt as to whether the infringement had occurred.

4.3.7 Receipt of formal documents

See chapter III.S for the applicable law and case law, and also chapter III.S.5.1. "Burden of proof and safeguards". With respect to the burden of proving receipt, see also chapter III.G.5.1.2g) "Receipt of formal documents" below and in particular **T 1529/20** for a recent case.

The respondent (opponent) in **T 1/12** argued that the boards' case law on the applicable standard of proof for proving receipt of documents by the EPO was contradictory. In that context, it cited **T 1200/01**, which suggested a balance of probabilities, and **T 2454/11**, which held that a stricter standard of proof was needed to convince the board. This prompted the opponent to draft points of law for referral. The board, however, refused its request for a referral, in particular because according to the principle of free evaluation of the evidence, that evaluation had to done on a case-specific basis. The standard of proof that the balance of probabilities needed to reach to convince the board was thus left to the discretion of the board itself. The board found no clear contraction between **T 1200/01** and **T 2454/11**. It dealt with the matter of the standard of proof in combination with, in particular, the principle established in the case law of free evaluation of the evidence.

The issue under appeal in **T 1200/01** was whether an opposition of the appellant against the patent could be deemed to have been filed. According to Art. 99(1) EPC, last sentence, this was only the case if the opposition fee had been paid within the opposition period. However, in the case at issue no trace of a notice of opposition nor of a voucher for payment of the opposition fee allegedly filed by the appellant had been found within the EPO. The board noted that, concerning the standard of proof to be applied for establishing the receipt of documents not found within the EPO, it was the established case law of the boards of appeal that, even if proof to this effect could seldom lead to absolute certainty, it at least had to show to a **high degree of probability** that the alleged filing had taken place (see also **T 128/87**, OJ 1989, 406, cited by the board). It also noted that in some previous cases (see **T 243/86** and **T 69/86**, cited by the board) it had been accepted that this standard was met if there were concrete traces of the item sought which, even if they did not show it for certain, indicated a high probability of the lost document having once been in the EPO. Nevertheless, any other means of giving evidence, such as witness testimony, could equally be considered in this context.

The communication noting the loss of rights under R. 112(1) EPC (former R. 69(1) EPC 1973) is deemed to have been delivered to the addressee on the tenth day following its posting, unless the letter failed to reach the addressee or reached him at a later date. In the event of any dispute, it is incumbent on the EPO to establish that the letter reached its destination (R. 126(2) EPC; CA/D 6/14 for the revised wording; former

R. 78(2) EPC 1973). In **J 9/05** and **J 18/05** the only evidence provided by the examining division was a letter from the Deutsche Post referring to the information received from the foreign postal service, according to which the letter had been delivered to an authorised recipient, who, however, was not specified. The board stated that the probative value of the submissions and evidence of the appellant had to be balanced against the probative value of evidence established by the EPO. Balancing the evidence of the examining division, which consisted of the rather vague letter from the Deutsche Post, against the evidence submitted by the appellant, and taking into account the serious consequences for the appellant, the board came to the conclusion that it had not been sufficiently proven that the applicant had received the R. 69(1) EPC communication. In such a situation, where the EPO bore the burden of proof, the applicant had to be given the benefit of the doubt.

In **T 529/09** a communication pursuant to R. 82(3) EPC (invitation to parties to file observations with regard to the maintenance of patent in amended form) had been sent out on 8 September 2008 by registered letter addressed to the proprietor's representative. According to R. 126(2) EPC (see CA/D 6/14 for the revised wording), a registered letter was deemed to have been delivered to the addressee on the tenth day following its posting, unless it had failed to reach the addressee or reached him at a later date. In the board's view, "delivered to the addressee" did not mean that the notification in question had to be brought to the attention of the professional representative in person. It sufficed that the registered letter had been received by a person authorised to take delivery, e.g. an employee of the representative's office (see **T 743/05**). In the present case, the board regarded the evidence on file as sufficiently reliable and complete to prove the proper delivery of the letter. In this respect, the board highlighted a significant difference between this case and **J 9/05** and **J 18/05**, in which the appellant had filed a considerable amount of counter-evidence pointing out specific reasons why the letter might not have been received by the representative's office.

In **T 1934/16**, since the appellant denied having received the communication under R. 82(3) EPC, the EPO had to establish that it reached its destination and the date on which it was delivered (R. 126(2) EPC). The result of the enquiry initiated by the board proved that the registered letter reached its destination and, as the appellant did not submit substantiated details that were apt to demonstrate a different course of events, no doubt existed that the letter was duly received by the appellant's representative.

The inter partes decision **T 1587/17** deals in detail with the standard of proof required to establish that a **notice of appeal** has been filed, with particular reference to **T 2454/11** and **T 1200/01**. The board decided that, in view of the evidence on file, the appellant had discharged its burden of proof and the respondent had not succeeded in raising doubts that were serious enough.

See also **J 10/04**, reported above, which differed from the "ordinary" cases concerning lost mail in that the application had reached the USPTO and only some of the papers were missing, and **T 1535/10**, in which the board found that responsibility for obstacles and delays in receiving decisions having to be notified under R. 126(1) EPC had to be assigned according to spheres of risk (see chapter III.S.5.1. "Burden of proof and safeguards").

5. Burden of proof

5.1. Apportioning the burden of proof

5.1.1 General

In the absence of relevant EPC provisions, the principles concerning the allocation of the burden of proof have been developed through the case law of the boards of appeal. **Each party bears the burden of proof for the facts it alleges**.

According to the established case law of the boards of appeal, each party to the proceedings bears the burden to prove the facts that it asserts. If a **decisive fact** is not proven, the decision taken will be to the detriment of the party that fails to provide the necessary proof (see decision **T 270/90**, OJ 1993, 725, point 2.1 of the Reasons; **T 355/97**, point 2.5 of the Reasons; **T 527/08**, point 3.4.1 of the Reasons; **T 1469/08** "Public prior use (no): public availability not sufficiently proven").

In **T 219/83** the board had held that it is not sufficient in opposition proceedings for the opponent to impugn a granted patent with an assertion which cannot be substantiated. And if the EPO is unable to establish the facts of its own motion (Art. 114(1) EPC), the proprietor is given the benefit of the doubt (**T 219/83**, OJ 1986, 211, 328; see also **T 293/87** and **T 459/87**, **T 200/94** (Art. 56 EPC – experimental evidence – conclusion: problem credibly solved across entire scope), **T 762/04** point 4.8.1 of the Reasons).

Example decisions summarising the consequences of making assertions without any evidence to support them (extracts out of context in brackets): **T 882/17** (the allegation merely speculative and not supported by any evidence); **T 346/03** with regard to a question of admissibility ; **T 707/21** (the appellant's unsupported allegation that for the skilled person also the distinguishing features found to be generic and manifestly speculative); **T 1540/21** (only one specific allegation based on verifiable evidence.); **T 1837/13** (the appellant nevertheless asserts, without providing any proof ... the board regards this assertion as purely speculative and cannot take it into account in its decision ... and if a decisive fact is not proven...); **T 2233/08** (the absence of any data supporting them, the allegations provided by the appellant – who had the burden of proof for them – were found to be entirely speculative and had to therefore be disregarded); **T 592/08** (absent any evidence confirming an effect is achieved ... the assertion that such effect is achieved over the whole claimed scope remains speculative and cannot be taken into account in the assessment of inventive step.); **T 51/97** (in the absence of any corroborating evidence the respondent's allegation was speculative and did not convince the board.) ; **T 523/18** (the argument that one or the other distinguishing feature did not contribute to the effect demonstrated amounted to a mere allegation, unsupported by evidence.); **T 40/17** (the assumed intention of the appellant to cause unnecessary costs was a mere allegation ; it could not justify the requested apportionment of costs); **T 61/20** (the reference to the skilled person's common general knowledge was a mere allegation without any evidence); **T 2038/19** (the absence of evidence showing the knowledge of the skilled person, in particular in relation to the production of water-absorbent resin particles, constituted a mere allegation devoid of any concrete support and was not persuasive); **T 1310/22** (the argument at issue

constituted a mere allegation devoid of any concrete support and was for this reason not persuasive), see also **T 1469/08** ; **T 2916/19**.

– Burden of presentation and burden to prove a negative fact

T 2037/18 concerned whether an opposition had met the requirements for "adequate substantiation" and thus been admissible and, in particular, whether the opponent, which had alleged a prior use, should have substantiated an asserted lack of a non-disclosure clause. Addressing in detail the burden of proof and the burden of presentation, the board held that in most legal systems and in proceedings before the EPO (beyond the area open to examination by the EPO of its own motion), the burden of presentation and the burden of proof were allocated such that each party had to present and prove the facts that were favourable to them, i.e. the facts that supported their own assertions (**T 219/83**, **T 270/90**). The principle of "*negativa non sunt probanda*", also recognised in the boards' case law (see **R 15/11**, **R 4/17**), was a clear expression of this allocation of the burden of proof. In other words, a party to the proceedings was not required to prove a negative fact. As a general rule, the burden of presentation followed the burden of proof. Decision applied in **T 1714/15** (Art. 83 EPC – burden to prove that a measurement apparatus no longer existed), **T 503/20** (patent proprietor bears the burden of proving and producing evidence of an implicit confidentiality agreement) and **T 1529/20** (proof that a notification was not received).

Another decision related to proving a negative fact with reference to **T 1798/14** (obligation to maintain confidentiality): **T 34/18** (prior use – extent of the requirement for the opponent to provide proof that there was no obligation to maintain confidentiality; see in particular point 4.2.3 of the Reasons).

In **T 998/04** the board emphasised as an obiter dictum that the burden of proof for alleged lack of patentability lay with the opponent and could not be dispensed with by requesting the board to carry out its own investigations, in particular, by summoning four named witnesses, by commissioning an **independent expert** to carry out experimental tests and by allowing individuals from the appellant company to attend any tests and to question witnesses or experts. Moreover, granting these requests would not be consistent with the character of the post-grant opposition proceedings under the EPC which were in principle to be considered as contentious proceedings between parties normally representing opposite interests, who should be given equally fair treatment (see **G 9/91**, OJ 1993, 408, point 2 of the Reasons).

– Taking doubt into account

If a material fact is not or cannot be proven, a decision is taken as to who bears the relevant burden of proof. If the real position cannot be established, this is to the detriment of the party who bears the burden of proof for this fact, among other things because the other party is given the benefit of the doubt. In principle, each party bears the burden of proof for the facts it alleges (**T 63/06**, points 3.1 and 3.2 of the Reasons).

In **T 1076/21** the board, which also made reference to the passage cited above from **T 63/06**, stated that since the parties in the case in hand made contradictory but unsubstantiated assertions concerning facts, the patent proprietor was given the benefit of the doubt (**T 72/04**, point 3 of the Reasons).

In case of uncertainty about a prior-art disclosure, the patentee should be given the benefit of the doubt (**T 1003/96**; see also **T 230/92**, **T 345/86**, **T 601/91** and **T 968/91**). On the issue of taking doubt into account in the examination of Art. 123(3) EPC, see **T 2285/09**.

See also **T 832/22** which addresses the meaning of a remaining doubt in relation to the "beyond reasonable doubt" standard.

– Irrelevance of access to evidence for apportioning the burden of proof

The patentee cannot relieve itself of the burden of providing **counter-evidence** for facts it alleges by simply stating that all the evidence was within the power of its opponent (with reference to **T 472/92**, OJ 1998, 161;), without providing proof for the contention that it is not within its power to obtain counter-evidence (**T 254/98**). As far as apportioning the burden of proof is concerned, it is irrelevant whether or not the patentee can access the requisite evidence more easily than the opponent (**T 1162/07**; see also **T 1710/12**).

5.1.2 Individual cases

a) Burden of proof on appeal

Concerning burden of proof on appeal, **T 1138/20** stated that the burden is on the party challenging a fact on appeal to demonstrate that the first-instance department erred in its finding of fact. In doing so, the party must specifically indicate each alleged error in the department's findings of fact or in its evaluation of the evidence and set out the reasons why this is considered erroneous. If the party succeeds in discharging this burden and demonstrating such an error, the board will establish the facts on its own if this is necessary to reach a decision. Depending on the circumstances of the case, the board may also remit the case to the respective department for a new finding of fact (Art. 111(1) EPC). For the sake of completeness, the board noted the following: since the review of decisions is only one of the functions – albeit the primary function – of the boards of appeal, a board may also decide, at any stage of the appeal proceedings, to establish the facts on its own motion, even if none of the parties has demonstrated an error (see point 1.2.5 of the Reasons).

See also **T 1076/21** on the burden of proof on appeal following revocation of the patent by the opposition division. This decision contains an extensive discussion of the burden of proof, the starting point for which is the argument of the respondent (opponent), with reference to **T 585/92**, that the appellant (proprietor) (now) bore the burden of proving that the patent was sufficiently disclosed because the opposition division had revoked the patent (see point c) below, chapter III.G.5.1.2d)).

b) Novelty

For the purpose of assessing novelty, the party alleging that the inevitable outcome of a prior art disclosure is in contradiction with the explicit disclosure of the cited prior art has not only the burden of reproducing the earlier disclosure in such a way as to demonstrate that the alleged inevitable outcome has occurred, but also the burden of proving convincingly that if any significant deviation from the conditions specified in the earlier disclosure are not material to the outcome (**T 204/00**; see also **T 396/89**).

In **T 713/01** the appellant denied the existence of an "enabling" disclosure in D2 with regard to the preparation of polymers in the presence of a solubilised lithium pyrrolidide initiator by reference to **T 124/87** (OJ 1989, 491) and **T 206/83** (OJ 1987, 5). The board held that the only difference between D2 and the claim wording did not qualify as a distinguishing feature of the claimed product because that **"product-by-process" feature** was not detectable on the product by a reliably distinguishing property. In this context, the board added that in proceedings before the examining division the burden of proof for an allegedly distinguishing "product-by-process" feature lay with the applicant (see further **T 205/83**, OJ 1985, 363 and **T 279/84**). Decision **T 713/01** was clearly concerned with the question of burden of proof in examination proceedings (**T 1912/10**).

In **T 664/20**, point 2 of the Catchword, the board stated that when a patent proprietor amends a product claim to specify that the product is intended for a particular use, the patent proprietor has to prove that the prior art products that have been cited to show a lack of novelty and which satisfy all the other features of the claim are unsuitable for the use in question.

In **T 172/20** it was decided that the burden of proof remained with the opponent since the parameter in dispute was not an unusual parameter; it was for the opponent to prove beyond reasonable doubt that the claimed subject-matter had been directly and unambiguously disclosed in the prior art.

In **T 2916/19** the nature of the catalyst system and the mode of preparation thereof were crucial, and in relation to the objections based on enabling disclosure (E1), considering that E1 constituted a written disclosure and not an alleged public prior use, the circumstances were not the same as in **G 1/92** and **T 1833/14**, which were both relied upon by the respondent (proprietor). Nevertheless, the arguments were equally relevant for the written disclosure E1. Indeed, in view of the respondent's submissions, the question arose as to whether or not the skilled person would be able to prepare without undue burden any of samples 1, 3 and 5 of E1 in view of the very limited information provided in E1 regarding their preparation process, in particular regarding the catalyst system used, even taking into account common general knowledge. It was in dispute between the parties whether the burden of proof regarding enablement of samples of E1 was on the appellant/opponent or on the respondent/patent proprietor. Since the appellant/ opponent raised objections (lack of novelty and inventive step) based on the disclosure of samples of E1, the burden of proof primarily resided with them to show that said samples of E1 effectively belonged to the state of the art. Also, according to established case law, the requirements of sufficiency of disclosure were identical for a prior art document and a

patent (**T 1437/07**). Since there were serious doubts substantiated by verifiable facts supporting the objection of lack of enablement raised by the respondent (proprietor) against samples of E1, the burden of proof was on the appellant. The appellant also unconvincingly argued, with reference to the minutes, that the objection that E1 was not enabling should be rejected since the respondent argued the contrary in the opposition proceedings.

See chapter I.C. "Novelty".

c) Inventive step

This section reports on several cases. Issues of proof in relation to Art. 56 EPC are inextricably linked to the assessment of inventive step discussed in chapter I.D "Inventive step".

In **T 547/88** inventive step had been contested. Although the board had asked the parties to issue a joint protocol stating what **tests** had to be done and under what conditions, each party had in fact conducted its own experiments and obtained contradictory results. It was therefore not possible for the board, on the basis of these tests, to conclude definitively that no inventive step was involved. The board held that in such a case the patent proprietor should be given the **benefit of the doubt** with regard to the relevance of the claimed features to the problem to be solved. Moreover, since the prior art did not suggest the subject-matter of the contested claims, that subject-matter implied an inventive step. The patent was therefore maintained.

The burden of proving that the claimed method leads to the **advantageous effects** mentioned in the patent in suit rests with the patentee. In the absence of any corroborating evidence that these advantageous effects were obtained, the alleged effects are not to be taken into account when assessing inventive step (cf. **T 97/00**; see also **T 1409/04**).

In **T 862/11** the appellant (opponent) had failed to submit comparative tests in support of its own assertion that an improvement was implausible owing to the lack of any evidence. In the absence of such tests, however, it failed to convince the board, which therefore regarded the problem as solved, and saw no need to reformulate it.

The problem stated in a granted patent is deemed to have been plausibly solved by the claimed invention when there are no grounds to suspect otherwise. According to the established case law of the boards of appeal, in opposition (or any subsequent appeal) proceedings, it is insufficient for the opponent to attack a granted patent with an unsubstantiated assertion. The opponent bears the burden of proving its assertion or must at least furnish evidence liable to raise doubts that the problem has indeed been solved (**T 534/13**, citing **T 1797/09**, point 2.7 of the Reasons). If the opponent succeeds in doing so, the burden shifts to the patent proprietor to prove its assertions (see e.g. **T 1797/09**).

The board in **T 291/15** observed that, according to established case law, each party bears the burden of proof for the fact it alleges. This means that a technical problem set out in a patent is considered to be credibly solved by a claimed invention if there are no reasons

to assume the contrary. In such circumstances, the onus is normally on the opponent to prove the opposite by appropriate counter-evidence or to at least provide evidence casting doubt on the alleged solution of the problem (**T 596/99**, point 7.2.9 of the Reasons and **T 1797/09**, point 2.7 of the Reasons).

In **T 2320/16** the opponent (appellant) alleged, with reference to **T 415/11**, that the burden of proof in relation to the problem-solution approach lay with the respondent (patent proprietor). The board disagreed, holding that it was insufficient in opposition proceedings for the opponent to challenge a granted patent with an assertion which had not been substantiated. The appellant (opponent) had not submitted any evidence which cast doubt on the claimed effects.

In **T 1177/17** the question arose as to whether 2-FL could, by itself, provide the claimed indirect antiviral effects by means of NK cell stimulation, as alleged by the respondent (patentee). In the board's view, it could not. There was no evidence on file to show this, the respondent not having substantiated its submissions with any evidence other than the data reported in example 1 of the patent – a study in mice vaccinated with Influvac. On the contrary, it had argued that it was down to the appellants (opponents) to demonstrate that 2-FL did not provide the claimed antiviral effects by means of NK cell stimulation. However, in the board's view, this argument could not succeed since the technical effects invoked by the respondent were not plausible over the whole scope of claim 1 of the main request.

In case **T 655/13** the examining division did not precisely identify the passage of document D1 (technical journal in Japanese as a prior art publication) which disclosed the feature in dispute and at the same time did not provide a translation of at least the referenced longer section of said Japanese document. The board recalled that in examination proceedings, as far as issues relating to patentability requirements are concerned, the burden of proof – and consequently the onus of presentation of the relevant facts – lies initially with the examining division, which must provide evidence and facts to support its objection (see **T 578/06**). As a rule, the applicant can dispute in a general way a general statement made by the examining division, which then in turn is obliged to raise a more detailed objection. In order to give an applicant a fair chance to challenge the findings of the examining division, the latter should, as a rule, at least once identify where in the closest prior art document each of the features of the claim in suit is disclosed (see e.g. the obiter dictum in **T 70/02**).

The board in **T 1285/21** dealt with the question of the burden of proof with regard to proving a technical effect, in relation to the issue of experimental data and remaining doubt. In the specific case of establishing that the claimed invention is associated with a technical effect, it is incumbent on the patent proprietor to prove that the claimed subject-matter leads to the advantageous effects mentioned in the patent in suit. Moreover, the board did not see any reason to relax this rule in the opposition phase (as opposed to during the examination phase), not even in cases where the contested patent disclosed comparative examples related to the distinguishing features. It was noted in particular that new prior art documents can be submitted in the opposition proceedings, potentially resulting in a complete reassessment of novelty and inventive step. In those cases, the opposition

division and board may have to analyse the examples of the contested patent again and examine whether they make it credible that a technical effect is achieved over the closest prior art. The burden of proof shifts only when a technical effect has been plausibly demonstrated, it then being incumbent on the opponent to furnish evidence in support of its counterarguments. According to decision **T 1797/09**, a technical problem set out in a patent is credibly solved if there are no reasons to assume the contrary. By implication, though, this would mean that it would first be down to an opposing party to substantiate why the problem addressed is not solved (negative evidence), rather than it being incumbent on the patent proprietor to present grounds or evidence (positive evidence) in support of a technical effect. This decision therefore appears to suggest that the burden of proof is initially with the opponent. However, the board in **T 1285/21** also underlined that **T 1797/09** still works on the assumption that even if a technical effect is presumed, this can be rebutted in opposition or appeal proceedings. Accordingly, the board in **T 1797/09** denied the technical effect – which had merely been alleged – in view of the evidence submitted by the opponent.

d) Sufficiency of disclosure

According to established case law of the boards of appeal, a successful objection of insufficient disclosure presupposes that there are serious doubts, substantiated by verifiable facts (**T 19/90**). In inter partes proceedings, the burden of proof **initially lies with the opponent**, who must establish, on the balance of probabilities, that a skilled person reading the patent, using common general knowledge, would be unable to carry out the invention. This is because it is generally to be presumed that a patent relates to an invention which is sufficiently disclosed. If the opponent has discharged its burden of proof and so conclusively established the facts, the patent proprietor then bears the burden of proving the counter-arguments it puts forward to refute those facts.

Decisions **T 19/90** and **T 63/06** are regularly cited, even in recent case law. Decision **T 1076/21** provides a very useful explanation of the framework for the burden of proof, particularly on appeal after a patent is revoked by the opposition division (see Catchword). It also discusses the notion of a strong or weak presumption and the resulting requirements as regards the evidence that the opponent has to furnish to discharge its initial burden of proof. **T 1076/21** also addresses unusual parameters. Regarding the benefit of the doubt, see **T 72/04**, the principles of which are applied in **T 1076/21**.

The burden of proof is determined by the legal cases which the respective parties are trying to make. Whether it is discharged or not is assessed by the board based on all the relevant evidence put before it. The burden of proof of insufficiency is as a general rule on the opponents, who should prove that despite making all reasonable efforts they were unable to put the invention into practice in view of the prevailing technical opinion. If the patentee is claiming a result, which the prevailing technical opinion suggests is not achievable, and if the opponents are not able to repeat the method in the patent, they cannot be expected to do more than the patentee. Then, the burden of proof is on the patentee to show that the extraction method in the patent works as stated so that at least one way of putting the invention into practice has been given to the skilled person (approach summarised in **T 518/10** (invention against the prevailing technical opinion that

given compounds could only be found in fruit, vegetable or algae – here extract from marine or aquatic biomass), which in turn cited **T 792/00** (also concerned an invention going against prevailing technical opinion) and **T 1842/06** ("memory of water")).

In **T 1608/13**, referring to **T 585/92**, the respondent (opponent) argued that in appeal, after the opposition division had revoked the patent, the burden of proof shifted to the appellant to prove that the decision was wrong. However, the primary aim of appeal proceedings was to review the decision under appeal on the basis of the submissions and requests of the parties. This clearly encompassed the review of the opposition division's reasoning, in particular the assessment of the respondent's objections considered in the decision. If the reasoning as such was found to be wrong, there could not be any shift of the burden of proof on the substance. This decision is cited by **T 1076/21** to show how the burden of proof is shifted to the patent proprietor on appeal; the mere existence of the opposition division's decision to revoke the patent is not sufficient to shift the burden (**T 1076/21**, point 1.1.3 of the Reasons; see chapter II.C.9.1 for a longer summary).

In **T 1886/12**, which also contains reasoning on the issue of burden of proof concerning alleged insufficiency of disclosure, the appellant (opponent) raised several objections but did not discharge the burden of proof.

In **T 1889/15** there was a strong presumption of sufficiency, to the extent that a high standard of proof was required from the respondent (opponent) to prove the opposite, for example through comparative tests showing that the stated ESCR index could not be reliably achieved by following the teaching of the patent. However, apart from referring to two flawed examples, the respondent had not provided any detailed arguments, let alone verifiable proof, for example in the form of experimental results, to highlight shortcomings in the disclosure.

In **T 275/16** the board recalled that the burden of proof of insufficiency of disclosure is, as a general rule, on the **opponent**. However, in the case of an invention which goes against the prevailing technical opinion, it is the patent proprietor who needs to prove that the invention is sufficiently disclosed (**T 792/00**, points 3 to 5 of the Reasons; **T 1842/06**, point 3.4 of the Reasons; **T 518/10**, point 7.10.1 of the Reasons; cf. **T 419/12**, point 1.1.4(6) of the Reasons). In the case at issue, it was the prevailing technical opinion that no processes existed which would allow the production of titanium dioxide particles in a gas phase reaction, the particles all having the same particle diameter, i.e. having a monodisperse particle size distribution. Moreover, the patent did not contain data for the contentious Dtop/D50 value of 1. It was the patent proprietor (appellant) who had to show that it was possible to arrive at a Dtop (maximum particle diameter) / D50 (median particle diameter) ratio of 1, a value explicitly claimed, when using the process disclosed in the patent in suit. The board considered the requirements of sufficiency of disclosure not met, even with a skilled person construing the patent with a mind willing to understand (cf. **T 190/99**).

In **T 298/17** the appellant (patent proprietor) argued that the respondents (opponents) bore the burden of proving that the claimed emulsions could not be obtained but had not filed any evidence in this respect. It further argued that, as per **G 9/91** and **T 1003/96**, it – as

the patent proprietor – should be given the benefit of doubt on the issue of sufficiency of disclosure. The board stated that it was generally accepted that opponents should bear the burden of proof on the issue of sufficiency of disclosure. However, the appellant had acknowledged the fact concerned and the respondents did not need to prove facts that the appellant did not question (**undisputed facts**).

In **T 2119/14** the appellant (patent proprietor) argued that it was down to the opponents to demonstrate the undue burden for the skilled person. The board addressed the burden of proof in detail and held that, in the context of the ground for opposition of insufficient disclosure, the weight of the submissions required to rebut the legal presumption that the patent met the EPC requirement depended on the strength of that presumption (see **T 63/06**). A strong presumption required more substantial submissions than a weak presumption. In the case in hand, the undue burden resulted from the almost infinite number of coating compositions that fell under the structural definition given in claim 1, and from the absence of any teaching in the patent on how to meet the unusual parametric requirement. As a consequence, the onus to prove that this did not necessitate an undue amount of work rested with the patent proprietor (appellant).

In **T 2218/16** (gene therapy) the board considered that, far from being a mere statement, the overall technical teaching provided in the patent amounted to a **strong presumption** of suitability, so the appellant (opponent) bore the burden of proof. Moreover, since the appellant's submissions on insufficiency were not supported by evidence, i.e. verifiable facts, the burden of proof had not been shifted to the respondent (patent proprietor). Decision **T 2218/16** summarises the principles applicable to the burden of proof as regards an allegation of insufficient disclosure of the invention.

In **T 2340/12**, concerning the burden of proof, it was not contested that it is for the organ raising the objection of lack of sufficiency to justify its view. In **ex parte** proceedings it is therefore up to the examining division or the board of appeal to substantiate the objection raised. Such objection should rely on concrete and verifiable knowledge or facts that question the reality of the effects provided for by the claimed invention. The lack of credibility could result, for example, from a conflict with established laws of physics. It was then for the applicant (appellant) to provide the arguments or evidence. The board remarked that the filing of experiments was **not** to be seen as **an obligation** imposed on the applicant **but**, in contrast, as a right, providing the applicant with the **opportunity to convince** that the examining division (or the board) had erred in its initial findings. In the case at issue, the invention related to fields of technology without any accepted theoretical or practical basis. Decision cited more recently in **T 2020/22**.

In **T 2571/12** the board disagreed with the conclusions of the opposition division that, because no evidence had been provided by the opponent to show that any neuropsychiatric disorder could not effectively be treated using a glutathione precursor, the patent in suit was considered to disclose the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art. It was the patent that has to demonstrate the suitability of the claimed treatment for the claimed therapeutic indication.

It was decided in **T 417/13** that **physical** and mathematical **facts** about particle size measurements were **notorious**. Therefore, there was no need to discuss documents filed in order to establish the related facts.

See, for example, **T 2437/13** as to how boards deal with an unsubstantiated allegation made by an opponent who bears the burden of proof. See also **T 1727/12** in relation to Art. 100(b) EPC, in which the board discussed that the opposition division bears the burden of proof for its objection when raising of its own motion a ground for opposition not covered by the notice of opposition or when raising new arguments in respect of a ground for opposition covered by the notice of opposition (with reference to Art. 114(1) EPC and **G 9/91**, OJ 1993, 408, point 16 of the Reasons).

See also chapter II.C.9. "Evidence"; **T 63/06** (summary of its contribution for instance in **T 347/15**), **T 1076/21**, **T 338/10** and **T 967/09** in present chapter III.G.5.2.2.

e) Priority and content of the priority document

– Priority

In **G 1/22** and **G 2/22** (OJ 2024, A50), the Enlarged Board concluded that there is a **rebuttable presumption** under the autonomous law of the EPC **that the applicant is entitled to claim priority**, in accordance with Art. 88(1) EPC and the corresponding Implementing Regulations (**G 1/22** and **G 2/22**, points 105, 112 of the Reasons and point I of the Order). The rebuttable presumption involves the **reversal of the burden of proof**, See also present chapter III.G.5.2.2e) and mainly chapter II.D "Priority" inter alia chapter II.D.2.4.1and II.D.2.4.3.

See chapter II.D "Priority" for the latest case law.

– Content of the priority document

In **T 1147/02** the board dealt with the issue of which party to the appeal proceedings bore the burden of proving the exact content of a priority document in order to establish the relevant priority date. Since the appellant was the one to challenge the priority date necessary for establishing prior art, the principles elaborated in the case law of the boards of appeal dictated that the appellant also bore the burden of convincingly proving that the relevant date was not the filing date of the priority document.

In **T 1303/18** (see Catchword), the patent proprietor held that the priority document D49 disclosed the same compound, meaning that the priority was valid. The board held that the patent proprietor bore the burden to prove that the compounds were identical. As a rule, any applicant filing an application claiming priority must ensure that the earlier application defines the same invention.

f) Specific case of internet citations of prior art

As a rule, each party bears the burden of proof for facts which it alleges. In the specific case of internet citations of prior art cited by the EPO, the burden of proof thus lies with the EPO. If, however, the EPO is satisfied that, on the balance of probabilities, an internet citation constitutes prior art, it is then up to the party to prove otherwise (ex parte cases **T 2227/11**, **T 1589/13**).

In ex parte case **T 545/08** the board stated that the commercial website from which document D1 was retrieved could not be considered, at least not without further investigations, as a source generally deemed to provide reliable publication dates, such as the websites of scientific publishers. It concluded that the examining division was not entitled to consider document D1 as prior art in its first substantive communication without providing further explanations and evidence as to the document's public availability before the priority date (see also **T 1961/13**). Thus, the objection was not properly raised. It could not generate an obligation on the applicant's side to submit evidence against the assumed publication date in the written proceedings (see the observations on the burden of proof in **T 545/08**, points 12 and 13 of the Reasons, and **T 1066/13**).

g) Receipt of formal documents

See chapter III.S for the applicable law and case law, and also chapter III.S.5.1. "Burden of proof and safeguards". On the requisite standard of proof, see also chapter III.G.4.3.7.

In **T 1529/20** the board explained that with the abolition of advices of delivery for notification of decisions by registered letter (see OJ 2019, A31), it was the practice of the EPO at the time to enclose an acknowledgement of receipt (Form 2936) with notifications by registered letter of decisions incurring a period for appeal and summonses. Addressees were requested to date and sign the form and return it immediately, as evidence of receipt (see OJ 2019, A57). The board observed that, even in view of the notice of the EPO concerning implementation of amended R. 126(1) EPC (OJ 2019, A57) – which did not require the enclosure of an acknowledgement of receipt (Form 2936) with the communication of the notice of opposition – the requirements of Art. 113 EPC had to be complied with. The board explained that the notice of the EPO merely determined the format of notifications. However, the provisions of R. 126(2) EPC remained unaffected. Rule 126(2) EPC defined a rebuttable fiction of notification, which, in case of dispute, had to be verified. The burden of proof lay with the EPO. The board agreed with the appellant that a party submitting that something had not happened, i.e. that a communication had not been received, was in difficulties in trying to prove a negative "negativa non sunt probanda", (see also **T 2037/18**, **R 15/11**, **R 4/17**). The filing of cogent evidence showing that a letter had not been received was hardly ever possible (see also **J 9/05**). Therefore, the respondent's arguments that the appellant allegedly had the duty to register mail incoming at their premises but failed to provide an excerpt of such a register was not pertinent, since there was no trace in the file that the EPO had discharged its burden of proving delivery. Under such circumstances, the appellant did not have to bear the risks normally falling in their sphere of responsibility (**T 1535/10**); they have to be given the benefit of the doubt (**J 9/05**). According to the board in the present case, legal certainty

and the protection of the right to be heard would have required that the opposition division establish, by any available means, the fact and date of delivery of the communication of the notice of opposition.

In **T 632/95** the board pointed out that the burden of proving that a document had been received lay with the party submitting the document just as, vice versa, the EPO bore the burden of proving receipt of the documents it issued.

It has to be observed that a party submitting that something has not happened is faced with the difficulty of proving this allegation. The party can essentially presume what could have happened or what normally would have been done if a letter had been received, in order to cast doubt upon the EPO's evidence, but it is hardly ever possible to file compelling evidence that the letter was not received. The EPO is also in a difficult situation if an applicant submits that it has not received a communication. The EPO then has to start enquiries with the postal services and rely on the information obtained. Since details are not given, this information is usually unsatisfactory. After a certain period, the relevant information may not even be obtainable at all. However, this ought not to be to the detriment of the applicant, specifically not where communication noting a loss of rights is concerned. These problems could be avoided if such communications were delivered by registered letter with advice of delivery (**J 9/05** and **J 18/05**).

According to the German version of R. 126 (2) EPC (former R. 78(2) EPC 1973), the EPO must in a case of doubt ("im Zweifel") establish the date on which the letter was delivered to the addressee. In **T 247/98** the board decided that, when establishing the meaning of the term "im Zweifel" in the German version, account should be taken of the French and English versions, which assumed that there was a dispute ("en cas de contestation", "in the event of any dispute"). From the general principles concerning the burden of presentation which fell on the parties, it followed that a party seeking the application of a legal provision favourable to its interests had to set out the facts justifying such application, even if it did not ultimately bear the burden of proof for those facts. Although, in the event of a dispute within the meaning of said rule, the burden of proof for the date of delivery fell on the EPO, this could not be taken to mean that a party wishing to rely on the late delivery of a letter from the EPO had no obligation to contribute to the clarification of circumstances within its own sphere of activity but could sit back, as it were, and wait to see whether the EPO succeeded in ascertaining when the letter had been delivered to the party. A dispute ("Zweifel" in the German version) within the meaning of this rule could only arise if it was maintained that a letter had in fact been received more than ten days following its posting.

In **J 3/14** the board stated that, in a situation where the representative submitted that he had not received a communication, the EPO bore the burden of proof. In the board's opinion, it had at least been **made plausible** that the postal authorities erroneously delivered the letter to an unauthorised person in view of an authorisation which seemed to allow the collection of "all registered mail". The appellant also brought evidence as to the absence of its representative from her place of business. The board concluded that, in cases where the EPO bore the burden of proof, the applicant had to be given the **benefit of the doubt**. If doubts remained about what had really happened, this could not be to the

detriment of the applicant. This applied all the more in a situation like the one at issue where the refusal of the application was the immediate consequence for the applicant.

In **T 50/12** the board held that, by producing the advice of delivery, the EPO had fulfilled its duty under R. 126(2) EPC to assess the actual date of delivery to the addressee. Hence, the burden of proof lay with the appellant. To prove the later delivery, the appellant submitted two documents, neither of which convinced the board of appeal.

Under the EPC, the date of receipt of an item at the EPO is critical when assessing compliance with a time limit. The burden of proof that a filing has been effected falls on the filing party. The impossibility of furnishing proof of a higher probability that an item was filed than that it was not filed, must therefore count against the filing party – as found by the board in **T 1200/01**. In this particular case, the available evidence did not convince the board that there was a higher degree of probability that the alleged filing had taken place than that it had not. Contrary to the decision in **T 1200/01**, the board in **T 2454/11** found that the strict allocation of the burden of proof to the sender of correspondence addressed to the EPO could not be mitigated by weighing up the probability of receipt. Such an approach to examining the issue would seriously jeopardise legal certainty and water down the standard of legal clarity required in formal procedures such as those before the EPO. The need in disputed cases to interpret the vague legal notion of probability and the judicial exercise of ascertaining whether a greater or lesser likelihood was to be presumed would result in a wide variety of possibly contradictory approaches to the issue. Such inconsistencies would run counter to the need for a transparent and straightforward procedure and therefore had to be avoided in the interests of the public and third parties involved in the proceedings. Consequently, a high probability of delivery could not be a factor in deciding whether correspondence had actually been received. Rather, it was for the sender to prove such receipt to the board's satisfaction.

In **J 10/91** the board held that if a letter and attached cheque in payment of a fee had been lost without further evidence or any high probability that it had been lost in the EPO, the risk was then borne by the sender. Even conclusive evidence that something had been posted could not be treated as sufficient to prove that a document had been received by the EPO. In this respect, the board in **J 8/93** stated that if the post failed to deliver a document, the applicant would suffer the consequences for failing to file that document.

Under R. 125(4) EPC (former R. 82 EPC 1973; paragraph 4 not amended by CA/D 6/14) the burden of proof that documents have been duly notified to the parties lies with the EPO. In **T 580/06** the question was raised whether the "OK" reference on the transmission sheet of a faxed document was sufficient proof of receipt. In the absence of relevant EPO case law, the board drew on procedural principles developed for notification by fax in German law, the fax transmission in question having arisen in the territory of the Federal Republic of Germany. In line with the German case law on that issue, the board recognised that an up-to-date objective assessment of the question of **receipt of a fax** by the addressee needed to take into account the technology underlying faxes. The high reliability of this technology nowadays was based amongst other things on established technical protocols, according to which modern fax machines operated. On the basis of various considerations the board reached the conclusion that the "OK" reference on the

transmission sheet of a fax was to be regarded as proof of an error-free and complete transmission, through which the fax had entered into the area of responsibility of the representative. Once the fax had entered the area of responsibility of the addressee indicated by the reference "OK", then a transfer of risk took place so that the recipient bore the risks in his own sphere.

Under R. 125(4) and 126(2) EPC the EPO has to bear not only the risks arising within its own sphere but also the "transport" risks, e.g. of post going astray on its way to the addressee. But here a distinction must be drawn between risks borne by the EPO and those for which the addressee has organisational responsibility and power (**T 1535/10**, see Headnote). See chapter III.S.5.1. "Burden of proof and safeguards". This same division of risk applies also to newer, electronic means of notification under R. 127 EPC (see also the EPO's explanatory notice in OJ 2015, A36, especially as regards amendment of R. 124 to 127 and 129 EPC).

Regarding a "lost request", see **T 8/16**.

h) Generally accepted procedural principles (Article 125 EPC) and national law

With regard to principles of procedural law generally recognised in the contracting states, a party relying on Art. 125 EPC and asserting that German law allows for the revision of a decision of a court of final jurisdiction in the case of a fundamental procedural violation, will also have to produce evidence that such a procedural principle exists in most EPC contracting states and is therefore "generally recognised" for the purpose of Art. 125 EPC (**T 843/91**, OJ 1994, 832). Following on from that, another board stated in **T 833/94** that, when the evidence offered did not directly indicate the truth or falsity of the fact in issue, but required knowledge of the **national law** and patent practice, such law and practice had to be **proved, as did any other fact** on which a party based its arguments.

In **J 14/19** the issue of when national proceedings became pending was to be assessed under German procedural law. At the EPO, German law was to be treated as foreign law for conflict-of-law purposes. Where the EPO was called on to apply foreign law, it has to do so within the overall context of the foreign legal system, wherever possible. When interpreting the foreign law to be applied, it was not bound by the case law of national courts, but if it was aware of the case law of the highest national court, it should consider and evaluate it in coming to its decision. The appellant had referred to German legal commentaries in support of its interpretation of German law. However, they were not official publications and did not form part either of the law created by legislation or of the case law, so they were not, as such, to be taken into account by the EPO when applying foreign law. Moreover, parties and their representative could not assume that the boards of appeal had access to all the legal literature of all the EPC contracting states, particularly when that literature was unrelated to patent law. The legal commentaries cited by the appellant in relation to the German Code of Administrative Court Procedure were therefore taken into account only to the extent that they had been produced.

The Enlarged Board in **G 4/19** (OJ 2022, A24) concluded that there was a real and effective agreement that the EPO should prohibit double patenting by taking into account

principles of procedural law generally recognised in the contracting states, i.e. by a direct application of Art. 125 EPC. At the time of signing of the EPC, the statement made by the delegations in this respect had to be taken as proof that the principle of the prohibition on double patenting was a generally recognised principle in the contracting states. No information had been brought to the Enlarged Board's attention, nor had it been argued, that this situation might have changed, for example through the accession of new contracting states, or as a result of more recent legislation in the contracting states.

The board in ex parte case **T 1473/13** (stay of proceedings – pending complaints before the German Federal Constitutional Court (FCC) regarding a possible lack of judicial independence of the members of the boards of appeal) was of the opinion that the case law (**T 833/94**, **T 74/00**, **T 517/14**) meant that a board was not required to make investigations of its own on a party's case but could still do so where it deemed it appropriate, at least in ex parte cases. The appellant had made assertions without providing details and/or explanations as to, for example, whether the FCC had jurisdiction under German constitutional law over acts of the EPO relating to Germany, and, if so, what the scope of that jurisdiction was and what powers were vested in the FCC to exercise it. The board considered it appropriate to cover the essentials of this point of law of its own motion. This was because if the German FCC did not have jurisdiction over acts of the EPO boards of appeal, any further discussion of the fourth auxiliary request would be moot. Note the FCC decision of 8 November 2022: the appellants complained that the impugned decisions of the technical boards of appeal and the Enlarged Board were based on a general and obvious shortcoming in legal protection and violated fundamental procedural rights. The Second Senate of the FCC rejected the constitutional complaints, deeming them inadmissible (2 BvR 2480/10, 2 BvR 561/18, 2 BvR 786/15, 2 BvR 756/16, and 2 BvR 421/13).

In ex parte case **J 6/22**, the board stated with very many references to case law that the "absolute" right to oral proceedings upon a party's request was subject to inherent restrictions by the EPC and procedural principles generally recognised in the contracting states of the EPO (Art. 125 EPC).

5.2. Shifting the burden of proof

5.2.1 General

Once a party has submitted conclusive proof of its allegations, it has complied with the requirement of the burden of proof. The evidence need not prove the facts with absolute certainty in order to be deemed conclusive; it suffices that it proves that they are highly probable. If a party has discharged its burden of proof, the counterparty seeking to refute the conclusively established facts by way of counter-arguments bears the burden of proving the alleged facts (**T 1162/07** summarised in **T 2037/18**; see also **T 270/90**, OJ 1993, 725). In **T 109/91** the board held that the burden of proof might shift constantly as a function of the weight of the evidence, i.e. if a party provided enough evidence to demonstrate a fact to the conviction of the board, the mere allegation of the contrary by the other party is not convincing (confirmed e.g. in **T 525/90**, **T 239/92** and **T 838/92**).

In **ex parte proceedings**, when the applicant challenges prima facie evidence concerning a fact, i.e. the nominal publication date of a document, and submits evidence to displace such prima facie evidence, the burden of proof shifts to the examining division to establish that the document was "made available to the public" within the meaning of Art. 54(2) EPC on that date (see **T 929/94** with reference to **T 750/94**, OJ 1998, 32). According to **T 128/87** (OJ 1989, 406), a party presenting a cheque to the EPO bore the burden of proof for its receipt by the EPO. However, if the party furnished sufficient proof that a certain document had been filed, such evidence shifted to the EPO the burden of providing a greater weight of evidence to the contrary (**T 770/91** and **J 20/85**, OJ 1987, 102). The more recent case **T 538/09** addressed this issue of burden of proof and standard of proof in its analysis of **T 750/94** and **T 151/99**.

In ex parte case **T 545/08** the board said that it is a general principle that, when the examining division raises objections, the burden of proof lies initially with it. This means that objections must be reasoned and substantiated, and must show that, on the balance of probabilities, the objection is well-founded (see Guidelines G-IV, 7.5.3 – April 2025 version). With respect to the publication date of a cited document, at least **prima facie evidence** is required. Prima facie evidence means evidence which is sufficient, on its own, to establish a fact or to raise a presumption of the truth of a fact unless controverted (see **T 750/94**, point 6 of the Reasons; **T 526/12**, point 1.4 of the Reasons; **T 1066/13**, "directory listing" – no prima facie evidence). Thus, not every indication or hint qualifies as prima facie evidence. If the objection is properly raised, it is then up to the applicant to prove otherwise or at least to submit evidence to displace the prima facie evidence. If the applicant successfully challenges prima facie evidence concerning a fact, e.g. the nominal publication date of a document, the burden of proof shifts back to the examining division to establish that the document was made available to the public (see e.g. **T 929/94**, point 2.1 of the Reasons). As to the case in hand in **T 545/08**, the board found, among other things that, in the absence of prima facie evidence of the public availability of document D1, the examining division had not been entitled to consider it as prior art in its first substantive communication without providing further explanations and evidence as to its public availability before the priority date (see also **T 1961/13**). Thus, the objection was not properly raised. It could not generate an obligation on the applicant's side to submit evidence against the assumed publication date.

In **inter partes proceedings** with reference to **T 585/92** cited by the opponent (respondent) in **T 1076/21** in relation to an objection of insufficient disclosure, the board addressed the issue of the burden of proof on appeal in detail. The board concluded in essence that the burden of proof did not automatically shift on appeal because the opposition division had revoked the patent; it only shifted once the opponent had discharged its burden of proof (for details, see the longer summary of **T 1076/21** in chapter II.C.9).

The board in **T 734/18** noted that none of the cases cited by the appellant-patentee (**T 2451/13**, **T 202/13** or **T 2338/13**) supported the view that the burden of proof should be shifted due to a common sphere of interest between the parties. These decisions rather turn on a legal relationship between parties such as that of a subsidiary, affiliated company.

5.2.2 Cases in which the burden of proof was reversed

a) Inventive step – furnishing of tests

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

In case **T 2108/21**, with detailed reference to **T 862/11** and **T 543/13** (see present chapter III.G.5.1.2c)), the board concluded that it was not immediately apparent for the person skilled in aerodynamics that the suction side winglet provided with the ranges of values for sweep and pre-bend defined in claim 1 would perform any better than the winglet of D1 disclosed with broader ranges of sweep and pre-bend. If any further or improved effect or advantage in terms of performance is alleged, then it should be supported by evidence in the patent. As both an explanation and data were missing any link between claimed parameter ranges and effect had not been plausibly demonstrated and thus the burden of proof shifted to the appellant proprietor. Under established case law, an unexpected effect of a patent has to be proven by comparative tests (**T 1285/21**; see also chapter I.D.4.3.2 and in this chapter III.G.5.1.2c)).

b) Non-disclosure agreement

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

c) Sufficiency of disclosure

The burden of establishing insufficiency of disclosure generally lies with the opponent. See also chapter II.C.6.8 and II.C.7.2 on how this applies in the context of medical uses, and **G 2/21** (OJ 2023, A85), points 74 and 77 of the Reasons.

In **T 1076/21** the board set out how the burden of proof is to be allocated on appeal following revocation of the patent by the opposition division (see Catchword and the detailed account of **T 1076/21** in chapter II.C.9.1). It made it clear that, after a decision by the opposition division allowing an objection of insufficiency, it was down to the patent proprietor to substantiate on appeal why that decision was wrong. However, the burden of proof on the substance (and in consequence the benefit of the doubt) only shifted if the opposition division's assessment that the presented facts, arguments and evidence were sufficient to discharge the opponent's burden of proof turned out to be correct. Referring to the case law, the board in **T 1076/21** also stated that the initial burden on the opponent to provide facts, arguments and evidence for an assertion of an insufficient disclosure could shift to the patent proprietor once the opponent had **successfully discharged** its burden of proof by submitting sufficient facts, arguments and evidence to rebut the presumption of sufficiency (**T 338/10**, **T 2218/16**). However, this shift could only be caused by sufficient submissions on the substance; formal reasons alone, such as the mere existence of the opposition division's decision to revoke the patent, did not lead to a shift of the burden of proof on the substance. If the reasoning in the impugned decision as such was found to be wrong, there could not be any shift of the "burden of proof on the substance" (**T 499/00**, **T 1608/13**). **T 585/92** had merely stated that the appellant bore the burden of substantiating the appeal. It did not imply that the decision under appeal reversed the burden of proof on the substance.

In **T 63/06** the board explained that, once a patent had been granted, there was a presumption that it was valid. The weight of submissions required to rebut this presumption depended on its strength. The board then distinguished between two cases. A "strong presumption" existed where the patent contained detailed information on how to put the invention into practice, including test results relating to a particular property. In such a case, detailed information or evidence, e.g. in the form of comparative tests, was required to establish a lack of sufficiency (**T 63/06**, point 3.3.1(a) of the Reasons). By contrast, when the patent **did not give any information** on how a feature of the invention could be put into practice, there was only a **weak presumption** that the invention was sufficiently disclosed. In such a case, the opponent could discharge the burden of proof by **plausibly arguing** that common general knowledge would not enable the skilled person to put this feature into practice. **The patent proprietor** then bore the burden of establishing the contrary assertion that common general knowledge would indeed enable the skilled person to carry out the invention (**T 63/06**; summary of this case law in, for example, **T 338/10**, **T 518/10**, **T 347/15** and **T 1889/15**; systemised approach in **T 1076/21**).

In **T 480/11**, **T 1529/17** and **T 518/10** the boards were of the opinion that the opponents had discharged their burden of proof on the substance by submitting experimental data. In **T 188/18** the board concluded that the opponent had discharged its burden of proof on the substance not by submitting experimental data but with reasoned arguments (see also

T 66/07, **T 428/21**, **T 262/11**, **T 347/15**). In **T 325/13** the board even considered that there was no need for the opponent to provide further evidence because the deficiency was plausible from the cited prior art and the simple physiochemical context. All these decisions are cited in **T 1076/21**.

In **T 100/15** an undue burden for the skilled person seeking to put the invention into practice arose from the addition of the term "controlled". It was undisputed that the contested patent did not provide a definition for controlled cooling. It had been rendered plausible by the opponent during the appeal proceedings that the skilled person did not get the required information from the contested patent as to how to perform the controlled cooling, and so it was for the patent proprietor to demonstrate otherwise.

In **T 1299/15** the patent specification did not describe any embodiment for the adjustment device, and so the appellant could not prove the alleged lack of reproducibility on the basis of such an example and instead could only base its case on attacking the device's plausibility, which it then did. That shifted the burden of proving the contrary to the patent proprietor (in this case the respondent).

In **T 603/22** (grinding method), the parties disagreed on who bore the burden of proof. In this case, the board found that it had switched to the patent proprietor (appellant), who thus bore the burden to prove that a person skilled in the art would have known how to obtain powders according to claim 1 without undue burden. The board noted that none of the examples in the patent had the claimed particle size distribution (PSD). The same applied to the other examples submitted during the proceedings. This repeated failure to provide powders according to the invention made it credible, as asserted by the respondents, that a person skilled in the art would not have known how to carry out the invention.

In the following cases, the patent proprietor was the appellant and whether the burden of proof had been shifted was an issue, but the boards in question saw no reason for such a reversal of the burden of proof; the burden still being on the opponent at the appeal stage: **T 499/00**, **T 355/05**, **T 1052/13**, **T 1608/13**, **T 720/17**, **T 55/18**. **T 1708/22** (applying **T 1076/21**). In **T 127/22**, the board, endorsed the findings of **T 1076/21** cited by the appellant (proprietor) but decided that, in the present case, there were further reasons that justified a shift in the burden of proof to the proprietor.

For recent decisions citing **G 2/21** (OJ 2023, A85), see **T 1394/21** and **T 2790/17**, the latter concluding that even though experimental data had been provided in the application as filed, it was not credible on the basis of this data that the claimed therapeutic effect was achieved; post-published evidence could not be taken into account, and the burden of proof rested with the respondent (patent proprietor).

d) Unusual parameters

In **T 131/03** the board pointed out that, once the opponent had established a strong presumption that unusual parameters as those used to define the claimed subject-matter were inherently disclosed in the prior art, the patent proprietor could not merely claim the

benefit of the doubt. It was incumbent upon the patentee to establish the extent to which the parameters used in the definition of its invention actually distinguished the claimed subject-matter from the prior art (followed by **T 2732/16**). See also **T 1452/16** (unusual parameters – alleged prior use – public availability of a product): as to the possibility for the patent proprietor to obtain samples and test them, the board stated that when testing samples manufactured after the priority date the legitimate question could arise of whether the results obtained were representative of the ratios present in the samples of the prior art. However, by using a parameter which had not been used in the prior art, the burden was on the patentee to prove that the prior art did not fall within the terms of the claim.

In **T 1666/16** the appellant (opponent), relying on **T 131/03** and **T 740/01**, argued that since the angle of repose (PVDF resin powder) was an unusual parameter in the context of PVDF resins, it would be legitimate to reverse the burden of proof and require the patent proprietor, who had chosen to rely on an unusual parameter as the sole distinguishing feature over the powder disclosed in example 4 of D1, to demonstrate that this parameter was not fulfilled by that powder in D1. The board decided that **T 131/03** and **T 740/01** were based on the same rationale, namely that when it had been established that there was a **strong presumption** that claimed subject-matter defined by an unusual parameter was inherently disclosed in the prior art, the patent proprietor could not merely claim the benefit of the doubt and had to demonstrate that the chosen parameter-based definition distinguished the claimed subject-matter from the prior art. In **T 1666/16**, however, the appellant had failed to show that the unusual parameter was inherently disclosed in the prior art and there was therefore no justification for reversing the burden of proof.

In case **T 555/18**, contrary to the proprietor's view, the FTIR ratio was considered to be an unusual parameter and consequently, in case of doubt it was the proprietor who carried the burden of proof to demonstrate that working within the defined range would not be obvious in view of the cited prior art. The board stated that the concept of "unusual parameter" did not necessarily imply that the parameter was unknown, but rather that it was uncommon in the sense that it was not generally used in the specific form proposed in the claims within the underlying technical field. The board then observed that when the only feature distinguishing the invention from the closest prior art was a range of an unusual parameter, the assessment of obviousness might be clouded by the fact that such parameters were by definition rarely described in the relevant prior art. The board concluded that in such circumstances, a similar approach to that proposed in **T 131/03** and **T 740/01** (concerning novelty) should be applied to decide on the question of obviousness. In particular, once it had been established that it would be obvious for the skilled person to solve the underlying technical problem in ways that could be presumed to inherently lead to values within or close to the claimed range, it was the proprietor who should carry the burden of proof to demonstrate that implementing such solutions would not lead to the claimed parametrical range (See Catchword). The board considered that it would be unequitable for a party to benefit from the uncertainties created by its decision to define the invention in terms of an unusual parameter, which was precisely what the board intended to avoid by shifting the burden of proof to the proprietor or by giving the opponent the benefit of the doubt.

In **T 2037/22** the appellant (opponent) argued that in view of the unusual parameter of the patent, it would be legitimate to reverse the burden of proof and to require from the respondent, having chosen to rely on an unusual parameter as the sole distinguishing feature over the compositions disclosed in D6 and D7, that it demonstrate that this parameter was not fulfilled by these compositions. The appellant relied in support of its case on decisions **T 131/03**, **T 740/01**, **T 2732/16** and **T 1666/16**. The board stressed that all these decisions were based on the same rationale, namely that when a strong presumption has been established that a claimed subject-matter defined with an unusual parameter is inherently disclosed in the prior art, the patent proprietor cannot merely claim the benefit of the doubt and has to demonstrate that the parametric definition chosen distinguishes the claimed subject-matter from the prior art. The appellant had not succeeded in showing that it was reasonable to assume that a variation of b-value of less than 2 was inherently achieved by the compositions of D6 and D7. Accordingly, there was in the present case no justification to reverse the burden of proof. The subject-matter of operative claim 1 was novel over each of D6 and D7.

e) Priority

In **G 1/22** and **G 2/22** (OJ 2024, A50), the Enlarged Board concluded that there is a **rebuttable presumption** under the autonomous law of the EPC **that the applicant** claiming priority in accordance with Art. 88(1) EPC and the corresponding Implementing Regulations **is entitled to claim priority**. This presumption is justified in view of the purpose of the priority rights, the lack of formal requirements for the transfer of priority rights and the presumed common interest of the priority applicant and the subsequent applicant (**G 1/22** and **G 2/22**, points 105, 112 of the Reasons and point I of the Order). The presumption of priority entitlement and its rebuttal are, like the priority entitlement in general, subject to the autonomous law of the EPC only. It cannot be excluded, however, that **in the context of the rebuttal** of the presumption **national laws need to be considered** as well.

The rebuttable presumption involves the **reversal of the burden of proof**, i.e. the party challenging the subsequent applicant's entitlement to priority has to prove that this entitlement is missing. If there is a strong presumption, the hurdle for rebutting it is higher than in the case of a weak presumption (**G 1/22** and **G 2/22**, point 109 of the Reasons, citing **T 63/06**).

The presumption that the subsequent applicant is entitled to the priority right is a **strong presumption** under normal circumstances since the other priority requirements (which establish the basis for the presumption of priority entitlement) can usually only be fulfilled with the consent and even cooperation of the priority applicant (**G 1/22** and **G 2/22**, point 110 of the Reasons). The party challenging the entitlement can thus **not just raise speculative doubts** but must demonstrate that specific facts support serious doubts about the subsequent applicant's entitlement to priority.

See chapter II.D.2.4.1 "Introduction" on Priority.

f) Disputing an experimental protocol

In **T 792/00** the claimed invention went **against prevailing technical opinion** and the patent only contained a hypothetical example. The board found that if the patent contained only an example with a hypothetical experimental protocol, and if this example was to be relied on for showing sufficiency, then the burden of proving that this protocol worked in practice as stated lay with the patentee. Evidence that a variation of the protocol worked was unlikely to be enough. However, if the example contained a complete experimental protocol and the patentee affirmed that the results reported had been obtained, a board was likely to accept that the patentee had done enough to shift the burden of proof to the opponent who would then have to provide a repeat of the experiment in order to convincingly demonstrate that the protocol did not, in fact, work as stated. The findings of this decision are summarised in **T 1875/19** (antibodies) as follows: in **T 792/00**, the deciding board held that, under the particular circumstances, the patent proprietor could only demonstrate sufficiency of disclosure if the hypothetical example was reproducible by following the experimental protocol as stated in the patent and not by using a different experimental protocol.

g) Common general knowledge of the skilled person

In **T 2070/13**, as to the burden of proof, serious doubts were set out concerning whether the skilled person's common general knowledge would be sufficient to enable him to carry out the invention. As a consequence, the burden of proof shifted to the patentee. The mere assumption that anti-adherence of the claimed groups of compounds was known, and the reference to post-published D16 referring to a particular bacterial non-adhesion, was not convincing evidence that could discharge the respondent (patentee) from its burden of proof.

In relation to proof of common general knowledge, see in particular chapter I.C.2.8.5.

h) Violation of the laws of physics

In **T 967/09** the board was satisfied that opponent III had substantiated, by means of verifiable facts, serious doubts that the patent did not disclose the invention as defined in claim 1 in a manner sufficiently clear and complete for it to be carried out by the skilled person. These doubts were considered not to be convincingly rebutted by the appellant (patent proprietor). Accordingly, the board considered that respondent (opponent III) had discharged its burden of proof in this respect. Therefore, the patent, in respect of the subject-matter of claim 1, was insufficiently disclosed. **T 1842/06** ("memory of water") sets out various evidential requirements under Art. 83 EPC, especially those applicable in ex parte proceedings. It states that if an examining division or board objects that the description's disclosure is insufficient, it bears the burden of proving that. If an invention is "revolutionary" (e.g. linked to the "memory of water" as in this case), reversing this burden of proof may be justified if the claimed invention's feasibility and reproducibility does not appear sufficiently plausible on the basis of the application. Doubts might arise for example merely because a technical effect that is **a priori contrary to the laws of physics** is not adequately substantiated by experimental results.

In **T 518/10** the appellant (patent proprietor) argued that the burden of proof that an extract comprising compound (II) could be obtained from aquatic or marine biomass, in particular krill, did not shift to the appellant. The patent in suit provided at least one way as to how such an extract could be obtained. Furthermore, the extraction of compound (II) from krill was not against the laws of physics as argued by the respondents (opponents). The board was not convinced and stated that in the present case, assertion of the appellant was against the prevailing technical opinion. The respondents provided evidence that compound (II) could not be obtained when working according to the general method described in the patent. By their experimental reports, the respondents conclusively showed that, by following the extraction method described in the patent in suit, it was not possible for the skilled person to obtain the claimed extract comprising compound (II). Since this fact was neither disproved by documents filed by the appellant nor refuted by the appellant's counter-arguments, the board concluded that the ground of Art. 100(b) EPC was made out.

i) Adverse effect of a reversal of the burden of proof cited in support of a request for review

In **R 21/10** the Enlarged Board ruled that a board's alleged reversal of the burden of proof is not a ground for review, these being exhaustively listed in Art. 112a(2)(a) to (e) EPC and R. 104 and 105 EPC (solution cited by **R 1/20**). It found that, in any event, the technical board concerned – far from reversing the burden of proof – had merely applied the rule that each party bears the burden of proving the facts it asserts.

5.2.3 Cases in which the burden of proof was not reversed

In **T 954/93** the appellant (opponent) had put forward objections to the patent on the basis of lack of novelty, which would have had to be demonstrated by means of experiments. It had not, however, carried out any tests on the ground that they would have been very expensive. The board considered the allegation unproven and refused to reverse the burden of proof. The fact that experiments would have been very expensive did not shift the burden of proof onto the patent proprietor.

In **T 453/04** the opposition had been rejected, i.e. the grounds alleged pursuant to Art. 100 EPC had been found not to be substantiated. The board referred to the previous case law in **T 667/94** according to which, in such cases, the burden of showing that the decision of the opposition division was incorrect remained with the appellant (opponent). The burden is not automatically shifted to the proprietor to show on appeal that the reasons for maintaining the patent were justified was not automatically shifted to the proprietor.

According to **T 499/00**, the burden of proof could not be reversed to rest with the patentee in cases where – as opposed to the situation in **T 585/92** – the patent had been revoked by the opposition division not on the strength of a real failure to disclose the information needed to reproduce the claimed subject-matter, but for reasons that the board elsewhere deemed erroneous. Decision cited more recently in **T 1076/21**.

T 55/18 is an example of a decision in which the parties were in dispute over whether the burden of proof had been shifted. The opposition division had placed the burden of proof on the patent proprietor but failed to explain in the reasons for its decision, which it had based on that allocation of the burden of proof, why it had not followed the applicable principles established in the established case law. Its decision was incorrect for that reason alone. Furthermore, the board was of the opinion that the objection raised by the respondent (opponent) had not been substantiated by verifiable facts, meaning that the respondent had failed to discharge its burden of proof. The fact that the appellant (patent proprietor) had filed two pixelated and fuzzy photos during the oral proceedings before the opposition division could not in itself relieve the respondent (opponent) of its burden of proof. There had thus been no shift of the burden of proof in **T 55/18**.

H. Interpretation of the EPC

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1. General

1.1. Guidance in the EPC on its interpretation

The EPC itself provides relatively little guidance on its interpretation. The Protocol on the Interpretation of Art. 69 EPC deals with the extent of protection under Art. 69 EPC. The EPC contains some regulations on the hierarchy of legal provisions (Art. 150(2) and 164(2) EPC) and the equal authenticity of the EPC in its three official language versions (Art. 177 EPC). Article 125 EPC is not concerned with the interpretation of the EPC but serves merely as a "fill-in" in case of missing procedural provisions. Rule 26 EPC provides some definitions concerning biotechnological inventions and states that the EU Directive 98/44/EC of 6 July 1998 on the legal protection of biotechnological inventions ("Biotech Directive") shall be used as a supplementary means of interpretation. In addition, the Preamble to the EPC states that the EPC constitutes a special agreement within the meaning of Art. 19 Paris Convention.

The EPC itself thus contains no general rules for its interpretation, and one must look outside its terms for such rules (**G 2/12** and **G 2/13**, OJ 2016, A27 and A28).

1.2. Interpretation according to public international law

As an international treaty, the EPC has to be interpreted in accordance with the rules of interpretation developed in the so-called "law of nations" or public international law (**G 5/83**, OJ 1985, 64; **G 2/12**; **G 2/13**). The principles of interpretation set out in the Vienna Convention on the Law of Treaties concluded on 23 May 1969 (hereinafter "Vienna Convention") and its application to the EPC is addressed in this chapter III.H.2.

In the interpretation of international treaties which provide the legal basis for the rights and duties of individuals and corporate bodies it is necessary to pay attention to questions of harmonisation of national and international rules of law. This aspect of interpretation, not dealt with by the provisions of the Vienna Convention, is particularly important where, as is the case with European patent law, provisions of an international treaty have been taken over into national legislation. The establishment of harmonised patent legislation in the contracting states must necessarily be accompanied by harmonised interpretation. The boards of appeal may take into consideration decisions and opinions given by national courts in interpreting the law (see **G 5/83**; see also **G 2/12** and **G 2/13**). TRIPS provisions, like decisions of the European and International Courts of Justice and national decisions, are elements to be taken into consideration by the boards of appeal but are not binding on them (see **G 2/02** and **G 3/02**, OJ 2004, 483, point 8.6 of the Reasons). Likewise, the interpretation of R. 101(9) EPC 1973 provided by the Administrative Council of the European Patent Organisation (the "Administrative Council") did not have any formal binding effect on the boards of appeal (**J 16/96**, OJ 1998, 347).

2. The Vienna Convention on the Law of Treaties

2.1. Application of the Vienna Convention to the interpretation of the EPC

The European Patent Organisation is not a party to the Vienna Convention. Moreover, as the Enlarged Board observed in **G 5/83**, the provisions of the Vienna Convention do not apply to the EPC ex lege, since it applies only to treaties which are concluded by States after the entry into force of the Vienna Convention with regard to such States (Art. 4 Vienna Convention). At the time of conclusion of the EPC, the Vienna Convention was not in force. Nevertheless, there were convincing precedents for applying the rules for interpretation of treaties incorporated in the Vienna Convention to a treaty to which they do not directly apply (see also **G 2/12** and **G 2/13**, point 4 of the Reasons). The International Court of Justice had already applied principles expressed in the Vienna Convention to situations to which the Convention strictly did not apply, whilst the ECtHR, the Federal German Constitutional Court and the House of Lords (England) had also applied the principles of interpretation in Art. 31 and 32 Vienna Convention to treaties to which strictly they do not apply. After a careful study of the whole subject, the Enlarged Board concluded that the EPO had to do the same.

In **J 8/82** (OJ 1984, 155) the Legal Board noted that it was well recognised that Art. 31 and 32 Vienna Convention merely codified existing public international law. In **J 10/98** (OJ 2003, 184) the Legal Board stated that, although the Vienna Convention did not expressly apply to the interpretation of the EPC, PCT or the Paris Convention, since it came into force at a later date than all of those treaties, in accordance with what had been recognised by the Enlarged Board in **G 5/83**, its principles of interpretation were a valuable guide to the interpretation of all treaties executed both before and after it. In **T 1173/97** (OJ 1999, 609) the board stated that although the Vienna Convention was not applicable to the EPC, it had considerable authority and had frequently been cited by the boards of appeal when applying principles laid down in it. See also **J 7/21** and **T 695/18.**

2.2. The rules of interpretation of the Vienna Convention

It is established in the jurisprudence that the rules of interpretation provided for in Art. 31 and 32 Vienna Convention are to be applied when interpreting the EPC. These principles have been acknowledged and applied by the Enlarged Board and the boards of appeal alike (**G 5/83**; **G 2/02** and **G 3/02**; **G 2/08**, OJ 2010, 456; **G 2/12**; **G 2/13**; **G 3/14**, OJ 2015, A102; **G 1/16**, OJ 2018, A70; **G 1/18**, OJ 2020, A26; **G 3/19**, OJ 2020, A11; **J 10/98**, OJ 2003, 184; **T 128/82**, OJ 1984, 164; **T 1173/97**, OJ 1999, 609; **T 1807/15**, OJ 2021, A92; **J 12/18; J 7/21; T 695/18**). In **G 2/08** the Enlarged Board stated that from the reading of Art. 31 and 32 Vienna Convention taken together it follows that the provisions of a treaty (here the EPC) must first be construed according to the **ordinary meaning** of the terms **in their context** and in the light of its **object and purpose**, which means that the judge is not entitled to depart from clear provisions of law, this principle pertaining to the requirement of good faith. From the wording of Art. 32 Vienna Convention it can also be derived that **preparatory documents** are primarily to be drawn into consideration in order to confirm a meaning or to determine a meaning if the first and ordinary means of construction would lead to ambiguity or to an absurd result (see also decision **G 1/07** of 15 February 2010, OJ 2011, 134, point 3.1 of the Reasons; **G 1/18**, point III. of the Reasons).

According to the Enlarged Board in **G 2/12** and **G 2/13** (OJ 2016, A27 and A28) this objective method of interpretation is directed to establishing the "authentic" meaning of the relevant provision and its legal terms. The starting point of interpretation is thus the wording, i.e. the "objective" meaning, regardless of the original "subjective" intention of the contracting parties. To this end, the provisions are to be read in their context so that they comply with the object and purpose of the EPC.

2.3. Application of the rules of interpretation of the Vienna Convention in decisions of the Boards of Appeal

In consolidated cases **G 2/12** and **G 2/13** the Enlarged Board applied Art. 31 and 32 Vienna Convention. In the case at hand, the term "essentially biological processes for the production of plants" in Art. 53(b) EPC needed to be construed pursuant to the general rules of interpretation. The Enlarged Board noted that this question was to be analysed by means of a **methodical interpretation** of Art. 53(b) EPC in respect of, primarily, its wording and, secondarily, considering also the legislator's intention and the aspects of

systematic and historical interpretation. In particular, it applied various methodical lines of interpretation which included grammatical (literal), systematic and teleological interpretations as well as supplementary means of interpretation, principally, such as subsequent agreement or practice. None of these lines of interpretation led the Enlarged Board to conclude that the term "essentially biological processes for the production of plants" extended beyond the processes to products defined or obtained by such processes. This conclusion reached under Art. 31 Vienna Convention was confirmed when the preparatory work of the EPC was taken into account under Art. 32 Vienna Convention.

Importantly, while **G 3/19** ultimately abandoned the interpretation of Art. 53(b) EPC arrived at in **G 2/12**, in view of how the law had developed in the meantime, it did not call into question the principle behind applying the various methods of interpretation.

A number of more recent decisions and opinions likewise lay out the rules for interpreting the EPC and how they are to be applied. This is true of the aforementioned opinion **G 3/19**, which addressed each of the various methods of interpretation in turn. Decision **G 1/18** contains several passages recapitulating the rules for interpreting the EPC (point III of the Reasons) and dealing with their application to the point of law referred in that case (in particular points IV and X of the Reasons). See also **G 1/19** (OJ 2021, A77) (pedestrian simulation), **G 4/19** (OJ 2022, A24) (double patenting) and **G 1/21** of 16 July 2021 (OJ 2022, A49) (oral proceedings by videoconference).

2.3.1 Literal interpretation

The Enlarged Board stated that when interpreting provisions of the EPC, it usually starts from the wording of the relevant provision and even if the wording of a provision reveals its meaning clearly, it examines whether the result of the literal interpretation is confirmed by the meaning of the words in their context (**G 2/12** and **G 2/13**; **G 1/21** of 16 July 2021). It could well be that the wording only has a clear meaning superficially. At any rate, a literal interpretation must not contradict the purpose of the provision (see **G 1/90**, OJ 1991, 275, 278, point 4 of the Reasons; **G 6/91**, OJ 1992, 491, 499, point 15 of the Reasons; **G 3/98**, OJ 2001, 62, 71, point 2.2 of the Reasons). In **G 2/12**, more than one meaning could in principle be attributed to the wording (cf. **G 1/88**, OJ 1989, 189, 193, point 2.2 of the Reasons). Therefore, the true and intended meaning of the term "essentially biological processes for the production of plants" needed to be analysed further.

In **G 1/18**, the Enlarged Board dealt with literal interpretation in point IV.1. Having reiterated the principles stated in consolidated cases **G 2/12** and **G 2/13**, it went on to interpret Art. 108, first sentence, EPC literally, before giving Art. 108, second sentence, EPC a first narrow and then broad literal interpretation. It found that, on a literal interpretation based on a joint reading of the two first sentences of Art. 108 EPC (broad literal interpretation), an appeal was validly filed only if the appeal fee was paid within the prescribed two-month period. It added that there was no inconsistency in the provision's wording in its three language versions. It concluded by stating that this literal interpretation

of Art. 108, first and second sentences, EPC led to a result in keeping with the provision's purpose.

In **T 844/18**, the board stated that the EPC was a special agreement within the meaning of Art. 19 Paris Convention, so application of its provisions could not contradict the basic principles concerning priority laid down in the Paris Convention. Therefore, in order to interpret "any person" in Art. 87(1) EPC, it was necessary to interpret the legal concept of "any person" in Art. 4A Paris Convention, the interpretation given in both treaties needing to be the same. The board concluded that the ordinary meaning of the term "any person" in Art. 87(1) EPC was ambiguous. The term "*celui qui*" in the authentic French text of Art. 4A Paris Convention was perhaps less ambiguous and more likely to support the "all applicants" approach. The "all applicants" approach was certainly a plausible interpretation of the term from the perspective of its ordinary meaning and appeared to be the one consistently applied by several member states of the EPC over the last hundred years (see points 36 et seq. and 83 of the Reasons). The board then turned to the object and purpose of the Paris Convention. See also chapter II.D.2.

In **G 1/21** the Enlarged Board found that the wording of Art. 116 EPC clearly indicated that this provision related to proceedings that were oral. According to the definition in the Oxford English Dictionary, oral meant "by the spoken word, by speech, by word of mouth". There was thus no basis in this word for limiting its scope to in-person hearings in a courtroom before the deciding body.

In **T 695/18**, the board first looked at the wording of R. 139 EPC, and found that, while the wording of the first sentence could give the impression that R. 139 EPC was applicable almost without limit ("in any document filed with the EPO"), the wording of the second sentence ("However"; "such") connected the provisions of the two sentences, with the second being a special instance of the general rule of the first and adding an obviousness criterion for parts, not of anything but of the patent application or patent, which were of more serious consequence to the interests concerned. The board noted that these textual observations did not in themselves provide a clear picture of the scope of R. 139 EPC. On the one hand, the language of the first sentence was open. On the other hand, its linkage to the content of the application or patent mentioned in the second sentence, and the lack of further conditions, were each indicative of some limitations. Literal interpretation of the provision therefore did not bring the board to a clear conclusion. The board continued its analysis with a systematic interpretation.

2.3.2 Systematic interpretation

According to the Enlarged Board in **G 2/12**, systematic interpretation forms a second pillar when construing a legal provision and its terms (see **G 1/88**, point 3 of the Reasons; **G 9/92**, OJ 1994, 875, point 1 of the Reasons; **G 4/95**, OJ 1996, 412, 421 et seq., points 4 and 5 of the Reasons; **G 3/98**, point 2.2 of the Reasons; **G 4/98**, OJ 2001, 131, 143, point 4 of the Reasons). In applying this second method of interpretation the meaning of the wording in question was to be established in the context of the relevant provision itself. In addition, the provision as such had to be interpreted taking into account its position and

function within a coherent group of related legal norms (see also **G 1/18**, point IV.2, which endorsed and followed this approach).

In **J 7/21,** the Legal Board decided that R. 22 EPC did not apply to cases of universal succession. According to the Legal Board, in the context of a systematic interpretation, the meaning of "transfer" in the provisions of R. 22 EPC had to be established, taking into account its position within a coherent group of related legal norms. R. 22 EPC implemented Art. 71 and 72 EPC, relating to patent applications as objects of property. Art. 71 and 72 EPC referred only to transfers of title by contract. No other possibility was dealt with in the EPC, and some of the formal requirements set out in Art. 72 EPC could not be met in the case of universal succession following the death of a natural person. Moreover, R. 143(1)(w) EPC stated that the European Patent Register must contain entries concerning the rights and the transfer of such rights relating to an application or a European patent where the Implementing Regulations provide that they are to be recorded. Hence, it could be inferred from that provision that not all kinds of transfers of rights needed to be registered, but only those explicitly mentioned in the Implementing Regulations.

In **T 695/18**, where the issue was the applicability of R. 139 EPC, the board observed that remedies with the rare capacity to revive EPO proceedings, either in full (e.g. re-establishment of rights), or in part (e.g. petition for review) were only available upon payment of the prescribed fee (Art. 112a and 122 EPC; R. 104 to 110 and 136 EPC). In stark contrast to this was the absence of a fee requirement in R. 139 EPC. Moreover, and more importantly, these extraordinary remedies endowed with resurrection powers were subject to clear and codified time limits and other precisely limited circumstances and conditions that ensure legal certainty for all stakeholders. Conversely, R. 139 EPC was merely a stand-alone provision ranked as an implementing regulation of the EPC. Legal certainty, as protected by the safeguards expressed in, or derived from the articles of the EPC governing re-establishment of rights and petition for review, corresponded, also from a systematic point of view, to a higher interest. It took precedence over the subordinate value of R. 139 EPC and its role relating to the "true" as opposed to the "ostensible" party intention. The board also found it convincing that in the early jurisprudence of the boards of appeal, it was found that the placing of R. 139 EPC (then R. 88 EPC 1973) only in the Implementing Regulations raised the presumption that it was a merely ancillary provision which could only be applied while proceedings were pending for some other purpose before the EPO, and that this Rule did not confer original jurisdiction on the EPO to make corrections at any time (see **J 42/92**, point 4 of the Reasons).

2.3.3 Teleological interpretation

The Enlarged Board applies the method of teleological interpretation in the construction of legislative provisions, which means interpreting the relevant provisions in the light of their purpose, values, and the legal, social and economic goals they aim to achieve. When doing this, the Enlarged Board examines the objective sense and purpose of a legislative provision (e.g. **G 1/88**, point 5 of the Reasons; **G 1/03**, OJ 2004, 413, point 2.1.1 of the Reasons). The starting point was marked by determining the general object of the relevant provision (ratio legis) because the interpretation could not contradict the provision's spirit

(**G 6/91**, point 8 of the Reasons). In point IV.3, **G 1/18** endorsed this approach, set out in point VII.3 of **G 2/12**. In its interim conclusion on this point, **G 1/18** found that the teleological interpretation of Art. 108, first and second sentences, EPC, led to the same interim conclusions as those reached by way of literal and systematic interpretation.

In interpreting Art. 116 EPC, the Enlarged Board in **G 1/21** noted that the object and purpose of the EPC was to provide a system for the grant of European patents with the aim of supporting innovation and technological progress. In the Enlarged Board's view, it would be at odds with this object and purpose if the intention of the legislator was to exclude future formats for oral proceedings that might be made possible by technological progress. In more specific terms, since the object and purpose of oral proceedings was to give parties an opportunity to plead their case orally, it was improbable that the legislator wished to rule out potential future formats which would allow them to do so. There was thus no basis to conclude that the term "oral proceedings" was to be understood in a more limited sense than its ordinary meaning, or that oral proceedings held in a particular format that only became available after the conclusion of the legislative process did not fall within the terms of Art. 116 EPC. The Enlarged Board therefore concluded that oral proceedings in the form of a videoconference were oral proceedings within the meaning of Art. 116 EPC. See also chapter III.C.

According to the Legal Board in **J 7/21,** the intention of R. 22 EPC on the registration of transfers was to ensure the informational role of the European Patent Register and to avoid any ambiguity as to who owned a patent application during proceedings before the EPO. More specifically, the intention of R. 22(3) EPC was to determine the effective date vis-à-vis the EPO of the ownership transfer of a patent application. These requirements were justified when transferring a patent application by assignment, since only a specifically designated right was transferred to a third party and the former patent proprietor, i.e. the assignor, continued to exist. However, in the case of universal succession, the entirety of the assets was transferred automatically as a result of the disappearance of the legal personality of the patent application's owner. Consequently, there was no risk of confusion between two legal entities that could be considered owners of the patent application, nor regarding the extent of the rights transferred since all assets remained united. Therefore, the Legal Board found no justification for delaying the effect of the transfer of assets vis-à-vis the EPO until the date and time at which the evidence was provided proving the disappearance of the legal personality of the patent application's previous owner and the identity of its universal successor.

In **T 844/18**, since the ordinary meaning of the term "any person" in Art. 87(1) EPC was ambiguous, the board had to turn to the object and purpose of the Paris Convention and, more broadly, public policy considerations. This was also in line with Art. 31(1) and 33(4) Vienna Convention.

2.3.4 Subsequent agreement or practice

Article 31(3) Vienna Convention clarifies further elements to be taken into account when considering the context of a provision. In **G 2/12** the Enlarged Board noted that under Art. 31(3) Vienna Convention any subsequent agreement between the parties regarding

the interpretation of the treaty or its application, and any subsequent practice in the application of the treaty which establishes the agreement of the parties regarding its interpretation is to be taken into account. It pointed out that R. 26(5) EPC (formerly R. 23b(5) EPC 1973) could be regarded as such subsequent agreement and practice and that R. 26(1) EPC explicitly called for due consideration of the Biotech Directive (see **G 2/06**, OJ 2009, 306, point 16 of the Reasons).

According to the board in **T 1063/18** the decision to adopt R. 28(2) EPC could not be regarded as a subsequent agreement between the parties that should be taken into account for the interpretation of the treaty, in the meaning of Art. 31(3)(a) Vienna Convention. Opinion **G 3/19** (OJ 2020, A119, point XIX.) stated that the board's conclusion in **T 1063/18** seemed to be based on the notion that in decision **G 2/12**, the Enlarged Board gave a definitive interpretation of the scope of the exception to patentability, which could only be overturned by a formal amendment of Art. 53(b) EPC itself. However according to **G 3/19**, this notion, which was not supported by the EPC itself or by any general legal principle, was too strict, bearing in mind that Art. 53(b) EPC had been acknowledged to be open to interpretation and, furthermore, that a subsequently made rule which diverged from a particular interpretation of an EPC article by a board of appeal was not per se ultra vires (see **T 315/03**). A particular interpretation which had been given to a legal provision could never be taken as carved in stone, because the meaning of the provision may change or evolve over time. This aspect was intrinsic to the ongoing development of the law by way of judicial decision-making. **G 3/19** held that the legislative and administrative developments in a quarter of the contracting states did not amount to a subsequent agreement or practice for the purposes of Art. 31(3)(a) to (b) Vienna Convention. However, the Enlarged Board regarded the introduction of R. 28(2) EPC as a clear legislative intent in the sense of Art. 31(4) Vienna Convention, which could not be ignored. This was taken as one of the reasons to apply a dynamic interpretation.

2.3.5 Secondary considerations: dynamic interpretation

The Enlarged Board stated that a "dynamic interpretation" might come into play where considerations have arisen since the EPC was signed which might give reason to believe that a literal interpretation of the wording of the relevant provision would conflict with the legislator's aims. It might thus lead to a result which diverges from the wording of the law (see **G 2/12** and **G 2/13**; **G 3/19**, point XXII of the Reasons; see also **G 3/98**, point 2.5 of the Reasons). In consolidated cases **G 2/12** and **G 2/13** the Enlarged Board concluded in relation to the process exclusion under Art. 53(b) EPC that the concept of dynamic interpretation did not require revising the result of the interpretation established by applying traditional rules of construction.

The application in **G 3/19** of the various methods of interpretation provided for in Art. 31 and 32 Vienna Convention, which also took into account the subsequent developments in the contracting states, did not in fact lead to the finding that the term "essentially biological processes for the production of plants" in Art. 53(b) EPC was to be read clearly and unambiguously as extending to products defined or obtained by such processes. The Enlarged Board therefore endorsed the conclusions it had come to in this respect in **G 2/12**. At the same time, however, it acknowledged that Art. 53(b) EPC did not prohibit

this broader understanding of the process exclusion either. Furthermore, it recognised that, with the introduction of R. 28(2) EPC, the legal and factual situation underlying decision **G 2/12** had substantially changed. This amendment constituted a new aspect or consideration which had arisen since the EPC was signed and which could give reason to believe that a grammatical, and restrictive, interpretation of the wording of Art. 53(b) EPC conflicted with the legislator's aims, whereas a dynamic interpretation could bring a result that diverged from the wording of the law. This meant that the interpretation of Art. 53(b) EPC in **G 2/12** had to be abandoned (albeit not with retroactive effect). See also chapter I.B.3.3.3b) "G 3/19 – dynamic interpretation of Article 53(b) EPC".

In **J 6/22**, the Legal Board held that a dynamic interpretation of the EPC, as derived from Art. 31(1) and 31(3) Vienna Convention, must take account of developments in national and international procedural law, notably as regards the guarantees of fair trial before a tribunal of law (Art. 6(1) ECHR). It found, through a dynamic interpretation of Art. 116(1) EPC, that there was no "absolute" right to oral proceedings upon a party's request. Rather, it was subject to inherent restrictions by the EPC and procedural principles generally recognised in the contracting states of the EPO. If oral proceedings did not serve any legitimate purpose, the requirement of legal certainty in due time prevented the board from appointing them.

2.3.6 Supplementary means of interpretation – "travaux préparatoires"

Under Art. 32 , recourse may be had to supplementary means of interpretation, including the preparatory work of the treaty and the circumstances of its conclusion, in order to confirm the meaning resulting from the application of Art. 31, or to determine the meaning when the interpretation according to Art. 31: (a) leaves the meaning ambiguous or obscure; or (b) leads to a result which is manifestly absurd or unreasonable (see **T 128/82**, OJ 1984, 164; see also **G 2/07**, OJ 2012, 130, point 4.3 of the Reasons; **G 1/08**, point 4.3 of the Reasons; **G 2/12** and **G 2/13**, point VII.5.(1) of the Reasons; **T 2320/16**, point 1.5.8 of the Reasons).

In **G 2/12** and **G 2/13** (point V.(4) of the Reasons) the Enlarged Board stated that the preparatory work ("travaux préparatoires") and the circumstances of the conclusion of the EPC serve only as supplementary sources of evidence to confirm the result of the interpretation or if no reasonable meaning can be determined by applying the general rule of interpretation (Art. 32 Vienna Convention).

According to opinion **G 1/18**, it follows from Art. 32 Vienna Convention that the "travaux préparatoires" and the circumstances in which the EPC was concluded are to be taken into consideration to confirm a meaning or to determine the meaning when the initial interpretation according to the ordinary meaning would create ambiguity or lead to an absurd result. In **G 1/18**, the Enlarged Board also set out the conclusions reached by boards of appeal on the basis of their analysis of the "travaux préparatoires" in the context of Art. 108 EPC and held them to be incorrect. In point V. of its opinion **G 1/18**, the Enlarged Board observed that neither Art. 108 EPC nor any other provision of the EPC or its Implementing Regulations expressly laid down the legal consequence arising in cases of failure to file the notice of appeal or pay the appeal fee within the two-month time limit

under Art. 108 EPC, and that case law on the matter had been based on the travaux préparatoires on Art. 108 EPC. While the "majority" view in the case law had inferred from the provisions' silence and by simple reference to the travaux préparatoires on Art. 108 EPC that the applicable legal consequence was that the appeal was deemed not to have been filed, the "minority" view in the case law, based on an analysis of the travaux préparatoires on Art. 108 EPC and a reading of R. 65(1) EPC 1973 (now R. 101(1) EPC), concluded that the appeal was inadmissible. The Enlarged Board then found that an analysis of the travaux préparatoires relating to former R. 69(1) EPC 1973 (now R. 112(1) EPC), and not to Art. 108 EPC, showed that the legislator had initially envisaged making express provision there for the legal effect of a loss of rights in the event of the appeal not being filed but that, in the course of the discussions on the rule, and with a view to simplifying things, it preferred to use a general wording covering all legal situations involving a loss of rights in the final version of R. 69(1) EPC 1973.

The Enlarged Board in **G 4/19** considered that a provision falling under Art. 125 EPC may well cover issues which touch upon substantive matters. This interpretation could be based on the EPC itself, without reference to the preparatory documents (see point 27 of the Reasons). As regards another aspect of the interpretation of Art. 125 EPC (legal basis for a prohibition on double patenting; whether any such principle exists and is generally recognised in the contracting states), the Enlarged Board considered whether recourse could be had to the preparatory documents (see points 43 et seq. and 63 and 76 of the Reasons). On that point, the Enlarged Board did not endorse the opinion that the interpretation of the EPC (in itself) provided a clear answer. On the contrary, there were good reasons, including on the basis of Art. 32 Vienna Convention, for consulting the "travaux préparatoires". The Enlarged Board concluded that the preparatory documents demonstrated with overwhelming certainty that there was a real and effective agreement that the EPO should prohibit double patenting by taking into account principles of procedural law generally recognised in the contracting states, i.e. by direct application of Art. 125 EPC. Since the competent legislator, here the Diplomatic Conference, had made it clear that this was a principle falling under Art. 125 EPC as a matter of interpretation of the law, the EPO was not only empowered to apply this principle but effectively also duty-bound to do so. On one specific point, the Enlarged Board found that it was more instructive to look at the German version of the "travaux préparatoires" than at their English text. The French version conveyed the same meaning as the German (**G 4/19**, see points 88 et seq. of the Reasons).

In **J 4/91** (OJ 1992, 402), for example, the Legal Board drew on historical material relating to the EPC 1973 to support its view, arrived at from a teleological and systematic interpretation of the relevant provisions, regarding the additional period for paying renewal fees. **G 1/98** (OJ 2000, 111) discussed the purpose of Art. 53(b) EPC 1973, its relationship to other international treaties and legal texts, and its legislative history. In **G 3/98** and **G 2/99** (OJ 2001, 62 and 83), the Enlarged Board reached its conclusions on Art. 55(1) EPC 1973 after interpreting the wording and considering also the legislator's intention and the aspects of systematic, historical and dynamic interpretation.

2.3.7 Interpretation of exclusions from patentability under the Vienna Convention

In **G 1/07** (OJ 2011, A134) the appellant had submitted that exclusions to patentability had to be construed narrowly according to Art. 31 and 32 Vienna Convention. The Enlarged Board held that no general principle of narrow interpretation of exclusions from patentability which would be applicable **a priori** to the interpretation of any such exclusions can be derived from the Vienna Convention. Rather, the general rule in Art. 31(1) Vienna Convention that a treaty shall be interpreted in good faith in accordance with the ordinary meaning to be given to the terms of the treaty in their context and in the light of its object and purpose must apply to the exclusion clauses contained in the EPC in the same manner as to any other provision. If the interpretation of the provision concerned according to these principles of interpretation leads to the result that a narrow interpretation is the right approach, then and only then is such restrictive meaning to be given to it.

G 1/07 made reference to opinion **G 1/04**, OJ 2006, 334 (point 6 of the Reasons), where the Enlarged Board stated – with reference to decisions of the boards of appeal having acknowledged the existence of such an a priori principle – that the "frequently cited principle", according to which exclusion clauses from patentability laid down in the EPC were to be construed in a restrictive manner, did not apply without exception. In that opinion concerning the definition of the term diagnostic methods practised on the human or animal body, the Enlarged Board came to the conclusion that the said exclusion was indeed to be interpreted narrowly only after a thorough examination of the wording and the purpose of the exclusion clause concerned. See also **T 1553/22**.

The same approach was taken in the Enlarged Board's decision **G 2/06** (OJ 2009, 306). There, the Enlarged Board was concerned with the interpretation of the exclusion from patentability of biotechnological inventions relating to uses of human embryos for industrial or commercial purposes under R. 28(c) EPC (and the corresponding Art. 6(2) of the Biotech Directive). The Enlarged Board made no reference to the existence of a principle of narrow construction of exceptions from patentability. Instead, as a method for interpreting the extent of the prohibition the Enlarged Board went directly to the rules of interpretation laid down in the Vienna Convention, i.e. it looked at the terms of the provision and its object and purpose (point 16 of the Reasons). No mention was made in that decision of any narrow or restrictive view which would have to be taken because the said prohibition was an exception to patentability.

In **G 2/12** and **G 2/13** the Enlarged Board came to the conclusion that, whilst there is no general notion of an obligatorily restrictive construction of exceptions to patentability, for example, such as that adopted by the Court of Justice of the European Union (CJEU) when insisting on a narrow interpretation of exceptions to or derogations from fundamental EC Treaty principles embodied in the four freedoms (Judgment of 21 June 1974, C 2-74, Jean Reyners v. Belgian State, ECJ 1974, 631), such a narrow interpretation might well result from applying the general principles of interpretation to a specific provision with regard to specific legal and factual circumstances. This interpretation of Art. 53(b) EPC given in **G 2/12** was abandoned in **G 3/19** in favour of a dynamic interpretation of the provision under Art. 31(4) Vienna Convention.

3. Implementing Regulations

In **T 39/93** (OJ 1997, 134) the board held that the meaning of an Article of the EPC on its true interpretation as established by a ruling of the Enlarged Board could not be overturned by a newly drafted rule of the Implementing Regulations, the effect of which would be to conflict with this interpretation. This is because, according to Art. 164(2) EPC 1973, in the case of conflict between the provisions of the Convention (the EPC Article) and those of the Implementing Regulations, the provisions of the Convention shall prevail (see also **T 885/93**; **T 83/05**, OJ 2007, 644; **G 2/07**).

In **T 991/04** of 22 November 2005 the board noted that the fact that requirements stipulated by an Article of the EPC need to be specified by the Implementing Regulations does not create a case of conflict. It stated that the Munich Diplomatic Conference (1973) as the legislator of the European patent system drafted the first versions of the EPC 1973 and the Implementing Regulations as a legal unity which should be read in a consistent way. In this regard the Implementing Regulations had the function of an **authentic interpretation** of the EPC 1973. According to the board, the interpretation of legal terms lies within the competence of the boards of appeal because of their judicial function, unless the Implementing Regulations to the EPC stipulate an authentic interpretation within the framework set by the EPC. This is because the boards of appeal are not only bound by the EPC but also by the Implementing Regulations as part of the EPC according to Art. 23(3) EPC 1973.

The Enlarged Board in **G 2/07** stated that it is the function of the Implementing Regulations to determine in more detail how the articles of the EPC should be applied and that there is nothing in the Convention allowing the conclusion that this would not also apply in the case of Articles governing issues of substantive patent law. The limits to the Administrative Council's law-making powers by means of the Implementing Regulations could be inferred from Art. 164(2) EPC. According to that Article, in case of conflict between the provisions of the Convention and those of the Implementing Regulations, the provisions of the Convention shall prevail. The Enlarged Board referred to **G 2/93** (OJ 1995, 275), which accepted that R. 28 EPC 1973 implemented Art. 83 EPC 1973 and was, at least in part, substantive in nature. Furthermore, in its decision **G 2/06** (points 12 and 13 of the Reasons), too, the Enlarged Board did not doubt the Administrative Council's power to lay down provisions concerning substantive law in the Implementing Regulations. Thus the Enlarged Board held in **G 2/07** that the legislator is entitled to provide for issues of substantive law in the rules of the Implementing Regulations. However, a rule, not having a legal history of its own, must be clear enough to indicate to those applying it in what way the legislator intended the article to be interpreted by means of that rule. This, however, was not the case for R. 26(5) EPC. This Rule did not give any useful guidance on how to interpret the term "essentially biological process for the production of plants" in Art. 53(b) EPC and therefore that term had to be interpreted on its own authority. This was for the Enlarged Board to do.

In **T 1063/18**, the board considered that R. 28(2) EPC, as amended by decision of the Administrative Council of 29 June 2017, was in conflict with Art. 53(b) EPC as interpreted by the Enlarged Board in decisions **G 2/12** and **G 2/13**. Since in accordance with

Art. 164(2) EPC, the provisions of the Convention prevailed, the Administrative Council was not, in the light of Art. 33(1)(b) and 35(3) EPC, competent to amend the Convention, here Art. 53(b) EPC, by amendment of the Implementing Regulations, here R. 28(2) EPC. This led to a referral to the Enlarged Board by the President of the EPO on the interpretation of Art. 164(2) EPC and the assessment of R. 28(2) EPC under said provision. The Enlarged Board in **G 3/19** concluded that, in view of the clear legislative intent of the contracting states as represented in the Administrative Council and having regard to Art. 31(4) Vienna Convention, the introduction of R. 28(2) EPC allowed and called for a dynamic interpretation of Art. 53(b) EPC. The Enlarged Board stated that the referring board's conclusion seemed to be based on the notion that in decision **G 2/12**, the Enlarged Board gave a definitive interpretation of the scope of the exception to patentability, which could only be overturned by a formal amendment of Art. 53(b) EPC itself. However, according to **G 3/19**, this notion was too strict, bearing in mind that Art. 53(b) EPC was open to interpretation. Furthermore, a subsequently made rule which diverged from a particular interpretation of an EPC article by a board of appeal was not per se ultra vires (see **T 315/03**). Following a dynamic interpretation of the provision, there was ultimately no conflict between R. 28(2) EPC and the new interpretation of Art. 53(b) EPC. Hence, contrary to the board's view in **T 1063/18**, Art. 164(2) EPC was not relevant. The interpretation of Art. 53(b) EPC arrived at in **G 2/12** was not set in stone either; it could indeed change, and it was inappropriate to disregard the introduction of R. 28(2) EPC, which reflected the contracting states' intention.

In **J 5/23**, the Legal Board observed that the Implementing Regulations to the EPC 1973 were part of the "text" of the treaty or at least of the "context" to be taken into account pursuant to Art. 31(2) Vienna Convention. The Enlarged Board confirmed that subsequent amendments to the Implementing Regulations are to be taken into account when interpreting an Article of the EPC (see **G 2/12**, point VII.4(1) of the Reasons and **G 3/19**, point VI.5.2, VI.5.3 and XXIV of the Reasons). In **G 2/12**, point VII.4(1) of the Reasons, the Enlarged Board referred to the interpretative means under Art. 31(3) Vienna Convention concerning, in point (a), any subsequent agreement between the parties regarding the interpretation of the treaty or its application and, in point (b), any subsequent practice in the application of the treaty which establishes the agreement of the parties regarding its interpretation. The Legal Board further noted that the mandatory interpretative means to be taken into account for interpretation under Art. 31(3)(a) and (b) Vienna Convention "together with the context" had the same interpretative weight as the "context" under Art. 31(2) Vienna Convention. Hence, regardless of whether the Implementing Regulations to the EPC 2000 and all subsequent amendments were subsumed under Art. 31(2) or under Art. 31(3)(a) and (b) Vienna Convention, they were to be taken into account in a systematic interpretation of an Article of the EPC.

4. Interpretation of the various language texts of the EPC

Pursuant to Art. 177 EPC, all three language texts of the EPC are equally authentic and form a single original text.

In **J 8/95** it was held that even if one language version of a provision of the EPC were found to differ from the other two versions, no legal consequences could be derived from

that version other than those which could be derived from the other two versions – regardless of the language of the proceedings. A difference in the wording in one language would have to be considered only in so far as it could form one element of the interpretation. In the case at issue, however, the provision under consideration, even in the allegedly different version, could readily be understood in context in the same way as the other two official languages, with the result that all three versions of the provision corresponded as far as content was concerned (see also **T 2321/08**).

The board in **T 1914/12** observed that Art. 114(1) EPC, albeit in its English version only, distinguished facts, evidence and arguments, so that the legislature must have considered them to be three distinct categories. Taking the English version of Art. 114 EPC, which seemed to it to reflect the legislative intention more accurately, the board held that arguments had to be treated differently from facts and evidence and that the discretion provided for in Art. 114(2) EPC did not extend to late-filed arguments.

In opinion **G 1/18** the Enlarged Board noted that there are some differences in the wording of the first sentence of Art. 108 EPC in the three language versions. The English version begins with the term "notice of appeal", whereas the French and German versions use "le recours" and "die Beschwerde", respectively, as opposed to "l'acte de recours" and "die Beschwerdeschrift." This cannot be taken as a basis for inferring any legislative intent. The initial versions of this first sentence of Art. 108 EPC 1973, now EPC 2000, were drafted in French and German only and used the words "recours" and "Beschwerde" respectively. Whichever language is taken, the article's first sentence provides that an appeal is initiated by filing notice of appeal within a period of two months and in accordance with the conditions laid down in the Implementing Regulations. In what follows, "notice of appeal filed" and "appeal filed" are to be understood as synonyms, as are "notice of appeal not filed" and "appeal not filed"(see point IV.1(1) of the Reasons).

The board in **T 844/18** recalled that Art. 33(4) Vienna Convention prescribes that in case of a difference in the meaning between two or more equally authentic texts, the treaty must be given the meaning which best reconciles the texts having regard to the object and purpose of the treaty. The board stated that in order to interpret "any person" in Art. 87(1) EPC, it was necessary to interpret the legal concept of "any person" in Art. 4A Paris Convention, the interpretation given in both treaties needing to be the same. This raised certain linguistic issues which had to be borne in mind: the authentic text of the Paris Convention is written in French, the EPC is written in German, English and French, all texts being equally authentic.

5. The Paris Convention for the Protection of Industrial Property

In **G 3/93** (OJ 1995, 018) the Enlarged Board held that even though the Paris Convention was not formally binding on the EPO, since the EPC – according to its Preamble – constitutes a special agreement within the meaning of Art. 19 of the Paris Convention, the EPC was clearly intended not to contravene the basic principles concerning priority laid down in the Paris Convention. In **G 2/98** (OJ 2001, 413), the Enlarged Board reiterated this principle and sought to ensure consistency with the Paris Convention when interpreting EPC provisions on priority. More specifically, the Enlarged Board looked at the

wording of the relevant provisions and the object and purpose of the applicable provision in the Paris Convention in order to ensure consistency in the interpretation of the Paris Convention and the EPC. See also **G 3/98** (OJ 2001, 62), **G 1/22** and **G 2/22** (OJ 2024, A50), **T 844/18** and chapter II.D. "Priority".

In **G 1/15** (OJ 2017, A82), the Enlarged Board referred to the Paris Convention when interpreting multiple and partial priorities. Paragraphs 2 to 4 of Art. 88 EPC corresponded to Art. 4F and 4H of the Paris Convention, though with the express provision that multiple priorities may be claimed for any one claim (Art. 88(2), second sentence, EPC). The term "elements" used in Art. 88(3) EPC (see also Art. 4F and 4H of the Paris Convention) was not to be understood as a single feature but as subject-matter such as that defined in a claim or disclosed in the form of an embodiment or example specified in the description (see **G 2/98**, points 4 and 6.2 of the Reasons). Thus, in view of the wording of Art. 88(2) and (3) EPC alone, the argument that partial priority was a concept not present in the European patent system could not hold, which was confirmed by the Paris Convention.

According to the Enlarged Board in consolidated cases **G 1/22** and **G 2/22**, the priority provisions contained in the Paris Convention should not be regarded as a body of exception clauses which should be interpreted strictly. To the contrary, the rules of the Paris Convention and the self-contained priority system of the EPC had to be construed in a manner which ensures that the general purpose of the priority right is fulfilled as far as possible.

In **T 844/18**, the board recalled that the EPC was a special agreement within the meaning of Art. 19 of the Paris Convention, so the application of its provisions could not contradict the basic principles concerning priority laid down in the Paris Convention. Therefore, the interpretation given to the term "any person" under the EPC and the Paris Convention needed to be the same (see also in this chapter III.H.2.3.1 and III.H.4).

6. The Agreement on Trade-Related Aspects of Intellectual Property Rights

The Enlarged Board observed in **G 2/02** and **G 3/02** that although the EPO is not a party to TRIPS and thus not bound by it, the national legal systems of the EPC contracting states might be affected by TRIPS and they may be under an obligation to see to it that the EPC is in conformity with TRIPS. TRIPS provisions, like decisions of the European and International Courts of Justice and national decisions, are elements to be taken into consideration by the boards of appeal but are not binding on them. Whereas it is legitimate for the boards of appeal to use TRIPS as a means to interpret provisions of the EPC 1973 which allow different interpretations, specific provisions of TRIPS cannot justify ignoring express and unambiguous provisions of the EPC 1973. To do so would usurp the role of the legislator. This was confirmed by the fact that the legislator of the EPC 2000 found it necessary to revise Art. 87 EPC 1973 in order to implement the TRIPS.

In **T 1173/97** (OJ 1999, 609) the board decided that, although TRIPS could not be applied directly to the EPC 1973, it was appropriate to take it into consideration in connection with the patentability of computer program products, since TRIPS was aimed at setting common standards and principles concerning the availability, scope, and use of trade-

related intellectual property rights. It thus gave a clear indication of existing trends. The appellant's reference to practice at the US and Japanese patent offices caused the board to emphasise that the situation under these two legal systems differed greatly from that under the EPC 1973; only the EPC 1973 contained an exclusion such as that in Art. 52(2) and (3) EPC 1973. These developments nevertheless represented a useful indication of modern trends and, in the board's view, could contribute to the highly desirable further (worldwide) harmonisation of patent law. The issue of the application of TRIPS in the context of the EPC was also considered, for instance, in **G 1/97**, OJ 2000, 322.

7. The European Convention on Human Rights

In **R 19/12** of 25 April 2014 the Enlarged Board observed that Art. 6 ECHR had been recognised in **G 1/05** (OJ 2007, 362) and **G 2/08** of 15 June 2009 as a binding standard for proceedings before the boards of appeal because it relied on principles of law common to all member states of the European Patent Organisation and applying to all its departments (see also **D 11/91** of 14 September 1994 and chapter III.J.1.3. "The European Convention on Human Rights"). That justified applying both national case law and that of the ECtHR as a supplementary means of interpreting the EPC.

The board in **T 1243/17** stated that the boards of appeal had deemed Art. 6(1) ECHR relevant for decisions taken under the EPC (particularly in the context of Art. 125 EPC) as a yardstick for the procedural law principles that are generally recognised in the contracting states (see **T 261/88**, OJ 1992, 627; **G 1/05**; **G 2/08**). Therefore, when Art. 6(1) ECHR was applied in EPO proceedings, it had to be interpreted by the EPO and its boards of appeal. On the question whether or not the "reasonable time" stipulated in Art. 6(1) ECHR had been adhered to, the board stated that the principles developed by the ECtHR regarding the length of the proceedings provided a useful framework for assessing the length of proceedings in the case in hand. See also **T 2805/19** and **T 2707/16**.

In **T 1787/16**, the board observed that Art. 125 EPC stipulated that in the absence of any procedural provisions in the EPC, the principles of procedural law generally recognised in the contracting states to the European Patent Organisation were to be taken into account. This applied in particular to the legal principle of a right to a fair trial, as laid down for instance in Art. 6(1) ECHR, which was a general yardstick for shaping proceedings. It also included the requirement to word the decision so that it could be understood by any party with a command of the language of the proceedings.

In **J 6/22**, the Legal Board noted that a dynamic interpretation of the EPC, as derived from Art. 31(1) and 31(3) Vienna Convention, must take account of developments in national and international procedural law, notably as regards the guarantees of fair trial before a tribunal of law (Art. 6(1) ECHR). It looked at Art. 6 ECHR and ECtHR case law and noted the different circumstances under which the ECtHR had found that the right to a hearing was to be dispensed with in order to hold a fair trial under Art. 6 ECHR. In the Enlarged Board's view, the right to oral proceedings under Art. 116(1) EPC also had to have limitations. The considerations related to the application of Art. 6 ECHR by the ECtHR supported the conclusion that an absolute right to oral proceedings under a literal interpretation of Art. 116(1) EPC conflicted with the legislature's aims when oral

proceedings would serve no purpose and would thus only prolong proceedings to no one's avail.

8. National decisions and legislation in EPC contracting states

In **G 2/02** and **G 3/02** the Enlarged Board recognised that, in accordance with the aim of the EPC, as expressed in its preamble, to strengthen co-operation between the States of Europe in respect of the protection of inventions, there has always been the intention to harmonise the substantive patent law to be applied in the contracting states and in the EPO.

8.1. National decisions: taken into account for the sake of harmonisation

In **G 5/83** the Enlarged Board stated that in the interpretation of international treaties which provide the legal basis for the rights and duties of individuals and corporate bodies it is, of course, necessary to pay attention to questions of harmonisation of national and international rules of law. This aspect of interpretation, not dealt with by the provisions of the Vienna Convention, is particularly important where, as is the case with European patent law, provisions of an international treaty have been taken over into national legislation. The establishment of harmonised patent legislation in the contracting states must necessarily be accompanied by harmonised interpretation. For this reason, it is incumbent upon the EPO, and particularly its boards of appeal, to take into consideration the decisions and expressions of opinion of courts and industrial property offices in the contracting states. This view was confirmed in **G 2/12** and **G 2/13**, **G 3/19**.

In **G 2/21** (OJ 2023, A85), for instance, the Enlarged Board examined the national legal framework and jurisprudence on the reliance on a purported technical effect for inventive step in Germany, France, the Netherlands, Switzerland, and the UK (England and Wales). It concluded that, like the EPC, none of the legal systems of these EPC contracting states provided for an explicit patentability requirement for "plausibility". The Enlarged Board also observed a certain degree of common ground that the courts of the EPC contracting states, when confronted with the examination of an asserted technical effect in the assessment of inventive step and with the question whether a patent proprietor may rely on post-published evidence to confirm that technical effect, ponder on the technical teaching of the claimed subject-matter that the person skilled in the art, with the common general knowledge in mind, understands from the patent application.

In **J 14/19**, the Legal Board observed that R. 14(1) EPC did not specify when national proceedings were deemed to have been instituted. Nor was it independently defined anywhere else in the EPC when national court proceedings became pending. The issue of when they became pending was therefore to be assessed under the procedural law of the country whose courts had been asked to take a decision within the meaning of Art. 61(1) EPC (see **J 7/00**; **J 2/14**; see also **T 1138/11**). Article 8 of the Protocol on Jurisdiction and the Recognition of Decisions in respect of the Right to the Grant of a European Patent ("the Protocol on Recognition") supported this interpretation. In the interests of a uniform European standard of interpretation, recourse could be had to the case law of the CJEU on Art. 21 of the 1968 Brussels Convention on Jurisdiction and the

Enforcement of Judgments in Civil and Commercial Matters (which both matched Art. 8 of the Protocol on Recognition in content and preceded it). In the context of that provision too, when proceedings were deemed to be pending was to be assessed for each court in line with its own national procedural law (ECJ, Case 129/83).

In **T 439/22** (OJ 2024, A104) the board referred questions on claim interpretation to the Enlarged Board (case **G 1/24**). In its decision the board reviewed the case law of the boards of appeal as well as the approaches on claim interpretation taken by the courts in France, Germany and UK as well as the Court of Appeal of the UPC.

8.2. National decisions: no binding effect on the boards of appeal

According to the board in **T 452/91,** in proceedings before the EPO, questions of patentability were to be decided solely in accordance with the EPC. No national decision should be cited as if it were binding on the EPO, and claims should not be refused by the EPO on the ground that their "patentability cannot be upheld under the jurisdiction of one member state". It could be that the law in most or all other contracting states was different. The reasoning that led the national instance to its conclusion might well lead an EPO instance to a similar conclusion under the EPC, but this would first need a careful assessment of the EPC, and of relevant EPO board of appeal case law, a comparison with the legislation and jurisprudence on which the national instance reached its conclusion, and a study of the position in other contracting states. See also **R 21/09**, **T 1753/06**.

In **T 154/04** (OJ 2008, 46) the board stated that in proceedings before the EPO, the consideration of decisions and opinions given by national courts does not exonerate a board of appeal from its duty as an independent judicial body to interpret and apply the EPC and to decide in the last instance in patent granting matters. In addition, despite harmonised legal regulations, it is not self-evident that their interpretation is also harmonised among different national courts, let alone courts of different contracting states, so that the boards of appeal would be at a loss as to which interpretation to follow if they did not exercise their own independent judgment.

8.3. Effects on the case law due to the differences between national legislation and the EPC

Although in general a high degree of harmonisation between the EPC and national laws is desirable and has indeed been achieved, differences between national legislation and the EPC were not ruled out by the EPC (**J 9/07** citing Art. 2(2) and 66 EPC 1973). In **J 9/07** the Legal Board stated that according to Art. 1 EPC 1973 the EPC establishes a system of law common to the contracting states for the grant of patents for inventions. This common system of law is applicable to all European patent applications irrespective of the contracting states designated in the European patent application. Save to the extent that the EPC expressly provides otherwise, the EPO is not allowed to take into consideration, with respect to the designated state concerned, a specific national legal provision which would be more favourable to the applicant than the provisions of the EPC. This is because this would have the consequence of giving European applications unequal treatment as regards the requirements for grant depending on which state or states have been

designated, contrary to Art. 1 EPC 1973. It would also go against the principle of the unity of the application enshrined in Art. 118 EPC 1973.

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1. Possibility of filing auxiliary requests

In the proceedings before the EPO main and auxiliary requests are allowed (for grant proceedings see e.g. **T 79/89**, OJ 1992, 283; for opposition proceedings see e.g. **T 234/86**, OJ 1989, 79). An auxiliary request is a request for amendment which is contingent upon the main request (or preceding auxiliary requests) being held to be unallowable, **T 153/85** (OJ 1988, 1). It is also a request for amendment covered by R. 86(3) EPC 1973 (R. 137(3) EPC), Art. 96(2) EPC 1973 and R. 51(2) EPC 1973 (Art. 94(3) EPC and R. 71(2) EPC), and, during appeal proceedings, Art. 110(2) EPC 1973 and R. 66(1) EPC 1973 (R. 100(1) EPC) (**T 79/89**, OJ 1992, 283).

2. Order of requests

2.1. Requirement to specify the order of requests

The established system of main and auxiliary requests in the proceedings before the EPO provides that parties, when filing alternative sets of claims, must indicate the order of preference for each set of claims (**R 14/10**, **T 1125/13** of 25 June 2015, **T 52/15**). In **T 255/05** the board held that under Art. 113(2) EPC 1973 (Art. 113(2) EPC) it was the applicant's responsibility to define the text on the basis of which it requested a patent to be granted. When the appellant, even after having been invited to do so by the board, did

not clearly indicate the order in which its requests were submitted and what the exact content of each of these requests was, there was no text submitted or agreed by the applicant within the meaning of Art. 113(2) EPC 1973. See also the summary of **T 148/06** in chapter III.I.3.2. "Requests of equal ranking".

In **T 1439/05** the board held that to avoid misunderstandings, the examining division should clarify the status of the requests before pronouncing its decision at the conclusion of oral proceedings. See also chapter III.B.3. "Text submitted or agreed by applicant (patent proprietor) – Article 113(2) EPC".

2.2. Order of examination of requests

Before a decision can be taken on the basis of an auxiliary request, the main request has to be examined and decided upon (**T 484/88**). The board in **T 169/96** pointed out that, under Art. 113(2) EPC 1973, the EPO was bound by the requests of the applicant or proprietor, and, in the case of main and auxiliary requests, this meant that the EPO was also **bound to the order of the requests** (see also **T 540/02**).

However, in **T 911/06** the board held that this principle did not necessarily apply in proceedings before the boards. In the case in hand the appellant (patent proprietor) had requested maintenance of the patent in amended form according to new claim sets as higher-ranking requests and review of the first-instance decision as a lower-ranking request. The board stated that applying the general principles of court procedure, such as the principle of party disposition (see **G 8/91**, OJ 1993, 346), to the order of the appellant's (patent proprietor's) requests might be inconsistent with the purpose of the inter partes appeal procedure as expressed in **G 9/91** (OJ 1993, 408). The board considered that it was in line with the purpose of the appeal to examine first whether the department of first instance had correctly assessed the substance of the requests presented to it.

In the proceedings underlying **R 8/16** the board had revoked the patent. The Enlarged Board held that, as a matter of principle, the technical board was free to examine the (pending) claim requests in any order, and therefore it was also free to conduct the discussion on them in any order, without having to give reasons. The principle of party disposition expressed in Art. 113(2) EPC did not extend so as to permit a party to dictate how and in which order a deciding body of the EPO might examine the subject-matter before it. The only obligation on the EPO was not to overlook any still pending request before a final decision was taken. The order of examination or discussion was a question of procedural economy, for which mainly the deciding body was responsible. As long as a discussion on the substantive issues of the still pending requests was possible, even if only by reference to discussions on other requests (see **R 6/11**), such a procedure was unobjectionable and the board had no particular duty to give reasons why it chose to proceed as it did. See also chapter III.B.3.1. "General".

During the opposition proceedings that preceded the appeal in **T 2217/22**, the patent proprietor had ranked auxiliary requests 5, 6, 3, 4 and 7 below the request later at issue on appeal as "auxiliary request 2". The board held that, even though it had done so after the opposition division had directed it to review the order of its auxiliary requests, the

opposition division had in no way influenced it as regards the order in which it had to put the many auxiliary requests it had already filed. The patent proprietor submitted that the opposition division had pointed out that it had discretion to decide whether or not to admit further auxiliary requests and set out what criteria would then apply. The board conceded that, from a subjective perspective, this had placed the patent proprietor in a dilemma when choosing from among the possible courses of action open to it by reason of its procedural freedom of disposition. Objectively, however, the opposition division's statement was at best a piece of procedural guidance and so not liable to limit that freedom.

In **T 353/18** the board noted that there was no provision in the EPC establishing any legal primacy of the **clean version** over an **annotated version** of a request. If they were different, only a declaration by the patent proprietor could establish the valid one (in the case in hand: the clean version). At the same time, the appellant (opponent) who had relied on the correctness of the (incorrect) annotated version, should not suffer a disadvantage from this.

3. Admissibility of requests

3.1. Party's responsibility to define subject-matter by filing appropriate requests

In **T 506/91** the board held that filing requests and deciding if several alternative requests were appropriate or not was a matter that in the end could only be decided by the party concerned and it should be routine for representatives to decide independently how to pursue their cases, including what requests to submit.

In **T 382/96** the board stressed that one of the fundamental principles of European patent law was that responsibility for defining the subject-matter of a patent rested with the applicant (patent proprietor). The applicant (patent proprietor) could not offload this responsibility de facto onto the EPO or any other parties to the proceedings by filing a multitude of requests, let alone incompletely formulated request variants. Doing so constituted an abuse of procedure, as it overburdened the EPO and any other parties to the proceedings with work not originally theirs to perform and thereby hampered the orderly conduct of proceedings. Auxiliary requests which had not been verbally specified in more detail were inadmissible for the purposes of R. 64(b) EPC 1973 (now R. 99(2) EPC) because they did not identify the extent to which amendment or cancellation of the contested decision was requested; the same went for auxiliary requests for which no grounds had been set out (i.e. not substantiated) within the meaning of the third sentence of Art. 108 EPC 1973.

T 446/00 concerned a case in which a large number of requests was filed with an offer to amend the claims further if the board so wished; the board held that a party could not in that manner abdicate its responsibility to present its case to the board and that such requests were both inadmissible and an abuse of procedure.

In **T 745/03** the board pointed out that it was up to a party to decide on the presentation of its case. When filing several sets of claims, a party usually listed them in order of

preference, the least limited claims being a main request, the more limited versions auxiliary requests, so that if a higher order request should fail, then a lower, more limited request would still have a chance of success. In the case before the board this had changed to an approach which could more aptly be designated as "**pick and mix**", as independent claims present in higher order requests were also to be found in lower order requests in differing permutations of independent claims. The "pick and mix" approach can both give an impression of fishing around for something patentable and mean that some independent claims are not even the subject of a decision. See also **T 221/06**.

In **R 11/08** the Enlarged Board confirmed that adopting a "pick and mix" approach could run the risk of requests being found inadmissible, abuse of procedure, and disadvantages for the party in question.

In **T 1138/12** the board decided that an auxiliary request for maintenance of a patent on the basis of the claims it considered grantable from among those in a claim set was insufficiently defined and therefore inadmissible.

With regard to the opposition division's chair's statement that only one further request may be filed, the board noted in **T 2188/22** that it was up to the parties to define their requests. In principle, the opposition division could not prevent the filing of requests, but could only decide on their admittance after having heard the parties on that issue. See also chapter III.B.3. "Text submitted or agreed by applicant (patent proprietor) – Article 113(2) EPC".

3.2. Requests of equal ranking

In **T 148/06** the board held several requests inadmissible which were submitted not as principle and auxiliary requests, but as requests of equal ranking. It was not the board's duty to give a legal opinion on the admissibility of several requests as guidance for appellants in defining the order in which they would like their requests to be examined. See also **T 255/05** on the applicant's responsibility to define the text on the basis of which it requests a patent to be granted (in this chapter III.I.2.1.).

3.3. Requesting further opportunity to formulate new requests

In **T 792/92** the board considered as inadmissible the appellant's request at the end of the oral proceedings that, should the outcome of the discussions be negative for him, he be given the opportunity to formulate new requests.

3.4. Admissibility of late-filed requests

On the late filing of requests for amendment in examination proceedings, see chapter IV.B.3.3.3 "Criteria for admitting amendments filed in reply to the Rule 71(3) EPC communication"; in opposition proceedings, see chapter IV.C.5.1.4 "Timeframe for filing amendments"; and in appeal proceedings, see chapter V.A.4. "New submissions on appeal".

4. Obligation to give reasons for refusal of each request

If a decision relates to several requests, it must give reasons for the rejection of each one. It must be clear from the decision which considerations led the division to its conclusions (**T 234/86** (inter partes), **T 169/96** (ex parte)).

According to **T 961/00**, it is a party's procedural right to file and maintain such requests as are regarded by the competent organ as unallowable or even inadmissible. If a party does so, then the competent organ has to give a decision on it, i.e. to refuse it if it is unallowable or inadmissible (see e.g. **T 1105/96**, OJ 1998, 249; **T 1029/16**), but it cannot simply disregard it and deal with the case as if the request did not exist. On the contrary, this would constitute a substantial procedural violation.

5. Withdrawal of request

In several recent decisions, boards have concluded (contrary to **T 1157/01**; see next paragraph) that **requests can be withdrawn implicitly** and that there is an implicit withdrawal when the circumstances leave **no doubt** that the party did not intend to pursue them (see e.g. **T 388/12**, **T 573/12**, **T 996/12**, **T 2301/12**, **T 52/15**, **T 1255/16**, **T 1695/14**, **T 1155/17** and **T 1411/21**).

In **T 1157/01** the applicant had maintained all its requests (main and three auxiliary requests). When it declared its non-approval of the text proposed for grant based on the third auxiliary request, however, the appellant did not explicitly repeat that it maintained all its previous and higher-ranking requests. The board considered that, according to the general principle "a jure nemo recedere praesumitur" mentioned in **G 1/88** (OJ 1989, 189), in the absence of an **explicit** withdrawal, surrender of a right could not be simply presumed and silence could not be deemed to be equivalent to surrender in the logic of how the EPC operated.

In **T 388/12** the board confirmed that, as a general principle of law, surrender of a right could not be simply presumed (with reference to **G 1/88**). On a strict application of the principle "a jure nemo recedere praesumitur", the withdrawal of a request could only result from acts of the party that manifestly establish such intention. At the same time, the board held that explicit withdrawal of a request would not be required insofar as the intention of the party, as it might result from its behaviour or comments made, was **unequivocal**.

5.1. Circumstances leaving no doubt that requests have been withdrawn

In the examination proceedings leading to the decision under review in **T 996/12**, the appellant filed by letter a redrafted main request. Furthermore, the appellant expressly requested the "grant of a patent on the basis of the redrafted main claim filed with this letter". According to the board, it was reasonable to interpret this letter and request as the clear intention of the appellant to have only this new main request examined by the examining division. Unlike the situation where an applicant submitted one or more auxiliary requests, submitting a new main request automatically led to the replacement and – in legal terms – withdrawal of (any) previous main request(s). This notion was a direct result

of the fundamental procedural principle of party disposition (ne ultra petita) that was guaranteed by Art. 113(2) EPC. According to the board, the fact that the examining division held the last amendment of the main request to be inadmissible could not and did not "revive" or "re-establish" the finally withdrawn previous main request(s). See also **T 573/12** in which the board took the same approach and added that it was up to the applicant to indicate if it maintained the former request as an auxiliary request.

In **T 1411/21** the examining division decided not to admit the main request into the proceedings. As to the appellant's argument that it had never made any statements to the effect that any subject-matter could be considered abandoned, the board noted that non-admittance under R. 137(3) EPC did not automatically revive the previous set of claims that the examining division had agreed to admit, unless an applicant had indicated that they had been relying on them as an auxiliary request (see **T 690/09**). Referring to **T 996/12** and **T 573/12**, the board confirmed that the filing of a new main request automatically resulted in the replacement and, in legal terms, the withdrawal of any previous main requests.

In **T 2301/12** the proprietor had replaced the initial requests with new requests before the opposition division. The board held that the use of the word "replace" implied that the initial main request was no longer the current main request, and since there was no attempt to retain it as a new auxiliary request either, it was difficult to avoid the conclusion that it had been simply withdrawn. The new requests had been annexed to the minutes and the first of them was clearly entitled "main request". The board did not accept the argument that the titles of requests should be considered mere labels for identification. Where a proprietor filed multiple requests, there had to be a single main request, and it had to be apparent at every stage of the proceedings which request this was.

In the same vein, in **T 52/15** the board noted that, in the circumstances of the case, the opposition division did not err when considering that each newly filed "main request" was clearly meant to replace the previously filed one/s. The board emphasised that the withdrawal of a request was a serious procedural step which was usually announced explicitly by a party via a corresponding statement and that any such statement must be mentioned in the minutes (see **T 361/08**). However, an explicit withdrawal was not required if a party's behaviour or procedural steps it took during the proceedings made its intention unequivocal (see **T 388/12**). The board confirmed that EPO departments have the duty to ensure that any uncertainty with regard to procedural acts of the parties is clarified. However, the board held that, if a procedural act of a party was clear and there were no reasons to suggest that its intentions were not correctly understood, that party could not expect not to have to bear the consequences of that procedural act.

In **T 1255/16** the board concluded from the following elements that the previously filed requests had been replaced with the newly filed claims: the appellant's reply to the preliminary opinion, in which the board had raised objections against the previously filed requests, contained no arguments in their support, but merely gave reasons why the newly filed amended claims complied with the EPC; in addition, the appellant did not disagree when the board informed him, in a further communication, of its understanding that the newly filed claims replaced the previous pending substantive requests.

In **T 1695/14** too, the board found that the request had been implicitly withdrawn. It also held that requests not later pursued as the main request or as an auxiliary request but instead (implicitly) withdrawn did not remain in the proceedings; the procedural law allowed for pending or withdrawn requests, but not for ones on hold.

In **T 1155/17**, the patent proprietor had filed a main request and auxiliary requests 1-6 with the reply to the appeal, making no mention of the requests initially filed with the statement of grounds of appeal. The board took the view that it was evident from those circumstances that the latter requests were not to be pursued and that any other interpretation would lead to there being multiple main requests and also multiple auxiliary requests 1 and 2, i.e. multiple requests of equal ranking, in the proceedings.

5.2. Circumstances indicating that requests have not been withdrawn

In **T 2188/22** the board pointed out that considering the annex to the minutes of the oral proceedings before the opposition division, it was clear that auxiliary requests 18 to 33 filed during the oral proceedings had been identical to auxiliary requests 2 to 17 filed during the written proceedings. According to the board, this supported the appellant's submission that the auxiliary requests filed during the written proceedings had not been withdrawn but only renumbered. Furthermore, the board held that with the appellant's statement at the oral proceedings that it had wished to revert to the auxiliary requests which had been submitted in the written proceedings, the appellant had defined its auxiliary requests for the further course of the proceedings, i.e. it had been clear at that point in time that the appellant had wished to pursue auxiliary requests 2 to 17 filed in the written proceedings. See also chapter III.B.3. "Text submitted or agreed by applicant (patent proprietor) – Article 113(2) EPC".

6. Examination procedure

6.1. Direct rejection of auxiliary request by examining division

In **T 488/94**, the board stated that before refusing an application in the case of main and auxiliary requests, the examining division in accordance with Art. 113(1) EPC would not only have to communicate its arguments regarding non-allowability of the main request to the applicant, but also regarding non-allowability of the auxiliary request, if the result of the subsequent examination of the auxiliary request was also negative. A "direct" rejection of an auxiliary request without preceding communication of the grounds on which the rejection was based would only comply with the requirements of Art. 113(1) EPC under rather exceptional circumstances, e.g. if there could be no doubt about the fact that the arguments already communicated to the applicant with respect to the subject-matter of the main request equally applied to the subject-matter of the auxiliary request (at least implicitly).

6.2. Rejection in advance of further request by examining division

According to **T 1105/96** (OJ 1998, 249), an applicant has a right both to file one or more auxiliary requests in addition to a main request, and to maintain all such requests even if

the examining division communicated its view that all except the last auxiliary request were inadmissible or unallowable, and he was then entitled to a reasoned appealable decision in respect of rejection of each such request (see also **T 1029/16**). Where an examining division had communicated its view that a further request in the form of an amended text of a claim would be allowable, the rejection in advance of such a further request unless all preceding requests were abandoned was an unlawful exercise of discretion under R. 86(3) EPC 1973 (R. 137(3) EPC) and a substantial procedural violation under R. 67 EPC 1973 (R. 103 EPC).

6.3. Practice of proposing one main and one or more auxiliary requests

The board in **T 1351/06** referred to the decisions **T 79/89** (OJ 1992, 283), **T 169/96**, **T 1105/96**, (OJ 1998, 249) and to Legal Advice No. 15/05 (rev. 2, OJ 2005, 357; now incorporated into the Guidelines, see Guidelines H-III, 3 –April 2025 version), where it was held that it was standard practice at the EPO that the applicant was able to propose one main and one or more auxiliary requests at the examination stage, to amend the text of the application. The board saw no reason why the applicant should not also be able to do so in response to a communication under R. 51(4) EPC 1973 (R. 71(3) EPC), especially in cases where that communication had not been preceded by a communication under Art. 96(2) EPC 1973 (Art. 94(3) EPC) and thus constituted a "first communication" within the meaning of R. 86(3) EPC 1973 (R. 137(3) EPC).

7. Interlocutory decision on allowable auxiliary request – distinction between examination proceedings and opposition proceedings

In **T 549/96** it was noted that Art. 113(2) EPC 1973 required the examining division to decide upon an application only in the text agreed by the applicant. Thus an applicant had to indicate clearly at the end of the proceedings which text he wished to be used. If an applicant failed to indicate his approval of the text of an allowable subsidiary request, e.g. by express disapproval or by maintaining one or more unallowable higher-preference requests over one considered allowable by the examining division, the examining division could refuse the application under Art. 97(1) EPC 1973. The board **contrasted opposition and grant proceedings**. In the case of an allowable auxiliary request in opposition proceedings an interlocutory decision was taken under Art. 106(3) EPC 1973 (Art. 106(2) EPC) to the effect that the European patent met the requirements of the EPC 1973, account being taken of the amendments made by the patent proprietor. This interlocutory decision then also had to include the reasons why the preceding requests did not meet the requirements of the EPC 1973. This saved the proprietor the further costs of fulfilling the formal requirements under R. 58(5) EPC 1973 (R. 82(2) EPC) before there was a final decision on the version in which the patent could be maintained. No comparable situation existed in grant proceedings. On the contrary, in ex parte appeal proceedings the principle of examination ex officio applied. Up to the grant stage it had to be ensured that the conditions for patentability were met. An interlocutory decision, stating that the application in a certain version met the requirements of the EPC 1973, would be in conflict with this purpose. The board drew attention to Legal Advice No. 15/98 (OJ 1998, 113).

In **T 482/06**, the board found that decision **T 549/96** was compatible with the updated Legal Advice No. 15/05 (rev. 2) (OJ 2005, 357), as it stated that "an applicant must unambiguously indicate at the end of the proceedings, which text he proposes". Legal Advice No. 15/05 set out the mechanism to provide this indication. See also **T 976/97**, also before the entry into force of Legal Advice 15/05, where the situation was similar to that in **T 549/96**. In **T 1220/05** the board (referring to **T 839/95** and **T 549/96**) confirmed that interlocutory decisions finding an auxiliary request allowable were not in keeping with standard first-instance practice in examination proceedings, as opposed to opposition proceedings (see Legal Advice No. 15/05 (rev. 2), point 1.1), and in appeal jurisprudence were deemed undesirable owing to possible repercussions (binding effect, no reformatio in peius).

On the interlocutory decision in opposition proceedings (that the European patent as amended meets the requirements of the EPC), see chapter IV.C.8.2.2.

8. Opposition procedure

According to **T 234/86** (OJ 1989, 79), the opposition division can – and in certain circumstances must – maintain the patent as per the patentee's subordinate auxiliary request if he pursues main and auxiliary requests which are not allowable although taking precedence over the allowable one. Rejection of the requests which take precedence must be reasoned.

In **T 5/89** (OJ 1992, 348) the board confirmed that a decision may confine itself to rejecting the main request only if all subordinate requests have been withdrawn. This principle was also confirmed in **T 785/91** and **T 81/93**. Following **T 5/89**, the board in **T 861/97** stated that deciding to revoke a patent solely on the basis of the main request when there was an expressly maintained auxiliary request constituted an infringement of Art. 113(2) EPC 1973.

In **T 2188/22** the board pointed out that the appellant had stated at the oral proceedings before the opposition division that it had wished to revert to the auxiliary requests submitted in the written procedure. It had thus been clear that the appellant had wished to pursue auxiliary requests 2 to 17 filed in the written proceedings. However, the question of admittance of auxiliary requests 3 to 17 had not been discussed. This in itself constituted a substantial procedural violation, as the appellant's right to be heard had not been respected. See also chapter III.B.2.5.2 "Decision must demonstrably show that arguments were heard and considered".

In **T 155/88** the board made it clear that the patentee could not be required to withdraw any request. If he filed one or more auxiliary requests in addition to a main request and did not withdraw any of them, an opposition division was obliged in its decision to give reasons why each successive request was either not admissible (in the exercise of its discretion under R. 57(1) EPC 1973 and R. 58(2) EPC 1973, see **T 406/86**, OJ 1989, 302), or not allowable on substantive grounds (see **T 234/86**, OJ 1989, 79). If an opposition division allowed an auxiliary request without giving reasons in its decision as to why the main request or preceding auxiliary requests were not allowable, such decision

would be set aside as void and of no legal effect, and the appeal fee refunded on the basis of a substantial procedural violation, as was the case in **T 234/86** and **T 484/88**.

In **T 1677/21** the board held that a violation of the proprietor's right to be heard had been committed by refusing the request to admit further auxiliary requests; the proprietor had been deprived of the possibility of filing further auxiliary requests before they had been filed and even before the auxiliary requests already filed had been examined. Citing **T 1105/96** the board recalled that it was established jurisprudence of the boards of appeal that a refusal of consent to amend in advance of any amendment being submitted was an unlawful exercise of the discretion under R. 137(3) EPC and was ipso facto a substantial procedural violation (see also chapter III.B.2.4.3 "Opportunity to comment on evidence").

In **T 848/00** the patentee had requested the deletion of the product claims from the main request in oral proceedings before the opposition division. In appeal proceedings the patentee argued that it had never abandoned the subject-matter of the product claims and that its actions in opposition had only introduced a new auxiliary request. The board agreed with the reasoning of decision **T 155/88** that if a patentee proposed amendments to its claims which arose out of the opposition and which were intended to meet the grounds of objection raised in the opposition by limiting the scope of protection sought, this should **not** normally be interpreted as an **abandonment** of the subject-matter protected by the claims of the patent as granted. But this statement did not influence how the amended set of claims was to be read, because a **restriction** of claims was possible without abandoning the subject-matter of the patent specification as originally filed. Since the patentee had expressly requested an amendment of the main request, the board concluded that the opposition division had granted the patentee's main request and that the patentee was thus not adversely affected.

9. Appeal procedure

In **T 1477/15** the board stated that it is generally accepted that in appeal proceedings the **principle of party disposition** applies (see e.g. **R 13/13**), meaning that parties can put forward, withhold or withdraw their requests as they see fit. In other words, if a patent proprietor withdraws or no longer agrees to a text (two auxiliary requests, in this case), this principle prevents the board of appeal from deciding on these issues.

Regarding the order of requests, however, in **R 8/16** the Enlarged Board held that the principle of party disposition expressed in Art. 113(2) EPC did not extend so as to permit a party to dictate how and in which order a deciding body of the EPO may examine the subject-matter before it. On principles established by case law with regard to the order of requests, see also chapter III.I.2.

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1. General principles

1.1. Exclusion and objection

Pursuant to Art. 24(1) EPC, members of the boards of appeal or of the Enlarged Board may not take part in a case in which they have any personal interest, or if they have previously been involved as representatives of one of the parties, or if they participated in the decision under appeal. If a member of a board or of the Enlarged Board considers that he should not take part in any appeal, he shall inform the board accordingly (Art. 24(2) EPC). Art. 24(3) EPC additionally provides that members of a board of appeal may be objected to by any party for one of the reasons mentioned in Art. 24(1) EPC, or if suspected of partiality. The decision as to the action to be taken in the cases specified in paragraphs 2 and 3 of Art. 24 EPC shall be taken without the participation of the member concerned. For the purposes of taking this decision, the member objected to is replaced (Art. 24(4) EPC).

If the board has knowledge of a possible reason for exclusion or objection which does not originate from a member himself or from any party to the proceedings, according to Art. 3(3) RPBA and Art. 4(3) RPEBA there shall be no further proceedings in the case before a decision on the exclusion or objection is taken. Art. 3(3) RPBA amends Art. 3(3) RPBA 2007 for reasons of clarity/consistency to "exclusion or objection"; Art. 4(3) RPEBA still has the wording of Art. 3(3) RPBA 2007, which does not include the word "objection" For the purposes of taking this decision, the procedure of Art. 24(4) EPC shall be applied.

While there are no provisions comparable to Art. 24 EPC that are applicable to members of the departments of first instance, the case law of the boards of appeal has determined that the basic requirement of impartiality applies also to them (see **G 5/91**, OJ 1992, 617; see also in this chapter III.J.1.6 below).

In **G 2/08** of 15 June 2009 the Enlarged Board noted that under "exclusion and objection" (Art. 24 EPC) the legislator distinguishes between, on the one hand, an irrefutable presumption of law consisting in those compelling **grounds for exclusion** (Art. 24(1) EPC; see in this chapter III.J.5.1.) that must apply ex officio, and may therefore be raised by anyone, i.e. the parties, the board or a third person, without their having to

justify any personal interest as of right, and, on the other hand, the **grounds for objection** (Art. 24(3) EPC; see in this chapter III.J.5.3.) that may be raised by any party to the proceedings if it suspects partiality of a member of a board of appeal or of the Enlarged Board, since said party enjoys a personal and legitimate interest in the proceedings and is entitled to due process of law in respect of said interest. In such a case the burden of proof lies with the party who raises the objection, since board members, including those of the Enlarged Board, are a priori **presumed to be unbiased** (see in this chapter III.J.1.5.). This distinction is also reflected in Art. 112a(2)(a) EPC, which provides as a ground of petition for review that a member of a board of appeal took part in the decision in breach of Art. 24(1) EPC or despite having been excluded pursuant to a decision under Art. 24(4) EPC. In other words, whereas the grounds under Art. 24(1) EPC are considered to be peremptory due to the violation of the legal principle that nobody should be a judge in his own cause, the ground which could have justified an objection for suspicion of partiality is not directly envisaged as constituting a priori (i.e. unless proven and decided by the board; see also **R 20/09**) a cause of review (Art. 24(3) EPC). See also **G 3/08** of 16 October 2009.

1.2. Rationale and importance

The right to object to a judge for reasons of suspicion of partiality is meant to prevent judges from being influenced in their decision-making – be it deliberately or inadvertently – by extraneous considerations, prejudices and predilections, i.e. by considerations other than the arguments they consider factually and legally relevant for the case under consideration (**G 1/05**, OJ 2007, 362; **G 1/21** of 17 May 2021).

In **G 5/91** (OJ 1992, 617), **G 1/05** (OJ 2007, 362) and **G 1/21** of 17 May 2021 the Enlarged Board underlined the importance of a very strict observance of the requirement of impartiality in proceedings before it and the other boards of appeal in view of their judicial functions at final instance within the European patent granting system.

1.3. The European Convention on Human Rights

The boards of appeal and the Enlarged Board act as judicial bodies and apply general principles of procedural law (**G 2/08** of 15 June 2009)

It is established case law of the Enlarged Board that the EPC, which was signed by contracting parties to the ECHR, must be applied in a way which supports the fundamental principles of Art. 6(1) ECHR (**G 1/05**, OJ 2007, 362; **G 2/08** of 15 June 2009; **R 9/12** of 25 April 2014; **R 8/13** of 20 March 2015). The principle of equal treatment and the right of parties to a fair trial enshrined in Art. 6(1) ECHR are to be observed in all proceedings before the EPO (**R 19/12** of 25 April 2014, **R 2/14** of 17 February 2015 (see also **D 11/91**). The boards of appeal are thus obliged to decide the individual cases pending before them according to uniformly applied criteria and not in an arbitrary manner (**G 1/05** OJ 2007, 362). See also chapter III.H.7 "The European Convention on Human Rights".

1.4. Parties' right to have their case decided by the judge designated by law

1.4.1 Allocation of appeals

Before the beginning of each working year, in accordance with R. 12b(4) EPC and Art. 1(1) RPBA, a Business Distribution Scheme (BDS) is drawn up for the distribution among the boards of appeal of all appeals that may be filed during the year, designating the members who may serve on each board and their respective alternates. The scheme may be amended during the working year. A BDS is likewise determined for the Enlarged Board before the beginning of the working year (R. 13 EPC, Art. 2 RPEBA). This too may be amended during the working year.

In **G 1/05** (OJ 2007, 362) the Enlarged Board stated that it was very important that board members discharged their duty to sit in the cases allocated to them. Board members cannot withdraw from the proceedings at will, i.e. for reasons which have nothing to do with the purpose of the provisions on exclusion and objection. On the other hand it should also be avoided that a board member has to sit in a case where they are convinced or fear that they might not be able to be impartial (see in this chapter III.J.2.1.).

In **G 2/08** of 15 June 2009 the Enlarged Board also pointed out that its members had a duty to sit on the cases allocated to them (see also **G 3/08** of 16 October 2009) according to their jurisdiction both "*ratione legis*" and "*ratione materiae*". That is to say, parties to judicial proceedings had a right to have their case considered and decided by the judge designated or appointed by law. This essential principle was even enshrined at a constitutional level in some EPC contracting states, e.g. Germany, Austria and Switzerland (see **G 1/05**, OJ 2007, 362; **T 954/98** of 9 December 1999, **J 15/04**, **R 2/14** of 17 February 2015, **R 15/11**). On the other hand, Art. 6(1) of the ECHR required inter alia that "in the determination of his civil rights and obligations ... everyone is entitled to a fair and public hearing within a reasonable time by an independent and impartial tribunal established by law". The Enlarged Board found that these principles were not incompatible and had to be construed in such a way that they were not mutually exclusive.

In **R 19/12** of 25 April 2014 the Enlarged Board likewise stressed that interpretation of the rules on objections of suspected partiality had to find a balance between two principles: no-one could escape the jurisdiction of the judge appointed by law, but on the other hand everyone had a fundamental right to a fair trial before an independent and impartial tribunal (Art. 6(1) ECHR, Art. 47(2) of the Charter of Fundamental Rights of the European Union).

In **R 15/11** the board, referring to **G 1/05** (OJ 2007, 362), held that not only could board members not withdraw from the proceedings at will, but also that the provisions on business distribution had to apply for a case to be re-opened before the board, unless there was a compelling reason for proceeding otherwise. It was therefore appropriate, when exercising the power of discretion conveyed by R. 108(3), second sentence, EPC, to consider the criteria and standards developed for the replacement of members of the board of appeal following an objection of suspected partiality pursuant to Art. 24(3) and (4) EPC.

1.4.2 Use of objective criteria to determine correctness of composition

In **T 281/03** of 30 March 2006 the board held that the correctness of the composition had to be decided on the basis of objective criteria, i.e. on the basis of the RPBA and the BDS. There was no subjective element which would justify an analogous application of Art. 24(4) EPC, nor did it in its substitute composition see any gap in the law which might require an analogous application of Art. 24(4) EPC. On the contrary, if the composition of a board had to be checked by a second composition, the operation of a board could be paralysed by a sequence of mere objections to its composition.

In **T 355/13** the board found inadmissible the appellant's mere allegation that as a result of changes to its composition, the board had formed a special tribunal ("Spezialtribunal") to the appellant's disadvantage, and that the "real grounds" for the changes to the composition had not been communicated by the board. The board had explained in a communication to the parties that the changes to the board's composition were due to changes to the BDS, in particular it was pointed out that the former technically qualified member had been transferred to another board and the former legally qualified member was no longer a member of the boards of appeal. The appellant had nevertheless pursued its objection without producing any evidential basis supporting the allegation.

In **R 12/22**, the petitioner first argued at the oral proceedings before the Enlarged Board that the replacement at short notice of the legal member infringed a "right to be heard by the judge designated by law" ("Recht auf den gesetzlichen Richter"). The Enlarged Board held that the EPC and its supplementary provisions, in particular those of the RPBA, do not regulate a "right to be heard by the judge designated by law". Art. 2 RPBA regulates exceptions to the BDS, namely the replacement of members if they are unable to participate. However, in the oral proceedings before the board of appeal, the petitioner had claimed neither a right to be heard by the judge designated by law nor argued the absence of any exception under Art. 2 RPBA. The Enlarged Board therefore decided to reject as clearly unfounded this newly alleged breach of the right to be heard resulting from infringement of a right to be heard by the judge designated by law.

1.5. "Subjective" and "objective" test, presumption of impartiality

Determining impartiality within the meaning of Art. 24(3) and (4) EPC, in the case law developed by the Enlarged Board and the boards of appeal in line with the case law developed by the ECtHR under Art. 6(1) ECHR means applying firstly, a **"subjective" test** requiring proof of actual partiality of the member concerned; and secondly, an **"objective" test** according to which the deciding board judges whether the circumstances of the case give rise to an objectively justified fear of partiality (see **T 190/03**, OJ 2006, 502, and **R 8/13** of 20 March 2015, OJ 2006, 502. See also **T 1021/01** of 18 March 2005; **T 1193/02**; **T 281/03** of 18 March 2005 and **T 281/03** of 30 March 2006; **T 283/03**; **T 572/03** of 18 March 2005). Actual partiality is an internal characteristic of the member concerned, its presence clearly objectionable because it goes against the principle of a fair trial. However, suspicion and appearances are not enough to show actual partiality. It is a fundamental duty of a board member acting in a judicial capacity to take decisions objectively and not be swayed by personal interest or other peoples' comments or actions.

Thus, a board member's personal impartiality is to be presumed until there is proof to the contrary (in addition to the case law cited above, see in particular **G 2/08** of 15 June 2009; see also **R 19/12** of 25 April 2014.

On the other hand, the appearance of partiality involves external aspects and reflects, regardless of whether the member was actually biased or not, the confidence that the board inspired in the public; "Justice must not only be done; it must be seen to be done" (see in addition to the case law above **G 1/21** of 17 May 2021, **T 900/02**, **T 2291/08;** see also **R 8/13** of 20 March 2015). The boards have held that this aspect of partiality did not need to be proved in the same way as actual partiality, but rather it had to be established whether the circumstances gave rise to an objectively justified fear of partiality (objective element). This essentially corresponds to the "objective" and "reasonable" grounds identified in the case law of the EPO and is in line with generally acknowledged procedural principles in the contracting states, e.g. the jurisprudence of the European Court of Human Rights (ECtHR).

In **G 1/05** (OJ 2007, 362) the Enlarged Board stated that, for an objection under Art. 24(3), first sentence, EPC to be justified, it was not necessary that the board member concerned actually be partial. It sufficed that there was a **suspicion** (see chapters III.J.4., III.J.5. and III.J.6. below), i.e. an appearance, of partiality (called the "objective test" in the ECtHR jurisprudence since Piersack v. Belgium (1982) of 1 October 1982, No 8692/79, paragraph 30). There should be no risk that the courts would not ensure that justice was both done and perceived by the public to have been done (see also **R 19/12** of 25 April 2014, **T 190/03**, OJ 2006, 502; ECtHR: Puolitaival and Pirttiaho v. Finland of 23 November 2004, No. 54857/00). The Enlarged Board noted that it was, however, also commonly recognised in the jurisprudence of the boards of appeal and elsewhere that the party's "suspicion" had to be justified on an objective basis. Purely subjective impressions or vague suspicions were not enough (see also **G 3/08** of 16 October 2009, **R 2/12** of 26 September 2012; and see **T 190/03**, OJ 2006, 502, and also e.g. **T 985/01** of 18 March 2005). Thus the deciding board judges whether the overall circumstances of the case could give rise to an objectively justified fear of partiality. This conclusion was in line with the ECtHR case law, e.g. see Puolitaival and Pirttiaho v. Finland: "The standpoint of the person concerned was important but not decisive" (see also **T 241/98** of 22 March 1999 and **R 8/13** of 20 March 2015). With respect to the objective test, the question to be answered was thus whether a reasonable, objective and informed person would on the correct facts reasonably apprehend that the judge had not or would not bring an impartial mind to bear on the adjudication of the case. It was thus necessary that a reasonable onlooker considering the circumstances of the case would conclude that the party might have good reasons to doubt the impartiality of the member objected to (see also **G 1/21** of 17 May 2021, **T 954/98** of 9 December 1999, **T 1257/14** of 5 February 2018).

In **T 2274/22** a member of the public attending oral proceedings with the opponent had been present during the interpreter briefing, albeit undisputedly by mistake. The board considered that there was a considerably greater risk of this kind of thing happening in videoconferences than at in-person oral proceedings. Indeed, owing to the lack of physical proximity and only indirect presence associated with a videoconference, it could even

come about more quickly that such an incident would be outwardly perceived in a negative light and a "bad impression" formed, and the threshold for suspecting partiality could be lower as a result. High standards therefore had to be met in terms of the proper conduct of the proceedings, especially when it came to handling technical malfunctions. In the case in hand, it could not initially have been apparent to the patent proprietor that the opposing party might have gained an advantage, and so it had been all the more entitled to expect that the opposition division would immediately inform it of what had happened.

1.6. Applicability of Article 24 EPC to first-instance proceedings

In **G 5/91** (OJ 1992, 617) the Enlarged Board stated that although Art. 24 EPC applied only to members of the boards of appeal and of the Enlarged Board, it must be considered as a general principle of law that nobody should decide a case in respect of which a party may have good reasons to assume partiality. The basic requirement of impartiality therefore applies also to the members of the EPO's departments of first instance who take part in decision-making activities affecting the rights of any party (see also **T 433/93**, **T 95/04**, **T 283/03**, **T 1193/02**, **T 2475/17**). The board noted, however, that Art. 24(1) EPC 1973 contained some provisions specifically aimed at safeguarding the impartiality of members of the boards of appeal and of the Enlarged Board. For example, while no member of a board of appeal could take part in an appeal if they had participated in the decision under appeal (see in this chapter III.J.5.1.2), it was clearly permissible under Art. 19(2) EPC 1973 for one member of an opposition division to have taken part in the proceedings for grant of the patent to which the opposition related. In **T 1674/12** the board observed that, whilst the rules applicable to board members were different, a member of an examining division which had granted a patent could take part in opposition proceedings concerning the same patent, provided they did not act as Chair (see Art. 19(2) EPC). In **T 1647/15** the board, with reference to **G 5/91** (OJ 1992, 617), stated that there was no legal basis for automatically applying Art. 24(3) and (4) EPC to an opposition division (as had been argued by the appellants).

T 990/06 concerned enlargement of the opposition division by the addition of a legally qualified examiner. The board stressed that the division's composition had to be clear at all times so that its compliance with Art. 19(2) EPC and its members' impartiality pursuant to **G 5/91** could be verified.

In **T 2274/22** the board considered, by analogy with the possibility provided for in Art. 24 (3), sentence 1, EPC, that objecting to an opposition division could be justified not only in cases of actual partiality but even where there was only a suspicion, i.e. appearance, of partiality.

See also chapter III.J.4 "Suspected partiality of members of the departments of first instance", as well as chapter III.K.1. "Composition of the competent departments of first instance".

1.7. Applicability of Article 24 EPC to disciplinary proceedings

Art. 3 of the Additional Rules of Procedure of the DBA of the EPO (see Supplementary publication 1, OJ 2024) contains rules on exclusion and objection in proceedings before the Disciplinary Board of Appeal. Art. 16 RDR provides that Art. 24 EPC shall apply mutatis mutandis as regards the exclusion of and objection to members of any of the Disciplinary Bodies (Supplementary publication 1, OJ 2024).

In **D 7/82** (OJ 1983, 185) the Disciplinary Board applied Art. 24(3) EPC by analogy.

In **D 25/05** the Disciplinary Board dismissed the request for exclusion of A as inadmissible under Art. 16 RDR and Art. 24 EPC, the appellant having taken a procedural step while aware of the possible reason for objection.

2. Initiation of partiality proceedings and other procedural issues

Art. 24 EPC provides for two procedural alternatives. First, under paragraph 2, the member concerned may inform the board of a reason for exclusion. Second, under paragraph 3, a party may raise an objection if it has reason to do so. Art. 3(1) RPBA (see also Art. 3(1) RPBA 2007) and Art. 4(1) RPEBA additionally provide that the procedure under Art. 24(4) EPC is to be applied if a board has knowledge of a possible reason for exclusion or objection which does not originate from a member himself or from any party to the proceedings.

2.1. Notices of self-recusation

Under Art. 24(2) EPC, if, for one of the reasons mentioned in Art. 24(1) EPC, or for any other reason, a member of a board of appeal or a member of the Enlarged Board considers that he should not take part in any appeal, he shall inform the Board accordingly.

In **G 1/05** (OJ 2007, 362) a member of the Enlarged Board informed it that she ought not to be taking part in the referral, since one of the opponents in the underlying case was represented by the law firm in which her husband and her son were partners. The Enlarged Board noted that in accordance with Art. 24(4) EPC, a notice of withdrawal did not automatically effectuate the exclusion of the board member concerned from the proceedings; an exclusion required a decision by the board in its composition according to Art. 24(4) EPC, the outcome of which was not anticipated by the notice of withdrawal (see also **J 15/04**, see also **R 2/15** of 21 October 2015, **T 1627/09** of 14 September 2018). The Enlarged Board held however that if a member of a board of appeal in a notice of withdrawal under Art. 24(2) EPC 1973 gave a ground which could by its nature constitute a possible ground for an objection of partiality, that ground should normally be respected by the decision on replacement of the board member concerned because it could be expected that the member submitting the notice knew best whether or not a possible suspicion of partiality might arise.

In **J 15/04** the board noted that if one accepted that a notice of self-recusation would immediately and automatically exclude the member concerned, then the party's formal

right to a hearing before a duly appointed member of the board as established by the EPC would be violated. The grounds of possible partiality given by a board member in a notice of self-recusation should normally be respected by the decision. It could be expected that the member submitting a notice of self-recusation based on specific facts knew best whether or not a possible suspicion of partiality might arise. The public or a party should not suspect bias after a decision of a board of appeal finding no grounds of suspicion of partiality (see also **T 584/09** of 1 March 2013).

In **R 2/15** of 21 October 2015 the Enlarged Board held that in the case of a party's objection under Art. 24(3), first sentence, EPC (see in this chapter III.J.2.3.) it had to be established that there was subjective partiality or at least an appearance of partiality (objective partiality). In the case of self-recusation, however, it was sufficient that an appearance of partiality was at least arguable in the circumstances of the case.

In **T 1627/09** of 14 September 2018 the board accepted the notices of recusation submitted by both the Chair and the legal member of the board in accordance with Art. 24(2) EPC. They had both formed part of the board in **T 1627/09** of 10 October 2013 (decision set aside by **R 2/14** of 22 April 2016, which ordered the proceedings be re-opened) and they held that if they remained as members of the board, they would have to decide for a second time on the same issues. The board referred to the jurisprudence of the boards of appeal mentioned above in this chapter and held further that this was in accordance with Art. 6(1) ECHR and Art. 47(2) of the Charter of Fundamental Rights of the European Union (CFR). The board referred to the case law of the ECtHR on Art. 6(1) ECHR that only under very exceptional circumstances a notice of self-recusation shall not lead to a replacement (inter alia, ECtHR, Rudnichenko v. Ukraine, no. 2775/07). As an example of national case law that followed the same lines, the board referred to Austrian Supreme Court 4 Ob 186/11y EFSlg 131.987.

2.2. Objection by other board members of the same board of appeal

In **J 15/04** the notices of self-recusation of the two legal members contained information concerning a possible reason for exclusion of the Chair (which did not originate from the Chair himself). These notices did not fulfil the requirements pursuant to Art. 24(2) or (3) EPC, with regard to the replacement of the originally appointed Chair, according to which the individual member had to have informed the board that they should not take part in the appeal or have been objected to by one of the parties. However, according to Art. 3(1) RPBA 2003, the application of Art. 24(4) EPC 1973 extended to cases in which the board had knowledge of a possible reason for exclusion or objection which did not originate from a member themselves or from any party to the proceedings.

2.3. Objection by a party to a board member or members

Most partiality proceedings are initiated by a party objecting to a board member under Art. 24(3) EPC. According to the established jurisprudence of the boards of appeal, if a party is to receive a fair hearing before a tribunal, such a party should have no reasonable ground (on an objective basis) to suspect that any member of the tribunal is partial or

prejudiced in relation to deciding the case (cf. **G 5/91**, OJ 1992, 617; **G 1/05**, OJ 2007, 362; **T 433/93**, OJ 1997, 509; **T 95/04**, **T 283/03**, **T 1193/02**).

Art. 24(3) EPC states that "members" of a board of appeal may be objected to by any party. In **T 843/91** (OJ 1994, 818) the board held that this implied that all the members of a board may be objected to, together or separately (see also **T 1020/06** of 12 November 2008 in which all the members of the original board were replaced pursuant to Art. 24(4), second sentence, EPC 1973).

In **T 1656/17**, even though a large part of the allegations of suspected partiality concerned the behaviour and statements of the Chair and not of the two other members of the board, the alternate board understood the substantiated allegations to apply equally to the two other members. According to the board, it was clear that a Chair, when presiding over the oral proceedings, was normally acting after consultation with or with the tacit consent of the other board members. Thus, in the case in hand, the objecting party could legitimately assume that the actions of the Chair were supported by the other two members.

2.4. Objection by a third party

In **R 2/14** of 17 February 2015 the Enlarged Board stated that grounds for exclusion under Art. 24(1) EPC must be applied ex officio and may be raised by anyone, i.e. the parties, the board, or a third party. In addition to this, members of a board of appeal or of the Enlarged Board may be objected to by any party for suspected partiality pursuant to Art. 24(3) EPC.

In **G 2/08** of 15 June 2009 the Enlarged Board noted that objections of suspicion of partiality were the monopoly of parties to the proceedings. However, under Art. 4(1) RPEBA, if the Enlarged Board had knowledge of a possible reason for exclusion or objection which did not originate from a member himself or from any party to the proceedings, then the procedure of Art. 24(4) EPC was to be applied (see also Art. 3(1) RPBA). When construing the meaning of the wording "possible reason for exclusion or objection", one had to bear in mind the following distinction: (a) grounds that may be raised ex officio according to Art. 24(1) EPC and (b) an objection of partiality, reserved to the parties.

The Enlarged Board stated it might appear appropriate not to proceed any further with a complaint if an alleged reason for exclusion or objection not originating from a party to the proceedings or the Enlarged Board itself would amount to an abuse of procedure. That would be the case where a complaint was not substantiated at all, ignored established case law, or had been filed maliciously in order to damage a member's reputation or with the purpose of delaying the proceedings, this list not being exhaustive.

3. Admissibility

According to Art. 24(3) EPC an objection on the ground of suspected partiality is not admissible if, while being aware of a reason for objection, the party has taken a procedural step. Nor may it be based on the nationality of members, or against the board "as a whole".

Additionally, the boards have rejected objections as inadmissible because they were not reasoned, were a mere repetition of a previously rejected objection, where the grounds for the request were based on a manifestly incorrect interpretation of procedural rules and obligations.

3.1. Competence of the board in its original composition

The board in its original composition, i.e. with the member(s) objected to, is competent to examine the admissibility of an objection under Art. 24(1) EPC or Art. 24(3) EPC for the purpose of opening the procedure under Art. 24(4) EPC. In **T 1028/96** (OJ 2000, 475) the board stated that, if an objection under Art. 24(1) or (3) EPC 1973 was made by a party, Art. 24(3), second sentence, EPC 1973 clearly required a preliminary examination of admissibility (see also **R 12/09** of 3 December 2009, **T 355/13**, **T 1656/17**). The purpose of the preliminary examination for admissibility was to determine whether the objection could go forward for substantive examination and decision. If the objection was not admissible, the board could not examine whether it was allowable or well founded. On the other hand, if, from the point of view of the board in its original composition, the objection was admissible, then the procedure under Art. 24(4) EPC applied. Thus, the issue of admissibility before the former board was only relevant to the opening of the procedure under Art. 24(4) EPC and had no bearing on the future decision of the board nominated in accordance with Art. 24(4) EPC. Admissibility, which is a fundamental prerequisite for a decision on the substance, must be examined by the board of its own motion (see also **T 289/91**, **T 2175/15** of 11 June 2024).

3.2. Obligation to raise the objection immediately

Article 24(3) EPC states that an objection shall not be admissible if, while being aware of a reason for objection, the party has taken a procedural step. The boards have consistently noted that an objection on grounds of suspected partiality must be raised immediately after the party becomes aware of the reason for the objection. This principle is crucial to prevent potential abuse of the system (**G 5/91**, OJ 1992, 617). A "procedural step" may include such actions as filing letters, raising objections under R. 106 EPC or participating in parallel proceedings, as evidenced by inter alia **T 49/11**, **T 568/17**, and **T 1677/11**, where the timing and nature of procedural steps have significantly influenced the admissibility of objections.

In **G 5/91** (OJ 1992, 617) the Enlarged Board stated that, although Art. 24(3) EPC 1973 was only applicable to appeal proceedings, an objection on the ground of suspected partiality could also be disregarded at first instance if it had not been raised immediately after the party had become aware of the reason for the objection (or if it was based on nationality). The system might otherwise be open to abuse.

In **T 1020/06** of 28 November 2008 the board held that filing new requests after proceedings under Art. 24(4) EPC 1973 had been started did not render the partiality objection inadmissible.

In **T 49/11** after having received the summons which had made the parties aware of the composition of the board, the respondent filed two letters with the board before raising the partiality objection. In the first letter, the respondent had expressed its intention to speak German at the oral proceedings. The board held that such a statement constituted a procedural step within the meaning of Art. 24(3), second sentence, EPC, because it was a formal notification under R. 4(1) EPC. The partiality objection was therefore rejected as inadmissible. After analysing the text of Art. 24(3), second sentence, EPC in the three official languages (Art. 177(1) EPC), the difference between Art. 24 EPC 2000 and Art. 24 EPC 1973, and the transitional provisions of the EPC 2000, the board stated that it would have come to the same result under the old and the new text of Art. 24(3) EPC.

In **T 1677/11** the board noted that the respondents had been aware of the closely related parallel appeal **T 1760/11** of 16 November 2012, which had been decided by a board in an identical composition one week previously, right from the beginning of the current appeal proceedings. Nevertheless, it was only after an adverse decision in that case had been announced that the respondents raised their objections of suspected partiality in the case at issue. The board stated that regardless of whether the respondents had taken a specific procedural step in the current appeal proceedings, they had not submitted their objection immediately after having become aware of the reasons. It held that, in view of the fact that the objections raised were linked to both appeals, attendance at oral proceedings in **T 1760/11** had to be regarded, in the factual context of the case now at issue, as a procedural step within the meaning of Art. 24(3) EPC. Thus, the objections under Art. 24(3) EPC were rejected as inadmissible.

In **T 49/15** respondent 4 argued that the board's decision to admit the appellant's new main request had been a prerequisite for its partiality objection because it had only been then that the appellant had been favoured. The board rejected this argument: a party did not have to be adversely affected by a board decision before it could cite suspected partiality as a reason for objection.

In **T 2175/15** of 1 April 2022 the opponent made a second request for exclusion on grounds of partiality at the same time as, and not after, taking further procedural steps. According to Art. 24(3) EPC, an objection is not admissible if, while being aware of a reason for objection, the party has taken a procedural step. In the view of the competent board, the concurrent objection in question did not fall under Art. 24(3) EPC.

In **T 2440/16** of 17 May 2022 the respondent had already expressed criticism of the statements in the board of appeal's communication and of the interlocutory decision, and had made various requests in this regard, without, however, making an objection on the grounds of suspected partiality. The board held that filing requests was a procedural act within the meaning of Art. 24(3), second sentence, EPC, as its purpose was to initiate a decision-making process by the board.

In **T 568/17** the board, with reference to **G 1/91**, held that if the appellant in the case in hand had wished to challenge the composition of the examining division because of the examiner's earlier actions during the international phase, it should have done so in the European regional phase when it became aware of that composition.

In **T 1656/17**, although the appellant claimed that it had not taken any procedural steps while being aware of a reason for objection on grounds of suspected partiality, it had filed an objection under R. 106 EPC at the end of the oral proceedings. In the board's view, such an objection was without doubt to be classed as a procedural step within the meaning of Art. 24(3), second sentence, EPC. The appellant's objection of suspected partiality was, however, not limited to facts occurring before the objection under R. 106 EPC was filed. It was based on a chain of events that also encompassed facts that occurred after this objection had been filed. Moreover, the board understood the appellant's submission to mean that it was not until all the events had occurred that it became aware of the original board's biased attitude against it. Consequently, the board considered that the filing of the objection under R. 106 EPC did not render the subsequent objection of suspected partiality inadmissible.

In **G 1/21** of 28 May 2021 the Enlarged Board considered that the appellant's third objection was filed inadmissibly late. The appellant had argued that because it was held in the first interlocutory decision that the Chair of the Enlarged Board and a further member could be suspected of partiality, the members that participated in the panel with them would be "infected" by their biased views on the referral and therefore the suspicion of partiality also applied to them. The Enlarged Board stated that the risk of "infection" existed mainly before the filing of the first objection and the objection based on this circumstance could and should thus have been filed at that time. It was not credible that the risk of influencing other members only became a concern after the Enlarged Board had agreed with the appellant that its objection against the Chair was justified. The Enlarged Board likewise held that objections 2 and 4 were filed inadmissibly late. Both objections were based on circumstances that were known from the very start of the referral proceedings, and therefore could and should have been filed already at the time of filing the first objection at the latest.

In **R 12/22** the Enlarged Board held that the right to be heard could also include the right to obtain information with a view to exercising the right to reject a new board member, if required, under Art. 24 EPC. The petitioner could have asked the member concerned relevant questions during the oral proceedings before the board of appeal. However, in its petition for review it had not pointed out any possible violations of Art. 24 EPC. Therefore, the Enlarged Board could not examine such submissions to identify a possible breach of the right to be heard.

3.3. Objection must be reasoned and substantiated

In **T 1028/96** (OJ 2000, 475) the board stated that, in addition to the two admissibility conditions prescribed in Art. 24(3) EPC, the EPC required, as a general rule, that objections be reasoned, i.e. indicated facts and arguments which were alleged to support such an objection. From this requirement it followed, firstly, that an objection based on purely subjective unreasonable doubts should be rejected as inadmissible. It also followed that if facts and arguments filed could not support the objection of suspected partiality raised, the objection was likewise inadmissible (see also **T 355/13**, and **T 2175/15** of 11 June 2024).

In **R 12/09** of 3 December 2009 the Enlarged Board referred to **T 1028/96** (OJ 2000, 475) and also held that, when determining admissibility, it had to be established whether the objection had been duly substantiated. However, according to the Enlarged Board, this merely meant ascertaining whether it met the minimum standard for objective reasoning, and not whether that reasoning was also persuasive (see also **T 2440/16** of 17 May 2022).

In **T 1760/11** of 13 November 2012 the board noted that no reasons were given as to why the fact that the Chair had been employed at Cabinet Regimbeau over thirteen years previously should bias him against respondent 6 or any of the other parties, regardless of whether or not he had in fact acted for respondent 6 during his time there. Such **vague and unsubstantiated allegations** could not support an objection of suspected partiality

In **G 1/21** of 28 May 2021 the Enlarged Board found that objections for suspicion of partiality against two regular members of the panel who had previously been objected to in earlier interlocutory proceedings (**G 1/21** of 17 May 2021) did not comply with the minimum standard for objective reasoning and substantiation. It was not based on facts ("we have reason to believe...") and the arguments were based on speculation. It was for the party who filed an objection to substantiate it with relevant facts and arguments (see also **T 2078/17**).

The Enlarged Board also noted that objections 1, 2 and 4 were not person specific and were very general; they could apply to any board member who took part in internal discussions or meetings with stakeholders (objection 1), all members of the Enlarged Board (objection 2), or all internal members of the Enlarged Board and the Boards of Appeal (objection 4). It found it questionable whether such general und unspecified objections could be seen as an objection of partiality within the meaning of Art. 24 EPC. With regard to Objection 1, merely limiting the objection to certain members was not sufficient to make the objection reasoned with respect to the members concerned. With regard to objection 4 – which was based on the fact that the re-appointment of members of the Boards of Appeal and the Enlarged Board was inter alia dependent on a positive opinion from the President of the Boards of Appeal, who was also the Chair of the Enlarged Board – the Enlarged Board noted that the mechanism of Art. 24 EPC was not meant for objections that were exclusively based on such general, institutional concerns and was also not capable of alleviating these concerns (as it also found with regard to objection 2). The use of Art. 24 EPC for the institutional concerns expressed by the appellant, when taken to the extreme, could potentially lead to a complete paralysis of the present proceedings.

In **T 2440/16** of 17 May 2022 the board held that an objection which was not supported by the facts in the proceedings because they were clearly unsuitable from a legal point of view to substantiate a suspicion of partiality was inadmissible. This was the case if the grounds for the request were based on a manifestly incorrect interpretation of procedural rules and obligations (see **T 1028/96**, OJ 2000, 475; **R 12/09** of 3 December 2009; **T 355/13**).

3.4. No objection to the board as a whole

In **T 2440/16** of 17 May 2022 the board held that an objection under Art. 24 EPC must always be directed at specific members of the board. Partiality is a characteristic of an individual person and therefore cannot be ascribed to a deciding body per se but only to its members.

In **T 1966/17** the board held that appellant 2's suspicion of partiality of all the board members simply because they did not agree with its submissions and because they expressed a different opinion could not support its allegation of partiality. To the contrary, such reasoning could not be considered to be based on the objective criteria relating to partiality as indicated in **G 1/05** (OJ 2007, 362, point 20 of the Reasons). For this reason alone, i.e. the lack of substantiation, the objection of partiality was found to be inadmissible.

3.5. Objection based on an obviously wrong understanding of the board's procedural obligations, the right to be heard and the principle of a fair trial

In **T 355/13** the appellant suspected the board of partiality, inter alia because it had not provided a provisional opinion on decisive aspects of the case and because it had issued a summons to oral proceedings instead of remitting the case to the department of first instance. Referring to **G 6/95** (OJ 1996, 649), the board stressed that there was no procedural obligation for the board to issue any provisional opinion, and that in inter partes proceedings it was not possible to automatically follow a party's request without giving the other parties the possibility to be heard on that request (in oral proceedings, if requested). The board considered the partiality objection inadmissible, as it was based on an obviously wrong interpretation of the board's procedural obligations, the right to be heard and the principle of a fair trial.

In **T 2078/17** the board found that the allegation that the replacement board members had not acted impartially in admitting the communication with the decision to reject the request to correct the minutes was based on several legal misunderstandings. For one thing, the board made it clear that the rejection of the request to correct the minutes was, both formally and substantively, a decision of the entire board and not just of the minute-writer. As for Art. 3(3) RPBA, which states that there must be a decision on the objection before further proceedings in the case, the board concluded as follows: for obvious reasons, an exception necessarily had to be made for requests to correct minutes relating to oral proceedings before a board whose members had been rejected on the grounds of partiality. The decision on the request to correct the minutes in cases such as the one at issue could only be made by the members of the rejected board, in this case the original board, as only these members had taken part in the oral proceedings and only they could judge whether the request was justified. Otherwise, the replacement board's subsequent decision on the objection could rely on an incorrect legal and factual basis, and this would be unacceptable for reasons of legal certainty and procedural economy.

3.6. Repetition of a previous objection

In **T 281/03** of 17 May 2006 the board found that the reason for the third partiality objection was essentially the same as that already decided by the replacement board in connection with the second partiality objection. Since the new objection had been made directly upon resumption of the oral proceedings after the respondent's previous objection to partiality had been refused, no new reason for objection could exist, so that the objection was simply a repetition of the previous objection and amounted to an abuse of the proceedings. Hence, the board decided that the request was inadmissible.

3.7. Dual function as members of the Enlarged Board and another board of appeal

In **R 12/09** of 3 December 2009 the petitioner objected to the members of the Enlarged Board in petition for review proceedings, alleging that they inevitably had a personal interest owing to their capacity as members of a technical board or the Legal Board. The Enlarged Board rejected this objection as inadmissible (see in this chapter III.J.6.2.1 "Previous participation in cases as members of the boards of appeal").

4. Suspected partiality of members of the departments of first instance

4.1. Competence to decide

According to the Enlarged Board in **G 5/91** (OJ 1992, 617) the practice that a partiality objection made at first instance is decided by the director of the department concerned cannot be considered illegal in view of the administrative character of the first-instance departments, which were subject to internal instructions by the President under Art. 10(2)(a) EPC (see also **T 2509/11** and **T 71/99**). The Enlarged Board explained that under the EPC there was no legal basis for any separate appeal against an order of a director rejecting a partiality objection to a member of a department of first instance such as an opposition division. However, the composition of the opposition division could be challenged on appeal against the final or interlocutory decision of the division. If not all the members of an opposition division fulfilled the requirement of impartiality, there was a procedural violation which would normally render the decision void. The Enlarged Board made it clear that it lay within the competence of the boards of appeal to decide whether this requirement had been fulfilled. This could also be seen in practice (cf. e.g. **T 251/88**, **T 939/91**, **T 382/92**, **T 476/95**, **T 838/02**, **T 1349/10**, **T 568/17**). Such consideration might take place of the boards' own motion or at the request of a party to the appeal proceedings.

In **T 479/04** the board found that **G 5/91** did not prohibit an opposition division from deciding itself on an allegation of partiality made against it. Moreover, it could not be inferred from **G 5/91** that it was forbidden to decide on that matter together with the decision on the substance. The board concluded that the opposition division had not committed any procedural error by deciding itself on the allegation of partiality raised against it in the contested decision (see also **T 1647/15**).

In **T 2475/17** the board noted that the boards had held multiple times that the EPC did not offer any legal basis that would allow them to act as a substitute for the EPO management

and order a change to the composition of the decision-making department of first instance. Since the composition of the department of first instance was the responsibility of the EPO President, or rather his or her representatives, and not the department itself, Art. 111(1) EPC could not justify such an approach. It took the view that in cases in which the board had found that the right to be heard had been violated, a board had the power to order a change in the department of first instance's composition only if it had arrived at the conclusion that the composition had been the actual cause of the violation of the right to be heard and that the violation could only be remedied by changing the composition. Any such order by a board would be limited to requiring that the composition be changed so that the right of the parties to fair and lawful proceedings could be ensured. The scope of the change or which member of the examining or opposition division was replaced by whom remained the responsibility of those in whose remit the matter fell.

4.2. Remittal and rehearing of a case

In **T 433/93** (OJ 1997, 509), the board noted in its Headnote that following a substantial procedural violation in connection with a decision issued by a first-instance department, at the request of a party, such decision had to be set aside. If a party had reasonable grounds to suspect that the same composition of opposition division would be tainted by the previous decision and therefore partial, at the request of that party the case should be reheard before a different composition of opposition division. If the case were re-heard and re-decided by the same composition of opposition division, the members would first have to attempt to put out of their minds the result of their previous decision on the case. The important point was not whether the file record showed any previous evidence of actual partiality by the members of the opposition division during the previous conduct of the case (see **T 261/88** of 16 February 1993), or whether the present members of the opposition division would in fact be unprejudiced or impartial if they re-heard the case, but whether a party would have reasonable ground to suspect that they would not receive a fair hearing if the case was re-heard before the same composition of opposition division (see also **T 628/95** of 13 May 1996, and **T 611/01**). In **T 2362/08** the board also ordered a new composition of the opposition division after remittal, stating that after procedural irregularities in the first proceedings it was fundamental that the parties had no ground to suspect that they had not received a fair hearing in the further proceedings, as they might well do if the same opposition division were again to revoke the patent even after conducting the proceedings in an impeccable way.

In **T 611/01** the board found a substantial procedural violation had occurred and remitted the case to the department of first instance for further prosecution to be conducted by a differently composed examining division (three new members). The board stated that this was typically done when there was a question of possible bias against a party. Although that was not the case here, a differently composed division could also be appropriate when a party had reasonable grounds for feeling it might not otherwise have a fair re-hearing (see **T 433/93**, OJ 1997, 509; see also **T 628/95** of 13 May 1996). Even if the appellant had not requested a different composition the board stated there should not be any ground for dissatisfaction with the conduct of the further proceedings. This could be the case if the same examining division, even after impeccably conducted proceedings, refused the application again.

In **T 1647/15** the board observed that whereas under normal circumstances a potential suspicion of bias concerning a member of an opposition division might be a strong indication for a remittal, this was not the case here where this suspicion did not affect the whole process of decision-making but only arose out of an uncontrolled outburst at the end of exceptionally long and intense oral proceedings. The contested decision was based on reasons which were extensively discussed in oral proceedings before said incident occurred. The board doubted that a remittal to the department of first instance, even in a different composition, would serve the interests of justice, as the remittal would cause an excessive delay in having the case finally decided. Accordingly, the board decided not to remit the case to the opposition division.

In **T 2475/17**, following a substantial procedural violation (infringement of Art. 113(2) EPC), the board set aside the decision and remitted the case to the department of first instance pursuant to Art. 111(1) EPC and Art. 11 RPBA for further prosecution. The appellant had requested that the board order that the examining division conduct the examination proceedings in a completely different composition. The board found that the appellant had not convincingly demonstrated that the procedural violations identified had resulted from the examining division's composition. In its view, the appellant's mere assertion that these procedural violations indicated partiality and that there was therefore the risk that the examining division would act in a biased manner when continuing the proceedings could not justify ordering that its composition be changed.

In **T 2274/22** the board found that there were objective reasons for suspecting the opposition division of partiality. The patent proprietor's objection to the opposition division's members ought therefore to have been allowed by analogy with Art. 24(3) EPC and the opposition division composed anew. That the opposition division had nevertheless gone on to take the contested decision in its original composition amounted to a substantial procedural violation requiring that the decision be set aside and the case remitted to a newly composed division (Art. 11 RPBA). The respondent (opponent) considered these legal consequences, and the considerable procedural delay they would entail, to be out of proportion to the opposition division's failure to play an active part in informing the patent proprietor of the undisputedly inadvertent presence of a member of the public attending with the opponent during the interpreter briefing. The board explained that, while it might appear excessive from the respondent's subjective point of view that an apparently unintended error in conducting the proceedings should have such major implications, it was normally irrelevant how serious the original error was if it ultimately resulted in a substantial procedural violation. The crucial factor was solely whether, as was the case here, the ensuing procedural violation had to be treated as so substantial that it called for a remittal of the case.

4.3. Personal interest

Under Art. 17(3) and (4) of the Service Regulations for permanent and other employees of the EPO (January 2025 version) any permanent employee who, in the performance of their duties, is called upon to decide on a matter in which they have a personal interest such as to impair his independence shall inform the President of the EPO (or the President of the Boards of Appeal in the case of members of the boards of appeal).

In **T 143/91** the board held that a member of an opposition division was biased if he had a personal interest within the meaning of Art. 24(1) EPC 1973. The mere fact that the member had previously been employed by a company dependent on a party to the opposition proceedings was, however, not sufficient proof of such an interest.

4.4. Disqualifying partiality

In **T 261/88** of 16 February 1993 the board stated that disqualifying partiality presumed that there was a preconceived attitude on the part of a deciding person towards a party to the case. When considering an allegation of partiality (in this case mainly based on the fact that the examiner was a former employee of the opponent), regard must be had to the particular facts of the case (cf. **G 5/91**). That the examiner's views differed from those held by the party was not disqualifying in itself. The board held that disqualifying partiality was limited to situations where the opinion of a person responsible for taking decisions affecting the right of parties was swayed by his attitude towards a party.

In **T 900/02** the board stated that a suspicion of partiality inevitably arose if a member of an opposition division, or any other first-instance body, first solicited and then accepted employment with a firm in which a partner or other employee was conducting a case pending before that member. It stressed that, to be above all suspicion of partiality, every member had to avoid any such situation at any time during the proceedings. No-one could be seen as independent of both parties while in the employ of one of them. The board held that the second examiner's employment by the respondent's representative's firm was both a fundamental deficiency in the first-instance proceedings under Art. 10 RPBA 1980 and a substantial procedural violation under R. 67 EPC 1973.

In **T 1055/05** the board decided that the examining division's refusal to minute the submissions of a party's representative during oral proceedings did not infringe the right to be heard or constitute grounds for suspecting partiality.

In **T 710/15** the opposition division had rejected a new argument under Art. 114(2) EPC, which is only a basis for disregarding new facts or evidence. The board held that such an error of judgment did not prove the partiality of the Chair or the opposition division.

In **T 568/17** the board noted that the examiner's communication had contained severe errors of judgment, but that this alone did not justify a suspicion of partiality. With reference to **G 1/05** (OJ 2007, 362), the board acknowledged that evidence of actual partiality was not required for an objection of suspected partiality to succeed. However, the suspicion of partiality must be justified on an objective basis which could be verified by the board. A mere allegation of unspecified and undocumented "negative statements" did not suffice.

In **T 2274/22** the board considered, by analogy with the possibility provided for in Art. 24(3), first sentence, EPC that objecting to an opposition division could be justified not only in cases of actual partiality but even where there was only a suspicion, i.e. appearance, of partiality. In the case in hand, that a party representative had been present (undisputedly by mistake) during the interpreter briefing was not a sufficient basis on its own for suspecting the opposition division of partiality, but this suspicion was justified by

the way events had unfolded at the beginning of the oral proceedings. The opposition division had not only neglected to mention what had happened on its own initiative but – even after the opponent had intervened by explicitly pointing out that there might have been a procedural defect – had also failed to play an active part in investigating the matter. Instead, it had simply accepted the opponent's suggestion that it file a written summary (short minutes), but did not then go on to address its contents. Considered from an objective observer's perspective, all of this amounted to circumstances and grounds that contributed to an appearance that the opposition division had not been impartial.

5. Suspected partiality of members of the boards of appeal

5.1. Grounds for exclusion under Article 24(1) EPC

5.1.1 Previous involvement of a board member as a party's representative in the case in question

In **R 16/10** the Enlarged Board held that the meaning of the English text of Art. 24(1) EPC taken as a whole, in its proper context and with respect to the text of the other two languages, was clear. It rejected the petitioner's argument that Art. 24(1) EPC included not only the specific situation where one of the members had represented a party in the case in question but also the general situation where a member had previously acted as representative of that party in any matter. Art. 24(1) EPC related to involvement in the particular case in question and not to any past representation (see also chapter V.B.4.1. "Article 112a(2)(a) EPC – alleged breach of Article 24 EPC".

5.1.2 Participation in the decision under appeal

In **T 1028/96** (OJ 2000, 475) the board stated that a member of a board in opposition appeal proceedings who had participated in the decision to grant the patent had not "participated in the decision under appeal" within the meaning of Art. 24(1) EPC. However, in certain special circumstances members of a board in opposition appeal proceedings may be "suspected of partiality" within the meaning of Art. 24(3) EPC if they participated in the decision to grant the patent in suit.

In **J 15/04** the Legal Board considered whether it would be appropriate to exclude a member of the board from proceedings whenever they had played any role in a previous case which had any functional coherence with the one under consideration. It noted that if members of a board were to be excluded because that board decided the same legal question in every case in an identical way, any established jurisprudence of a board would lead to exclusion of its members whenever the same legal question was at stake. The principle of judicial efficiency also constituted an essential element of the right to a fair trial and outweighed any allegation concerning a generally "possible" suspicion of partiality which was not based on the specific facts of the case. By the same token, the principle of a fair trial did not generally exclude a member of the boards of appeal from dealing with a party's case repeatedly, as might happen when a board referred a case back to the first instance and the appeal from the following decision established the competence of the same board. The Legal Board held that any broader interpretation of the wording

"participated in the decision under appeal" pursuant to Art. 24(1) EPC had to be based on the occurrence of specific facts of the case to be decided which were sufficient to raise specific concrete doubts on the ability of the member of the board to hear the appeal with an objective judicial mind and which could not be concluded from the mere procedural fact that a member of the board had already been involved in former proceedings with the same party or the same legal question to be decided in the case in hand. The essence of Art. 24(1) EPC 1973 was not to establish an assumption that any former involvement of a member of the board in a case dealing with the interests of a specific party established a suspicion of partiality of that member in all subsequent cases, but to exclude the participation of this member in reviewing a decision which had been dealt with by himself as part of the deciding body. In the case at issue (a divisional application), the Legal Board refused the partiality objection.

In **T 1020/06** of 28 November 2008 the board found that there was no provision in the RPBA 2003 or the BDS for a member to be excluded from participation in an appeal case pending before a technical board if that member had already dealt with a similar legal or factual question in another case pending before the same or another technical board. On the contrary, Art. 7 BDS stipulated that, where appeals pending before the board were closely linked the Chair could order that the board decide in the same composition. The board rejected the objections of partiality under Art. 24(3) EPC 1973 against the original board members.

In **T 1889/13** of 14 March 2017 the board stated, with reference to **J 15/04**, that the mere desire for a board which had not encountered any of the relevant factual and legal issues in a related case could not justify an obligation to appoint non-overlapping boards in cases concerning divisional and parent applications in the absence of specific facts which were sufficient to raise specific concrete doubts on the ability of the board members to hear the appeal with an objective judicial mind. Practical considerations and the procedural framework not only give rise to a provision in the BDS encouraging identical compositions in closely linked cases, but may even require that overlapping or identical board compositions are established in cases which may involve closely linked questions. The board further considered that cases involving grant and opposition appeal proceedings for the same file had to be clearly distinguished from cases involving parent and divisional applications. The conflicts and limitations concerning cases involving grant and opposition appeal proceedings for the same file did not exist with regard to cases involving parent and divisional applications.

5.2. Grounds for exclusion under Article 24(2) EPC: any other reason

In **G 1/05** (OJ 2007, 362) the Enlarged Board stated, with reference to R. 28(2)(a) of the Rules of Court of the European Court of Human Rights and national civil procedure rules, that a close family relationship with a party was one of the classic grounds for legally excluding a judge from taking part in the case concerned. That was not generally so where a family or other close relationship was not with the party but with a representative of the party. If a member of a board of appeal in a notice of withdrawal gives a ground which may by its nature constitute a possible ground for an objection of partiality that ground should normally be respected by the decision on replacement of the board member concerned,

because it can be expected that the member submitting the notice knows best whether or not a possible suspicion of partiality could arise (see also **J 15/04**).

In **J 15/04** the Legal Board noted that the notices of self-recusation were based on the situation that the two members concerned did not share the Chair's legal opinion in respect of the occurrence of a possible suspicion of partiality and a presumption that the appellant might therefore doubt their legal integrity. It held that a legal disagreement between the members of a board as such **did not establish any ground for exclusion** or objection under Art. 24 EPC. Each member of a board was responsible for a decision even if he was voted down by the majority of the other members of the board.

In **T 584/09** of 1 March 2013 the board held that the reason the members had given for recusing themselves, namely the avoidance of any appearance of partiality resulting from their having to decide afresh on the same matters, could be an "other reason" within the meaning of Art. 24(2) EPC (see also **T 1627/09** of 14 September 2018).

In **T 1656/17** a technically qualified member of the alternate board informed it in a notice of exclusion that they considered that they should not take part in the appeal proceedings as there existed a close family relationship between them and a person who had been involved in the first-instance proceedings. The alternate board decided that in the case in hand the technically qualified member concerned should be replaced. It was at least arguable that a board member who had family ties to a person involved in the first-instance proceedings might have an interest in confirming the findings of those proceedings and could therefore appear to be biased.

5.3. Grounds for objection under Article 24(3) EPC

5.3.1 Expressions of preliminary opinions

In **T 241/98** of 22 March 1999 the board of appeal observed that forming an opinion was one of the most important tasks of a board. Issuing a preliminary opinion was to be seen within this context and therefore could not be regarded as partial (see also **T 355/13**, **T 2175/15** of 23 June 2023 and chapter III.J.6.2.3).

In **T 355/13** the board held that the issuing of a preliminary opinion could not per se be regarded as a sufficient ground for an objection of suspected partiality. In the case in hand the board found that it was immediately apparent that the annex to the proceedings was in all its parts clearly written as a merely preliminary, non-binding opinion, evidenced not only with the introductory wording " [the] following observations are made without prejudice to the board's final decision", but also expressions used throughout. The board came to the conclusion that the annex to the summons in the case in hand could not support the allegations brought forward in relation to the objection of suspected partiality.

In **T 2440/16** of 17 May 2022 the board held that a board was not generally obliged to give explanations or grounds for its provisional or (after discussion and deliberation) final opinion during oral proceedings. As a general rule, the lack of such grounds could not therefore justify a suspicion of partiality. Adhering to a provisional opinion following

discussion of the substantive and legal position in the oral proceedings and subsequent deliberation was not an appropriate reason for suspecting partiality. It is in the nature of proceedings that the deciding body must make a (interim) decision after discussing the facts and legal position and after the subsequent deliberation.

In **T 2175/15** of 1 April 2022 (interlocutory decision), the board found that merely provisional, non-binding opinions could also be the subject of an objection (here the summons, in which the board, among other things, expressed doubts about the admissibility of the first objection). Objections on the grounds of suspected partiality arise not only when a party has been adversely affected by the board's decision (see also **T 49/15**, **T 1677/11**). Provisional statements in a summons that relate to issues raised in a case do not, in principle, provide grounds for objection if the provisional statements: do not favour a party, for example by providing information not covered by Art. 114(1) EPC; are objectively stated, i.e. do not contain, for example, any derogatory comments about a party or their representative; do not amount to an application of the law that is so grossly incorrect as to be considered arbitrary. However, the replacement board in **T 2175/15** of 23 June 2023 noted with regard to the third criterion (grossly incorrect and therefore arbitrary application of the law) that ultimately the specific circumstances of the individual case must always be decisive and that it must at all times be determined whether such an arbitrary application of the law gives rise to the legitimate fear that it is indeed an expression of bias against a party. A grossly incorrect application of the law could also be due to reasons other than bias against a party, such as the board's simple belief in the correctness of the actually grossly incorrect legal opinion. It was also conceivable that such grossly incorrect legal views could affect both parties in the same proceedings. In such a situation, it would appear difficult to conclude that the board was biased against a party.

The objectivity of the provisional opinion was also examined and confirmed in **R 2/12** of 26 September 2012, in which the board held that " ... the communication ... itself does not contain any bold contention, nor has been substantiated in 'such outspoken, extreme or unbalanced terms' that it would preclude the capacity of the member concerned from dealing with the pending petition with an open mind and without preconceived thoughts."

See also in this chapter III.J.6.2.3.

5.3.2 Disqualifying partiality

Members of a board of appeal may be objected to by any party for one of the reasons under Art. 24(1) EPC, or if suspected of partiality (Art. 24(3) EPC). For the grounds for objection under Art. 24(1) EPC, see chapter III.J.5.1. For the "subjective" and "objective" test for partiality, see chapter III.J.1.5.

In **T 261/88** of 16 February 1993, the board held that a disqualifying partiality presumed that there was a preconceived attitude on the part of a deciding person towards a party to the case. It was limited to situations where the opinion of a person responsible for taking decisions affecting the right of parties (e.g. a judge) was swayed by their attitude toward a party. Conversely, such a person would not be disqualified for having a certain tendency

or holding a particular view on an issue (see also **T 843/91,** OJ 1994, 818; **T 1028/96**, OJ 2000, 475).

In **T 843/91** (OJ 1994, 818) the board agreed with the view held in decision **T 261/88** that disqualifying partiality presumed a preconceived attitude on the part of a deciding person towards a party. More precisely, in the board's view, partiality would be willingly to favour one party by granting it rights to which it was not entitled, or by intentionally disregarding the rights of the other party (see also **T 954/98** of 9 December 1999). The question whether an objection to board members on the ground of suspected partiality was justified could only be decided in the light of the particular circumstances of each individual case (see **G 5/91**). The board found that, whatever their gravity, deficiencies, erroneous practices or procedural violations could not be regarded as a basis for an objection on the ground of partiality if they did not result from such a preconceived attitude or deliberate intention (see also **T 1257/14** of 5 February 2018, **T 2175/15** of 23 June 2023).

In **T 792/12** the appellant contended that the board did not want to listen to his arguments and appeared to lack impartiality because it interrupted him on several occasions. The board rejected this contention and referred to Art. 15(4) RPBA 2007, according to which the Chair of the board presides over the oral proceedings and ensures their fair, orderly and efficient conduct. A Chair may interject in a party's submissions to ensure that the proceedings are efficiently conducted, in particular to avoid a party repeating arguments. In the same way, a Chair, or indeed any member of the board, may interrupt to ask questions which were, for example, considered important for reaching a decision.

In **T 1493/20** the board held that the exhaustive list of grounds for objection in Art. 24(3) EPC indicated that an objection could not be based on just any arbitrary ground, even if the facts submitted concerning the members of the board could at least subjectively be viewed as detrimental to a party's case. The appellant had objected to the board on the basis of partiality resulting from an alleged lack of technical knowledge. The board held that the appellant's objection was inadmissible because a lack of technical knowledge was not an admissible ground for objection under Art. 24(3) EPC. It pointed out that neither the EPC nor the RPBA provided for the technical incompetence of a board in a technical area assigned to it under the BDS as a ground for objection. In this context, it referred additionally to Art. 117(1)(e) and R. 121 EPC.

5.3.3 Late filed objections under Article 24(3) EPC

In **R 2/14** of 17 February 2015 the Enlarged Board held that in the event of an objection to a member for suspected partiality pursuant to Art. 24(3) EPC, the statement of grounds of objection must contain the party's complete case in respect of the factual and/or legal circumstances that gave rise to the party's suspicion of partiality. The party may substantiate its initial submissions further during the proceedings. However, since the primary factual (and legal) framework has to be set in the party's initial statement, any subsequent submission must remain within that framework. Submitting new facts and/or legal aspects unrelated to or otherwise distinct from those previously submitted would constitute a new case outside the scope of the objection defined at the outset. In its Catchword, the Enlarged Board set out that the factual scope of an objection pursuant to

Art. 24(3) EPC is defined in the statement of grounds of the objection initiating the interlocutory proceedings under Art. 24(4) EPC. Apart from a subsequent elaboration of said objection by supporting facts, evidence and arguments, the subject-matter of the proceedings, as a rule, cannot be extended or changed, whether by new facts or by a new objection. Accordingly, the Enlarged Board did not admit a submission in which the petitioner referred to a new category of objections (personal or "subjective partiality" as opposed to structural or "objective partiality").

5.3.4 Discretionary procedural decisions negatively affecting a party

In **T 954/98** of 9 December 1999 the board held, with reference to **T 843/91** (OJ 1994, 818), that the mere taking of discretionary procedural steps which might disadvantage a particular party was not enough to justify exclusion, not even if the party interpreted those steps as expressing bias against it.

In **T 190/03** (OJ 2006, 502; see also **T 283/03**, **T 572/03** of 18 March 2005 and **T 985/01** of 18 March 2005) the board held that not admitting amended claims, regardless of whether the board had correctly used its power or discretion to do so, would not give rise to an objectively justified fear of partiality.

In **T 2175/15** of 11 June 2024 the board found that it was at a Chair's – normally non-reviewable – discretion to adjourn oral proceedings with a view to ensuring "their fair, orderly and efficient conduct" (see Art. 15(4) RPBA), irrespective of any legal requirement to do so. Although not convinced that the board as originally composed had indeed been applying, specifically, Art. 13(3) RPBA 2007 when admitting the auxiliary request and adjourning the oral proceedings, the board ruling on the partiality objection found that, even supposing it had, there was insufficient evidence that its members had acted arbitrarily in a way that could objectively justify suspecting them of partiality. If a board applied a legal provision contrary to its wording without providing any sort of adequately comprehensible explanation, acting, so to speak, "on a whim", that might indicate arbitrariness. But that was not what had happened in the case at issue.

5.4. Comments of the board member concerned

Under Art. 3(2) RPBA (see also Art. 3(2) RPBA 2007, and for the Enlarged Board Art. 4(2) RPEBA) the member concerned is to be invited to present comments as to whether there is a reason for exclusion or objection (as to the scope of Art. 3(2) RPBA 2003 and Art. 4(2) RPEBA, see **T 985/01** of 18 March 2005).

In **T 1938/09** of 2 October 2014 the appellant referred to **R 19/12** of 25 April 2014 and objected to the Chair of the board, arguing he was a potential deputy for the Vice-President of the EPO Directorate-General 3 (VP3). The Chair had not provided details, as requested by the appellant, on whether he had deputised for VP3. The board acknowledged that there might be cases where a board would not be in a position to decide on the objection without having received the necessary information from the member objected to. However, in the case at hand the board deemed it irrelevant for the question of impartiality whether the Chair had deputised for VP3 and refused the partiality objection. The provision of the

requested details would only have been necessary if the board in its composition at that time had considered that these details were relevant for the decision to be taken.

In **T 2440/16** of 17 May 2022 the board found that the respondent's belief that the comments submitted in the case at hand justified a suspicion of partiality was based on a clearly incorrect interpretation of the sense and purpose of the comments of the objected to member. There are no legal provisions placing formal constraints or limits on comments within the meaning of Art. 3(2) RPBA (see also **T 190/03**, OJ 2006, 502). Furthermore, it is not true that a rejected member always has to present comments. The sweeping assertion that an objected to member must comment on all internal and external facts put forward in the objection was therefore unsuitable to justify suspected partiality and thus inadmissible.

6. Suspected partiality of members of the Enlarged Board of Appeal

6.1. Referral proceedings under Article 112 EPC

6.1.1 Previous participation in cases as members of the boards of appeal

In **G 1/05** (OJ 2007, 362) a member of the Enlarged Board was objected to because he had been the Chair of a technical board which had given a prior decision related to the question of law referred to the Enlarged Board. The Enlarged Board held that to the extent that the participation in a referral of a board member who had already dealt with the matter as a member of a board of appeal was not excluded by the relevant provisions (Art. 1(2) RPEBA and Art. 2(3) BDS of the Enlarged Board), an objection of partiality could not be based on that very fact alone (see also **G 2/08** of 15 June 2009 and **R 12/09** of 3 December 2009). On the contrary, unless there were specific circumstances casting doubt on the member's ability to approach the parties' submissions with an open mind on a later occasion, there could not be any objectively justified, i.e. reasonable, suspicion of partiality against a member of the Enlarged Board. Moreover, if all members of the Enlarged Board having once taken part in a decision expressing a view on a point of law which was then referred to the Enlarged Board were to be excluded from taking part in that referral, it could become impossible to allocate the number of Enlarged Board members needed to conduct the case. The Enlarged Board noted that the situation could be viewed differently if there were deficiencies in the view expressed to such an extent that there was reason to believe that they were the result of a preconceived attitude. It would also have been different if a board member had pronounced on a matter to be decided with his or her participation in such outspoken, extreme or unbalanced terms, be it in the course of or outside the proceedings, that his or her ability to consider the arguments put forward by the parties with an open mind and without a preconceived attitude and to bring an objective judgment to bear on the issues before him or her, could be doubted.

In interlocutory decision **R 4/24** of 19 August 2024, the Enlarged Board noted that in a referral under Art. 112 EPC the Enlarged Board answered questions of law, while the application of the law in question to the facts of the appeal case rested exclusively with the competent board of appeal. Thus, the Enlarged Board was of the view that the fact

that the Chair in the petition for review case at issue had also been Chair in **G 2/21** (OJ 2023, A85), which was then applied in **T 116/18** of 28 July 2023 – against which decision the petition of review at issue had been filed – did not exclude the objected to Chair from taking part in said petition for review case. The Chair had not participated in the decision that was the subject of the petition for review and was therefore not excluded under Art. 2(6), second sentence, RPEBA, from acting as Chair in the petition for review case. The Enlarged Board acknowledged that **G 2/21** was binding for the decision under review; but pointed out that a decision by the Enlarged Board under Art. 112 EPC and the following final decision by the referring board were separate decisions. Moreover, it saw no other reasons, whether or not mentioned in Art. 24(1) EPC, for excluding the Chair from the review case at issue.

6.1.2 Previous involvement in the preparation of legislation

In **G 1/21** of 17 May 2021 the Chair of the Enlarged Board and members X and Y of the composition determined by the Chair to decide on the referral **G 1/21** were objected to on the basis of suspected partiality (Art. 24(3) EPC), based on the Chair's involvement, in his function of President of the BoA, in the preparation and enactment of Art. 15a RPBA, which dealt with the same topic as the referral. A further member of the panel determined by the Chair to deal with **G 1/21** (Z) asked the Enlarged Board in a composition under Art. 24(4) EPC to decide on his continued participation in the referral **G 1/21** on the basis that he was also involved in the preparation of Art. 15a RPBA.

The Enlarged Board explained that the fact that a judge had expressed an opinion on a legal issue that was to be decided upon in a case was not in itself and not always a ground for suspicion of partiality (see **G 3/08** and **G 2/08**). However, in the current case, the issue was not so much about the expression of an opinion on a legal issue but that the Chair of the Enlarged Board had in his capacity as President BoA performed legislative and managerial acts based on the view that oral proceedings by videoconference without consent of all the parties were compatible with Art. 116 EPC (the basis for the referral question). The Enlarged Board concluded that the concern that the Chair might have a bias towards answering the referred question in the positive in order to avoid the outcome that his own acts were not in compliance with Art. 116 EPC was therefore objectively justified. He was involved in all stages of the preparation of the legislation, which was at least indirectly under review in **G 1/21**, his involvement was direct and decisive; he initiated the proposal, presented it for adoption and approval by the competent organs; he steered the practice of the boards of appeal in this direction and communicated this practice to the public. The reasoning of the ECtHR in McGonnell v. the United Kingdom (8 February 2000 - 28488/95), that a direct involvement in the passage of legislation was likely to be sufficient to cast doubt on partiality, therefore seemed to apply a fortiori to the present case.

The Enlarged Board was not convinced by the arguments against X and Y, both members of the Presidium of the Boards of Appeal. It noted that the proposals for amending the RPBA had been discussed during a meeting of the Presidium, but that there did not appear to have been a vote on a negative or positive opinion. Their role in an advisory body could not be qualified as a direct involvement in the passage of legislation as was

the case for the Chair. Z was involved in the drafting of a proposal for Art. 15a RPBA, but unlike the Chair, did not play a formal role in the decision-making process leading to the adoption and approval of that provision. However, the Enlarged Board found that there may exist in the public eye an objectively justified concern that he, like the Chair, might be biased towards answering the referred question positively, because answering the question negatively would imply that he had been actively involved in the preparation of a proposal that was not compatible with Art. 116 EPC. The Enlarged Board thus decided that the Chair and Z should be replaced. It rejected the objection under Art. 24(3) EPC against X and Y.

6.1.3 Previous expressions of opinion on the legal issues to be decided

In **G 3/08** of 16 October 2009 the Enlarged Board noted that, according to established case law of the boards of appeal, of the Enlarged Board and also of national courts of member states, the mere fact that a board member (in the case in hand a member of the Enlarged Board) had expressed a view on the legal issue to be decided on a previous occasion, be it in a prior decision or in literature, be it in a prior position in the EPO or as an expert for external political institutions, could not lead to doubts as to impartiality.

6.2. Petition for review proceedings under Article 112a EPC

This chapter concerns partiality objections raised in petition for review proceedings against members of the Enlarged Board themselves. For decisions of the Enlarged Board on the alleged breach of Art. 24 EPC in appeal proceedings, see chapter V.B.4.1. "Article 112a(2)(a) EPC – alleged breach of Article 24 EPC". As to the replacement of board members after a petition for review has been held allowable, see chapter V.B.3.14.2 "Replacement of board members".

6.2.1 Previous participation in cases as members of the boards of appeal

In **R 12/09** of 3 December 2009 (see also **R 2/14** of 17 February 2015) the petitioner had objected to the Enlarged Board members, alleging that they inevitably had a personal interest owing to their capacity as members of a technical board or the Legal Board. The board observed that the legislator had consciously decided to allocate the task of hearing petitions for review to the Enlarged Board as a pre-existing body with appointed members and, when doing so, had been fully aware that those members were for the most part also experienced members of technical boards or the Legal Board. The legislator could thus only have intended that those members also be deployed in procedures under Art. 112a EPC. The legislator had demonstrated its intention that these members' dual function should not, by itself, constitute a reason for objecting to or excluding them when it came to performing this task. The objection was thus dismissed as inadmissible.

6.2.2 Article 24(3) EPC objection under Article 112a(2)(a) EPC

In **R 17/09** the petitioner raised an objection under Art. 112a(2)(a) and 24(3) EPC on the basis of a suspicion that the board's actions and decisions could be linked to the interests of multinational companies opposed to the petitioner's patent application. The only

evidence relied on for any such link was the board's use of the term "man in the street" of the petitioner. The Enlarged Board found that in English this term had no pejorative associations but was commonly used to describe an average citizen. It could see no support for the allegation that members of the board were influenced in their decision by any bias against the petitioner.

In **T 49/15** respondent 4 argued that the reasons for an objection referred to in Art. 24(3) EPC, and so the suspected partiality too, were relevant for the purposes of Art. 112a(2)(a) EPC, asserting in support of its position that the Enlarged Board had cited them in **R 17/09**. The board found that the respondent had overlooked that the Enlarged Board had rejected the petition for review under Art. 112a(2)(a) EPC in that case as clearly unallowable. That, in doing so, it had chosen to look at the merits of the objection under Art. 24(3) EPC did not mean that the reference in Art. 112a(2)(a) EPC to Art. 24(1) EPC could be interpreted as including Art. 24(3) EPC too.

In the decision under review in **R 3/16**, the petitioner argued that once an objection based on Art. 24(3) EPC had been raised, the member(s) objected to could not take part in the decision, whatsoever, be it on the admissibility or on the merits of the objection. The Enlarged Board noted that Art. 112a(2)(a) EPC foresaw the situation where a member of the board had taken part in the decision despite being excluded pursuant to a decision under Art. 24(4) EPC or in breach of Art. 24(1) EPC. The case in hand was not concerned with those two grounds since the members had not been excluded and no personal interest had been alleged. Therefore, by a mere application of the principles developed by the established case law of the Enlarged Board under Art. 112a EPC, the Enlarged Board held that if the alleged unlawfulness of the composition was not the consequence of a violation of the right to be heard or an omission of a request, this ground (an objection based on Art. 24(3) EPC) appeared to fall outside the scope of a review, since inter alia it was not on the list of grounds under Art. 112a EPC.

6.2.3 Expressions of preliminary opinions

In **R 2/12** of 26 September 2012 the objection of suspected partiality was derived exclusively from the communication by which the petitioner was informed of the Enlarged Board's provisional opinion on the petition. The Enlarged Board found it would be incompatible with an objective assessment of a case and with the principle of a fair trial in inter partes proceedings, if a board member could be 'deposed' on the ground that they did not opine in favour of a particular party right from the beginning of the proceedings. See also in this chapter III.J.5.3.1.

6.2.4 Suspected partiality of the Chair of the Enlarged Board of Appeal who at the same time was Vice-President of Directorate-General 3 (VP3)

Previously, the Boards of Appeal, together with their administrative services, were integrated into the organisational structure of the EPO as DG3 directed by a Vice-President (VP3). For the case law relevant to the previous structure of the Boards of Appeal, in particular **R 19/12** of 25 April 2014, **R 2/14** of 17 February 2015, and **R 8/13** of 20 March 2015, see CLB, 9th edn., 2019, III.J.6.2.3.

Following a structural reform in 2016 (see Annual Report of the EPO 2016), the Boards of Appeal are now organised as a separate unit directed by the President of the Boards of Appeal (see Supplementary publication 1, OJ 2017). The President of the Boards of Appeal also serves as the Chair of the Enlarged Board. For more information on the current structure of the Boards of Appeal, see chapter VII.1.1.

7. Legal restrictions for former board members

In accordance with Art. 20a(2) Service Regulations for permanent and other employees of the EPO (January 2025 version), a member of the boards or former member of the boards intending to engage in an occupational activity, whether gainful or not, within two years of leaving the service shall inform the Administrative Council thereof. If that activity is related to the work they carried out during the last three years of their service and could lead to a conflict with the integrity of the EPO's appeal system, the Administrative Council may, having regard to their interests and to those of the EPO's appeal system, either forbid them from undertaking it or give its approval subject to any conditions it thinks fit.

In **G 2/94** (OJ 1996, 401) the Enlarged Board noted that there was a potential conflict between what might be seen as a right of former board of appeal members to seek subsequent employment on the basis of their special knowledge by making oral submissions during proceedings before the EPO, and the need for proceedings before the EPO to be conducted free from any suspicion of partiality. The public interest in the proper conduct of proceedings before the EPO had to prevail over the personal interest of former board of appeal members wishing to make oral submissions on behalf of parties to such proceedings. The Enlarged Board found that, in the absence of specific legislation, the point in time following the termination of a former member's appointment to the boards of appeal after which he or she may make oral submissions in proceedings before the boards of appeal was a matter within the judicial discretion of the boards of appeal. The Enlarged Board held that three years should normally have elapsed before the former member should be given permission to make oral submissions as an accompanying person. See also chapter III.V.5.3. "Oral submissions by former members of the boards of appeal".

In **T 585/06** the board noted that the former member of the boards of appeal was no longer an EPO employee when he attended the oral proceedings. By virtue of the fundamental principle of freedom to exercise a profession, he was in principle not prevented from working as a consultant in the field of patent law. He had not acted as an authorised representative, and had not addressed the opposition division. This amounted to an important difference from the facts of case **G 2/94**, where a former member of the boards of appeal had presented his case before his former colleagues. In the case at issue, the former member had given only hints by whispering to the authorised representative, who had been absolutely free to accept them or not, but had not made any intervention of his own motion. The appellant's representative had agreed at the beginning of the oral proceedings to his sitting beside and assisting the respondent's representative. The request for reimbursement of the appeal fee was thus refused.

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1. Composition of the competent departments of first instance

Article 18(2) and 19(2) EPC respectively govern the composition of examining divisions (see in this chapter III.K.1.2.) and opposition divisions (see in this chapter III.K.1.3.). Both examining and opposition divisions can add a legally qualified member to their number where they deem this to be necessary. General comments on changes in their composition appear in the next section (III.K.1.1.).

1.1. General comments on changes in composition of the competent departments of first instance

In **T 390/86** (OJ 1989, 30) the board held that a decision given orally at the oral proceedings must be written up on behalf of – and represent the views of – the members appointed to decide the proceedings. The written reasons for a decision delivered during oral proceedings can only be signed by members of the deciding body who took part in the oral proceedings. The same principle applies if between the orally delivered decision and the written decision proceedings in accordance with R. 58(4) EPC 1973 have taken place. If the written decision is signed by persons who did not constitute the opposition division during the oral proceedings, the decision is invalid. In **T 2020/20** the board specified that it was irrelevant to the finding of a substantial procedural violation that the examining division in its former composition had not announced its decision at the oral proceedings (see also **T 862/98**).

In **T 1652/08** the board held that where the change in the composition of the opposition division occurs **prior** to the oral proceedings, this is not by itself a breach of the right to a fair hearing (see also **T 2365/11**, **T 2344/16** and **T 1090/18**). Similarly, the board in **T 160/09** read **T 390/86** to mean that it did not prohibit the composition being changed.

There was nothing to preclude changing the composition of an examining division, nor was the EPO required to follow a particular procedure to do this. In **T 1207/09** the board went along with this reading of **T 390/86**, concluding that it could not be construed as prohibiting a change in the examining division's original composition prior to oral proceedings.

In **T 2348/19** the board held that if a member of the department of first instance, who participated in the oral proceedings before that department, is unable to act at the time the reasoned decision is to be issued, for example due to death or a longer lasting illness, one of the other members may sign on behalf of the incapacitated member. However, in such a situation, a written explanation as to why one member is signing on behalf of another must be provided. In the absence of such an explanation, the contravention of R. 113(1) EPC constitutes a substantial procedural violation. See also **T 243/87** in this chapter III.K.1.3.2.

1.2. Examining division

Art. 18(2) EPC stipulates that an examining division must consist of three technically qualified examiners. If the examining division considers that the nature of the decision so requires, it shall be enlarged by the addition of a legally qualified examiner.

In **T 714/92** the board held that the taking of a decision on a date on which the examining division no longer existed in its stated composition, without the examining division ensuring that it be apparent from the part of the file open to public inspection that the member who left the examining division had agreed the text of the decision before leaving, had to be considered as a substantial procedural violation. Thus the impugned decision was set aside as void ab initio and without legal effect.

In **T 2020/20** the composition of the examining division had changed between the oral proceedings and signature of the decision under appeal. The board concluded that the examining division in the composition issuing the decision under appeal had committed a substantial procedural violation by not offering new oral proceedings to the appellant. The decision under appeal was set aside as void ab initio and without any legal effect.

In **T 160/09** the board found it permissible for the second examiner at oral proceedings to be different from the one who signed the summons. This was not at all comparable to the situation in **T 390/86** (see in this chapter III.K.1.3.2), where the written decision had not been signed by those members of the opposition division who had delivered the decision during oral proceedings. There is no prohibition on changing the composition of a division, nor is the EPO required to follow a particular procedure to do this.

1.3. Opposition division

Art. 19(2) EPC stipulates that an opposition division must consist of three technically qualified examiners, at least two of whom must not have taken part in the proceedings for grant of the patent to which the opposition relates. An examiner who has taken part in the proceedings for grant of the patent may not be Chair of the opposition division.

1.3.1 Enlargement of the opposition division by addition of a legal member

Under Art. 19(2), fifth sentence, EPC, the opposition division can enlarge its composition by adding a legally qualified member where it deems this to be necessary.

In **T 990/06** the board held that the opposition division's composition should be clear and transparent at all crucial stages of the proceedings so that the parties could verify compliance with Art. 19(2) EPC 1973 and check that the division members were impartial in keeping with **G 5/91** (OJ 1992, 617). It is essential that the opposition division's composition is lawful. Any doubt surrounding this casts doubt on the lawfulness of the decision. In the case in question, there were discrepancies between the documents issued to the parties and an internal instruction. Although the division had apparently been first enlarged and then reduced again in size, there was no information about either of these measures on file, so the board was unable to verify whether the decision given at the oral proceedings had been made by a lawfully composed opposition division and whether the written reasons for the decision had been issued by the same panel. The procedure for enlargement of the opposition division by addition of a legally qualified member under Art. 19(2) EPC 1973 – or their later withdrawal – must be verifiable.

In **T 1254/11** the board held that an opposition division enlarged to four members pursuant to Art. 19(2) EPC 1973 could in principle be reduced again to three members. It was for the four-person panel to decide on the reduction. In this respect the board concurred with **T 990/06**. In deciding on the reduction, the opposition division consisting of four members must properly exercise its discretion. The board assumed arguendo that the fact that neither a decision to enlarge nor a decision to reduce the opposition division had been added to the publicly available file and the fact that the appointment of the new Chair could only be traced from the internal register of the EPO both constituted fundamental deficiencies of the proceedings before the opposition division. However, unlike in **T 990/06**, it was possible to determine from the file that the division had been lawfully enlarged and, at a later stage, lawfully reduced again.

In **T 1088/11** the board held that in principle, an opposition division may set aside a decision to enlarge its composition. However, where an opposition division has been enlarged according to Art. 19(2) EPC, but the case is nevertheless decided in a composition of three members, there should be clear evidence on the public file that a decision to set aside enlargement was taken by the opposition division in its four member composition prior to the final decision.

1.3.2 Change in composition of opposition division during opposition proceedings

In **T 390/86** (OJ 1989, 30) all three members of the opposition division were changed between the oral and written decision. The board held that a decision must at least be written on behalf of and represent the views of the members appointed to decide the proceedings, and must bear signatures which indicate this (see also **T 243/87**, **T 960/94** and **T 2076/11**).

In **T 243/87** the board of appeal developed the principles established in **T 390/86**, further holding that even though only **one** member of the opposition division had been replaced after the oral proceedings, there was no longer any guarantee that the reasoned decision signed subsequently accurately reflected the point of view of all three members who had taken part in the oral proceedings. The situation in which one of the appointed members was incapacitated (e.g. through illness) was quite different; in such cases one of them could sign on behalf of the member unable to do so after checking that the reasoned written decision represented the point of view of all the members who had taken part in the oral proceedings. This was followed in other cases where only one member of the opposition division had changed between the oral and written decision; see e.g. **T 960/94**, **T 862/98**, **T 2175/16** and **T 2348/19**.

In **T 900/02** a number of procedural irregularities had occurred after the oral proceedings before the opposition division, including a delay of over three years before despatch of the written decision (in fact, two decisions were issued, in different compositions). The board followed **T 390/86** and **T 862/98** and held that if for any reason, (even quite acceptable and understandable reasons such as illness or retirement), the same three members were not available, then the parties were to be offered new oral proceedings.

1.3.3 Composition of opposition division includes those who have taken part in proceedings for grant contrary to Art. 19(2) EPC

Art. 19(2), first and second sentence, EPC refers to the participation of members of the opposition division at **every stage** of the grant proceedings, not only to their involvement in the final decision (**T 476/95**). If only one examiner took part in the prior proceedings, that examiner may not be Chair in the subsequent opposition proceedings under Art. 19(2) EPC (**T 939/91**). It is established case law (**T 251/88**, **T 939/91**, **T 382/92**, **T 476/95**, **T 838/02**, **T 825/08**, **T 1349/10**, **T 1700/10**, **T 234/11**) that an improper composition of the opposition division is a substantial procedural violation.

In **T 1788/14** the opposition division's decision had been taken in a composition that differed from the examining division only in that a new Chair had been appointed. The board regarded this to be a substantial procedural violation.

In **T 382/92** the board held that in cases of a breach of Art. 19(2) EPC it follows from the lack of jurisdiction of the department of first instance that the impugned decision is void ab initio (see also **J 38/97**).

1.3.4 Remittal after breach of Article 19(2) EPC

Where the composition of an opposition division is in breach of Art. 19(2) EPC, this is deemed to be a substantial procedural violation that can warrant reimbursement of the appeal fee and remittal of the case (established case law, see **T 251/88**, **T 939/91**, **T 382/92**, **T 476/95**, **T 838/02**, **T 825/08**, **T 1349/10**, **T 1700/10**, **T 285/11**, **T 135/12**).

In **T 838/02** the Chair of the opposition division ought to have been excluded as he had participated in the grant proceedings, yet he had been in place when the patent was

revoked. The board held that it was immaterial for the purposes of Art. 19(2) EPC 1973 whether or not the opposition division had actually been aware of the circumstances justifying exclusion. If the composition of the opposition division was contrary to Art. 19(2) EPC 1973, the parties should be given the opportunity to comment before the board decided on the remittal of the case.

Although the facts in **T 1349/10** were similar, the board distinguished the situation from that in **T 838/02**, as the patent had been maintained in the opposition proceedings, which meant that the public too was affected by the procedurally flawed decision. The board held that violations of Art. 19(2) EPC 1973 should lead to a remittal regardless of the parties' position at least in situations where third parties were affected by the outcome of the defective first-instance proceedings.

In **T 234/11** the dossier showed that two members of the opposition division had taken part in the grant proceedings. The board ruled that the wording of Art. 19(2) EPC left no room for discretion. Nor did the conclusion reached in **T 838/02** apply because here the issue was the patent's maintenance in amended form and, besides, the parties to the proceedings had conflicting interests: one sought remittal to the opposition division; the others did not want that.

2. Date of decision

2.1. Entry into force of decisions

The Enlarged Board in **G 12/91** (OJ 1994, 285) distinguished between decisions taken after the closure of the debate in oral proceedings and decisions taken following written proceedings. Where oral proceedings are held, the decision may be given orally. The decision becomes effective by virtue of its being pronounced. The equivalent of that point in time in written proceedings is the moment the decision is notified. Once it has been pronounced and, in the case of written proceedings, notified, the decision enters into force and cannot be amended, even by the department that issued it. A decision may only be revoked by the department that issued it by way of an interlocutory revision under Art. 109 EPC 1973 if one of the parties has filed an admissible and well-founded appeal.

2.2. Completion of the internal decision-making process

According to **G 12/91** (OJ 1994, 285) the point in time at which a decision enters into force, i.e. the moment it is pronounced or notified, is not the last moment at which parties could still submit observations. This had to be done **at an earlier point** in the proceedings to allow the decision-making department time to deliberate and then issue its decision based on the parties' submissions. Where oral proceedings are held, this moment is the closing of the debate, this point being fixed by the decision-making department – having first heard the parties' submissions – to allow itself time to consider its decision (see **J 42/89**; **T 762/90** and **T 595/90**, OJ 1994, 695). In the case of decisions taken following **written** proceedings, the point in time at which the internal decision-making process was completed was the date on which the formalities section handed over the date-stamped, post-dated decision to the EPO postal service. This marks the completion of proceedings

before the decision-making department, which can no longer amend its decision. This point in time should be clearly indicated in the decision.

In **T 2573/11** the board decided that if it was clearly indicated in the decision on which date the formalities section handed the decision over to the EPO postal service, this date was thus the date on which written proceedings before the decision-making department were completed.

In **T 798/95** the board held that a request for amendment filed after the completion of the proceedings up to grant before an examining division was to be disregarded even if the filing of the request and the completion of the proceedings occurred on the same date.

On to the completion of the internal decision-making process where oral proceedings are held, see also chapter III.C.8.9. "Closing and reopening the debate".

2.3. Date European patent takes effect and jurisdiction after pendency

Under Art. 97(3) EPC the decision to grant a European patent takes effect on the date on which the mention of the grant is published in the European Patent Bulletin (see also chapter IV.B.3.10. "Date on which a decision to grant a European patent takes effect"). A request under R. 139 EPC for corrections in the description or claims can only be filed during the pendency of application or opposition proceedings. In **J 42/92** the Legal Board held that there was no reason why, once no application or opposition proceedings were pending before the EPO, decisions on the question of corrections should not fall within the sole jurisdiction of the national courts or other authorities responsible for proceedings in which this question might arise (see also **T 777/97**).

3. Form of decisions

R. 111 EPC governs the form of decisions issued by the EPO. It must first of all be established whether a "decision" – as distinct from e.g. notices and communications (see in this chapter III.K.3.1.) – has in fact been taken. Decisions are to be put in writing – even those that have been announced at oral proceedings – and accompanied by a communication pointing out the possibility of appeal (see in this chapter III.K.3.2.). R. 113 EPC also stipulates that a signature is required, although this may be replaced by a seal in the case of computer-generated decisions (see in this chapter III.K.3.3.). Under R. 111(2) EPC, appealable decisions must be reasoned (see in this chapter III.K.3.4.). Decisions must also be notified to the parties (see chapter III.S.).

3.1. When is there a decision within the meaning of Rule 111 EPC?

On when a decision is open to appeal before the boards, see chapter V.A.2.2.2 "Whether there has been a decision". On the interpretation of the term "decision" within the meaning of Art. 113(1) EPC see chapter III.B.2.2. "Decisions within the meaning of Article 113(1) EPC" and on its interpretation within the meaning of Art. 112a(1) EPC see chapter V.B.3.4.2 "Article 112a(1) EPC – Whether there has been a decision".

Determining whether there is a decision depends on the **substance** of the document content and not its **form** (**J 8/81**, OJ 1982, 10; **J 26/87**, OJ 1989, 329; **J 43/92**; **J 14/07**; **T 222/85**, OJ 1988, 128; **T 713/02**; **T 165/07**). The criterion of substance has to be assessed in its procedural context (see **T 713/02**, OJ 2006, 267). The decisive question was whether the document at issue, when objectively interpreted in its context, could have been understood by its addressees as a final, i.e. not merely preliminary, and binding determination of substantive or procedural issues by the competent organ of the EPO (**T 165/07**). A decision of the EPO may be, but ought not to be, given in a document which in form appears to be merely a communication (**J 8/81**, OJ 1982, 10).

In **T 1093/05** (OJ 2008, 430) the board expressly deviated from the view held in **T 971/06** that a flawed decision was void. A flawed decision could be set aside only following an admissible and allowable appeal (as in **G 4/91**, OJ 1993, 707; **G 12/91**, OJ 1994, 285; **T 222/85**; **T 371/92**, OJ 1995, 324; **T 1081/02**; **T 830/03**).

In **T 222/85** (OJ 1988, 128) the board noted that the contents of a "communication" never constituted a "decision". This distinction was important, because only a "decision" could be the subject of an appeal - see Art. 106(1) EPC. In the case at issue the communication only represented a preliminary view, on an ex parte basis, and was not binding upon the department of the EPO which sent it. In contrast, the contents of a "decision" were always final and binding in relation to the department of the EPO which issued it, and could only be challenged by way of appeal (see also **T 1456/22**). See, however, **R 3/22** in chapter V.B.3.4.2.

In **T 999/93** the annex to the minutes of the oral proceedings had been sent, but not the decision itself. The annex – although containing reasons – did not validly fulfil the function of a decision in writing since it did not bear any name or signature. If a decision of a particular division is to be legally valid, it must have been written on behalf of and represent the views of the members who were appointed to that division to decide the issues forming the subject of the decision, and it must bear signatures which indicate this (see **T 390/86**, OJ 1989, 30).

In **J 14/07** the Legal Board held that the communication refusing the request for reimbursement of 50% of the examination fee constituted a decision within the meaning of Art. 106(1) EPC. The mere indication of the name of the formalities officer without any signature, but which had been replaced by a seal, complied with the requirements of the then current R. 70(2), first sentence, EPC 1973 because the communication was produced by using a computer. The formalities officer was also competent to decide on the request for reimbursement of the fee; see R. 9(2) EPC 1973 in conjunction with the notice from the Vice-President of DG 2 of the EPO dated 28 April 1999 concerning the entrustment to non-examining staff of certain duties normally the responsibility of the examining or opposition divisions, OJ 1999, 504. See now decisions of the President of the EPO (OJ 2014, A6, OJ 2015, A104 and OJ 2020, A80) and notice from the EPO (OJ 2014, A32).

3.1.1 Cases involving two decisions

In **T 830/03** the opposition division had issued a second written decision intended to supersede a first written decision already sent. The board noted that the need for legal certainty required a presumption of validity in favour of a written decision which was notified to the parties by an opposition division in accordance with the formal requirements of the EPC 1973, in particular R. 68 to R. 70 EPC 1973 (now R. 111 to 113 EPC). Once the decision was pronounced and the (first) written decision, in the case at issue, notified to the parties, the opposition division was bound by it even if it considered its decision not to "have any legal effect" (see **T 371/92**, OJ 1995, 324). The decision could be set aside only by the second instance on the condition that an allowable appeal was filed under Art. 106 EPC 1973 (see also **T 1093/05**). With the filing of the first notice of appeal, the power to deal with the issues involved in this case passed from the department of first instance to the appeal instance (devolutive effect of the appeal). All actions carried out by the opposition division after the notification of the (first) decision, and a fortiori after the filing of the first appeal, were ultra vires and thus had no legal effect.

In **T 1257/08** the board, referring to **T 830/03** stated that under the presumption of legal validity, the first written decision notified constituted the opposition division's only legally valid written decision. The opposition division was bound by it and could not itself set it aside. Furthermore, only the first written decision as legally valid decision was appealable.

In **T 1972/13** the board held that the second decision issued by the examining division, refusing the applicant's request for refunding an additional search fee, was null and void. It held that it is not relevant whether or not a separate appeal against the second decision was filed, given that an appeal against a legally void decision could logically have no legal effect.

3.1.2 Inconsistency between oral and written decisions

In **T 425/97** the sole ground of appeal was the inconsistency existing between the written decision and the form of the patent held to be patentable by the opposition division at the oral proceedings. The board observed that R. 68(1) EPC 1973 (now R. 111(1) EPC) laid down that the decision announced at the oral proceedings and the written one had to be the same and so any discrepancy between the two was a procedural flaw (see also **T 318/01**, **T 1590/06** and **T 1698/06**).

In **T 850/95** (OJ 1997, 152) the board held that in examination proceedings, where the decision to grant the patent referred to the documents approved by the applicant under R. 51(4) EPC 1973 (now R. 71(3) EPC) these documents became an integral part of that decision.

In **T 740/00** the board found that in opposition proceedings the documents referred to in the decision to maintain the patent in amended form also formed an integral part of that decision. Differences between the decision pronounced at the oral proceedings and the written decision were not mistakes which could be corrected under R. 89 EPC 1973, but

amounted to a substantial procedural violation requiring immediate remittal of the case to the department of first instance.

3.2. Pointing out the right to appeal in accordance with Rule 111(2) EPC

Under R. 111(2) EPC appealable EPO decisions must be accompanied by a communication pointing out the possibility of appeal and drawing the attention of the parties to Art. 106 to 108 EPC, which specify how to file appeals.

However, the parties cannot invoke any omission to communicate this possibility; see R. 111(2), second sentence, EPC. According to **T 42/84** (OJ 1988, 251), the EPO's failure to enclose the text of Art. 106 to 108 EPC with the decision neither invalidated the decision nor amounted to a substantial procedural violation. See also **T 231/99** and **T 493/08**.

3.3. Signatures on a decision under Rule 113 EPC

Under R. 113 EPC EPO decisions must be signed by, and state the name of, the employee responsible. Under R. 113(2) EPC a seal may replace the signature when a decision is produced using a computer (see also OJ 2020, A37). The requirements for board decisions are set out in R. 102 EPC.

In **J 16/17** the Legal Board held that the requirement laid down in R. 113(1) EPC, according to which decisions from the European Patent Office must be signed by and state the name of the employee responsible, is not just a mere formality but an essential procedural step in the decision-taking process. The name and the signature serve to identify the decision's authors and express that they unconditionally assume responsibility for its content (see also **T 3085/19**). This requirement is aimed at preventing arbitrariness and abuse and ensuring that it can be verified that the competent body has taken the decision. It therefore constitutes an embodiment of the rule of law. In **T 572/19** the board added that the purpose of the signature requirement under R. 113(1) EPC was only achieved if there was an unbroken chain of manifest personal responsibility, taken by each member of the decision-making body who was assigned to the case, throughout the decision-making process, including for the written decision.

In **T 989/19** the board held that, where the cover page of the examining division's decision had not been signed by all the division's members, this amounted to a substantial procedural violation and the decision was invalid. Under R. 113(1) EPC, EPO decisions had to be signed by the employee responsible and state their name. Since, in addition, Art. 18(2) EPC stipulated that examining divisions consisted of three examiners, the signatures of all three of those examiners were required.

3.3.1 Decisions to be signed

R. 113(1) EPC says that decisions, summonses, notices and communications from the EPO must be signed by, and state the name of, the employee responsible. If a document referred to in R. 113(1) EPC is produced by the employee responsible using a computer,

the EPO seal may replace the signature. If it is produced automatically by a computer, the employee's name may also be dispensed with (R. 113(2) EPC).

In **T 390/86** the board decided that if the decision of a particular division was to be legally valid it had to bear the signatures of the members who had been appointed to that division to decide the issue.

Referring inter alia to **J 16/17** and **T 390/86**, the board in **T 572/19** held that the jurisprudence of the boards of appeal indicated that the written decision, including the substantiation, was the object of the signature requirement. There was, then, no doubt that the signature requirement under R. 113(1) EPC applied to the written decision, including the substantiation, and not only to the outcome that might be announced during oral proceedings.

3.3.2 Examples of invalid or missing signatures

a) Decision announced in oral proceedings

The written reasons for a decision delivered during oral proceedings can only be signed by members of the deciding body who took part in the oral proceedings. The same principle applies if between the orally delivered decision and the written decision proceedings in accordance with R. 58(4) EPC 1973 (R. 82(1) EPC) have taken place (**T 390/86**, OJ 1989, 30). In **T 390/86** the board also stated that in a case where a final substantive decision has been given orally by an opposition division during oral proceedings, if the subsequent written decision giving the reasons for such oral substantive decision is signed by persons who did not constitute the opposition division during the oral proceedings, the decision is invalid.

In **T 243/87** the board declared a decision to be null and void where one of the three signatures was provided by a member who had not attended the oral proceedings.

In **T 3085/19** the board found that the missing signature of the legally qualified member on page 2 of EPO Form 2009.2 and on EPO Form 2906 gave the impression that the decision had not been consented to by all the members responsible for the decision. Therefore, it could not be concluded that all members who had participated in the oral proceedings had authorised the decision. This was qualified by the board as a substantial procedural violation.

Similarly, in **T 289/23** the board considered the requirement pursuant to R. 113(1) EPC not complied with since the decision had not been signed by the legally qualified member. Moreover, there was no indication that this member had been for some reason unable to act at the time the written decision had had to be issued, and in any event none of the other members had signed or authenticated the decision on their behalf. This was considered a substantial procedural violation.

In **T 572/19** the board found that the missing signature could not be remedied under R. 140 EPC, with the Chair belatedly signing the EPO Form 2339 on behalf of the legally qualified

member, since the mistake was not an obvious one within the meaning of R. 140 EPC. The board considered the missing signature a substantial procedural violation, and the appealed decision invalid.

b) Decision not announced in oral proceedings

The decision under review in **T 2020/20** had been signed by persons who did not constitute the examining division holding the oral proceedings. The board declared the decision to be null and void. It argued inter alia that it was irrelevant that the new Chair, after having studied the written file, had arrived at the same opinion as that expressed in the minutes of the oral proceedings. Furthermore, the board held that it was also irrelevant to the finding of a substantial procedural violation that the examining division in its former composition had not announced its decision in the oral proceedings (see also **T 862/98**).

c) Director's signature in place of examiner's signature

In **T 211/05** the board held that a director's signature purporting to be on behalf of the second examiner was invalid because nothing in the EPC 1973 authorised a director to sign on behalf of a member of an examining division to which the director did not belong (see also **T 1033/16**).

3.3.3 Examples of valid signatures

a) Computer-generated communications

Under R. 113(2) EPC the signature can be replaced by a seal when a computer is used to produce the decision.

In **T 225/96**, the board noted that the forms accompanying the decisions are never signed, because they are computer-generated and therefore, under R. 70(2) EPC 1973 (R. 113(2) EPC), a seal may replace the signature.

In **J 14/07** a communication produced using a computer in which a request for reimbursement of 50% of the examination fee had been refused was found to constitute a decision within the meaning of Art. 106(1) EPC. Since it indicated the name of the formalities officer responsible and bore a seal, it complied with the requirements of the then applicable R. 70(2) EPC 1973 (now R. 113(2) EPC).

b) Death of examiner between oral proceedings and written decision

In **T 1170/05** one of the examiners had died and so the decision of the first instance bore the signatures of only two of the three members of the division, the Chair signing on behalf of the deceased examiner. The Chair explicitly declared in a note that the written grounds reflected those which had been discussed during the deliberation of the examining division, and which had led to the decision announced at the end of the oral proceedings. This was held to comply with the case law of the boards of appeal, in particular, **T 243/87** (see in this chapter III.K.1.3.2); the decision was valid.

c) Decision in written proceedings

In **T 777/97**, only two of the members of the opposition division had signed the contested decision refusing a request for correction, one purporting to sign on behalf of the absent Chair. According to the board, decisions **T 390/86** and **T 243/87** (see in this chapter III.K.1.3.2) were not directly applicable, because the case in hand concerned a decision taken in a written procedure on the basis of the evidence on file, whereas those two cases had been concerned with the opposition divisions' composition during the oral proceedings at which the decision was announced, in connection with the requirement that the subsequent written decisions giving the reasons for those oral decisions be signed by the same members. The conclusions reached in **T 243/87** could nevertheless be applied by analogy. It went without saying that only those members who had taken the decision could decide on a request for its correction, but if one of the three members of the decision-making department was absent (here: the Chair), one of the others (here: the first examiner) could sign on that absent member's behalf.

d) Illegible signature

In **D 8/82** (OJ 1983, 378) the surname of the signature appeared only as a mark in which one could still discern the first letter and which was recognisably intended as a signature. The board held that it was valid since in several contracting states of the EPO there is no requirement that a signature be legible or recognisably composed of letters. It is enough that it serves to identify the signatory.

e) Draft decisions

In **T 225/96**, only the first examiner on the opposition division had signed the contested decision. The board sent the case back to the division for regularisation, but the three non-signing members replied that they were not prepared to put their names to a text issued without their knowledge or approval. The board observed that, in general, the decision as notified to the parties was presumed to be authentic. See also **T 837/01**, where it was clear that the document sent to the parties was merely a draft. This amounted in the board's view to a substantial procedural violation. Had the signatures simply been missing, this could have been corrected under R. 89 EPC 1973 (now R. 140 EPC).

3.4. Reasons for the decision

R. 111(2) EPC expressly stipulates that appealable decisions are to be reasoned.

3.4.1 Purpose of the duty to provide reasons

R. 111(2) EPC (formerly R. 68(2) EPC 1973) embodies the general principle of law that decisions must be reasoned and states: "Decisions of the European Patent Office which are open to appeal shall be reasoned …". This principle is intended to ensure fairness between the EPO and parties to proceedings and enable the decision to be reviewed on appeal (**T 70/02**). The EPO can only properly issue a decision against a party if that decision is adequately reasoned (**T 652/97**). In **T 292/90** the board found that the

reasoning given in a decision open to appeal has to enable the appellants and the board of appeal to examine whether the decision was justified or not (see also **T 1532/21**, **T 1655/21**).

In **T 1713/20** the board specified that the requirement to provide reasons for appealable decisions ensured that the party adversely affected by the decision is enabled to understand whether the decision was justified and to decide whether to lodge an appeal. It likewise ensured that the board of appeal, whose primary task it is to review the decision under appeal in a judicial manner, is enabled to understand the conclusions on which the decision is based and why they have been drawn. On the basis of the reasoning given in the decision under appeal, the board assessed whether the conclusions drawn by the department which had taken the decision were correct (see also **T 66/20**). In **T 265/03**, and in **T 1356/05** and **T 1360/05**, both referring to **T 278/00** (OJ 2003, 546), the boards held that also from the point of view of the practical functioning of the system envisaged in the EPC, they could not examine the appeal in the absence of a reasoned decision.

3.4.2 Right to be heard – right to have submissions taken into consideration

The right to be heard is enshrined in Art. 113 EPC and reads: "The decisions of the European Patent Office may only be based on grounds or evidence on which the parties concerned have had an opportunity to present their comments." The boards refer to this right in their case law on the duty to provide reasons under R. 111(2) EPC (see also, with regard to Art. 113 EPC, chapter III.B.2.5. "Consideration of the parties' arguments, requests, evidence and other submissions" and, with regard to Art. 112a EPC, chapter V.B.4.3.11 "Consideration of the parties' arguments in the written decision").

The right to be heard under Art. 113(1) EPC is not just a right to present comments but also to have those comments **duly considered** (see, e.g. **R 8/15**; **J 7/82**, OJ 1982, 391; **T 508/01**; **T 763/04**; **T 1123/04**; **T 246/08**; **T 1492/18** and **T 431/21**). The comments presented must be considered in the ensuing decision (**J 7/82**, OJ 1982, 391; and **T 246/08**).

Insufficient reasoning of a decision under R. 111(2) EPC may amount to a violation of the right to be heard under Art. 113(1) EPC (see e.g. **T 66/20** and **T 1713/20**). By providing adequate reasoning, the deciding body can demonstrate that it adhered to the requirements of Art. 113(1) EPC (see e.g. **T 66/20** and **T 1713/20**). Accordingly, the board in **T 363/22** held that since at least for the objection relating to lack of novelty of the subject-matter of claim 1 as granted with respect to the disclosure of document D12 the decision was insufficiently reasoned due to no mention of the appellant's arguments, it could not be determined whether such arguments had been duly considered. The board in **T 1713/20** found that since the examining division's decision had not been sufficiently reasoned with regard to inventive step and inventive step had been the sole reason on which the decision to refuse the application had been based, this lack of reasoning amounted to a violation of Art. 113(1) EPC. The board in **T 1094/20** found the contested decision to be insufficiently reasoned (R. 111(2) EPC) because important arguments put forward by the patent proprietor had been disregarded, which was an infringement of its right to be heard (Art. 113(1) EPC).

In **R 8/15** the Enlarged Board held that Art. 113(1) EPC implies that decisions of the EPO boards of appeal should adequately state the reasons on which they are based in order to show that the parties were heard. A party must be able to examine whether, in its view, the board has afforded it the right to be heard in order to be in a position to decide on whether or not to file a petition under Art. 112a(2) (c) EPC. However, Art. 113(1) EPC must be interpreted more narrowly than R. 102(g) EPC which requires a board to give reasons for its decision, but infringement thereof is not as such a ground for review. In other words: for the purpose of compliance with the right to be heard, reasons may be incomplete, but as long as they allow the conclusion to be drawn that the board, in the course of the appeal proceedings, substantively assessed a certain point arising in the procedure that it found to be relevant, there is no violation of Art. 113(1) EPC. With reference to **R 8/15**, the Enlarged Board expressed the view in **R 10/18** that it was to be presumed that a board took account of a party's submissions that it did not address in the reasons for its decision, meaning that it, in a first step, took note of them and, in a second step, considered them, i.e. assessed whether they were relevant and, if so, whether they were correct. However, the Enlarged Board admitted that an exception to this presumption may have to be made if there are indications that may result in its rebuttal, e.g. if a board does not address in the reasons for its decision submissions by a party that, on an objective basis, are decisive for the outcome of the case, or dismisses such submissions without assessing them as to their correctness. In analogy to Catchword 2 of **R 10/18**, the board considered in **T 1550/18** that a department of first instance was presumed to have taken into account a party's submissions that it did not address in the reasons for its decision, meaning that it, first, took note of them and, second, considered them, i.e. assessed whether they were relevant and, if so, whether they were correct. The board added that an exception may apply if there are indications to the contrary, e.g. if a department of first instance does not address in the reasons for its decision submissions by a party that, on an objective basis, are decisive for the outcome of the case. See also chapters III.B.2.5. "Consideration of the parties' arguments, requests, evidence and other submissions" and V.B.4.3.11 "Consideration of the parties' arguments in the written decision".

In **T 1123/04** the board observed that the opportunity to present comments and arguments guaranteed by Art. 113(1) EPC is a fundamental principle of the examination, opposition and appeal procedures and cited the finding in **T 508/01** that this is not just a right to present comments but also to have those comments duly considered (see also **T 2915/19**).

In **T 246/08** the board found that it had to be clear from the reasons that the core arguments had been addressed in substance in arriving at the decision (see also **T 363/22**). The decision had to show that all potentially refutative arguments adduced by a party were actually refutable (see also **T 337/17**, **T 1655/21**). The board cited **T 763/04** and said that merely repeating the parties' submissions was not enough. The board in **T 1997/08** ruled that comments received in response to communications had to be taken into consideration too. On the same note, the board in **T 1997/21** found that it was not apparent from the contested decision what view the examination division had taken of the arguments the applicant had submitted after the communication under Art. 94(3) EPC had been issued. As a result, neither the applicant nor the board was able to ascertain why the examining division had found the arguments unconvincing. That was not in keeping with the duty to give reasons for decisions and infringed the applicant's right to be heard.

In **T 420/86**, for example, it was found that the opposition division had based its decision on factors on which the parties had been unable to comment because it had only emerged in the written reasons that a further document had been of central importance to the decision.

3.4.3 The requirement of sufficient reasoning

According to the case law of the boards of appeal (see e.g. **T 951/92**; **T 740/93**; **T 278/00**, OJ 2003, 546; **T 963/02**; **T 897/03**; **T 316/05**; **T 1182/05**; **T 1366/05**; **T 1709/06**; **T 2352/13**; **T 1655/21**; **T 1901/22**) a "reasoned" decision should deal with all important issues of dispute. The grounds upon which the decision was based and all decisive considerations in respect of the factual and legal aspects of the case must be discussed in detail in the decision.

A decision should discuss the facts, evidence and arguments which are essential to the decision in detail. It also has to contain the logical chain of reasoning which led to the relevant conclusion (see **T 292/90**, **T 278/00**, **T 316/05**, **T 1366/05**, **T 1612/07**, **T 1870/07**, **T 2366/11**, **T 66/20**, **T 1713/20**, **T 1532/21**, **T 1564/21**).

The requirement in R. 111(2) EPC of a decision being reasoned is not met if the decision merely contains statements that at best give rise to speculation about what the deciding body might have intended to express (**T 278/00**, **T 1713/20**, **T 1532/21**, **T 1564/21**). This requirement cannot be construed in such a way that in spite of the presence of unintelligible and therefore deficient reasoning, it is up to the board or the appellant to speculate as to what might be the intended meaning of it. Deficient reasoning cannot be compensated for by the speculative interpretation of the appellant or guess work by the board (**T 278/00**).

If a decision is merely reasoned by a reference to a preceding communication, the criteria of R. 111(2) EPC are only met if said communication itself fulfils these criteria (**T 963/02**, **T 897/03**, **T 1612/07**, **T 2366/11**). The decision under appeal must not leave it to the board and the appellant to speculate as to which of the reasons given in preceding communications might be essential to the decision to refuse the application (**T 963/02**, **T 897/03**, **T 2366/11**). See also in this chapter III.K.3.5.

The absence of reasoning satisfying the criteria of R. 111(2) EPC amounts to a substantial procedural violation requiring the decision under appeal to be set aside (**T 292/90**, **T 963/02**, **T 897/03**, **T 1366/05**, **T 1612/07**, **T 2366/11**).

In **T 70/02** the board held that reasoning does not mean that all the arguments submitted should be dealt with in detail, but it is a general principle of good faith and fair proceedings that reasoned decisions contain, in addition to the logical chain of facts and reasons on which every decision is based, at least some motivation on crucial points of dispute in this line of argumentation in so far as this is not already apparent from other reasons given.

In **T 2241/19** of 10 July 2024 the board emphasised that the final decision must address all those objections which could potentially have led to a different outcome in order to comply with the requirement of R. 111(2) EPC.

In **T 1123/04** the board was of the view that it was not enough if a board of appeal had to reconstruct or even speculate as to the possible reasons for a negative decision in the first-instance proceedings. As a rule, a decision within the meaning of R. 68(2) EPC 1973 should be complete and self-contained. The reasons were inadequate if the only arguments advanced by the examining division were unsubstantiated claims.

In **T 1622/21** the board found that neither were "all decisive considerations in respect of the factual and legal aspects of the case discussed in detail in the decision", nor did the appealed decision "contain the logical chain of reasoning which led" to the finding of the subject-matter of claim 1 lacking an inventive step. Insufficient reasoning in the appealed decision prevented the board from following the line of argument having led to the examining division's finding of lack of inventive step.

In **T 596/22** the board noted that it was not a requirement for a reasoned decision to give reasons as to why an opposition division deviated from its preliminary opinion.

3.4.4 Deficient reasons

a) Deficient reasons sufficient for the purposes of Rule 111(2) EPC?

According to established case law (**T 292/90**; **T 951/92**; **T 740/93**; **T 698/94**; **T 278/00**, OJ 2003, 546, **T 70/02**; **T 963/02**; **T 897/03**; **T 763/04**; **T 316/05**; **T 1366/05**; **T 1612/07**; **T 1870/07**; **T 1997/08**; **T 2366/11** and **T 1787/16**), a decision should consider the essential facts, evidence and arguments in detail and contain the logical chain of reasoning which led to the conclusion drawn.

However there are isolated decisions where deficient reasons have been treated as being sufficient as long as they amounted to some form of reasoning at all. In **T 856/91** the board regarded incomplete and poor reasoning as being sufficient for the purposes of R. 68(2) EPC 1973. In **T 1231/03**, it was decided that the contested decision contained an assessment of the main points in dispute and was therefore sufficiently reasoned. The decision's defects in terms of its content (incoherent line of argument, inaccurate formulation of the technical problem and allegedly erroneous assessments) were not an infringement of R. 68(2) EPC 1973 in this case. In **T 647/93** (OJ 1995, 132) the board found that the reasons cited by the examining division in its refusal decision were somewhat "enigmatic" and without basis in the EPC 1973. However, even if those reasons were therefore ill-founded, this did not mean that the decision did not contain any at all within the meaning of R. 68(2) EPC 1973 or that there had been a substantial procedural violation. In **T 1621/21** the board considered the appealed decision seriously flawed because the examining division had neither made a clear division of the features of claim 1 into technical and non-technical features nor properly applied the problem-solution approach nor explained the reasons for not applying it. The board however expressed the

view that, despite serious deficiencies in the examining division's reasoning, the decision could not be considered as not reasoned for the purposes of R. 111(2) EPC.

In **T 374/12** the board found that no consideration whatsoever had been given to a line of attack considered to be important by the opponent, as distinct from **T 856/91** and **T 1231/03**, where in each case there had been a gap in the reasoning. Also in **T 1747/06** the board distinguished the case before it from that in **T 856/91** because no reasons of any kind had been given. For other cases in which nothing akin to reasons were given, see in this chapter III.K.3.4.4c) "No reasons for decision".

In **T 2461/10** the board held that a distinction had to be made between cases where the examining division made an error of judgement on substantive issues and those where it based its decision without any legal basis on a non-existent ground for refusal. Only in the latter case was there a substantial procedural violation.

This distinction between acceptable but deficient reasoning and non-existent reasoning is not always made. The prevailing view in the case law is that the requirement of sufficient reasoning set out under chapter III.K.3.4.3 applies (**T 292/90**; **T 951/92**; **T 740/93**; **T 698/94**; **T 278/00**, OJ 2003, 546; **T 70/02**; **T 963/02**; **T 897/03**; **T 763/04**; **T 316/05**; **T 1366/05**; **T 1612/07**; **T 1870/07**; **T 1997/08** and **T 2366/11**).

b) Deficient reasoning insufficient for the purposes of Rule 111(2) EPC

In **T 70/02** the board found that simply stating "no convincing arguments have been found in your letter" in response to letters in which the objections put forward were exhaustively discussed by the applicant, did not comply with R. 68(2) EPC 1973. Whilst reasoning did not mean that all the arguments submitted should be dealt with in detail, it was a general principle of good faith and fair proceedings that reasoned decisions should contain at least some reasoning on crucial points of dispute, in order to give the party concerned a fair idea of why its submissions were not considered convincing and to enable it to base its grounds of appeal on relevant issues. In **T 1291/13** the decision did not deal with crucial (and, on the face of it, plausible) counter-arguments presented by the applicant. The board referred to **T 70/02** and held that the decision must contain at least some reasoning on crucial points of dispute, i.e. deal with at least the main counter-arguments presented by the applicant to be sufficiently reasoned (see also **T 2915/19**). In **T 2241/19** of 10 July 2024 the board concluded that the decision under appeal did not contain reasons concerning an objection raised by the opponent-appellant. This had adversely affected the opponent-appellant's right to a sufficiently reasoned decision (see also **T 363/22**).

In **T 1366/05** the board held that the mere summary of a party's submissions does not constitute sufficient reasoning. See also **T 431/21**.

In **T 534/08** it was not clear from the wording of the contested written decision why the opposition division had come to its conclusion, whether or not it had adopted the respondent's arguments entirely, or whether or not it had had its own objections. This too was regarded by the board as being insufficient.

In **T 548/08** the board found that unsubstantiated assertions were made by the examining division. Instead of a logical chain of reasoning as to why e.g. the claims were not supported by the description, the entire burden of analysis and argument was put on the applicant and the board, who were expected to work out for themselves the true nature of the examining division's objections.

In **T 405/12** the board held that a decision is not reasoned if it is not unambiguously clear from it (possibly after consulting other parts of the file) which request(s) – including any items such as claims, description pages and drawings – it is based on.

In **T 278/00** (OJ 2003, 546) the board decided that it was not up to it or the appellant to speculate as to what the intended meaning of unintelligible and therefore deficient reasoning might be. The reasoning of a decision under appeal had to be taken as it stood. The board had to be in a position to assess on the basis of the reasoning given in the decision under appeal whether the conclusion drawn by the department of first instance was justified or not. That requirement was not satisfied when the board was unable to decide which of the various inconsistent findings indicated in and justifying the decision under appeal were correct and which were false (see also **T 316/05**).

According to the board in **T 1029/20** the decision under review failed to clearly identify the features which had been considered disclosed in D1 and to explain how the division had arrived at the formulation of the objective technical problem. This made it impossible for the reader to follow the logical chain of reasoning which had led to the decision and to examine whether it had been justified or not.

In **T 655/13** the board held that in order for the examining division to make its reasoning on the basis of a pertinent prior art document in a non-official EPO language comprehensible to the board, it must provide the translation used in the examination proceedings of at least the relevant sections of the document (or even of the whole document, if this is necessary for its overall understanding) into an official language of the EPO. Otherwise, the board is unable to examine the reasons for the decision, and in certain cases even whether the decision was justified or not, which amounts to a violation of the legal requirement for reasoned decisions under R. 111(2) EPC.

In **T 1787/16** the board decided that there was only very limited room for using a language other than the language of the proceedings in the decision, namely only in so far as answering questions of fact or evidence and points of law relevant to the proceedings demanded it. According to Art. 125 EPC, in the absence of procedural provisions in the EPC, the principles of procedural law generally recognised in the contracting states of the European Patent Organisation were to be taken into account. This applied in particular to the general legal principle of a fair trial, which was also enshrined in, for example, Art. 6(1) ECHR and which served as a general guiding standard for the organisation of proceedings. It also included a requirement to draft the decision in such a way that it could be understood by a party with a command of the language of the proceedings.

In **T 1840/13** the board held that including additional reasoning into the proceedings, to which the applicant had not had the opportunity to react constituted a violation of its right

to be heard. Furthermore, these new arguments still did not provide a comprehensible reasoning according to the board, resulting in a substantial procedural violation.

In **T 1929/12** the board found that a decision was insufficiently reasoned within the meaning of R. 111(2) EPC if it did not indicate the features or combination of features in the claims in question that were considered to extend beyond the content of the originally filed application (Art. 123(2) EPC). However, it decided against remitting the case in hand because the examining division would probably take the same decision again, albeit with better reasoning.

In **T 689/20** the opposition division's reasons for its decision did not explicitly mention the issue of disclosure of one of the features or address it in substance. The board therefore held that the decision was not sufficiently reasoned and did not meet the requirements of R. 111(2) EPC. Observing that the minutes showed that the feature in question had been looked at in detail as part of the discussion of inventive step, the board took the view that it should have been clear to the division in the light of this discussion that the feature and its interpretation were crucial for the decision. It had nevertheless failed to consider the parties' submissions on this critical point in its decision and so infringed the right to be heard under Art. 113 EPC. See also this chapter III.K.3.4.2 and chapter III.B.2.5.2 "Decision must demonstrably show that arguments were heard and considered".

In **T 1351/12** the examining division had not appreciated that the main request was different from the auxiliary request. The reasoning of the examining division or parts of it might have been envisaged to also apply to the main request, however it could not be inferred from the decision whether this was the case and, if so, which arguments would apply correspondingly.

In **T 1029/16** the examining division's reasoning of the decision in respect of the main request seemed to be copied from the summons to oral proceedings. The only three paragraphs concerning the main request which had not been directly copied appeared to be a paraphrased version of what had been said in the summons. In its written submissions, the applicant had already replied to the arguments raised in the summons. Furthermore, it was clear that the decision had very little in common with what had actually been discussed at the oral proceedings. The board held that while the reasons of a decision may, in the interest of procedural economy, refer in appropriate cases to previous communications, it must be clear from the decision which considerations led the division to its conclusions. The fact that preliminary opinions or arguments which may be applicable to these requests have been expressed in previous communications or in the minutes of oral proceedings cannot replace reasons in the decision itself. Hence, the examining division had failed to provide adequate reasoning. This was also a substantial procedural violation.

In **T 1757/20** the board found that during the examination procedure the examining division had changed its mind several times with regard to the admissibility and allowability of auxiliary requests. The appellant had thus been confronted with alternating objections, without proper reasoning. The board concluded that the discretionary decision of the

examining division was not fully reasoned and justified. The board agreed with the appellant that a substantial procedural violation had occurred.

In **T 899/17** the board held that the reasons for the failure of auxiliary requests which were skipped in the discussion during the oral proceedings before the opposition division in favour of more promising lower-ranking auxiliary requests and which were explicitly not withdrawn by the patent proprietor had to be set out in the written decision. See also **T 27/20**.

c) No reasons for decision

In **T 493/88** (OJ 1991, 380) the board held that a decision of an opposition division rejecting an opposition had not been correctly reasoned within the meaning of R. 68(2), first sentence, EPC 1973 if, after giving the reasons why it, unlike the opponent, considered the subject-matter of the patent to be new, it failed to state the reasons why it considered that the subject-matter also involved an inventive step.

In **T 1532/21** the board agreed with the appellant that the examining division had not provided any reasoning for its assertion in the contested decision that the technical effect of the distinguishing features had not been achieved over the whole scope of claim 1. Nor had the contested decision indicated the part of the scope of the claims over which the technical effect had not been achieved. Under these circumstances, the appellant had been forced to speculate how the claims had to be limited so as to ensure that the technical effect was achieved over their whole scope. Instead of providing a logical sequence of arguments, the examining division had raised a number of questions.

In **T 1411/07** the board found that the opposition division's failure to make any reference to its thinking on the factual and legal circumstances of the case, and the total absence of a logical train of thought, had left both the parties and the board in the dark as to what considerations had led it to the conclude that the opposition was to be regarded as adequately substantiated. The board was thus of the view that the contested decision was not reasoned within the meaning of R. 68(2) EPC 1973 (see also **T 2245/12**).

In **T 1553/07** the opposition division had not explained why it believed that there had been public prior use and how it had arrived at this conclusion. Nor was it apparent what its considerations had been in arriving at its conclusion regarding novelty. The board was thus precluded from reviewing whether or not its conclusions were justified and so ruled that the decision had not been reasoned within the meaning of R. 68(2), first sentence, EPC 1973.

Where there was no explanation of how the examining division had arrived at its conclusion that the claimed process was an obvious juxtaposition of certain documents, this was held insufficient (**T 292/90**).

In **T 708/00** (OJ 2004, 160) the board found that neither the communications nor the examining division's decision went beyond a list of the features appearing or lacking in the claimed inventions, which was obviously not an appropriate way to substantiate the lack

of unity of invention. Since lack of unity was a central issue in these proceedings and an important reason for refusing the application, this lack of substantiation had to be regarded as a substantial procedural violation.

In **T 153/89** the examining division had given no reasons for finding in its decision that the subject-matter of the dependent claims was not inventive. The board of appeal took the view that the perfunctory statement in the contested decision did not permit the board to judge whether this issue had been sufficiently investigated, or investigated at all. The examining division's decision on such grounds did not amount to a reasoned decision.

In **T 698/94** neither the minutes of the oral proceedings before the opposition division nor the appealed decision itself contained the slightest hint at the arguments brought forward by the parties. Nor did the reasons address the decisions of the Enlarged Board that had been cited in the summary of facts and submissions. It was impossible for the parties to the proceedings to see how the opposition division had arrived at its conclusion of lack of novelty. The losing party was deprived of its legitimate right to challenge the reasoning on which the decision was based, which was the very purpose of proceedings before the boards of appeal (see **G 9/91**, OJ 1993, 408). See also **T 135/96**, **T 652/97**.

In **T 1747/06** the board, distinguishing the situation before it from that in **T 856/91**, where it had been decided that even incomplete and deficient reasoning still amounted to reasoning for the purposes of R. 68(2) EPC 1973, found that no reasons at all had been given since it was unclear whether or not any of the documents cited had been considered by the opposition division in arriving at their decision and proper reasoning for the conclusion drawn was lacking. Further, it was unclear whether the statements made in the "Grounds for decision" actually reflected the view of the opposition division or merely that of, e.g., the patent proprietor (see also **T 1366/05**).

In **T 1724/10** the board held that the juxtaposition of seemingly contradictory conclusions (e.g. acknowledgement of technical differences but no possibility to define a technical problem), presented in the contested decision as apodictically evident and without any factual support, does not constitute a "reasoned decision" within the meaning of R. 111(2) EPC.

In **T 1713/20**, the examining division's reasoning with regard to a lack of inventive step was incomplete. Only individual points of the problem-solution approach were addressed in isolation and it was not clear in relation to which claims or claimed subject-matter the respective arguments or statements were made. There was no logical chain of argumentation concerning the assessment of inventive step of the claimed subject-matter. It was in particular not clear from the decision as a whole from which document(s) the examining division had started when examining inventive step. The board held that the requirement in R. 111(2) EPC of a decision being reasoned is not met if the decision merely contains statements that at best give rise to speculation about what the deciding body might have intended to express.

In **T 3071/19** the examining division's decision had relied on a video which was no longer available at the time of the appeal decision. The board held that a decision open to appeal

is not reasoned within the meaning of R. 111(2) EPC if it does not enable the board of appeal to review its correctness. A decision should therefore not rely on evidence accessible only at a web page which is not guaranteed to remain accessible and unchanged. Rather, it should be ensured that a person inspecting the file can reliably access the cited evidence, for example by using appropriate screenshots as evidence of what was shown in the video. Essentially the same situation was dealt with in **T 3000/19** in that the video on which the decision was based was no longer available as of the date of the board's decision. The board found that the screenshot included in the file was clearly insufficient for the judicial review of the decision under appeal. Furthermore, it was not apparent from the file whether the video's content had been collected, preserved and/or stored in a manner which guaranteed accessibility for members of the judiciary or interested parties. According to the board, when a video retrieved from the internet is used as prior-art evidence for refusing a patent application, its content, in a form suitable for reviewing the decision, and metadata evidence demonstrating when and how it was made available to the public should be preserved and made accessible over time to interested parties and judicial bodies.

In **T 505/20** the board found that the opposition division's failure to consider the valid claim 1 of auxiliary request 1 submitted at the oral proceedings caused that reasons given by the opposition division for holding auxiliary request 1 filed at the oral proceedings allowable did not relate to claim 1 of auxiliary request 1 as actually maintained by the opposition division. As a consequence, at least some of the conclusions reached by the opposition division were not duly supported by the reasons given for the decision. The board held that the decision was not reasoned, constituting a substantial procedural violation.

3.4.5 Special cases

a) References to communications

See in this chapter III.K.3.4.3 and III.K.3.5.

b) Reference to a board decision or case law

In **T 1205/12** and **T 1206/12**, which are worded identically, the board held that a mere reference to jurisprudence of the boards of appeal did not, by itself, constitute or replace an argument in a first instance decision. If a deciding body, in a decision, wanted to rely on an argument put forward in a decision of the boards, be it part of its ratio decidendi or an obiter dictum, it was insufficient merely to refer to it or to cite it. The deciding body also had to make clear that it adopted the argument and explain why, in what respect and to what extent this argument applied to the case at hand.

In **T 227/95** the contested decision contained no reasons on the merits of the case but merely stated: "for the reasons it is referred to the decision of the board of appeal dated 24.01.94" (meaning **T 527/92**). However, **T 527/92** contained no such reasons, since the case was remitted to the opposition division for further prosecution. The requirements of R. 68(2) EPC 1973 were not met.

c) Assessment of inventive step without assessing the prior art

In **T 87/08** the board pointed out that Art. 56 EPC required that the assessment of inventive step be made "having regard to the state of the art". Accordingly, a decision was not sufficiently reasoned if the chain of reasoning to justify the finding of lack of inventive step merely stated that a purported effect had not been achieved, i.e. this technical problem had not been solved, without reformulating the problem in a less ambitious way and without assessing the obviousness of the claimed solution to that reformulated problem in the light of the cited prior art.

In **T 2375/10** the board found that since the requirement of inventive step under Art. 56 EPC had to be assessed in the light of the prior art, the decision of the examining division to conclude that there was a lack of inventive step without referring to the prior art was insufficiently reasoned within the meaning of R. 111(2) EPC. See also **T 306/09**.

d) Identical decision after remittal for further prosecution

In **T 740/93** the case had been sent back to the department of first instance because of a procedural violation (incorrect composition of the opposition division). Because of the remittal with the order for further prosecution of the opposition, the first decision became nothing more than a communication and the first statement of grounds of appeal therefore had to be considered as a response to this communication. The new opposition division rendered a decision which was nearly identical to the first one. Although the decision under appeal contained a reasoning as to why the subject-matter of the patent in suit was considered to lack an inventive step and referred to points of dispute raised in the proceedings up to the first decision, it did not contain any direct reference to the important issues of dispute raised in the first statement of grounds of appeal and failed to comment upon the other issues of dispute. It thus did not meet the requirements of R. 68(2) EPC 1973.

e) Dealing with issues that go beyond the decision itself

In **T 473/98** (OJ 2001, 231) the board held that it is entirely appropriate and desirable in the interests of overall procedural efficiency and effectiveness that an opposition division should include in the reasons for a revocation decision pursuant to Art. 102(1) EPC 1973 employing the standard decision formula, by way of obiter dicta, findings which could obviate remittal in the event of the revocation being reversed on appeal. By contrast, the board in **T 615/95** decided that an examining division's decision should not normally be supplemented by annexes dealing with issues having no relation to the issues dealt with in the reasons for this decision.

3.5. Decisions according to the state of the file

3.5.1 Request for decision "according to the state of the file"

Applicants may request a decision "according to the state of the file" or based "on the file as it stands" during examination proceedings, e.g. when their arguments have already

been sufficiently put forward and they are interested in a speedy appealable decision. In such a case, a decision can be issued by way of a standard form (EPO Form 2061), simply referring to a previous communication (see Guidelines C-V, 15 – April 2025 version).

The Guidelines (C-V, 15.2 – April 2025 version) explain that a standard form referring to a previous communication (EPO Form 2061) can be used only where the previous communication properly identifies the application documents on file, is well reasoned and complete with respect to the grounds and the reasons for refusing the currently pending request and addresses all the arguments raised by the applicant. A further condition is that the applicant has submitted no new arguments or amendments since the previous communication.

According to the boards' case law, a standard form may be used to issue a decision only if all the arguments put forward have already been sufficiently addressed in one or more previous communications and, moreover, no new objections have been raised since those communications were transmitted (**T 2364/09**, **T 1093/13**).

3.5.2 No absolute right to a decision issued by way of EPO Form 2061

In **T 62/13** the board observed that a decision to refuse based on the file as it stands could be issued either by way of a form (EPO Form 2061) referring to an earlier communication, or alternatively by way of a fully reasoned decision. In **T 1360/05** the board stated that the examining division is not obliged to restrict itself to a decision by reference using the standard form when the necessary reasons in relation to the latest filed claims have not been formulated in any document on file.

3.5.3 No waiver of right to a reasoned decision

A request for a decision on the state of the file thus cannot be construed as a waiver of the right to a fully reasoned first instance decision (**T 265/03**, **T 583/04**, **T 1182/05**, **T 1309/05**, **T 1356/05**, **T 1360/05** and **T 750/06**). **T 1356/05** goes further and states that even if an applicant were to waive its right to a reasoned first instance decision expressis verbis, it hardly authorises the examining division to dispense with it.

In **T 952/07** the board made it clear that the duty to provide reasons in administrative decisions was a fundamental principle in all contracting states, R. 68(2) EPC 1973 simply being an expression of this principle. The losing party must be in a position to understand the reasons for the negative decision taken against it so that it can consider the option of filing an appeal.

In **T 2187/17** the board noted that a request for a decision based on the current state of the file is not to be understood as a waiver by the party of its right to a fully reasoned decision. The departments of the European Patent Office cannot omit to give reasons for their decisions when the EPC requires them to do so.

3.5.4 Reasons for a decision by way of EPO Form 2061

a) Requirements

In accordance with the boards' case law (e.g. **T 278/00** (OJ 2003, 546), **T 861/02**, **T 897/03**, **T 276/04**, **T 1182/05**, **T 1309/05**, **T 1356/05**, **T 1360/05**, **T 1709/06**, **T 952/07**, **T 1612/07**, **T 1442/09**, **T 180/10** and **T 177/15**), a standard decision based "on the state of the file" which refers to one or several communications only meets the "reasoned" requirement of R. 68(2) EPC 1973 (now R. 111(2) EPC) if the board of appeal is not left to reconstruct the applicable reasons by piecing together various arguments from the file and if it leaves no doubt as to which claim version the arguments relate to.

In **T 963/02** the board held that a decision issued by way of EPO Form 2061 and referring to one or more earlier communications only met the criteria for a reasoned decision if the cited communication itself met those criteria as defined in **T 897/03** and **T 278/00** (see above), i.e. the reasons for the decision were clear (similarly **T 1182/05**).

In **T 583/04** the board held that the decision by reference using a standard form is appropriate when the communication incorporated by reference contains a fully reasoned exposition of the examining division's objections to the current application text and refutation of any rebuttal by the applicant. This makes it transparent that the decision is being taken on the agreed text and that nothing is being said in the decision which has not already been communicated to the applicant with an opportunity to present comments, thus guaranteeing that the right to be heard is observed (Art. 113 EPC).

In **J 18/16** the appealed decision merely referred to a preceding communication on deficiencies in the application, and the section of the form headed "Further comments on the remaining deficiency" gave no information on why the Receiving Section had considered the subsequently filed documents not to have corrected the deficiencies noted or to what extent those documents made amendments going beyond what would have been sufficient to correct them, thereby infringing R. 58, second sentence, EPC. That, the Legal Board held, breached R. 111(2) EPC. The Legal Board remitted the case to the department of first instance on account of a substantial procedural violation.

In **T 353/11** the decision under appeal referred solely to a communication annexed to a summons to attend oral proceedings. The communication did no more than to identify the closest prior art and the distinguishing feature of the invention, indicate that it was "not clear" whether the examples of the application illustrated the distinguishing feature of the invention, state it would be examined whether or not the process was inventive, and invite the appellant to file a comparative example. It neither gave an explicit conclusion with respect to inventive step, nor any reasons as to why the claimed process was not inventive. Thus, the examining division did not issue a reasoned decision within the meaning of R. 111(2) EPC.

The board in **T 1998/10** held that the use of the standard form could be considered appropriate for decisions on the state of the file in exceptionally plain cases. In the case at hand, the decision under appeal referred to a communication of the examining division,

which in turn referred to the written opinion of the ISA. Although the board would have preferred an independently, fully-reasoned, self-contained decision, it concluded that the objections leading to the refusal could be identified and understood from the references in an unambiguous manner and without undue guesswork.

In **T 1997/21** the earlier "communications" referred to in the contested decision did not take account of the applicant's letter of 28 May 2021. The board held that the detailed position taken in this letter, with the introduction of new arguments, had created a situation in which a decision that simply referred to earlier "communications" was no longer procedurally permissible. The decision should in any event have addressed the new arguments. Issuing a new communication or holding oral proceedings might well have been expedient too. See also the passage reporting on **T 1997/21** in chapter III.K.3.5.4b) below.

b) Reference to more than one communication

The Guidelines (C-V, 15.2 – April 2025 version) state that reference can be made to more than one communication only in exceptional cases and that, especially if the various communications deal with different sets of claims and it is therefore unclear which of the reasons given in them by the examining division might be essential to its decision to refuse, a fully reasoned decision should be issued instead.

In **T 897/03** the board held that a decision that leaves it to the appeal board and the appellant to speculate as to which of the reasons given by the examining division in different communications might have been decisive for the refusal of the application, could not be considered to meet the requirements of R. 68(2) EPC 1973 (see also **T 652/97**; **T 278/00**, OJ 2003, 546; **T 177/15**).

In **T 180/10** two communications had been referred to. However, contrary to what was stated in the second communication ("the applicant's explanations … have been carefully considered"), it was apparent that the examining division had ignored all the appellant's arguments since this communication and, therefore, the decision were silent on them. The requirements of R. 68(2) EPC 1973 were not fulfilled.

In **T 1946/17** the board held that a blanket statement like "arguments were carefully considered" but "no new evidence" was provided, in the communications to which the decision refers cannot be considered to address the arguments raised and thus constitutes insufficient reasoning.

In **T 737/11** the board concluded that considerable uncertainty existed as to the precise reasons on which the contested decision was based. The claims were amended substantially between the two communications to which the written reasoning of the contested decision referred. Furthermore, oral proceedings had taken place in absence of the applicant, despite the applicant withdrawing the respective request and the minutes of these oral proceedings were not mentioned in the decision. This was held to amount to a substantial procedural violation and insufficient reasoning. In both **T 406/15** and **T 62/13** the examining division had refused an application based on the file as it stood, using a

form referring to two earlier "communications". However, the file in each case revealed that these had not been "communications" as such. The examining division had issued only one formal communication that raised just one briefly reasoned objection to lack of novelty and did not clearly explain why the application had been refused. The board nevertheless held that it was just enough to fulfil the obligation to substantiate decisions, but only having taken into account that the appellants themselves had not argued on appeal that the reasoning was insufficient.

In **T 1997/21** the board, observing that the contested decision referred to two "communications", found that the first one was not in fact a communication but the minutes of a telephone consultation with the applicant/representative. Besides not being a communication, because they had been sent purely "for information", these minutes anyway did not deal with all the arguments made by the applicant that were important for the decision.

3.5.5 Documents included in the "state of the file"

The "state of the file" is not restricted to those documents on file which were issued by the EPO, but also includes all those documents and arguments which were filed by the applicant prior to (or even simultaneously with) its request for a decision "on the status of the file" (**T 265/03**, **T 1360/05**). It does not include the note of a telephone conversation (**T 583/04**). This was the summary record of a conversation. Whereas the phone call note is a record of a dialogue, a communication under Art. 96(2) EPC 1973 constitutes a unilateral legal notice to a party. This does not exclude the possibility of the statements made orally by phone being confirmed and adopted in a formal communication from the examining division inviting to file observations with a term set for reply. See also **T 750/06**. In **T 1356/05** the board held that minutes of oral proceedings are most probably not meant to be included in the term "previous communications" and it is thus not appropriate to refer to them in the standard decision.

4. Loss of rights within the meaning of Rule 112(1) EPC

If a party to the proceedings or a third party fails to comply with a time limit laid down in the EPC or fixed by the EPO, this will result in a loss of rights in certain cases specified in the EPC. Pursuant to R. 112(1) EPC (formerly R. 69(1) EPC 1973), if the EPO notes that such a loss of any rights results from the EPC, it must communicate this to the party concerned. If the party disagrees with the finding of the EPO, it may apply for a decision on the matter by the EPO (R. 112(2) EPC, formerly R. 69(2) EPC 1973) or it may request further processing or re-establishment of rights, as the case may be (**J 14/94**, OJ 1995, 824). By decision of the President of the EPO dated 12 December 2013 (OJ 2014, A6), responsibility for issuing the communication within the meaning of R. 112(1) EPC was entrusted to formalities officers working for the examining and opposition divisions.

4.1. Purpose of notification of loss of rights under Rule 112(1) EPC

In **J 7/92** the Legal Board stated that the purpose of a notification under R. 69(1) EPC 1973 is not to give an applicant a chance to take at least remedial action by way of a request for re-establishment of rights. As stated by the Enlarged Board in its opinion **G 1/90** (OJ 1991, 275), when, according to the EPC the European patent application shall be deemed to be withdrawn, the applicant must be "informed" of the loss of rights (R. 69(1) EPC 1973). According to R. 69(2) EPC 1973 the applicant may then, within two months of notification of the communication, apply for a decision "if he considers that the finding of the EPO is inaccurate". Although it is the customary practice of the EPO to send renewal fee reminders, it is in no way compelled to issue such communications. By communicating such information, the EPO provides only a voluntary service from which no rights can be derived (following **J 12/84**, OJ 1985, 108). The EPC 1973 did not provide that the EPO should note the loss of rights mentioned in R. 69(1) EPC 1973 within a certain period. Nor did it provide any period of time for the ensuing communication. However, when incoming requests or documents contained clear deficiencies which were obviously easy to correct and could be expected to be remedied within the time limit to avoid a loss of rights, then the principles of good faith might require the EPO to draw attention to such deficiencies. For further information and case law on the principle of the protection of legitimate expectations see chapter III.A. "The principle of the protection of legitimate expectations".

4.2. Form of notification of loss of rights under Rule 112(1) EPC

The Legal Board in **J 43/92** noted that R. 69(1) EPC 1973 did not prescribe any particular form for the communications provided therein, distinguishing them from other communications or notifications under the EPC. A reference to a time limit to apply for a decision was not necessarily decisive as to the true nature of the communication. Whether a document constituted a communication pursuant to R. 69(1) EPC 1973 should be derived from its substantive content and its context (see also **J 8/81**, **J 24/01**, **T 713/02**).

4.3. Request for a decision under Rule 112(2) EPC subsequent to a communication

If the party concerned considers that the finding of the EPO is inaccurate, it may, within two months of notification of the communication, apply for a decision on the matter. In **J 43/92** the Legal Board noted that a decision pursuant to R. 112(2) EPC could be applied for only if it was preceded by a communication under R. 112(1) EPC. Otherwise, there was no basis for the EPO to issue such a decision.

4.4. Responsibility for issuing decisions under Rule 112(2) EPC

By decision of the President of the EPO dated 12 December 2013 (OJ 2014, A6), responsibility for issuing communications and decisions within the meaning of R. 112(2) EPC was transferred to formalities officers working for the examination and opposition divisions.

4.5. Right to a decision under Rule 112(2) EPC

The right to a decision after notification of loss of rights is a substantial procedural right which cannot be ignored by the EPO. A party who applies for a decision under R. 112(2) EPC is entitled to receive one. If the correctness of a notification of loss of rights under R. 112(1) EPC is challenged, the EPO has a duty to reply within a **reasonable period of time** having regard to the subject-matter of the communication (see **J 29/86**, OJ 1988, 84; and **J 34/92**).

5. Notification of decision under Rule 111(1) EPC

Under R. 111(1) EPC, a decision delivered during oral proceedings must be put in writing and notified to the parties. The date of notification is relevant with regard to the filing of an appeal (Art. 108 EPC and R. 111 EPC). The legal fiction of deemed notification set out in R. 126(2) EPC applies whereby the document is deemed to be delivered to the addressee on the date it bears, unless it has failed to reach the addressee (see notice from the EPO concerning legal changes to support digital transformation in the patent grant procedure (OJ 2022, A114) and notice from the EPO concerning amended R. 126, 127 and 131 EPC (OJ 2023, A29)). For the case law on notifications see chapter III.S. "Notifications".

L. Correction of errors in decisions

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1. Competence to correct a decision according to Rule 140 EPC

The competence to correct errors under R. 140 EPC (R. 89 EPC 1973) lies with the body which took the decision (see e.g. **G 8/95**, OJ 1996, 481, **J 12/85**, **J 16/99**). Hence, even during opposition proceedings, the examining division is competent for correcting errors according to R. 140 EPC (Guidelines H-VI, 3.3 – April 2025 version). In accordance with the decision of the President of the EPO dated 23 November 2015 (OJ 2015, A104), decisions under R. 140 EPC are dealt with by formalities officers.

1.1. Competence of opposition division or examining division

In **T 226/02** the board considered that the opposition division had acted *ultra vires* in taking a decision under R. 89 EPC 1973 to correct a decision of the examining division. The board held that only the body which had taken a decision was entitled to correct it so as to put it in the form which it had intended it to take. Thus, only the examining division was entitled to correct its own decision. This finding was endorsed by the board in **T 1495/09**, which held that, in the case at issue, pursuant to R. 140 EPC, the opposition division in opposition proceedings had no competence to correct the decision taken by the examining division and would thus have acted *ultra vires* if it had corrected the grant decision. The same applied to the board of appeal in opposition-appeal proceedings (Art. 111(1), second sentence, EPC 1973).

1.2. Competence of the boards of appeal

In **J 12/85** (OJ 1986, 155) the board held that a board of appeal could only examine appeals from decisions of other instances of the EPO (Art. 21(1) EPC). Thus, it cannot examine a request for a correction, based on R. 89 EPC 1973 (R. 140 EPC), of the decision under appeal. A decision on this request first had to be rendered by the examining division before the matter could be referred to the board of appeal.

In **T 810/09** the board held that it was not competent to decide on a request for correction of a written decision taken by the opposition division and for this reason rejected the appellant's request for correction under R. 140 EPC.

In **T 255/22**, the board held that it had no competence to correct or amend under R. 140 EPC the reasons given by a first-instance department in the written decision, or to order such a correction or amendment (see point 2.2.1 of the Reasons). It also held that it had no competence to confirm that an "obvious mistake" within the meaning of R. 140 EPC had been made in the reasons given by a first-instance department in the written decision (see point 2.3 of the Reasons). Lastly, it held that the board had no competence to correct or amend the content of the minutes of oral proceedings before a first-instance department, or to order such a correction or amendment (see point 3.3 of the Reasons).

1.2.1 Legal Board or Technical Boards

In **G 8/95** (OJ 1996, 481) the Enlarged Board held that the decision refusing a request for correction of the decision to grant concerned the grant of the patent. It was, therefore, the technical boards – not the Legal Board – which had to decide on appeals from a decision of an examining division refusing a request under R. 89 EPC 1973 for correction of the decision to grant.

1.3. Competence to correct if application is no longer pending

In **T 867/96** of 30 November 2000 the patentee had requested the correction under R. 89 EPC 1973 of a sentence in the reasons for a board of appeal decision, stating that all the parties had agreed that a certain document represented the closest prior art. The board pointed out that the case was closed, as res judicata, and therefore no longer before it. However, citing in particular **G 8/95** (OJ 1996, 481) and **G 1/97** (OJ 2000, 322), the board held that only the board which had taken a decision could decide whether it required correction. Furthermore, establishing whether correction was necessary involved studying the facts, implying in general and up to a certain point that such requests were admissible. The current board thus ruled that the request for correction was admissible. Nevertheless this particular request did not fulfil the requirements of R. 89 EPC 1973 and was therefore refused.

In **J 16/99** the board held that when correction of the priority date of a granted patent is requested, there may be a case for correction under R. 89 EPC 1973 of the EPO's decision to grant. The board found that R. 89 EPC 1973 allowed the correction of errors in, inter alia, decisions to grant, without the limiting requirement that proceedings be pending.

2. Scope of Rule 140 EPC

According to the wording of R. 140 EPC, in EPO decisions, only linguistic errors, errors of transcription and obvious mistakes may be corrected. R. 140 EPC (formerly R. 89 EPC 1973) applies to both decisions of the Boards of Appeal and those of first-instance departments. Following **G 1/10** (OJ 2013, 194) R. 140 EPC no longer covers the

correction of the text of a patent. Neither is it applicable for the correction of legal errors, irrespective of whether they concern substantive or procedural aspects (**G 1/97**, OJ 2000, 322). This leaves only errors in bibliographic data contained in the decision to grant or formatting/editing errors during the preparation of the "Druckexemplar" (as well as printing errors in the publication of the granted patent) to fall under R. 140 EPC (Guidelines H-VI, 3.1 – April 2025 version).

Correction of errors in decisions must be distinguished from correction of errors in documents filed by the applicant (or patentee) which falls under R. 139 EPC.

2.1. Correction of the text of a patent

Under the boards' case law prior to **G 1/10** (e.g. **T 850/95**, OJ 1997, 152; **T 425/97**, **T 965/98**) the text of a patent could be corrected under R. 140 EPC if it was not, and obviously could not be, in the form intended by the decision-making department.

T 367/96 of 21 June 2001 and **G 1/97** introduced a narrower interpretation of R. 140 EPC. According to this, R. 89 EPC 1973 had to be interpreted narrowly and only allowed for the correction of formal errors in the written text of the decision notified to the parties in accordance with R. 111 EPC (R. 68 EPC 1973). It did not, however, pave the way for re-examination of the factual or legal issues on which a decision was based, nor for reversal of any conclusion derived by the decision-making department from a consideration of these issues.

In **G 1/10** (OJ 2013, 194), the Enlarged Board went further, holding that, although patent documents referred to in a grant decision become an integral part of the decision, they cannot be corrected under R. 140 EPC. Since R. 140 EPC is not available to correct the text of a patent, a patent proprietor's request for such a correction is inadmissible whenever made, including during opposition or limitation proceedings (now established case law of the Boards of Appeal, see e.g. **T 2051/10**, **T 657/11**, **T 1578/13**, **T 164/14**). The Enlarged Board's decision was limited to corrections within grant decisions of the description, claims and drawings (patent documents), and not concerned with corrections of bibliographic data.

The Enlarged Board stated that the absence of a possibility to request patent corrections under R. 140 EPC should not prejudice patent proprietors. If a correction is obvious (as it should be to satisfy R. 140 EPC) then there will be no surprise or adverse effect on opponents or others, because all concerned should read the patent as if corrected and an actual correction is unnecessary. If however a correction is less than immediately obvious, it should not be allowed under R. 140 EPC anyway, which is confined to correction of "obvious mistakes". If, given the opportunity to check the patent text before approving it, an applicant does not draw any errors to the attention of the examining division and thus ensures that his approval is limited to the correct text, then the responsibility for any errors remaining in that text after grant should be his alone, whether the error was made (or introduced) by him or by the examining division.

If however the examining division proceeds to make a decision to grant which contains an error subsequently made by it, so that the granted text is not that approved by the proprietor, then the proprietor is adversely affected by that decision and is entitled to appeal. A patent proprietor may seek to amend his patent during opposition or limitation proceedings and such an amendment could remove a perceived error, however, it would have to satisfy all the legal requirements for amendments including Art. 123 EPC.

In **T 806/21** the board held that as ruled in decision **G 1/10**, R. 140 EPC was not available to correct patents. **G 1/10** did not restrict the scope of the exclusion of the applicability of the rule in any way.

In **T 506/16** the board held that according to **G 1/10**, the obligation to check the text in which the patent is to be granted lies with the applicant, and if it does not draw the examining division's attention to any errors, then the appellant alone bears the responsibility for any errors remaining in the text, regardless of who is responsible for the error.

In **T 2051/10**, the appellant asserted that there was an erroneous discrepancy between the wording of the granted patent and that of the Druckexemplar and requested its "correction". Citing **G 1/10**, the board held that such a "correction" could not be made under either R. 139 EPC or R. 140 EPC and treated the appellant's request as a "normal" request for amendment under Art. 123(1) EPC.

In **T 1003/19** the board did not deviate from **G 1/10** and held that R. 140 EPC was not available, but reiterated the right to appeal a decision to grant when the granted text was not approved by the applicant. The case at hand was an example of this. **G 1/10** based its consideration on the requirement according to R. 71(3) EPC that the applicant must be informed of the text in which the examining division intends to grant a patent and deals with the applicant's possible reactions thereto, like the implicit approval of this text. In contrast thereto, the decision at hand was based on the fact that the text intended for grant by the examining division had, based on verifiable facts, not been communicated to the appellant and, therefore, R. 71(5) EPC did not (yet) apply.

In **T 2081/16** the board affirmed **T 1003/19** and held that where the text intended for grant is not communicated to the applicant under R. 71(3) EPC, the fact that the appellant subsequently files a translation and pays the fees for grant and publishing is not decisive. The provisions of R. 71(5) EPC, in this regard, refer to R. 71(3) EPC and therefore presuppose that the applicant has not only been notified of any text but of the text intended for grant.

In **T 1846/20**, the appellant referred to **T 1003/19** in support of its argument. However, the board distinguished the case at hand from **T 1003/19** because the appellant had not filed any appeal against the decision to grant. Therefore, the grant decision became final, and the granted patent ceased to be within the jurisdiction of the EPO (**G 1/10**). The applicant had also approved the Druckexemplar, which did not include the drawings in question.

3. Obvious mistakes according to Rule 140 EPC

In **T 450/97** (OJ 1999, 67), the board held that there was an obvious mistake within the meaning of R. 140 EPC if the text of a decision did not reflect the decision-making department's real intention. In **T 715/14** the contested decision had referred to a communication dated 3 October 2013 although, undisputedly, the last issued communication dated 19 April 2013 had been meant. Its correction had then introduced an additional reference to two other communications, which led the appellant to contend that it amounted to a subsequent change in the decision's content and the underlying reasons. The board, however, considered the correction permissible under R. 140 EPC because the communication dated 19 April 2013 was clearly and undisputedly meant and that communication referred to the other two.

In **T 683/06**, the board held that a correction under R. 140 EPC was not available for re-dating an application where its filing date had been deliberately chosen in a decision-making process (even if that process turned out to be mistaken).

In **T 212/88** (OJ 1992, 28) the board held that the absence of a chair's or minute-writer's signature at the end of an opposition division's decision was a rectifiable, obvious error within the meaning of R. 89 EPC 1973. In the case in question a second examiner had been referred to in the minutes as a member of the opposition division, although in fact he was not a member and did not take part in the oral proceedings (see also **T 212/97**). The board decided otherwise in **T 572/19** and held that the missing signature of the legal member was not an obvious mistake.

In **T 212/97** the board pointed out that R. 89 EPC 1973 permitted the opposition division to correct an obvious mistake in the copy of the decision notified to the parties. In the case at issue, a fourth person had been named as a member of the opposition division although no such person had been mentioned in the original document.

4. Legal effect of corrections according to Rule 140 EPC

The EPO makes corrections on request or of its own motion (**T 150/89**). In **T 212/88** the board held that correction of errors under R. 89 EPC 1973 (R. 140 EPC) had to be done by means of a decision, with retrospective effect from the date of the original decision. In **T 116/90** of 3 December 1990 it was held that it was unnecessary to re-date the decision as from the date of correction.

In **T 130/07**, the board reiterated that a correction made no difference to either the date of the corrected decision or the appeal period triggered by its service (as previously held in **T 212/88** and **T 1176/00**). It nevertheless reprimanded the EPO for its continued failure, despite the case law already established on the point, to avoid issuing such "second decisions" bearing a seemingly new date and so seemingly triggering a fresh appeal period and instead issue properly reasoned correction decisions clearly marked as such (similarly

T 105/11). On the issue of the distinction from genuine second decisions, see III.A.3.6. and III.K.3.1.1

In **T 105/11** the board held that in application of the principle of the protection of legitimate expectations, the statement of grounds of appeal was deemed to have been filed in time, even though the appellant directed the notice of appeal and the statement of grounds of appeal against the correction decision with an alleged new date.

4.1. Correction requests as opposed to appeals

In **T 425/97** the board referred to **G 8/95** (OJ 1996, 481), which dealt with the scope of R. 89 EPC 1973 (now R. 140 EPC), stating that the difference between an appeal against a decision and a request for correction of a decision might be seen in the fact that in the first case the remedy was directed against the substance of the decision and in the latter case against the form in which the decision was expressed. In another decision issued prior to **G 1/10**, the board in **T 1093/05** (OJ 2008, 430) similarly held that, if a grant decision was defective, the patent proprietor had to consider carefully the nature of the defect and how it could best be rectified. If it involved a substantial procedural violation, rectification was possible only on appeal.

In **T 1869/12** the board stated that in case of procedural violations in the granting procedure, rectification is only possible via appeal against the decision to grant. A correction of the published European patent specification or of the decision to grant cannot be allowed when this specification corresponds to the true intention of the Examining Division when granting the patent.

In **T 1869/12** the appellant (applicant) lodged an appeal against the decision of the examining division refusing to correct the published European patent specification. It tried to achieve, via correction of the decision to grant, the patent to be comprising the set of claims proposed by the examining division with a communication under R. 71(3) EPC, however, with substantive amendments as subsequently proposed by the appellant. The board based its decision on **G 1/10** and also stated that the appellant's request could not be granted, since it was clear that the examining division intended – and maintained that intention – to grant the patent with its own proposed claims. Therefore, the appellant should have filed an appeal against the decision to grant the patent.

In **T 1558/21** the board held, for the reasons below, that once announced at oral proceedings, the decision to maintain the patent as amended according to auxiliary request 1', which had been filed in writing, could not be corrected retrospectively based on R. 139 EPC and R.140 EPC, but could only be challenged by filing an appeal. Auxiliary request 1', as filed in writing, had become an integral part of the decision announced by the opposition division. It was nevertheless not possible to correct its claims 1 and 8 under R. 140 EPC, which only allowed for the correction of obvious mistakes such as bibliographical errors in decisions. In addition, the requirement of an obvious mistake in the sense of a mistake that would be immediately recognised by a third party was not met either.

5. Correction of printing errors in the publication of the patent specification

Errors in publication occur where the content of the printed specification differs from the documents (Druckexemplar) transmitted to the applicant, if these documents form the basis of the decision to grant. Such errors in publication can be corrected at any time. The competence to correct errors in publication lies with the body before which proceedings are or were last pending (Guidelines H-VI, 6 – April 2025 version). Mistakes in the specification of a European patent arising in the course of its production have no effect on the content of the patent granted (Guidelines C-V, 10 – April 2025 version).

In **T 84/16** the board noted that the text of the patent specification had no binding character. Its function is confined to facilitating public access to the content of the granted patent. The definitive text of the patent is established by the grant decision. The board held that while the EPC does not explicitly deal with the situation where the patent specification does not correctly reproduce the content of the European patent, it is established practice at the EPO that if the patent specification diverges from the text on which the grant decision is based, then the patent specification is corrected by the EPO (**T 150/89**, **T 1644/10**, Guidelines C-V, 10. – April 2025 version).

In **T 84/16** the specification contained printing errors, but the patentee instead of requesting a reprint of the patent specification, filed an appeal, which was held to be inadmissible, the appropriate remedy in such cases being that the text of the patent specification be brought into conformity with the content of the grant decision. The Office can arrange for correction at any time by means of a note in the European Patent Bulletin and publication of a corrigendum (see R. 143(2) EPC and the decision of the President of the EPO dated 15 July 2014, OJ 2014, A86).

6. Procedural status of third parties

In **T 1259/09**, in the course of the opposition proceedings, opponents had requested a correction of the decision to grant pursuant to R. 140 EPC. The opposition division forwarded this request to the examining division. In a communication the examining division informed the opposition division that no correction of the grant decision would take place. The opponents filed an appeal against this communication of the examining division. The dispute at issue was whether the appellants (opponents), by filing their request for correction, had initiated proceedings before the examining division which were separate from the ex parte examination proceedings with the consequence that they had become a party to the proceedings before the examining division. The board held that by filing a request for correction of the grant decision under R. 140 EPC a third party does not become a party to the examination proceedings.

In **T 1349/08** the board held that correction of the decision to grant belongs to the examination proceedings. Analogous to Art. 115 EPC a person – here the appellant (opponent), who is neither applicant nor patentee – contesting the allowability of a correction of a decision to grant under R. 140 EPC and requesting reinstatement of the original decision to grant, cannot thereby become a party to the proceedings, irrespective

of whether or not the appellant is adversely affected by said "decision", it cannot acquire the quality of party status to the examination proceedings.

M. Inspection of files, European Patent Register and stay of proceedings

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1. Inspection of files

1.1. General

Article 128 EPC governs the inspection of European patent applications. Article 128(1), (2) and (5) EPC regulate file inspection prior to publication of the application under Art. 93 EPC and are therefore exceptions, as an application must normally be kept secret until it is published. Thus prior to publication, file inspection may be granted under Art. 128(1) EPC if the applicant consents, or without the consent of the applicant under Art. 128(2) EPC where any person can prove that the applicant itself has invoked its rights under the application against them.

Article 128(3) and (4) EPC, on the other hand, regulate file inspection after the application has been published. Rule 144 EPC sets out the parts of the file excluded from file inspection under Art. 128(4) EPC. See also decision of the President of the EPO dated 12 July 2007 concerning documents excluded from file inspection (OJ SE 3/2007, 125), decision of the President of the EPO dated 20 February 2019 on the inspection of files (OJ 2019, A16) and decision of the President of the EPO dated 20 February 2019 concerning online file inspection of documents contained in the file held by the EPO as receiving Office, International Searching Authority or Authority specified for supplementary search (OJ 2019, A17).

According to **J 5/81** (OJ 1982, 155), Art. 128 EPC establishes that the confidential treatment of patent applications ceases on publication of the application, not on expiry of the 18-month period mentioned in Art. 93(1) EPC.

According to **J 14/91** (OJ 1993, 479), rights under a European patent application could be considered invoked under Art. 128(2) EPC where their invocation was formulated in relation to the first filing in a contracting state, but the subsequent European application was mentioned at the same time. Any dispute between the applicant and a third party concerning the latter's right to inspect the files pursuant to Art. 128(2) EPC was best decided in oral proceedings convened at short notice.

In **J 27/87** the Legal Board confirmed the Receiving Section's decision to refuse a request pursuant to Art. 128(2) EPC, because there was no proof that the applicants had invoked their rights under the application against the appellants. The extracts from correspondence in which the applicants' representative asserted that his clients had developed a new technology and mentioned the patent application were not deemed sufficient evidence.

1.2. Exclusion from inspection under Rule 144 EPC

R. 144 EPC (see R. 93 EPC 1973) indicates those parts of the file which are to be excluded from inspection pursuant to Art. 128(4) EPC. These include documents excluded from inspection by the President of the EPO, who can exclude from inspection documents that would not serve the purpose of informing the public about the European patent application or the resulting European patent pursuant to R. 144(d) EPC in conjunction with Art. 128(4) EPC.

The President's power to exclude documents from file inspection was last exercised in the decision of the President of the EPO dated 12 July 2007 (OJ SE 3/2007, 125, see above), which provides under Art. 1(2) that documents other than those referred to in Art. 1(1) of the decision "shall be excluded from file inspection at the reasoned request of a party or his representative if their inspection would be prejudicial to the legitimate personal or economic interests of natural or legal persons". Documents may, exceptionally, be excluded by the EPO of its own motion (Art. 1(2)(b) of the decision).

1.2.1 Test for exclusion

In **T 2522/10** of 28 January 2014 the board summarised that the **test for exclusion or non-exclusion** was clear and straightforward, namely would the document in question serve the purpose of informing the public about the patent or patent application in issue? While the answer to that question will depend on the facts of each case, if the answer is "yes", then there may be no exclusion and the matter need not be considered further. If the answer is "no", then consideration must be given to a further question, namely whether inspection would be prejudicial to the legitimate personal or economic interest of natural or legal persons (see also **T 1839/11)**. The board in **T 1150/13** also stressed the importance of the requirement of legitimate personal or economic interest, recalling that exclusion from file inspection is an **exception** from the general principle of public file inspection.

In **T 379/01** the board stressed that the provisions concerning the exclusion of documents from file inspection (R. 93 EPC 1973; decision of the President of the EPO dated 7 September 2001, OJ 2001, 458) stipulated exceptions from the principle of public

inspection of files pursuant to Art. 128(4) EPC 1973, thus requiring a **narrow construction** of those provisions (see also **T 1150/13**, and **T 1839/11** in relation to the interpretation of the President's decision dated 12 July 2007, OJ SE 3/2007, 125). The board concluded that a merely abstract prejudice to hypothetical personal or economic interests was not a sufficient bar. The party requesting such exclusion should rather show that public access to certain documents would be prejudicial to specific and concrete personal or economic interests. Citing that conclusion, in **T 1401/05** of 20 September 2006 the board further expressed the opinion that documents that did not furnish information about patent applications or patents were generally subject to being excluded from file inspection, in line with the then applicable decision of the President of the EPO concerning documents excluded from file inspection dated 7 September 2001 (OJ 2001, 458). Such documents did not serve the paramount purpose of such inspection, i.e. obtaining patent information, to which the public was entitled in return for the exclusive monopoly rights that patents confer.

In **T 851/18** of 12 April 2019, the board held that the request to exclude documents from file inspection was successful only insofar as the appellant (patent proprietor) had requested, in the alternative, that the documents in question be made available for inspection in anonymised form only. The board pointed out, however, that the appellant could not successfully invoke the EU General Data Protection Regulation (GDPR) as this was not binding on the European Patent Organisation. The applicable law was instead to be found in the Guidelines for the Protection of Personal Data in the EPO of 1 April 2014, together with Art. 1(2)(a) of the decision of the President of the EPO dated 12 July 2007 concerning documents excluded from file inspection (OJ SE 3/2007, 125) and the provisions in Art. 128(4) and R. 144(d) EPC on which that decision was based.

In **T 2893/18** the board found that the fact that the contested documents were communicated to the other opponents was not in contradiction with their provisional exclusion from public inspection. The opposition division had at least provisionally excluded the contested documents from file inspection – as requested and as foreseen in the decision of the President of the EPO dated 12 July 2007 (OJ SE 3/2007, 125) – and examined their relevance for admission into the proceedings, their public availability and their exact influence on the patentability of the opposed patent before ultimately deciding on the issue of public file inspection.

1.2.2 Examples where file inspection was found not to be prejudicial to interests of appellant

In **T 2254/08** the board decided that the inspection of documents that were marked confidential on filing but were publicly accessible on the internet was not prejudicial to the economic interests of the appellant (proprietor).

In **T 1839/11** the board came to the conclusion that where a filed document contained information, some of which served the purpose of informing the public about the patent but some of which did not, the filing of a version of the document in a form from which the latter information had been redacted might form the proper basis for an order excluding

the unredacted document from file inspection under R. 144 EPC, the redacted version being open to file inspection.

In **T 1150/13** the board agreed that details of the arrangement for providing instructions to a representative did not serve to inform the public about the application and that such information was not normally obtainable from a file. However, the board rejected the request for exclusion of a letter requesting the postponement of oral proceedings on the basis that the appellant had not argued why the publication of the letter would be prejudicial to its legitimate personal or economic interest, and the board did not consider that this would be the case.

1.2.3 Examples where documents were excluded from file inspection

In **T 811/90** (OJ 1993, 728) the board ordered that documents that would not normally be excluded from public inspection pursuant to Art. 128(4) and R. 93(a) to (d) EPC 1973, but which were issued as an immediate consequence of a substantial procedural violation, be withdrawn from that part of the file available to public inspection. It was further ordered that the documents had to be returned to the filing party if it so requested. Similarly in **T 516/89** (OJ 1992, 436), the board ordered that documents marked "confidential" which did not belong to classes of documents to be excluded from file inspection be returned to the party concerned without note being taken of their contents. See also **T 760/89** (OJ 1994, 797).

In **T 264/00** two internal documents, belonging respectively to the appellant and to the respondent and concerning the outcome of a confidential meeting between two of their employees, contained confidential information on the conception, manufacture and marketing of some of the respondent's products. The board held that the dissemination of this information might effectively be prejudicial to legitimate economic interests. In agreement with both parties, the board excluded the documents from file inspection pursuant to R. 93(d) EPC 1973.

In **T 1401/05** of 20 September 2006 the board took the view that documents containing company-internal details could deprive the applicant and its domestic agent of valuable commercial assets, could be used by competitors to obtain a competitive edge over the appellant, and that a number of additional details could adversely affect the career opportunities of certain employees of the applicant and its domestic agent. It concluded that public inspection of essential parts of the documents would be prejudicial to legitimate economic interests of legal persons, and to legitimate personal and economic interests of natural persons. As the documents in question did not furnish patent information, the board excluded the relevant documents from file inspection.

In **T 99/09** the document for which inspection had been requested contained precise technical details, particularly as to the source of the constituents of a medicinal product available on the market and certain specifications for the product's manufacture. Given the technical nature of the document, the board concluded that its disclosure might indeed be prejudicial to the appellant's economic interests. Since the respondents had not objected to or commented on the request to exclude the document from inspection, it was excluded

under Art. 1(2)(a) of the EPO President's decision of 12 July 2007 (OJ SE 3/2007, 125) in the light of Art. 128(4) and R. 144(d) EPC.

In **J 23/10** it could be gathered from the document in question that the applicant had paid the renewal fees for certain applications for which they were not the registered applicant. These applications had been transferred to them but this had not been made public. It was still the assignor who was mentioned in the Register. In the Legal Board's view, this was information about internal relationships between the parties concerned, the publication of which could be prejudicial to their economic interests, while being irrelevant for the assessment of the patent application as such and therefore was to be excluded from file inspection.

In **T 1201/10** of 20 May 2019, the request for re-establishment of rights contained information about the appellant's financial affairs. The board held that the appellant had a legitimate personal interest that this information was not made public. This request for re-establishment was itself not relevant to the decision in the case in hand.

In **T 1534/16**, during written proceedings before the board, a number of documents were filed by the appellant before it withdrew its opposition, which were provisionally excluded from file inspection at the request of the appellant (patentee). The board, considering that the opponent and intervener had explicitly agreed in writing to the appellant's request and being satisfied that the documents in question did not serve the purpose of informing the public about the patent in suit, concluded that the above-mentioned documents should remain excluded from file inspection pursuant to R. 144(d) EPC.

In **T 575/23** the intervener had submitted document D20 with its notice of intervention and requested that it be excluded from file inspection under Art. 128(4) and R. 144(d) EPC (business information). It later produced a partially adapted version of the document in which some passages had been redacted. At the oral proceedings, it said that it had no objection to publication of this adapted version. The board decided to exclude the original version of D20 from public inspection. The adapted version contained all the information needed to examine the admissibility of the intervention and so excluding the original did not conflict with any public interest.

2. European Patent Register

2.1. General

Article 127 and R. 143 EPC (previously R. 92 EPC 1973) govern entries in the European Patent Register. Rule 143 EPC gives a list of items that are to be entered in the Register, additional entries required being specified in the EPO President's decision dated 15 July 2014 concerning the information given in the European Patent Register, which was adopted under R. 143(2) EPC. No entries can be made in the Register prior to the publication of the European patent application (see also **J 5/79**). The Register shows the state of the proceedings and the legal status of patents rights. Entries are made in it until the end of the opposition period or of opposition proceedings, as appropriate. In **J 12/16** the Legal Board held that, in view of the suspensive effect any appeal yet to be filed would

have, entries potentially interfering with the outcome of the then resulting appeal proceedings should not be made in the Register while the period for appeal (here, against a decision refusing requests for registration of a transfer and for a stay of grant proceedings) was still pending.

An entry in the Register recording the withdrawal of a patent application fulfils the same function as a publication in the European Patent Bulletin in that it amounts to a notification to the public (**J 25/03**, OJ 2006, 395; see also **J 14/04** and **J 12/03**). The withdrawal of an application cannot be retracted once it has been published in the Register (**J 2/15**).

In **T 194/15** the board held that the entry of a change of an opponent's name in the Register does not establish a right, it merely records it (see also **T 799/97**).

Under Art. 20 EPC in conjunction with the EPO President's decision dated 21 November 2013 concerning the responsibilities of the Legal Division (OJ 2013, 600), the Legal Division is usually responsible for decisions on entries and deletions in the Register (for exceptions – in cases where a request can be granted directly – see EPO President's decision dated 21 November 2013 concerning the entrustment to non-legally qualified staff of certain duties incumbent on the Legal Division, OJ 2013, 601). Appeals against such decisions are a matter for the Legal Board, not the technical boards (Art. 106(1) and 21(2) EPC). The entitlement of the proprietor entered in the Register cannot be questioned in either opposition or appeal proceedings (see **T 553/90**, OJ 1993, 666).

2.2. Registration of licences

As to the recording in the Register of an exclusive licence under a patent **already granted**, the Legal Board ruled in its decisions **J 17/91** (OJ 1994, 225) and **J 19/91** that registration was no longer possible once the patent had been granted because the EPO had renounced jurisdiction in favour of the national offices of the contracting states designated in the request for grant.

2.3. Registration of transfers

Article 72 EPC provides that an assignment of a European patent application must be made in writing and requires the signatures of the parties to the contract. Under R. 22 EPC, a transfer of a European patent application is recorded in the European Patent Register at the request of an interested party and on production of documents satisfying the EPO that the transfer has taken place. This is in line with the PCT system (R. 92*bis*.1 PCT). Rule 22 EPC applies to any transfer of the European patent made during the opposition period or during opposition proceedings (R. 85 EPC).

In J 5/23 of 4 September 2023, the Legal Board held that in the absence of an explicit legal basis, Art. 72 EPC was to be construed as requiring handwritten signatures of the parties. It must be noted however that R. 22 EPC was amended shortly after by decision of the Administrative Council CA/D 26/23 of 14 December 2023 (OJ 2024, A16), which entered into force on 1 April 2024. Accordingly, R. 2(2) EPC which provides that the authenticity of a document may be confirmed by handwritten signature or other appropriate means the

use of which has been permitted by the President of the EPO, shall apply mutatis mutandis to the signature of the parties in the context of R. 22 EPC. To this end, see decision of the President of the EPO dated 9 February 2024 concerning signatures on contracts and declarations under R. 22 and 85 EPC and R. 23 EPC (OJ 2024, A17).

The decisions listed below predate the entry into force of the aforementioned amendments to R. 22 EPC.

In **J 12/00** the Legal Board summarised the preconditions for registering a transfer of a European patent application (R. 20 EPC 1973; now R. 22 EPC) as follows: (i) a request of an interested party; (ii) the production of documents satisfying the EPO that the transfer has taken place; and (iii) the payment of an administrative fee. Documents relating merely to the obligation to transfer the right, but not to the transfer itself, were not sufficient to satisfy the EPO. Nor, according to the Legal Board, was it enough to cite registrations in different countries on the basis of documents other than assignment documents (similarly **J 4/10**).

In **T 128/10** the board held that the three requirements under R. 22 EPC in conjunction with R. 85 EPC, as formulated in **J 12/00**, did not need to be fulfilled at the same time. If they were met on different dates, the transfer would only have effect vis-à-vis the EPO at the date on which all the requirements mentioned above were fulfilled.

In **J 38/92** and **J 39/92** the Legal Board ruled that a transfer could only be recorded in the European Patent Register on the basis of an official document in accordance with R. 20(1) EPC 1973 if that document **directly** verified the transfer (similarly **J 4/10**). It did not suffice if a judgment was submitted which mentioned another document from which it was possible to verify the transfer.

In appeal proceedings, assessing whether there are documents satisfying the EPO that a transfer has taken place in accordance with R. 20(1) and (3) EPC 1973 and recording the transfer in the Register is a matter for the department of first instance responsible for making the entry in the Register. Accordingly, in appeal proceedings, substitution of another party for the original applicant is possible only once the relevant department of first instance has made the entry or where there is clear-cut evidence of a transfer (**J 26/95**, OJ 1999, 668; see also **T 976/97**; **T 1751/07**). In **T 393/15** the board held that evidence of a transfer could not be regarded as clear-cut if the person carrying out the transfer had not been clearly authorised to do so (see also **T 581/14**).

A transfer can be recorded in the Register even after deemed withdrawal of a patent application, if it is still possible that restitutio is available and the successor in title has taken, together with his request for registering the transfer, procedural steps suitable for restoring the application (**J 10/93**, OJ 1997, 91). See also **J 16/05**, **J 4/11**.

In **J 17/12** the Legal Board held that the transfer of a European patent application may not be recorded in the Register at a time when proceedings for the grant of the application are stayed under R. 14(1) EPC. There is nothing to stop the filing, during the suspension of grant proceedings, of a request to transfer the application, but no action will be taken on

the request during the suspension. While the fact of the transfer may not be apparent from the Register, it will be apparent from an inspection of the public file, as will the decision to stay the grant proceedings itself.

In **J 17/14** the Legal Board decided that the reversal of a completed transfer in the Register was not necessarily justified simply because doubts subsequently arose as to whether the claimed succession had been satisfactorily proven. There were cases where it might be more appropriate to stay the grant or opposition proceedings in favour of the party originally registered.

The Legal Board in **J 7/21** reviewed existing case law and concluded that none of the requirements in R. 22 EPC regarding the registration of transfers applied to cases of universal succession. See chapter III.O.1. "Party status as patent proprietor".

3. Stay of proceedings under Rule 14 EPC

3.1. Rule 14(1) EPC

3.1.1 General

Under R. 14(1) EPC (R. 13(1) EPC 1973) the EPO must stay the proceedings for grant ex officio if a third party provides it with evidence (under the EPC 1973, 'proof') that they have instituted proceedings against the applicant seeking a decision within the meaning of Art. 61(1) EPC (see **J 28/94**, OJ 1997, 400; **J 10/02**; **J 6/10**; **J 7/10**; **T 146/82**, OJ 1985, 267), unless the third party communicates to the EPO in writing their consent to the continuation of such proceedings, and unless the European patent application has been withdrawn or is deemed withdrawn (**J 28/94**, OJ 1997, 400; **T 146/82**, OJ 1985, 267). Suspension of proceedings during the period when the third party is seeking a judgement that they are entitled to the grant of the European patent has the objective of preserving the rights of the third party during the entitlement proceedings (**J 7/96**, OJ 1999, 443; **J 20/05**; **J 15/06**; **J 2/14**; **J 17/12**). A patent applicant who is not heard when grant proceedings are suspended at a third party's request pursuant to R. 13 EPC 1973 may still challenge the justification for that suspension (**J 28/94**, OJ 1997, 400).

In **J 14/19** the Legal Board summarised the previous case law as follows. A stay of grant proceedings takes effect immediately on the day the third party demonstrates that the requirements under R. 14(1) EPC have been met (**J 9/12**); proceedings can also be stayed with retroactive effect from that day (**J 7/96**, OJ 1999, 443; **J 36/97**; **J 15/06**). If a department of first instance has wrongly stayed grant proceedings, their continuation can be ordered on appeal only with effect for the future. The immediate effect of the stay cannot be set aside with retroactive effect or reversed by a decision in appeal proceedings (**J 9/06**; see also **J 10/19**).

In **J 28/94** (OJ 1997, 400) the Legal Board found that it was right not to hear the applicant in cases of suspension of proceedings, noting that R. 13 EPC 1973 said nothing about this. It justified the automatic and immediate nature of suspension by the fact that it

constituted a preventive measure in favour of the third party requesting it, and also by the need to maintain in full the rights derived from grant of the patent in dispute.

In **J 15/06** and **J 18/06** the Legal Board followed the justification in **J 28/94** (OJ 1997, 400). In **J 18/06** the Legal Board considered the communication ordering suspension to be a preliminary procedural measure "sui generis" which was justified as a preventive measure to preserve the third party's possible rights to the patent in dispute and took immediate effect. In **J 15/06** the Legal Board noted that the respondent's withdrawal of its request for suspension of the proceedings had significantly changed the procedural situation in the appeal proceedings. There existed no provision in the EPC that the withdrawal of a request for suspension had the effect that the suspension was automatically terminated. However, the existence of a legitimate interest of a third party was an unwritten prerequisite for a further stay of the proceedings under R. 13 EPC 1973. The withdrawal was therefore equivalent to and to be interpreted as consent to the continuation of the proceedings pursuant to R. 13(1) EPC 1973.

Under Art. 97(4) EPC 1973 (Art. 97(3) EPC) the grant proceedings ended on the date on which the European Patent Bulletin mentioned the grant. In the interim period, proceedings for grant were still pending before the EPO and a request for suspension of proceedings under R. 13 EPC 1973 was admissible (**J 7/96**, OJ 1999, 443). See also **J 33/95** of 18 December 1995, **J 36/97**, **J 15/06**, according to which the EPO could also order suspension pursuant to R. 13(1) EPC 1973 after the publication of the mention of the grant of a patent was acknowledged, provided that an allowable request had been filed before the publication. Suspension of the proceedings for grant meant that the legal status quo existing at the time they were suspended was maintained, i.e. neither the EPO nor the parties might validly perform any legal acts while the proceedings were suspended (**J 38/92** and **J 39/92**). See also **J 14/19**, in which the Legal Board held that proof of the existence of the conditions for a stay of proceedings under R. 14(1) EPC must be furnished during a pending grant procedure and thus before publication of the mention of grant in the European Patent Bulletin. Evidence filed after this date may not be taken into account by the EPO for this purpose.

In **J 20/05**, **G 1/09** and **J 9/12** the boards established that R. 14 EPC prevents the filing of a divisional application if the proceedings for grant concerning the earlier application are stayed. In **J 9/12** the Legal Board held that an application filed after the effective date of the stay of proceedings concerning the parent application, but before communication of stay, was to be treated as a divisional application.

In **J 10/02** the appellant argued that where an appeal was lodged against a decision to suspend grant proceedings, the provisions of R. 13 EPC 1973 appeared to be in conflict with those of Art. 106(1) EPC 1973, and that the provisions laid down by an article had to prevail over those of a rule. If the suspension of the grant proceedings were maintained, in spite of the pending appeal, this would amount to a serious procedural violation. The Legal Board, however, pointed out that the suspensive effect of an appeal served to provide an appellant with provisional legal protection in the sense that no action should be taken to implement the decision of the department of first instance in order not to deprive the appeal of its purpose. However, if the grant proceedings were continued and the

appellant were to arrive at a definitive end to the grant proceedings in its favour, this would be more than the appellant could achieve if it succeeded with the appeal under consideration.

3.1.2 Opening of proceedings before a national court

According to **T 146/82** (OJ 1985, 267), suspension had to be ordered if satisfactory proof of the opening of relevant proceedings before a national court was given to the EPO by a third party, provided that the European patent application had not been withdrawn or was not deemed to have been withdrawn.

In **J 36/97** the Legal Board, with reference to Art. 9(2) of the Protocol on Jurisdiction and the Recognition of Decisions in respect of the Right to the Grant of a European Patent of 5 October 1973 ("Protocol on Recognition"), stated that neither the jurisdiction of the national court whose decision was to be recognised nor the validity of such decision may be reviewed by the boards of appeal (see also **J 8/96**, **J 10/02**, **J 14/19**). When and how legally relevant civil proceedings were opened in a contracting state was likewise determined by national law (**J 7/00**). In **J 6/03** the Legal Board held that R. 13(1) EPC 1973 referred to proceedings which resulted directly, i.e. generally and automatically, in decisions mentioned in Art. 61(1) EPC 1973. The provision was therefore not applicable in respect of decisions of courts of third states (here, Canada).

In **J 9/06** the Legal Board pointed out that, according to **G 3/92** (OJ 1994, 607), only the courts of the contracting states had jurisdiction to decide claims to entitlement to the right to the grant of a European patent. It was not possible for the EPO, nor was it its function in the context of the examination of a request to suspend proceedings under R. 13 EPC 1973, to examine whether the subject-matter disclosed in a European patent application in respect of which suspension was requested corresponded to the disclosure of another application, ownership of which was disputed before a national court.

In the same vein, the Legal Board in **J 14/19**, observed that R. 14(1) EPC (R. 13(1) EPC 1973) did not specify when national proceedings were deemed to have been instituted. The issue of when they became pending was therefore to be assessed under the procedural law of the country whose courts had been asked to take a decision within the meaning of Art. 61(1) EPC (see also **J 2/14**, **T 1138/11**). Article 8 of the Protocol on Recognition supported this interpretation. It provided that if proceedings based on the same claim to a grant of a European patent and between the same parties were brought before different courts, the court to which a later application was made had to decline jurisdiction in favour of the court to which an earlier application had been made. Which court had been applied to first had to be determined on the basis of when proceedings had become pending. The Legal Board in **J 14/19** further held that, where the EPO was called on to apply foreign law, it had to do so within the overall context of the foreign legal system, wherever possible. When interpreting the foreign legislation to be applied, it was not bound by the case law of national courts, but if it was aware of the case law, in particular of the highest national courts, it should consider and evaluate it in coming to its decision. As regards whether instituting national proceedings might have involved an abuse of law ("Rechtsmissbrauch"), the Legal Board held that, to avoid contradictory interpretations, the

EPO should rule on any such issues autonomously, i.e. irrespective of national legal systems, even when they arose in relation to staying proceedings. Improperly asserting a right could amount to an abuse of law in some cases, for instance if the right was asserted predominantly with a view to causing damage, ahead of other, legitimate aims. The abuse of law had to be established beyond any doubt; that meant carefully examining and weighing up the circumstances of the individual case, with the burden of proof falling on whoever alleged the abuse.

In **J 15/13** the Legal Board found that while it was established case law that the board was not allowed to examine the substance and merits of a national entitlement case, the board's power of examination could not be limited to merely checking whether the claim submitted with the entitlement suit was directed to the transfer of the application, but – to a certain extent – it also allowed and possibly even required a consideration of the grounds given in the complaint of the entitlement suit. The board had to verify that the national proceedings were in accordance with R. 14(1) EPC, since to request a stay of the grant proceedings was a strong weapon which could be misused.

In **T 1473/13** the appellant's request for a stay of proceedings mentioned constitutional complaints pending before the German Federal Constitutional Court (FCC) on the basis of claimed insufficient judicial relief at the EPO against decisions of the boards of appeal. With reference to one of the constitutional complaints, the board explained that the appellant in the case in hand had not stated why and how a ruling on certain provisions of the EPC, its Implementing Regulations, the RPBA and the RPEBA could impact on other board decisions with effect for Germany. For the board it was not obvious that any FCC decisions on the constitutional complaints would have direct legal implications beyond those cases concerned. The appellant had also stated no possible disadvantage from a decision of the board in the case in hand in case of success of the constitutional complaints. The board held that in the absence of an established disadvantage for the appellant, the respective adverse consequences of staying or not staying the proceedings (i.e. the delay of the proceedings) could not be balanced. Consequently, the board held that the request for a stay must be refused.

3.2. Rule 14(3) EPC

Under R. 14(3) EPC (R. 13(3) EPC 1973), upon staying the proceedings for grant, the EPO may set a date on which it intends to resume the proceedings for grant, regardless of the stage reached in the national proceedings under R. 14(1) EPC. It is clear from the wording of R. 14(3) EPC that this is a discretionary decision (**J 33/03**; see also **J 2/14**; **J 3/18**).

In **J 10/02** the Legal Board, exercising its discretion under R. 13(3) EPC 1973 took into account the fact that the entitlement proceedings only concerned part of the invention and the duration of the suspension.

In parallel decisions **J 6/10** and **J 7/10** the Legal Board held that some aspects of the exercise of discretion under R. 14(3) EPC were (i) how long the proceedings before the national courts/authorities had been pending (with a period of more than four years held

to be considerable both for grant proceedings to be stayed and for entitlement proceedings to be pending in first instance) (ii) the duration of the suspension of grant proceedings, and (iii) requests for suspension of grant proceedings filed at a late stage.

In **J 15/13** the Legal Board held that the filing of the request under R. 14(1) EPC at the last possible moment could only be taken as an argument for the resumption of the grant proceedings if such behaviour appeared to be a misuse of the respondent's right to a stay of the grant proceedings.

In **J 4/17** the Legal Board held that the legislator had left it to practice and jurisprudence to define the circumstances that justify setting a date for resumption on a discretionary basis. Resumption of the proceedings was not limited to cases involving misuse or delaying tactics. The possibility that the EPO sets a date for resumption upon staying the proceedings for grant hints towards a broader construction. However, an applicant cannot justify its request for resumption based on the length of the entitlement proceedings where this duration has been significantly caused by the applicant's procedural conduct.

In **J 13/12** the Legal Board decided that in exercising its discretion under R. 14(3) EPC, the EPO had to weigh the interests of the applicant up against those of the third party which had brought a national action to determine rights against the applicant. The Guidelines for Examination, as internal administrative guidelines, could also be consulted; but they gave no indication that the national proceedings had to be finally determined, where applicable after exhaustion of all legal remedies, before a date for resuming the grant proceedings could be set, or at any rate before they could actually be resumed. See also **J 14/19**.

In **J 1/16** the Legal Board held that where, when deciding not to resume proceedings, the Legal Division had properly identified and exhausted its scope for discretion and weighed up the situation in the light of all the relevant factors, without being influenced by anything irrelevant and without making any logical mistakes in its assessment of the facts, it was not open to the Legal Board to exercise its own discretion in the Legal Division's place. Where a decision is basically to be upheld, a subsequent change in circumstances (in the case in hand: an appeal court ruling in national entitlement proceedings) can nevertheless present a ground for adapting it.

In **J 3/18** the Legal Board agreed with the decision of the Legal Division not to set a date for resumption of the grant proceedings pursuant to R. 14(3) EPC. The appellant had alleged, inter alia, that further actions of the respondent (third party) could last for at least a further six years. The Legal Board found that the fact that litigation in the Belgian legal system was extremely long until the final decision is reached could not influence the outcome of the appeal proceedings, because it was unclear how long these proceedings would actually take and what consequences these would have for the parties.

The board held in **T 146/82** (OJ 1985, 267) that if, in accordance with R. 13(3) EPC 1973, the EPO set a date on which it intended to continue the proceedings for the grant of the European patent, the date might be varied or the order staying the proceedings might be

discharged at the subsequent request of the applicant or of the third party who applied for the order.

In parallel decisions **J 10/21** and **J 11/21** the Legal Board held that, when exercising discretion under R. 14(3) EPC, the Legal Division had to weigh up the interests of the applicant against those of the third party who had initiated the national entitlement proceedings, and in doing so keep in mind the legislative aim of Art. 61 EPC (**J 14/19**, **J 13/12** and **J 2/14**). However, only the national courts had the competence to settle the issue of actual entitlement. As a rule, therefore, the EPO had to weigh up the relevant interests under R. 14(3) EPC without any assessment of the merits of the national court proceedings (**J 24/13** und **J 2/14**) and thus on the basis of different criteria. The Legal Board observed first of all that the following factors in particular had to be taken into account (**J 14/19**, **J 6/10** and **J 15/13**): (i) how long the proceedings before the national courts or authorities had already been pending, (ii) how long the grant proceedings had already been stayed, (iii) whether the stay had been requested at a late stage in the grant proceedings and (iv) whether the third party's conduct had involved any abuse of rights. It was for the applicant to submit the facts forming the basis for assessing these or other criteria.

N. Observations by third parties

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1. Introduction

Under Art. 115 EPC, any third party may present, in proceedings before the EPO, following publication of the European patent application, observations concerning the patentability of the invention to which the application or patent relates. There are no fees or deadlines for presenting such observations. The third party is not a party to the proceedings. Rule 114(1) EPC requires that any such observations be filed in an official language of the EPO, while R. 114(2) EPC states that they will be communicated to the applicant or patent proprietor. Third-party observations are an integral part of the file and, as such, open to inspection under Art. 128 EPC. More information can be found in the Guidelines (see e.g. Guidelines A-VII, 3.5, A-XI, 2.1, D-X, 4.5 and E-VI, 3 – April 2025 version), the decision of the President of the EPO dated 10 May 2011 (OJ 2011, 418) and the notice from the EPO dated 5 July 2017 concerning the filing and processing of third-party observations (OJ 2017, A86).

Observations must be restricted to the substantive requirements of the EPC (see for instance **T 172/13**, where third-party observations relating to procedural issues, i.e. admittance of claim requests, were held inadmissible). Most observations concern lack of novelty and/or lack of inventive step. In the proceedings for petition for review **R 18/11** third-party observations were filed. The Enlarged Board considered the observations to be inadmissible, because according to Art. 115 EPC such submissions had to concern patentability, and patentability issues could not be the subject of review proceedings under Art. 112a EPC.

EPO departments have discretion under Art. 114(1) EPC to admit third-party observations of their own motion, in particular where they consider them to have some bearing on the outcome of the proceedings (**T 1216/12**). Observations that contain legal or technical information relevant for the decision in hand will generally be considered (**T 866/01**).

Article 115 EPC helps to ensure that no legally invalid patents are granted or maintained. The public must be able to rely as far as possible on the legal validity of a patent granted by the EPO (**T 156/84**, OJ 1988, 372; **T 1495/09**). This provision protects the public interest in ensuring that no European patent is granted which does not meet the EPC requirements and, to that end, permits third parties to act as, so to speak, the public's "mouthpiece" by providing additional information to support the expertise within the EPO (**G 2/19**, OJ 2020, A87; **T 60/91**, OJ 1993, 551).

2. Formal requirements

2.1. Language of the documents

Under R. 114(1) EPC, any observations by a third party must be filed **in writing** in an official language of the EPO, i.e. English, French or German; otherwise, they are deemed not to have been filed (Art. 14(4) EPC). Observations not filed in an official language and so deemed not to have been filed are nevertheless added to the file and so accessible to the public under Art. 128(4) EPC. Third-party observations will be communicated to the applicant or patent proprietor even if they have not been filed in one of the prescribed official languages (Art. 14(4) EPC, R. 114(1) EPC).

Rule 114(1) EPC also explicitly provides for applicability of R. 3(3) EPC, which states that **documentary evidence** and, in particular, publications may be filed in any language. The EPO may, however, require that a translation in one of its official languages be filed, within a period to be specified. If a translation is not filed in due time, the EPO may disregard the document in question.

2.2. When can third-party observations be filed?

Article 115 EPC specifies that observations cannot be filed until after publication of the European patent application but sets no upper time limit for their presentation by persons wishing to make adverse observations concerning the patentability of inventions claimed in patent applications/patents. This means that observations can also be filed during opposition proceedings, even after expiry of the opposition period, and during appeal proceedings (**T 390/90**, **G 9/91**, OJ 1993, 408, **T 1756/11**, **T 2255/15**, **T 972/22**). Art. 115 EPC explicitly covers all proceedings before the EPO and so applies, in principle, to revocation and limitation proceedings too.

2.3. Pending proceedings

Article 115, second sentence, EPC according to which a third party shall not be "a party to proceedings before the European Patent Office", assumes that proceedings are pending before the EPO.

In **T 580/89** observations submitted by a third party were not added to the file until after the decision had been taken and were therefore not considered.

In **T 690/98** the question arose as to whether observations filed by a third party could give rise to a reassessment by the EPO of its own motion, under Art. 114(1) EPC, of the patentability of the subject-matter of the contested patent, even if the appeal proved to be inadmissible. In the board's view, the answer was no, since the admissibility of an appeal, according to Art. 110(1) EPC 1973, was a prerequisite for examination of the appeal. The substance of the contested decision could only be examined when admissibility was established. Therefore, objections by third parties lodged at the appeal stage were not to be examined by the EPO of its own motion as there no appeal proceedings were pending.

2.4. Anonymously filed observations

According to the EPO notice dated 5 July 2017 concerning the filing and processing of third-party observations (OJ 2017, A86), third-party observations may be filed anonymously.

In the inter partes proceedings **T 735/04**, document D6, a patent application by one of the patent proprietors, was cited in anonymous third-party observations. Since D6 was highly relevant for the patentability of the claimed subject-matter and could cause the patent to be revoked, it was introduced into the proceedings.

In **T 146/07** anonymous third-party observations were received by the board at a very late stage. According to R. 114(1) EPC, any observations by a third party must be filed in writing. The board stated that this requirement implied that the observations had to be signed (see R. 50(3) and 86 EPC) in order to allow an identification of the third party. Identification is particularly important in the context of opposition proceedings in order to allow the competent organ of the EPO to verify whether the observations have indeed been filed by a third party rather than by a party to the proceedings. Otherwise, a party might be tempted to submit late observations and/or documents by means of anonymous third-party observations in order to avoid negative procedural consequences such as apportionment of costs. The board was aware that anonymously filed third-party observations might nevertheless be adopted by a party to the proceedings as its own or may even trigger objections by the competent organ of the EPO of its own motion (see above **T 735/04**). In the absence of such a further procedural act, anonymous third-party observations are to be disregarded altogether. This view is in line with the decisions **G 1/03** and **G 2/03** (OJ 2004, 413 and 448) in which the Enlarged Board refused to take into account an anonymously filed third-party statement. In **T 1439/09** and **T 1635/15** the board agreed with this line of reasoning. Therefore, the anonymous observations filed under Art. 115 EPC were deemed not to have been filed and were disregarded by the board.

In view of these decisions, the board in **T 1756/11** held that anonymous third-party observations made at a very late stage in the opposition appeal proceedings should be disregarded on formal grounds, in order to preclude covert abuse of procedure by parties to the proceedings. Likewise in **T 1181/12**, **T 379/13**, **T 345/15** and **T 1876/18** the board

did not take into consideration third-party observations which were submitted anonymously during the appeal proceedings.

In **T 1336/09**, however, the board came to the conclusion that in this **ex parte case** the anonymous character of the third-party observations did not bar them from being admitted into the procedure. The board referred to earlier decisions of the boards, which did admit such observations, both in ex parte and inter partes appeal proceedings without apparent misgivings in relation to their anonymous character (**T 735/04**, **T 258/05**). Unlike **T 146/07**, which had concerned an inter partes appeal, the case at hand here (**T 1336/09**) concerned ex parte proceedings, in which the appellant was the sole party and could raise new issues or submit new prior art at any time – as could the board of its own motion by virtue of Art. 114(1) EPC. Accordingly, the risk of anonymous third-party observations providing a cover for procedural abuse could largely be excluded.

In **T 1528/13** the board noted that observations under Art. 115 EPC had been received and signed by a member of a firm of European representatives. That meant they did not come from an unidentified third party and were therefore not inadmissible on that basis (see also **T 1224/09**).

2.5. Reasons for observations

Rule 114(1) EPC requires, among other things, that third-party observations state the grounds on which they are based.

In **T 189/92** the board held that it was the responsibility of the third party to ensure that the facts and evidence filed were not only unequivocally clear but also as complete as possible, so that they could be handled directly by the investigating instance without doubt and without further inquiry.

In **T 908/95** the evidence adduced to show fulfilment of the criteria for establishing public prior use, in particular public availability, did not substantiate or prove such fulfilment to the extent that the allegation could be accepted. The board found that the additional inquiries needed to prove it, which might even include the hearing of witnesses, could only be conducted with the co-operation of the "third party", but that this was impossible where the person in question was not a party to the proceedings. The third party's observations therefore had to be disregarded (see also **T 73/86**).

In **T 301/95** (OJ 1997, 519), the opposition division had disregarded third-party observations as to a claim of public prior use, as the alleged facts had not been proven with near certainty.

3. Third party's legal status

3.1. General issues

Article 115, first sentence, EPC states that **any** third party may present observations. There is no requirement to state whether the third party is acting in its own name or on behalf of someone else (**T 1224/09**, **T 1528/13**).

In **T 811/90** the patentee had filed an appeal against a decision of the opposition division concerning the removal of certain documents from the public part of the file. The opponent was not a party to the impugned decision and was consequently not entitled to be a party to the proceedings before the board. The request of the opponent was therefore inadmissible but was admitted as an observation by a "third party".

Similarly, the board in **T 446/95** held that the intervention of a company was inadmissible, so its auxiliary requests were also inadmissible. However, there was nothing to prevent the company's observations and the documents it had filed from being dealt with under Art. 115 EPC 1973 (**T 223/11**).

In **T 7/07** the board agreed with the findings in **T 1196/08** that an intervention based on proceedings for infringement of a patent that has effect in a particular state solely on the basis of national law is inadmissible. The intervener's submissions were consequently regarded as third-party observations under Art. 115 EPC.

In **T 887/04** of 14 November 2006 the board found that, although the intervention had to be held inadmissible, account had to be taken of document D5 cited by the intervener under Art. 115 EPC 1973 for the purposes of examining novelty and inventive step, because, despite its belated submission, it was highly relevant. On the admissibility of interventions, see chapter III.P.1.

In **T 1860/13** the board stated that with the withdrawal of their oppositions, the opponents renounced to their positions as parties to the proceedings and accordingly to any active role in them. The fact that the opposition division continued ex officio with the examination of the oppositions did not affect this. The submissions filed by opponent III, following the filing of the statement of grounds by the appellant (patent proprietor), were therefore regarded as observations made by a third party.

3.2. Third party's procedural rights

According to Art. 115, second sentence, EPC a third party is not a party to the proceedings. In principle, therefore, third parties have none of the procedural rights associated with such status, in particular the right to appeal and the right to be heard (**T 1756/11**; **G 2/19**, OJ 2020, A87; see also **T 1196/08** citing **G 4/88**, point 2 of the Reasons). In **T 831/17** of 21 October 2019, the board observed that the EPC legislator had decided to confer a right of appeal only on parties to proceedings and not on authors of third-party observations (**T 660/19**). It was held in **G 2/19** that a third party does not become a party to proceedings by virtue of its comments having been considered in those

proceedings. A third party's lack of status as a party to the proceedings also goes hand in hand with a lack of any adverse effect, for legal purposes, ensuing from the decision taken in those proceedings. That is consistent with the object and purpose of Art. 115, first sentence, EPC.

In **T 951/91** (OJ 1995, 202) the board found that by interpreting the words "shall not be a party to the proceedings" in Art. 115 EPC 1973 in the light of their object and purpose, it was clear that they were intended exclusively to cut down, and not to extend, the rights of third parties, still less to extend their rights beyond the rights of parties to the EPO (see also **T 1756/11**, **T 1528/13**, **T 2255/15**, **T 1574/17** and **T 1779/17**).

According to **T 390/07,** the admissibility of third-party observations is entirely a matter for the board as a third party within the meaning of Art. 115 EPC is not a party to the proceedings and has no more than an opportunity to "present observations". While it is well-established by case law that third-party observations can be considered, both at first instance and on appeal, there is no obligation on the board beyond such consideration and no right of a third party to be heard on the admissibility of its observations or any evidence in support of them. The actual parties to proceedings have the right to be heard in relation to such observations, but their admissibility is entirely a matter for the board.

In **T 283/02** the opposition division had duly forwarded the observations by third parties to the patentee, who had made no comment. The failure of the opposition division to mention these observations in its decision did not constitute a procedural violation, even though a mention would have been desirable. See also, in **T 1756/11**, in which the board observed that the opposition divisions should at least comment on the relevance of third-party observations, for example in the summons to oral proceedings (see also **T 972/22**).

4. Third-party observations in opposition-appeal proceedings

4.1. Third-party observations and the extent of opposition

Examination of an opposition is limited to the extent to which the patent is opposed in the notice of opposition. If the opponent limits the notice of opposition to certain matters, the remaining matters are not opposed within the meaning of Art. 101 and 102 EPC 1973 (now merged in Art. 101 EPC) or the subject of any proceedings within the meaning of Art. 114 and 115 EPC 1973 (**G 9/91** and **G 10/91**, OJ 1993, 408 and 420). The opponent thereby deliberately refrains from exercising its right under the EPC to oppose the other matters covered by the patent and, consequently, the EPO has no competence to deal with them at all. For more details on the extent of opposition, see chapter IV.C.3.2.

Following **G 9/91** and **G 10/91**, the board in **T 580/89** of 28 April 1993 concluded that it had no power to examine the patentability of the subject-matter of claims which had not been opposed in the notice of opposition but were the subject of observations by the third party under Art. 115 EPC 1973 which had not reached the EPO until after the decision of the opposition division had been taken.

4.2. Introducing a fresh ground for opposition in opposition proceedings

An opposition division may, in application of Art. 114(1) EPC, of its own motion raise a ground for opposition not covered by the statement pursuant to R. 55(c) EPC 1973 (R. 76(2)(c) EPC) but referred to by a third party under Art. 115 EPC 1973 after the expiry of the time limit laid down in Art. 99(1) EPC 1973. The Enlarged Board emphasised that the consideration of grounds not properly covered by the statement should only take place before the opposition division in cases where, prima facie, there were clear reasons to believe that such grounds were relevant and would in whole or in part prejudice the maintenance of the patent. The possibility under Art. 114(2) EPC of disregarding facts and evidence in support of fresh grounds not submitted in due time should, of course, also be kept in mind (**G 9/91**, OJ 1993, 408; **T 356/94**; **T 1053/05**).

4.3. Introducing a fresh ground for opposition in appeal proceedings

In an appeal procedure, the provisions of Art. 114(1) EPC have to be interpreted in a more restrictive manner than in an opposition procedure and, accordingly, fresh grounds for opposition raised by an opponent or referred to by a third party under Art. 115 EPC 1973 after expiry of the time limit laid down in Art. 99(1) EPC 1973 may in principle not be introduced at the appeal stage, unless the patentee agreed (**G 9/91** and **G 10/91**, OJ 1993, 408, 420).

In **T 667/92** of 27 November 1996 the board disregarded third-party observations because the patentee had not consented to their admission.

In **T 1667/07** some documents which were copies of submissions made by third parties during the examination of the application were submitted as evidence in support of fresh grounds for opposition raised for the first time on appeal. The board pointed out that since, according to **G 10/91**, it could not consider the fresh grounds of opposition put forward by the appellant for the first time in appeal proceedings – as the patent proprietor opposed to their introduction into the proceedings – it could not consider **evidence** submitted in their support either.

4.4. Third-party observations presented after expiry of the opposition period

4.4.1 General

Because Art. 115 EPC sets no upper time limit for presenting third-party observations, in principle they can also be filed after expiry of the opposition period, and so even during inter partes appeal proceedings. Although the Art. 114(2) EPC provision on late-filed submissions mentions only the parties to the proceedings, established case law holds that submissions (i.e. facts and evidence) emerging from third-party observations not filed until after expiry of the opposition period are likewise to be treated, by way of a legal fiction, as "late". This means that Art. 115 EPC cannot serve to extend third parties' rights, let alone extend them beyond the rights of parties to the proceedings. In other words, where third-party observations are filed after the time limit under Art. 99(1) EPC, the principle enshrined in Art. 114(1) EPC of examination by the EPO of its own motion is to be applied

on the fictional basis that those observations are late, i.e. they are subject to the criteria developed in the case law for the board's exercise of discretion in deciding whether to admit late-filed submissions within the meaning of Art. 114(2) EPC. **T 1756/11** citing **T 580/89**, **T 951/91**, **G 9/91** and **G 10/91**; see also **T 402/12**, **T 1216/12**, **T 1528/13**, **T 1285/15**, **T 1574/17**, **T 2913/19**, **T 972/22**.

It is also established case law that, since the RPBA specify some criteria for exercising this discretion in appeal proceedings with respect to the submissions of the parties to the proceedings, these criteria also apply to third-party observations. See e.g. **T 2255/15**, **T 1779/17**, **T 2391/18**, **T 1321/19**, **T 2913/19**, **T 2342/19**.

Irrespective of a third party's legal status, the principle that the EPO must examine the facts of its own motion in first-instance administrative proceedings does not have the same legal importance in judicial appeal proceedings, in particular in inter partes proceedings (**G 9/91** and **G 10/91**, OJ 1993, 408, 420). See chapter V.A.3.3. "Facts under examination – applying Art. 114 EPC in appeal proceedings ".

In **T 301/95** of 28 March 2000 a third party had alleged public prior use after expiry of the period for opposition, i.e. belatedly. Under Art. 114(2) EPC, it was at the discretion of the opposition division and the board whether or not to consider the belated submissions, but in deciding whether to do so, the most important criterion was the relevance of the belatedly cited prior art. The observations were not considered.

According to **T 923/10,** the boards have discretion to take such observations into consideration or to disregard them. When exercising their discretion, the boards normally take criteria into account which they consider when they decide about the admissibility of submissions by parties to the proceedings that are considered "late-filed" in view of Art. 114(2) EPC and the RPBA. These criteria include the relevance of the submissions filed (see for example **T 1137/98**, **T 390/07**, **T 544/12**). More specifically, it is the boards' established case law that a crucial factor is whether submissions filed late in appeal proceedings are prima facie highly relevant, i.e. likely to change the outcome of the proceedings (**T 1216/12**, **T 2342/19**, **T 1321/19**). In **T 1348/11** the board added that submissions provided by a third party should not be given a more favourable status than submissions of a party to the proceedings to whom Art. 114(2) EPC applies (**T 1574/17**, **T 1427/21**).

4.4.2 Third-party observations admitted

In **T 1216/12** third-party observations had been filed together with an employee statement asserting that the test results cited in the notice of opposition were erroneous and so irrelevant. The board observed that, since these test results had been used in the contested decision as a basis for assessing whether the claimed subject-matter involved an inventive step, the statement raised serious doubts about that assessment. It therefore admitted the observations as prima facie highly relevant.

In **T 1224/09** a third party had submitted documents D53 to D55 (Japanese patent applications) at the start of the appeal proceedings. The board considered documents D53

to D55 to be prima facie relevant, as they had led to the refusal of the corresponding application before the Japanese Patent Office. The board stated that third-party observations could be submitted at any time as long as proceedings were pending. Admitting and considering such observations, however, was an issue to be decided by the competent department of the EPO. In the case of the boards of appeal, the principles set out in Art. 13 RPBA 2007 seemed to be a reasonable basis on which the discretion to admit the third-party observations was to be exercised.

The observations under Art. 115 EPC were filed more than 1 1/2 years before the oral proceedings so that the parties and the board had sufficient time to consider the document. The board had also notified the parties that it considered document D27 to be relevant. None of the parties had requested that the submission of the third party be disregarded. Thus, exercising its discretion pursuant to Art. 114(2) EPC, the board decided to admit the submission of the third party into the proceedings (**T 458/07**).

4.4.3 Third-party observations not admitted

In **T 637/09** the board took into account that, when exercising its discretion, it should not accord the third party within the meaning of Art. 115 EPC more favourable treatment than would be given to an actual party seeking to introduce such submissions shortly before the oral proceedings. The board explained that the third-party observations contained inter alia new submissions which would, if admitted at that late stage, have compromised the fairness of the proceedings. Hence, the third-party observations were not admitted into the proceedings (see also **T 1348/11**, **T 346/15** and **T 1876/18**).

In **T 953/02** the respondent had challenged the submission under Art. 115 EPC 1973 because of a signature which was deficient, i.e. not that of a natural person. The submission by the third party was filed substantially less than one month before the oral proceedings. The board did not admit it into the proceedings.

In **T 1528/13** not only had the third-party observations been presented well after the notice of appeal had been filed but neither they nor the evidence produced in support of them appeared prima facie any more relevant than the submissions already on file. See also **T 771/13**.

5. Remittal following filing of observations

A board may choose to remit a case to the department of first instance as a result of observations filed under Art. 115 EPC. See for example, **T 249/84** and **T 176/91** of 10 December 1992.

In **T 929/94** a preliminary examination by the board of the third-party observations and the supporting material showed that an entirely new case based on new facts and evidence had been presented against the patentability of the claimed invention in these observations. In order to preserve the applicant's right to review through appeal of any adverse decision of the department of first instance, the board remitted the case for examination of and decision upon such new material, as requested by the applicant.

In **T 41/00** a document submitted during the appeal proceedings by a third party under Art. 115 EPC 1973 appeared to come closer to the claimed subject-matter than any of the prior-art citations considered during the examination proceedings. However, since the question of whether the document had been available to the public at the patent's priority date remained open, the case was remitted to the department of first instance.

In **T 848/06** the board intended to remit the case to the department of first instance. The board concluded that it would not be appropriate for the board to take into account the third-party observations so as not to prejudice their consideration by the said department.

In **T 30/01** the case was remitted to the department of first instance for further prosecution. The board stated that the opposition division would also have to consider whether to admit or disregard the observations presented during the appeal proceedings by the third party and partially incorporated by reference in the respondent's own case. Similarly, see **T 172/13** where the case was remitted for further prosecution and the board left it for the examining division to decide whether to take the second third-party observations into account.

For more details on remittals, see chapter V.A.9. "Remittal to the department of first instance".

O. Transfer of party status

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1. Party status as patent proprietor

Where the European patent is transferred during opposition proceedings, the new patent proprietor entered in the Register takes the place of the previous patent proprietor both in the opposition and in the appeal proceedings. The new patent proprietor's entitlement may not be questioned in these proceedings (**T 553/90**, OJ 1993, 666).

For a transferee of a patent to be entitled to appeal, the necessary documents establishing the transfer, the transfer request and the transfer fee pursuant to R. 22 EPC must be filed **before** expiry of the period for appeal under Art. 108 EPC. Later recordal of the transfer does not retroactively validate the appeal (**T 656/98**, OJ 2003, 385). In appeal proceedings, substitution of another party for the patent proprietor is possible only once the relevant department of first instance has made the entry in the Register or where there is clear-cut evidence of a transfer (**J 26/95**, OJ 1999, 668, **T 593/04**). The procedural requirements to be fulfilled for recording the transfer of a European Patent in the Register (filing of a request, providing evidence, payment of a fee) need not be fulfilled at the same time. If they are met at different times, the transfer takes effect vis-à-vis the EPO from the date on which all of these requirements are fulfilled (**T 128/10**). The original party remains, as long as the transfer has not been proven, a party to the proceedings, with all its rights and obligations (see **T 870/92** of 8 August 1997). A name change does not result in a change of legal identity (see **T 19/97** and, in this chapter III.O.2.1, **T 7/21**).

In **T 1068/15** and **T 1001/15** the applicant requested transfer of the patent application during pending appeal proceedings. The Legal Division did not register the alleged transfer. The board considered that it had to examine the question of party status ex officio before dealing with the substance of the case (with reference to **G 2/04**). In doing so it was not bound by the assessment of other departments of the EPO or by the state of the Register (with reference to **T 854/12**).

In **T 15/01** (OJ 2006, 153) the board distinguished between the situation where a party acquired a patent through a transfer, as in **T 656/98** and through a merger, as in the case before the board. It held that R. 20(3) EPC 1973 (now R. 22(3) EPC) did not apply in the latter case, where the change of proprietor status was caused by universal succession in law. The universal successor of a patent applicant or patentee automatically acquired party status in proceedings pending before the EPO.

The transfer of party status as patent proprietor must be distinguished from a "transfer" of the legal entity from one jurisdiction to another. In **T 786/11** the patent proprietor had requested that the address of the "applicant (patentee)" be changed from one in the British Virgin Islands to one in Mauritius and submitted evidence that it had merely changed its address. The board held that both these jurisdictions – unlike many others – allow a legal entity to be transferred from one jurisdiction to the other without any effect on its identity. The board therefore concluded that the respondent had been "transferred" from the British Virgin Islands to Mauritius and had continued as a legal entity under Mauritian law (see also **T 2330/10** and **T 1458/12**).

2. Party status as opponent

2.1. General principles

The status as an opponent cannot be freely transferred (**G 2/04**, OJ 2005, 549). The opponent does not have a right of disposition over its status as a party. If the opponent has met the requirements for an admissible opposition, it is and remains an opponent until the end of the proceedings or its involvement in them. The opponent cannot offload its status onto a third party (**G 3/97**, OJ 1999, 245, **T 298/97**, OJ 2002, 83).

However, in the following two circumstances the status as an opponent may be transferred:

- in the case of universal succession of the opponent (**G 4/88**, OJ 1989, 480, **T 475/88**, **T 1091/02**, OJ 2005, 14); or

- when a relevant part of the opponent's business has been transferred (**G 2/04**, **T 670/95**), in which case the transfer or assignment of the opposition to a third party has to be made as part of the transfer or assignment of the opponent's business assets together with the assets in the interests of which the opposition was filed (**G 4/88**, OJ 1989, 480).

Opponent status may also be transferred in opposition appeal proceedings (**T 659/92**, OJ 1995, 519, **T 670/95**, **T 19/97** and **T 1268/17**). In **T 563/89** the board held that the right to lodge an appeal may also be transferred to a third party, based on the same reasons as developed in case **G 4/88**.

A transfer of an opposition has to be requested at the EPO together with supporting evidence before it can take effect (**T 1137/97**, **T 19/97**, **T 1911/09** and **T 1268/17**). This does not apply to cases of universal succession where the opponent status is automatically acquired from the date of the effective succession (**T 6/05**, **T 425/05**,

T 2382/10); in the case of universal succession the change may – upon request and production of evidence by either party – be recorded with retroactive effect as from the effective date of the legal succession (**T 2357/12**).

The EPO has a duty to examine, ex officio, the status of the opponent at all stages of the proceedings. This duty not only extends to the admissibility of the original opposition, but also to the validity of any purported transfer of the status of opponent as a new party (**T 1178/04**, OJ 2008, 80). Even if the objection against the admissibility of the appeal and the appellant's status as party is raised very late, namely at the beginning of the oral proceedings before the board, this issue has to be examined ex officio at every stage of the appeal proceedings; an appellant's objection against the late introduction of this issue can therefore not succeed (**T 1415/16**).

In **T 7/21** company X GmbH had filed an opposition against the patent in suit as opponent 1. The company had been renamed Y GmbH, as evidenced by the extract from the commercial register submitted by the appellant. The board concluded that Y GmbH was therefore entitled to file an appeal against the decision of the opposition division. The fact that the name change had not been recorded in the EPO's systems until some time after it had taken place and/or that the request for transfer had not been directly accessible to the public via file inspection did not change the status of Y GmbH as opponent 1.

2.2. Universal succession

In **T 349/86** (OJ 1988, 345) the board referred to R. 60(2) EPC 1973, which stated that in the event of the death of the opponent the opposition proceedings could be continued by the EPO of its own motion, even without the participation of the heirs. According to the board this may be read as definitely stating that an opposition may be transferred to a deceased opponent's heirs and, by analogy, to a company absorbing the opposing company by merger or takeover (see also **T 1091/02**, OJ 2005, 14). In **G 4/88** the Enlarged Board confirmed that the opposition may be transferred to the opponent's universal successor in law (point 4 of the Reasons). In **T 475/88** the board held that the appeal was admissible because the opponent status had been transferred to the company that filed the appeal as a result of its merger with the initial opponent.

In **T 2357/12** the board was concerned with a situation in which the transfer of all assets of an enterprise had been made whose legal entity had subsequently been dissolved. The board noted that "universal succession" as an exception to R. 22(3) EPC was a concept of procedural law under the EPC and was to be construed autonomously by the EPO, independently of national law. Under the case law of the boards of appeal, the main considerations for acknowledging that a universal succession has taken place were legal certainty as to the person of the successor and the need to avoid a legal vacuum. The transfer of all assets of an enterprise, immediately followed by its dissolution as a legal entity, could therefore constitute universal succession. The board concluded that although there was no genuine concept of "universal succession" under the national law in question (State of Delaware), the case at hand was to be considered one of universal succession under the EPC. See also **T 1755/14** for a case in which universal succession occurred through "accrual" ("Anwachsung" under German law).

In **T 660/15** the board agreed with **T 2357/12** that the concept of universal succession had to be interpreted autonomously, i.e. independently of national law. An essential point for accepting universal succession was that there was only one transferee possessing all the assets and the former opponent had ceased to exist, so that no legal uncertainty could arise about who the opponent was. See also **T 1575/17**, which was a case of universal succession as per the case law of the boards of appeal (**G 4/88**, **T 475/88** and **T 2357/12**) because both the change of the company's legal form and the merger with another company had given rise, each time, to a single legal entity which remained the owner of all the opponent company's assets and liabilities.

In **T 659/92** (OJ 1995, 519) there had been no universal succession. There was nothing to indicate that the opponent's business assets had been contractually transferred. The board concluded that a unilateral declaration by the owner of rights that he had transferred industrial property rights and opponent status in proceedings relating to a particular right could not of itself effect universal succession by transfer of business assets.

In **T 531/11** the board held that an excerpt from a purchase contract stating that a company had been acquired "through sale of individual business assets" showed that under the terms of the contract there had been no universal succession.

2.3. Transfer together with the business assets to which the opposition relates

In **G 4/88** the question referred to the Enlarged Board (**T 349/86** of 29 April 1988) was whether an opposition instituted before the EPO is transferable only to the opponent's heirs or whether it may be transferred freely either with the opponent's enterprise or with a part of that enterprise operating in a technical field in which the invention to which the patent in suit relates can be exploited. The Enlarged Board examined the situation in which the opposition has been instituted in the interest of the opponent's business or part of that business. The term "business" was understood in a broad sense as describing an economic activity which is or could be carried on by the opponent and which constituted a specific part of the opponent's business assets. In such a situation, the opposition constituted an inseparable part of those business assets. Insofar as those assets were assignable under applicable national laws, the opposition which was part of them had also to be regarded as transferable. The Enlarged Board answered the referred question by stating that an opposition pending before the EPO may be transferred or assigned to a third party as part of the opponent's business assets together with the assets in the interests of which the opposition was filed. Applying **G 4/88** to the facts of the case the board in **T 349/86** thus held in its decision of 30 November 1989 that the universal successor in title of the original opponent had transferred its opponent status to the singular successor of part of its industrial and commercial activity (operations in the commercial vehicle field) to which the opposition related.

In **T 9/00** (OJ 2002, 275) the board found as follows: if, as was the case, the subject of an opposition is assigned to two different parts of the opponent's company, the status of opponent can pass to a third party only if both parts or the entire company are transferred to it.

In **T 298/97** (OJ 2002, 83) the board held that the transfer may be to one, and one only, successor or transferee.

In **T 799/97** the opponent had gone bankrupt during the opposition proceedings. The board held that the opponent's entire business, and so the activities to which the opposition related, had been transferred to the company with which the administrator had concluded a contract of sale. Not all receivables and liabilities had been acquired, but that had not been established as an essential prerequisite for the transfer of opponent status in **G 4/88** and **T 659/92**. In **T 384/08** the board confirmed that the mere fact that certain assets were explicitly excluded in an assignment contract was as such not sufficient for concluding that the contract did not result in the transfer of a business or a specific part of it.

In **T 423/11** of 11 March 2015 the board held that the transferred assets were those in the interest of which the opposition had been filed. The objection that not all the corresponding assets had been transferred, because exceptions had been made for some patents, had no bearing on the decision. It was true that some patents had not been transferred and only a licence had been given. However, a licence conferred on the licensee the necessary rights to undertake any action to defend the patent under licence. Therefore those exceptions did not deprive the transferee of the general rights conferred on it by the transfer of the other assets.

In **T 1421/05** the board held that where the business assets in relation to which an opposition was filed have been transferred and at the same time the transferor has contractually agreed to transfer the opposition to the transferee, the status of opponent remains with the transferor in the absence of there being filed with the Office (a) evidence sufficiently evidencing the transfer and (b) a request to recognise the transfer of opponent status. Where in such a case the transferor subsequently ceases to exist but has a universal successor, the status of opponent is capable of passing to that successor.

In **T 2357/12** the board held that successions by law where parts of an enterprise form new legal entities or are immediately merged with other entities (de-merger, spin-off, secession merger), would be considered to be cases of universal succession under national (e.g. German) law. The continued existence of the former opponent, and the fact that it would not be possible to decide at first sight to which of the resulting legal entities the part of the enterprise to which the opposed patent was assigned, might result in applying the rules of singular succession under the procedural law of the EPC (see **T 136/01**, **T 1514/06**, **T 1032/10**).

In **T 445/16** the board held that, although a spin-off merger ("Umwandlung durch Ausgliederung") was seen as a form of universal succession in German national law, it was, in the context of transfer of opponent status under EPC law, considered to be a transfer of assets within the meaning of **G 4/88**. See also **T 848/13**.

In **T 833/15** the board held that the crucial factor was whether the contested patent related to the transferred part of the commercial activity. It was immaterial whether, based on the wording of the agreement, the contested patent (if part of the opponent's assets) would have had to be transferred or would have been licensed to the transferee under the terms

of a licence agreement as an industrial property right used together with the "Industrial Business". The only thing that mattered was the connection between the opposition as originally filed and the commercial activity which the opponent was conducting when it filed the opposition but later transferred as a business asset. The opponent status was then transferable as part of this asset (see **G 4/88**, points 5 and 6 of the Reasons).

2.4. No transfer: sale of opponent's subsidiary company

In **T 711/99** (OJ 2004, 550) the board emphasised that the exception stated in **G 4/88** to the general principle that an opposition was not freely transferable should be construed narrowly. In **G 4/88** the Enlarged Board had considered a situation where the commercial vehicles department, which was subsequently sold, was without legal personality. The company which filed the opposition was the only one entitled to do so. In **T 711/99**, by contrast, the issue was whether the opponent parent company should be recognised, in the event of the sale of a subsidiary that has always been entitled itself to file oppositions, as having the right to transfer its opponent status. The board denied this and held that the opponent status could only be transferred together with the assignment of part of the commercial activity of an opponent with sole legal authority where the transferred company division or department did not have that status and therefore lacked legal personality. It added that the notion of legitimate interest in the proceedings, which was irrelevant for the admissibility of an opposition at the time of its filing, likewise had no bearing on the opponent's status at any subsequent stage.

In **T 1091/02** (OJ 2005, 14) the board challenged the case law subsequent to **G 4/88** which required, for a transfer of opponent status outside universal succession, a transfer of the relevant business or part of it (**T 659/92**, **T 670/95**, **T 298/97**, **T 711/99**). It referred to the Enlarged Board questions which included the following: can a legal person who was a wholly owned subsidiary of the opponent when the opposition was filed and who carries on the business to which the opposed patent relates acquire opponent status if all its shares are assigned by the opponent to another company and if the persons involved in the transaction agree to the transfer of the opposition? In **G 2/04** (OJ 2005, 549) the Enlarged Board decided that there was no convincing reason, in particular not any overriding interest of the parties or the public, to extend the application of the rationale of **G 4/88** to the case where a subsidiary company was sold in whose interest the opposition had been filed by the parent company. Thus, a legal person who was a subsidiary of the opponent at the time when the opposition was filed and who carries on the business to which the opposed patent relates cannot acquire the status as opponent if all its shares are assigned to another company. In its reasoning, the Enlarged Board emphasised that in **G 4/88** the Enlarged Board was faced with a situation in which, for legal reasons, it was not possible from the outset to attribute the procedural status of opponent to the business in whose interest the opposition was filed, whereas the Enlarged Board in **G 2/04** was concerned with the situation in which the holding company did not want to attribute the procedural status of opponent to the entity in whose interest the opposition was filed. The opponent could easily have made provision for a future eventuality that its subsidiary should take over the responsibility for the opposition. If the holding company and subsidiary had filed the opposition as common opponents, the holding company could have withdrawn from the opposition at any time, leaving the subsidiary as the sole

opponent. The Enlarged Board noted that a liberal admission of transfers could often result in the need to examine contested questions of fact or difficult questions of company law. This would broaden the possible procedural battlefields for the parties and give rise to complications and delays in opposition proceedings.

2.5. Legal uncertainty as to who is the correct party

In **G 2/04** the Enlarged Board also considered the issue of what could be done if there was a justifiable legal uncertainty as to how the law was to be interpreted in respect of the question of who the correct party to the proceedings is. It decided that in such a situation it was legitimate that the appeal was filed in the name of the person whom the person acting considers, according to their interpretation, to be the correct party, and at the same time, as an auxiliary request, in the name of a different person who might, according to another possible interpretation, also be considered the correct party to the proceedings.

For an example of a case where a justifiable legal uncertainty as to the person entitled to appeal existed, see **T 1091/02** of 28 June 2006.

2.6. Evidence for and effect of a transfer

The EPC does not contain any explicit provisions regarding the formal requirements for the transfer of opponent status. Nevertheless, the boards of appeal have consistently held that formal requirements have to be fulfilled for the opponent status to be considered as transferred (see **T 960/08** with reference to case law, see also **T 261/03** of 24 November 2005). A new opponent acquires party status as opponent and as party to the opposition appeal proceedings only upon filing documentary evidence of the legal succession with the EPO (**T 244/12**).

A transfer of an opposition is something that has to be requested at the EPO together with supporting evidence before it can take effect. The effective date of the transfer of an opposition must be taken as the date when the transfer has been requested at the EPO and adequate evidence provided (**T 1137/97**, **T 19/97**, **T 1421/05**, **T 1032/10**). Pursuant to **T 261/03** of 24 November 2005 such a request may also be an implicit one.

Until evidence of the transfer has been provided, the original party to the proceedings continues to have the relevant rights and obligations (**T 870/92** of 8 August 1997, **T 1137/97**, **T 413/02**, **T 1268/17**). Acts performed before the relevant point in time by the former opponent are valid – provided the former opponent is still in existence and able to act; acts performed by the new opponent are invalid, and may have to be repeated once the change of parties has come into effect (**T 2357/12**, with reference to **T 1514/06**).

In case of a universal succession, however, there is necessarily and automatically a continuation of the existing legal status as opponent from the date of merger (**T 6/05**, see further below); in the case of universal succession, the change may – upon request and production of evidence by either party – be recorded with retroactive effect as from the effective date of the legal succession (**T 2357/12**).

2.6.1 Date of effective transfer

In **T 19/97** the board emphasised that there was a clear distinction between the substantive transfer of opponent status as a business asset and its procedural validity in the case at issue. As a formal requirement, the procedural validity of a transfer of opponent status was dependent on the submission of a duly substantiated request within the proceedings. On grounds of procedural certainty, a change of party based on an assignment could not take place outside the proceedings without the formal cognisance of the board and also could not have retroactive effect, as otherwise procedural acts or decisions could be respectively performed or taken without the involvement of the new opponent as the only legitimate party.

In **T 956/03** the board considered the question of the time limit for filing evidence of a transfer. According to the board, the case law showed a definite balance in favour of the view that a transfer could only be acknowledged from, at the earliest, the date when adequate evidence to prove the transfer had been filed. This was desirable in the interest of legal certainty and, within that principle, to ensure that the identity of an opposing party was known. If the transfer took place before the appeal period expired, then the entitlement of the transferee to replace the opponent had to be established by filing the necessary evidence before the appeal period expired.

In **T 428/08** the appellant had argued that it ought to be admissible to submit evidence of legal succession after the appeal period had expired, as evidence of prior use could also be submitted after the opposition period had expired without being rejected as grounds for opposition. The board did not follow this argument and relied on case law which made the date when the transfer became valid explicitly dependent on the date when evidence of it was supplied, in keeping with the procedural certainty requirement for the identities of the parties to the proceedings to be clear at all times.

In **T 184/11** the board could not share the appellant's view that, following **T 956/03**, any transfer occurring before the appeal period expired also had to be substantiated by the end of that period. In **T 956/03** the board had had to rule on the admissibility of an appeal filed by a party which maintained that it was successor in title to one of the opponents in the first-instance proceedings but failed to provide evidence of that within the appeal period. It was in that light that the principle set out in **T 956/03** – that if a transfer occurred before expiry of the appeal period, then the evidence showing that the transferee was entitled to take the opponent's place also had to be submitted by the end of that period – was to be understood. In the case at issue, however, a party that had been opponent in the first-instance proceedings had initially been respondent in the appeal proceedings, and only during the latter was transfer of party status requested. This request was granted during the oral proceedings before the board, once the requisite evidence of the transfer of opposition had been provided. See also **T 1563/13**.

In **T 6/05** the board drew a distinction between those cases where the opponent status is transferred together with the assignment of business assets and the cases of universal succession via merger – like the case at issue. Whereas in the former cases, the party status might either remain with the original opponent or be transferred to the new one, the

universal successor of a patent proprietor automatically acquired party status in proceedings pending before the EPO, since R. 20(3) EPC 1973 (now R. 22(3) EPC) did not apply in the context of universal succession in law (see also in this chapter III.O.1 and III.O.2.1). The successor acquired party status from the date on which the merger became effective and not only once sufficient evidence to this effect had been produced. The principles for transferring a European patent were to be applied mutatis mutandis to the transfer of opponent status. In the case of the universal succession of the opponent, there could only be one (legal) person who had rights and obligations, with the consequence that there was necessarily and automatically a continuation of the existing legal status as opponent from the date of merger. It could thus be established unambiguously and without any legal uncertainty, at any point in time in the proceedings, who in fact was the opponent having party status, regardless of the date when sufficient evidence to this effect was filed (see also **T 425/05** and **T 2382/10**).

In **T 7/17** the board recalled that, when a pending opposition was transferred or assigned to a third party as part of the opponent's business assets together with the assets in the interests of which the opposition had been filed, the party status as opponent was transferred only with effect from when an allowable request for transfer of the opponent status was received.

2.6.2 What kind of evidence suffices

If no evidence of legal succession is produced, the mere declaration by a company designated as legal successor to the original opponent that it is the original opponent's legal successor is not sufficient to substantiate the transfer of the status of opponent and of party to the appeal proceedings (**T 670/95**).

In **T 261/03** of 24 November 2005 the board considered what kind of evidence was required to establish a valid transfer. The board drew parallels with the requirements of R. 20 EPC 1973 (now R. 22 EPC) and noted that it was not aware of any appeal decision that had held that the documents to be submitted according to this provision have to prove the alleged transfer "up to the hilt". Such a yardstick of full and absolute proof would indeed be overly strict since in many situations documentary evidence alone could then hardly suffice. As the wording of R. 20(1) EPC 1973 suggested, something less was required. The board took the view that the requirements of R. 20 EPC 1973 were complied with if the documents submitted were such as to render it credible to the competent organ of the EPO, evaluating the documents in a reasonable way and in the light of all the circumstances, that the alleged facts were true. The mere fact that another document might have been a more direct piece of evidence than the one submitted by the appellant does not invalidate the proof actually offered (see **T 273/02**, applied in **T 1178/04**).

In **T 1513/12** the board refused a request for a transfer of opponent status because, although the filed extracts from a commercial register showed there had been a spin-off, they did not contain any evidence of a transfer. In particular, no extracts from the spin-off agreement or from the agreements negotiated in connection with it, which could have proved the transfer more conclusively, had been filed.

In **T 347/15** it was not clear from the submitted documents whether the opponent status had in fact been transferred. The two trade register extracts showed that the company had been restructured as per a restructuring agreement ("*Ausgliederungsvertrag*"), but they did not contain any information about the transfer of assets. It was therefore not possible to establish whether the opposition had indeed been filed in the interests of the part of the company at issue. No part of the restructuring agreement or of any addendum to that agreement had been submitted. Consequently, the board refused the request to transfer the opponent status.

In **T 219/15** the board refused the request for transfer of the opponent status. The appellant had provided the purchase agreement, but that agreement did not demonstrate that the relevant business assets, i.e. the opposition proceedings relating to the patent in suit, were sold to the other company.

In **T 2016/12** the board rejected the transfer of a specific part of the original appellant's (ATech Ltd) business assets to the purported transferee (AES AG). The board had requested the submission of the contracts concluded between the legal entities involved in the merger; the opponent had replied, however, that such contracts could not be provided for reasons of confidentiality. Other evidence presented was not conclusive. Furthermore, the board considered that if a transfer was not unequivocally proven, the original party to the proceedings would normally continue to be considered as the appellant. In the case in issue, ATech Ltd (the original party) allegedly continued to exist under its new name of GETech GmbH. However, from the two extracts of the commercial register concerning GETech GmbH, it was apparent that some assets had been transferred according to a separation plan to yet another company. The party provided no details as to this split or the business assets involved. The evidence indicated that GETech GmbH did not become the universal successor to that party through a complete acquisition of the entire business of the original party and a successive simple change of name. Therefore, it also could not be concluded that GETech GmbH was a party to the proceedings. Under these circumstances, the board could not reliably establish ownership of the business assets to which the opposition and appeal belonged. Consequently the board could not continue the proceedings, which therefore had to be terminated.

In **T 234/18** the board recalled that being party to a pending opposition is not a property right but a procedural right and concluded that this procedural right was not covered by the term "intellectual property rights" in the purchase agreement filed as evidence. Since according to the case law of the boards of appeal an automatic transfer occurred only in the case of universal succession, but not where particular business assets were transferred from one party to another (see **T 6/05** and **T 1421/05**), the request to register the purchaser as opponent could not be granted.

In **T 7/17** the board held that the requirements for a transfer of party status as appellant-opponent were not met. It was not sufficiently proven that all relevant business assets in the interests of which the opposition had been filed had been transferred; nor was it proven that the opposition had been transferred. Where a company contractually transferred the business assets in the interests of which an opposition had initially been filed, it was a matter of what the parties had agreed whether or not the opposition – i.e. the party status

as opponent – was transferred together with these assets. The board also noted that it was for the opponent or the third party seeking the party status as opponent to prove that all assets in the interests of which the opposition had been filed had been transferred.

2.6.3 Natural heir

In the case of a transfer of an opposition from a deceased natural opponent to their heir, the heir can only be ascertained by reference to the particular national laws of succession applicable to the estate of the deceased opponent. It follows that the person seeking to establish that they have the right to succeed to an opposition must produce satisfactory evidence that they have done so under the relevant national law (**T 74/00**).

2.7. Effect of finding that no transfer took place during opposition proceedings

In **T 1178/04** (OJ 2008, 80) the opposition division had decided that the transfer of opponent status in the course of the opposition proceedings was valid. The board held that even if the transfer of the opponent status during the opposition proceedings was invalid, the appeal by the opponent was nevertheless admissible. The board explained that "party" simply meant someone who takes part in the proceedings before the EPO. If the department of first instance had decided that someone was entitled to take part in the proceedings they remained a party even though this decision was later reversed on appeal; such a decision on appeal had the effect that they were no longer entitled to take part in the proceedings, but not that they had never been a party to the proceedings. Their position could not change retrospectively from that of having been a party to that of never having been a party. After reviewing the evidence the board held that no valid transfer of the status of opponent had taken place. The only means of correcting this error was to set aside the decision of the opposition division as a whole. The opposition division was thus not bound by its previous decision. It was only bound by the ratio decidendi of the board's decision as regards the transfer of opposition status (see also **T 1081/06**).

In **T 194/15** the board decided that the evidence submitted showed that the transfer of the business assets from Abbott to AbbVie took place before the opposition had been filed. Accordingly, the opposition filed by Abbott could no longer be transferred to AbbVie. As a consequence, the opposition proceedings were continued with the wrong party as opponent. Referring also to **T 1178/04** and **T 1982/09**, the board decided to remit the case to the opposition division so that the proceedings could be conducted with the right party.

2.8. No administrative fee for a transfer of opponent status

There is no administrative fee to pay for a transfer of opponent status (**T 261/03** of 24 November 2005; **T 413/02**).

P. Intervention

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1. Admissibility of intervention

Under Art. 105 EPC, to intervene admissibly in opposition proceedings a party must show either that proceedings for infringement of the same patent have been instituted against them, or that following a request of the proprietor of the patent to cease alleged infringement, the third party have instituted proceedings for a ruling that they are not infringing the patent. Under Art. 105(2) EPC, an admissible intervention shall be treated as an opposition.

1.1. Any third party – independent legal entity

In **T 305/08** the appellant (opponent I) had filed an appeal against the decision of the opposition division to reject the opposition. Two separate interventions were subsequently filed (by opponents II and III), which also raised fresh grounds of opposition under Art. 100(c) EPC 1973. The board stated that the term "any third party" in Art. 105(1) EPC could not be given an interpretation other than that each party had to be a separate legal entity and that it was irrelevant whether they belonged to the same group of companies. Nor was allowing the interventions tantamount to allowing the appellant to late-file

oppositions via opponents II and III under its control and thus introduce new evidence. The interventions were therefore admissible.

In **T 384/15** two interventions were filed in the appeal procedure by different legal entities, both belonging to the same company. The respondent (patent proprietor) argued that there was credible evidence that the opponent was acting as a straw man on behalf of the company to which also the two interveners were inextricably linked. The board considered that there was no question that the interveners were third parties within the meaning of Art. 105(1) EPC, i.e. different legal entities, with respect to the opponent (appellant) regardless as to whether or not one of the interveners was the principal instructing the opponent (**G 3/97**, OJ 1999, 245). The board also rejected the argument that there had been an attempt by the opponent and the interveners to circumvent the law by abuse of process, since there was no proof that the opponent had acted directly on behalf of one of the interveners (**T 305/08**).

In **T 1702/17** the board held that the only material issue when determining whether the interveners could be regarded as third parties was whether the appellant and the interveners were legally distinct companies and thus independent legal entities. Economic ties of any kind between the three companies (in the case in issue, the respondent had asserted that the relationship was as 100% subsidiaries of the appellant under its authority) were immaterial under the EPC as regards the admissibility of the interventions. Nor had there been any abuse of law. On the contrary, allowing third parties to assert new grounds for opposition and submit new documents as interveners with the aim of having the patent revoked was in keeping with the spirit and purpose of the provisions of Art. 105 EPC and thus the legislator's intent.

In **T 435/17** the board held that a "third party" within the meaning of Art. 105(1) EPC had to be a separate legal entity from the other parties, and that there was no legal basis for excluding an intervener on the grounds that it shared premises, a current account for fee payments or a professional representative with an opponent.

In **T 1891/20** an intervention was filed in the appeal procedure by a legal entity separate from appellant II. The respondent (patent proprietor) argued among other things that appellant II and the intervener had a common representative, who had made submissions in a single document which concerned both of these parties. The board referred to R. 151 EPC, according to which parties may appoint a common representative. The appointment of a common representative for two opponents was not different from the appointment of a common representative for an opponent and an intervener. In both cases, the commonly represented parties could be in a different situation as to the admittance of their submissions. This, however, did not prevent them from appointing a common representative. The board considered the intervener as a "third party".

1.2. Relevant patent

In **T 446/95**, in which an infringement action had been based on a French national patent, the board held that the intention and purpose of an intervention in accordance with Art. 105 EPC 1973 was to enable the assumed infringer to defend itself against the action by the

patentee based on the opposed European patent, in order to prevent the EPO and the national courts handing down contradictory decisions on the validity of European patents. In the case in question, the fact that the European patent had claimed priority from the French patent and that France had been designated was irrelevant, as there was no legal basis for intervening in the European patent on the basis of an infringement action relating to the French patent. The admissibility of an intervention before the EPO could not depend on a provision of national law. The intervention was therefore inadmissible.

In **T 7/07** the board held that the patent in suit was not granted for Lithuania under the EPC, as Lithuania was an extension state and therefore could not be designated for a European patent. The national law of the extension state governs the extension proceedings and the legal effects of the extension. The infringement proceedings were based on a patent which had been granted for a number of EPC contracting states and which, under Lithuanian law, also took effect in Lithuania, but exclusively on the basis of Lithuanian national law, which conferred the same effect on this patent as on a national patent. As a result, the infringement proceedings were not based on the European patent in suit in the opposition proceedings. The board agreed with the findings in **T 1196/08**, that an intervention based on proceedings for infringement of a patent that has effect in a particular state solely on the basis of national law is inadmissible because it fails to meet one of the requirements under Art. 105(1)(a) EPC. It therefore regarded the intervener's submissions as third-party observations under Art. 115 EPC. See also, chapter III.N.3.

1.3. National infringement proceedings

Under Art. 105 EPC, third parties may intervene only if they prove either (a) that proceedings for infringement of the opposed European patent have been instituted against them or (b) that, following a request by that patent's proprietor that they cease the alleged infringement, they have instituted proceedings for a ruling that they are not infringing the patent (**G 4/91**, OJ 1993, 707). The principle that the assessment of the nature of a procedural act taken by a party before the EPO is to be made with consideration of its actual substance rather than with consideration of its form or name applies equally when deciding whether national infringement proceedings have been commenced (**T 188/97**).

1.3.1 Proceedings for infringement instituted by patent proprietor – Article 105(1)(a) EPC

In **T 223/11** the board held that it was internationally a widely accepted principle that the submission of a request on the national level for a marketing authorisation for a pharmaceutical product by a generic company did not constitute patent infringement (the so-called Bolar exemption). The proceedings instituted by the patent proprietor before the national administrative court, no matter how obstructive these may have been to a future market entry of the intervener's product, could not be considered as equivalent to infringement proceedings, irrespective of whether the Bolar exemption had been codified in the relevant national law or not.

In **T 1713/11** the board stated that the EPC gives no specific definition of what constitutes proceedings for infringement. Furthermore, intervention was conceived as a procedurally exceptional situation, which is justified only by a substantial legitimate interest of the

assumed infringer to enter the opposition proceedings. Therefore, it did not appear likely that there was a legislative intent to create an elaborate and intricate system of procedural provisions for the admissibility of interventions, and the boards too should refrain from creating such a system through their case law, and focus instead on whether the substantive conditions for admitting an intervention were fulfilled. Nullity proceedings concerning the patent at issue would not qualify and neither would saisie-contrefaçon proceedings (see also **T 305/08**). However, the definition of "proceedings for infringement" was not limited to civil proceedings, to proceedings that allow for certain remedies to be claimed, or two-party proceedings. The board therefore concluded that as long as a patent proprietor or any other party entitled to do so initiated proceedings which aimed to establish whether a third party was commercially active in an area that fell within the patent proprietor's right to exclude, such proceedings were "proceedings for infringement" within the meaning of Art. 105 EPC.

In **T 1746/15** the board followed **T 1713/11**, according to which "proceedings for infringement" pursuant to Art. 105(1)(a) EPC were "proceedings meant to establish whether a third party is commercially active in an area that falls within the patentee's right to exclude". The board held that the independent evidentiary proceedings under German law ("selbständiges Beweisverfahren" or "Beweissicherungsverfahren, § 485 DE-ZPO) initiated against the respondent by decision of the Landgericht Düsseldorf did not constitute the "establishment" of an infringement within the above meaning. The independent evidentiary proceedings under German law were comparable to "saisie" proceedings, e.g. "saisie-contrefaçon" in France, which were not regarded as "infringement proceedings" in terms of Art. 105(1)(a) EPC (**T 1713/11** and **T 305/08**).

The appellant (opponent) in **T 439/17** had filed notice of intervention in the opposition proceedings, invoking evidence preservation proceedings in Germany ("Beweissicherungsverfahren", § 485 DE-ZPO) that the patent proprietor had instigated. The patent proprietor had then, based on those proceedings' outcome, duly initiated infringement proceedings against the opponent while the appeal proceedings were pending. The appellant had argued that the two sets of proceedings had to be seen as one within the meaning of Art. 105 EPC, alleging support for its view in Section 493 DE-ZPO. The board disagreed, finding that it could not be derived from the latter provision that they had to be considered consolidated or otherwise procedurally linked. Furthermore, an intervention had to be admissible at the time of the intervention and could not be made admissible retroactively. In short, the board held that evidence preservation according to Section 493 DE-ZPO and subsequent infringement proceedings had to be seen as separate when applying Art. 105(1)(a) EPC. Consequently the intervention before the opposition division had been inadmissible.

In **T 2597/22** the board found that, in the circumstances at issue, an application for an interim injunction was covered by the term "proceedings for infringement" in Art. 105 EPC as it initiated such proceedings. It also found that it was irrelevant whether the proceedings were still pending before the Mannheim Regional Court.

1.3.2 Request to cease alleged infringement and institution of proceedings for non-infringement – Article 105(1)(b) EPC

In **T 195/93** the board held that if a patentee simply sent a legal warning letter asking the intervener to stop production and sale of a product covered by the patent, this could not be regarded as institution of proceedings for a court ruling even if under national law the addressee became liable for damages 30 days after receiving the letter. The intervention was therefore rejected as inadmissible.

According to **T 392/97**, Art. 105 EPC 1973 required that an intervener should prove both that the patentee had requested that the intervener cease alleged infringement of the patent and that they had instituted proceedings for a court ruling that they were not infringing the patent. Thus where the letter was sent not to the allegedly infringing company, but to an unrelated one which it was assumed was about to acquire it, the first requirement was not fulfilled and their interventions were inadmissible. The first requirement was also not fulfilled in **T 446/95**, where the letter merely set out a position adopted in response to a letter from the purported intervener and did not give notice to cease infringement. According to **T 887/04** of 14 November 2006, it was for the assumed infringer to prove, first, that they had received a "request" to cease the infringement, i.e. that they had been expressly asked to do so, and, second, that they had been required to "cease", i.e. put an end to, the infringement. Proof of mere warnings or threats of legal action had therefore to be considered insufficient.

In **T 898/07** the board found the intervention admissible. It was apparent from the documents submitted by the opponent that the respondent had repeatedly informed it that it considered its actions to infringe the patent and, with reference to infringement proceedings already pending against third parties, invited it to enter licensing negotiations. The board considered this a request to cease patent infringement by concluding a licensing agreement which would render the allegedly unlawful conduct (patent infringement) lawful (licensed use). This met the first requirement under Art. 105(1)(b) EPC, the wording of which covered not only to a request to refrain from using the invention altogether, but also generally to a request to cease the alleged patent infringement. In addition, the opponent had instituted proceedings against the respondent for a declaration of non-infringement of the patent.

In **T 1138/11** the board held that compliance with the requirement that the intervener has been requested to cease the alleged patent infringement was not to be determined in accordance with the relevant national law. Since the laws in the contracting states varied to quite an extent from one to another, this requirement had to be applied in a harmonised manner for all contracting states. This could only be achieved by way of an autonomous interpretation of the EPC provisions and their legal terms. The board also found that, since an intervention by a third party was treated as an opposition and so – as an exception to the 9-month time limit for filing a notice of opposition – this party was granted the status of an opponent, Art. 105 EPC had to be interpreted in a restrictive manner.

In **T 304/17** the appellant argued that for the three-month time limit to be triggered, it was necessary but also sufficient for the two criteria mentioned in Art. 105(1)(b) EPC to be

fulfilled, regardless of the order in which this happened. The board disagreed with this understanding of Art. 105(1)(b) EPC. It followed from its clear wording that it required a specific sequence of events ("following a request of the proprietor of the patent ..., the third party has instituted proceedings ..."). The travaux préparatoires confirmed that the legislator had intentionally chosen this sequence of events. This conclusion was also in line with a systematic interpretation, because in both alternative scenarios – Art. 105(1)(a) and (b) EPC – it was the formal institution of proceedings (before a court or another competent national authority) which triggered the time limit. These were events which could be unambiguously established with legal certainty, since they had official dates (see **T 296/93**) and thus set "a clear demarcation line" (see also **T 18/98**).

1.4. Proceedings pending before the EPO

1.4.1 Intervention in opposition proceedings

In **G 4/91** (OJ 1993, 707) the Enlarged Board held that the intervention under Art. 105 EPC 1973 of an assumed infringer in the opposition proceedings presupposed that opposition proceedings were pending at the time they gave notice of intervention. Moreover, a decision of the opposition division on the relief sought had to be regarded as conclusive in the sense that the opposition division no longer had the power thereafter to amend its decision. The Enlarged Board further held that proceedings before an opposition division were terminated when such a conclusive decision was issued, irrespective of when this decision became final. Thus, if, after an opposition division had issued a decision terminating the proceedings, and none of the parties to the opposition proceedings filed an appeal, any notice of intervention filed during the two-month period for appeal under Art. 108 EPC 1973 was invalidated.

In **T 791/06**, where an intervention was filed after the oral proceedings before the opposition division when the decision was pronounced but before notification of the written decision, the board held that it had not been filed during pending opposition proceedings but considered the intervention to have been filed during the appeal proceedings.

In **T 631/94** (OJ 1996, 67) the board noted that when a decision to terminate opposition proceedings, taken in written proceedings, was handed over to the EPO postal service, it became public and effective and had therefore been issued. If the parties to the proceedings leading to that decision did not appeal, the opposition proceedings were completed at that point in time and thereafter intervention based on Art. 105 EPC 1973 was no longer possible.

1.4.2 Intervention in appeal proceedings

In **G 1/94** (OJ 1994, 787) the Enlarged Board concluded that intervention of the assumed infringer under Art. 105 EPC 1973 was admissible during pending appeal proceedings and could be based on any ground for opposition under Art. 100 EPC. The term "opposition proceedings" was not restricted to the department of first instance but could also refer to such proceedings at second instance. Intervention during pending appeal proceedings was therefore admissible (see also **T 694/01**). A notice of intervention filed during the two-

month period for appeal has no legal effect if no appeal is filed (**G 4/91**, OJ 1993, 707). However, see **T 1286/23**.

In **T 694/01** the board found that intervention depended on how far the opposition or appeal was still pending. An intervener could not challenge issues on which a final decision had already been taken (in earlier appeal proceedings).

1.5. Time limit for intervention

Under R. 89 EPC, intervention is not possible until the opposition period has expired (this was previously laid down in Art. 105 EPC 1973), but notice of it must be filed within three months of the date on which proceedings referred to in Art. 105 EPC were instituted.

If multiple proceedings are under way, the three-month time limit for intervening is always triggered by the date on which the **first** proceedings were instituted (**T 296/93**, **T 1143/00**).

The two alternative starting points under Art. 105(1) EPC 1973 for calculating the three-month period for intervention were mutually exclusive (**T 296/93**, OJ 1995, 627). See also **T 144/95** and **T 18/98**. Article 105 EPC 1973 could not be used to give an opponent who failed to file an appeal in time a second chance, as the opponent does not fulfil the requirement of being a third party (**T 1038/00**).

In **T 694/01** the board held that Art. 105(1), first sentence, EPC 1973 did not stipulate when infringement proceedings were deemed to have been instituted. As they could only be instituted before the national courts, the wording of Art. 105 EPC, even if not explicitly, set this date by reference to the relevant national procedural laws.

In **T 452/05** the board considered three dates which could possibly have triggered the three-month period: the date on which the request for an interim injunction was made, the date on which the request was granted, or the date when the injunction order was served upon the opponent. In the board's view, only the last date should be regarded as the decisive point in time, as only from that date onwards could the opponent provide evidence of the proceedings that entitled it to intervene.

In **T 691/16** the appellant (patent proprietor) disputed that the three-month time limit prescribed by Art. 105 EPC and R. 89 EPC had been adhered to since the date on the advice of delivery recording service of the notice of action was not clearly legible and, moreover, the signature on it was allegedly not identical to the intervener's. The board ruled that the intervention had been filed properly and in due time. Proving service was the very point of the advice of delivery, and both the stamped date and the handwritten date (in so far as it was legible) showed the relevant date. So there was at least prima facie evidence against which the patent proprietor had not asserted any substantiated doubts. Moreover, R. 126(2), last half of the sentence, EPC reflected a general principle whereby, in case of doubt, it was for the sender of a document, not the recipient, to prove that it had reached the recipient and when. Doubts owing to things such as illegibility therefore could not act to the recipient's detriment. As regards the differences in the signature, the board pointed out that a notice of action did not necessarily have to be

served on the recipient itself, but could also be served on people living in the building or with the necessary authorisation. This was generally what happened at companies. There was therefore no reasonable doubt that the intervener's claim to have received the notice of action on the relevant date was true. It must be noted, however, that R. 126(2) EPC has been amended. See notice from the EPO of 25 November 2022 concerning legal changes to support digital transformation in the patent grant procedure (OJ 2022, A114) and of 6 March 2023 concerning amended Rules 126, 127 and 131 EPC (OJ 2023, A29). See also chapter III.D.1.

In **T 308/23**, the board recalled that the provisions of Art. 105 EPC were intended to allow the alleged patent infringer to defend themselves by challenging the validity of the patent within the centralised procedure before the EPO rather than through separate national proceedings. The intervention could only be initiated based on the first infringement proceedings, even if there were separate national infringement proceedings underway in different EPC contracting states. The board noted that if the alleged infringer were able to choose at will the infringement procedure allowing them to intervene in the opposition proceedings, it would be theoretically possible for them to deliberately delay the opposition proceedings by intervening at a later stage on the basis of a subsequent infringement procedure, which would run counter to the objective pursued by Art. 105 EPC and R. 89(1) EPC. Thus, the different interests of the alleged infringer in one or other of the national proceedings or its subjective assessment of the economic importance of a territory could not play a role in this context.

1.6. Fees

Under Art. 105(2) EPC in conjunction with Art. 2(1) No. 10 RFees, interveners must pay the opposition fee (see R. 89(2), second sentence, EPC).

Where a party intervenes only at the appeal stage, several decisions have stated that no appeal fee need be paid if the party is not seeking appellant status in their own right (see **T 27/92**, **T 684/92**, **T 467/93**, **T 471/93**, **T 590/94**, **T 144/95**, **T 886/96**, **T 989/96**, **G 3/04** (OJ 2006, 118)). In **T 1011/92** and **T 517/97** (OJ 2000, 515) the board ruled that an intervener must pay the appeal fee if they want to have their own right to appeal proceedings, in the sense that they can continue such proceedings if the original appellant withdraws their appeal (see in this chapter III.P.2.). However, in **T 144/95**, where an intervention was filed during appeal proceedings and an appeal fee paid, the board ordered the appeal fee to be refunded (at the request of the intervener). See also **T 2597/22**. According to the board, under Art. 107 EPC 1973, an admissible appeal could only be filed by a party who was already a party to the proceedings leading to the decision and who was adversely affected by it. Where the intervention was filed during appeal proceedings, the intervener could not satisfy these conditions, and, referring to **G 1/94**, OJ 1994, 787, could not be considered as an appellant (but rather an opponent). The act of paying an appeal fee, which is one of the conditions for an admissible appeal, did not change this position in any way. The board then added that, whilst Art. 105 EPC 1973 provided an exception to the time limit for payment of the opposition fee under Art. 99 EPC 1973, no such exception was made concerning the appeal fee. However, see referring decision **T 1286/23** where the board explained that if it were found that an

intervener could be entitled to appellant status, it would appear logical that the payment of an appeal fee would also be necessary if the intervener wanted to make effective use of their entitlement.

In **G 3/04** (OJ 2006, 118) the Enlarged Board held that there was no legal basis for demanding the payment of the appeal fee by an intervener in appeal proceedings. Fees paid by way of precaution but without a legal basis were reimbursed.

1.7. Substantiation requirement

Under R. 89 in conjunction with R. 76 EPC, the notice of intervention must give the grounds for the intervention, and the facts and evidence submitted to substantiate them.

In **T 1659/07** the board found that the substantiation requirement under R. 89(2) EPC in conjunction with R. 76(2)(c) EPC was met by a reference to an existing statement of grounds for appeal or notice of opposition. The purpose of the requirement was to ensure that the intervener's arguments could be objectively understood, i.e. that the intervener's position was set out clearly enough that both the patentee and the opposition division or board of appeal could identify the reasons for the intervention. Reference to the arguments of another opponent already on file was sufficient to that end. Accordingly, an intervener need not repeat those arguments in detail or contest the patent on the basis of new, independent reasoning or facts.

2. Legal status of the intervener

In **G 3/04** (OJ 2006, 118) the Enlarged Board held that the valid intervener acquired the status of an opponent, irrespective of whether the intervention occurred during the proceedings before the opposition division or at the appeal stage. In either case the intervener's rights and obligations were the same as those of other opponents.

2.1. In opposition proceedings

In **G 3/04** the Enlarged Board also considered that an intervener in the proceedings before the opposition division had a right of appeal under Art. 107 EPC. For the appeal to be validly filed, they must pay the appeal fee under Art. 108, second sentence, EPC. The Enlarged Board held that an intervener in proceedings before the opposition division, where all the opponents had withdrawn their oppositions, could continue the proceedings alone and, if need be, file an appeal, since they had the same status as an opponent under Art. 99 EPC 1973 (Art. 99 EPC).

In **T 614/13** of 2 July 2015 the board had to rule on the admissibility of an intervener's appeal against the opposition division's decision to reject its opposition because it had not shown that it had intervened in the opposition proceedings in time. The board held that, even if it upheld the opposition division's decision, that would not mean the intervener had never been a party to the proceedings, but only that as from the date on which decision on appeal took effect it would no longer be entitled to take part in the (further) proceedings.

Until that point in in time its procedural status would be confined to obtaining clarification as to whether it was entitled to take part.

2.2. In appeal proceedings

In **G 3/04** the Enlarged Board ruled that an intervener, if the appeal is filed by someone other than them, is a party as of right according to Art. 107, second sentence, EPC. If the intervention is filed during the appeal proceedings, the intervener, again because they can only acquire the status of an opponent, has the same rights and obligations – apart from the right to raise new grounds of opposition – as any opponent who has not filed an appeal. If in this case the sole, or each, appeal has been withdrawn, the appeal proceedings are terminated in respect of all the substantive issues, including the new grounds for opposition raised by the intervener, for all the parties (see also **T 694/01**, OJ 2003, 250).

In **G 1/94** (see in this chapter III.P.1.4.2), the Enlarged Board also examined the question of whether an intervener during appeal proceedings could raise any of the grounds for opposition under Art. 100 EPC 1973 (now Art. 100 EPC) even if they had not yet been examined by the opposition division and found in the affirmative. If a fresh ground for opposition was raised, the case should be remitted to the department of first instance unless the patent proprietor wished the board to rule on it there and then. In **T 694/01** (OJ 2003, 250), it was made clear that where a board has decided to maintain a patent on the basis of a given set of claims and a description to be added to them, in subsequent appeal proceedings confined to the issue of the adaptation of the description the previous decision is res judicata and the intervener cannot therefore challenge this decision by introducing a new ground of opposition.

In **T 1286/23** the board referred the following question to the Enlarged Board: "After withdrawal of all appeals, may the proceedings be continued with a third party who intervened during the appeal proceedings? In particular, may the third party acquire an appellant status corresponding to the status of a person entitled to appeal within the meaning of the Art. 107, first sentence, EPC?"

2.3. Intervener enters proceedings at stage they are at on the date of intervention

In **T 392/97** the would-be interveners requested that the date for the appointed oral proceedings be postponed and submitted that they had not been duly summoned to the oral proceedings in accordance with R. 71(1), second sentence, EPC 1973 which stipulated at least two months' notice. In the board's view, R. 71(1) EPC 1973 did not stipulate that the requirement of a two-month period also applied if, subsequent to a duly effected summons, there was an intervention by a third party. As a general principle, an intervener entered the proceedings at the stage they were at on the date of intervention, including pending time limits. Issuing a further summons or adjourning the date in this case was therefore rejected.

3. Legal status of documents filed with intervention during appeal proceedings

3.1. No need to exercise discretion for the board to admit documents filed with intervention

In **T 1665/16** documents E1 to E20 were filed with an intervention during appeal proceedings. The board considered that documents E1 to E20 had been filed as early as possible, since the intervention was not subject to any time limit other than the requirements under Art. 105 EPC and R. 89(1) EPC. Documents E1 to E20 were thus part of the appeal proceedings, without the board needing to exercise discretion or decide on admitting these documents into the proceedings.

3.2. No change of legal status of documents after withdrawal of intervention

In **T 1665/16** documents E1 to E20 were filed with an intervention during appeal proceedings. The intervener subsequently withdrew its intervention. The patent proprietor (respondent) requested that the documents should not be admitted into the proceedings. The board held that the withdrawal had not changed the legal and factual status of documents E1 to E20. The withdrawal of the intervention only terminated the status of the intervener as opponent and party to the proceedings but had no direct procedural consequences for the appeal proceedings, as the original opponent, who had filed a valid appeal, remained a party to the proceedings. The withdrawal of the intervention did not affect the legal validity of procedural acts like the filing of documents or other evidence carried out before the withdrawal. In particular, it did not render the intervention retroactively inadmissible, since it had only the legal effect ex nunc. There was no legal basis for regarding documents E1 to E20 as retroactively late filed. Since there was no legal basis in the EPC for the exclusion of documents from opposition proceedings which continued when one of the oppositions was withdrawn, documents E1 to E20 submitted by the opponent/intervener remained in the proceedings and had to be taken into account in the board's decision.

4. Intervention shortly before oral proceedings

In **T 1961/09** the board summarised in the catchword that while an intervention under Art. 105 EPC shortly before oral proceedings in an appeal, raising new issues, will normally require the oral proceedings to be adjourned if not the remittal of the case altogether (**G 1/94**, OJ 1994, 787), the oral proceedings may be continued if and so far as this can be done without unfairness to the other parties, in particular the proprietor (see **T 2597/22**).

Q. Continuation of the opposition proceedings by the EPO

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1. General

Rule 84(1) EPC provides that the opposition proceedings may be continued where the patent has lapsed or been surrendered and the opponent requests continuation of the opposition proceedings. In the event of the death or legal incapacity of an opponent and where the opposition has been withdrawn, the opposition proceedings may be continued by the EPO of its own motion (R. 84(2) EPC). In the case of a withdrawal of the opposition during the opposition appeal proceedings, there are a number of procedural consequences which depend on the party status of the opponent and which do not permit the exercise of discretion as to whether or not opposition appeal proceedings are continued (see in this chapter III.Q.4.3.).

2. Surrender and lapse of the patent

2.1. Surrender of patent

The patent proprietor is unable to terminate the proceedings by informing the EPO of the surrender of the European patent, since this is not provided for in the EPC; notices of surrender have to be addressed, as far as national law permits, to the national authorities of the designated contracting states (as already established in earlier decisions, such as **T 73/84**, OJ 1985, 241; **G 1/90**, OJ 1991, 275; see **T 123/85**, OJ 1989, 336 and **T 196/91**). Under the provisions of the EPC 2000 the patent proprietor may request that the European patent be revoked pursuant to Art. 105a EPC. The existence of this procedure as well as the possibility of requesting revocation during opposition and opposition appeal proceedings (see chapter IV.D. "Limitation/revocation") do however not preclude patent proprietors from giving notices of surrender to national authorities.

Neither the surrender of a patent nor its lapse has retroactive effect. Both therefore have to be distinguished from revocation, which takes effect from the outset (Art. 68 EPC).

2.2. Continuation of the opposition proceedings after lapse or surrender (Rule 84(1) EPC)

If a European patent has lapsed or been surrendered in all the designated contracting states, the opposition proceedings may, under R. 84(1) EPC (R. 60(1) EPC 1973), be continued at the request of the opponent, provided the request is filed within two months of a communication from the EPO informing the opponent of the surrender or lapse. R. 84(1) EPC is limited to the situation where the opposed patent has been surrendered or has lapsed during ongoing opposition proceedings. Where the patent had already lapsed or been surrendered in all the designated contracting states prior to the filing of the opposition R. 75 EPC applies, which states that an opposition may be filed in those circumstances (**T 606/10**).

R. 84(1) EPC also applies, pursuant to Art. 111(1) EPC and R. 100(1) EPC, to opposition appeal proceedings, **T 2165/08** of 6 March 2013, **T 702/15**.

Where the European patent expires during ongoing appeal proceedings in all the designated contracting states and the appellant (opponent) does not request continuation of the proceedings, the proceedings are terminated without any decision on the issues (**T 329/88**, followed by numerous decisions, including **T 762/89**, **T 749/01**, **T 289/06**, **T 949/09**, **T 480/13**, **T 977/14** and **T 2442/18**).

R. 84(1) EPC establishes no legal obligation on the EPO to ascertain of its own motion the legal status of a European patent and does not apply in the event of an alleged surrender or lapse of a European patent, unless confirmation thereof has been received by the EPO from the appropriate authorities of all the designated contracting states (see **T 194/88**, **T 809/96**, **T 201/04** applying R. 60(1) EPC 1973). However, in some exceptional circumstances, the proceedings have been terminated where such evidence was missing. In **T 762/89** the respondent (patent proprietor) had submitted that the patent had lapsed following non-payment of the national renewal fees in the designated contracting states (AT, BE, DE, FR, GB, IT, LU, NL und SE). EPO records showed that the European patent had lapsed in 1990 in all the designated contracting states except Italy and Luxembourg, and the respondent provided confirmation that the patent had lapsed in Italy with a letter of 7 January 1992. Since the respondent had expressly declared on a number of occasions that the patent had lapsed in all the designated states, the board held that, with a view to procedural economy, there was no valid reason why the respondent should be required to show that it had lapsed in Luxembourg as well. In **T 607/00** the board accepted the respondent's statement, which was not challenged by the appellant, that the patent had lapsed in Italy.

If the appellant (opponent) expressed doubts concerning a respondent's (patent proprietor's) claim that a patent had lapsed or been surrendered, then the lapse had to be registered with the EPO or properly proved. Otherwise, R. 60(1) EPC 1973 was not applicable and the appeal procedure continued (**T 194/88**, **T 682/91**, **T 833/94**, **T 201/04**).

2.2.1 Request for continuation of the proceedings made by the opponent

In **T 1213/97** the patent had expired for all designated contracting states during the opposition appeal proceedings. The appellant (opponent) requested a decision on the state of the file which implied a request for the continuation of the appeal proceedings for the purpose of issuing a decision. The board exercised its power under R. 60(1) EPC 1973 (R. 84(1) EPC) to continue the appeal proceedings.

In **T 598/98** too the patent had lapsed for all designated contracting states since a time subsequent to the opponent's filing of the appeal, and the appellant (opponent) had requested continuation of the proceedings. The request was allowed. The board maintained that the opponent's legitimate interest in retroactive revocation was one of the elements that could be a factor in the board's decision to terminate or continue the proceedings under R. 60 EPC 1973. It also stated that the general interest in a central ruling on the patentability of an invention claimed in a patent did at any rate justify continuing the proceedings until a final decision was taken if the case was essentially ready for decision at the time when the patent lapsed and if it also made a significant difference to the patent's fate whether a decision was taken on the merits or the proceedings were simply terminated.

In **T 500/12** the board granted the request filed by the appellant (opponent) for continuation of the appeal proceedings. The appellant had provided evidence from several national patent registers showing that the opposed patent had not lapsed in all contracting states and was still in force. The appellant further submitted that the annuity fees could be paid not only by the patentees but also by a third party. Furthermore, annuity fees could still be validly paid with a surcharge in many of the contracting states and, even if they were not paid with a surcharge in due time, reinstatement periods also had to be considered.

In **T 740/15** the board interpreted R. 84(1) EPC to mean that if the opponent files a request for continuation of the opposition proceedings within the given time limit, the scope of discretion of the opposition division provided in R. 84(1) EPC is thereby limited to only one possible lawful decision and this is the continuation of the opposition proceedings. The board noted that this understanding found support in the travaux préparatoires of the EPC 1973.

In **T 2492/18** the board set aside the opposition division's decision not to continue the opposition proceedings in accordance with R. 84(1) EPC. The reason given by the opposition division was that no timely request for continuation had been filed. The board noted that the request for continuation had been filed when an appeal was pending and that it would have been within the competence of the board in question to decide upon it. However the appeal had been withdrawn after two months and thus before the board was able to deal with it. From that moment on, the competence to deal with the request was again with the opposition division. The course of events might have led to some confusion, but that did not take away from the fact that a request for continuation had been timely filed and the opposition division had had an obligation to consider it.

In **T 1959/15** the board, exercising its discretion under R. 84(1) EPC, granted the request of the appellant to continue the appeal proceedings. In doing so, it had regard to the appellant's legitimate interest in attempting to reverse the opposition division's rejection of the opposition and to the circumstance that the board's decision on the patent had an ex tunc effect under Art. 68 EPC.

2.2.2 Request for continuation of the proceedings made by the patent proprietor

In contrast to the case law cited above, **T 708/01** concerns the situation where the patent proprietor had appealed against the decision of the opposition division to revoke the patent. The patent had expired in all the designated contracting states. The board decided that R. 60(1) EPC 1973 only applied, if at all, to the extent that the appellants were required to state whether they wished to maintain the appeal. The proprietors could also apply to have the patent maintained in amended form with effect only for the past. In the case in point the appellants stated that they wished to maintain the appeal. The board decided to continue the proceedings.

In **T 520/10** the board noted that if a European patent has lapsed in all designated contracting states, opposition proceedings may be continued at the request of the opponent. However, if – as in the present case – the patent proprietor was the appellant, it would be inappropriate to allow one or more of the opponents (respondents) to decide whether the appeal proceedings should be continued. For this reason, R. 84(1) EPC had to be applied mutatis mutandis in such opposition appeal proceedings so that it was the patent proprietor who could request that the appeal proceedings be continued. As no such request had been made, the appeal proceedings were terminated (see also **T 1733/09**, **T 1313/10**, **T 1272/10**, **T 1825/11**, **T 2020/14**, **T 998/15**). In **T 769/18**, at the request of the patent proprietor, the appeal proceedings were continued.

In **T 2536/10** the board, which had asked the appellant (patent proprietor) whether it wished to request continuation of the appeal proceedings, interpreted the statement of the appellant that the patent had been allowed to lapse in all designated states to mean that the appellant did not wish to request continuation. The appeal proceedings were terminated.

3. Death or legal incapacity of an opponent

Rule 84(2), first sentence, EPC provides that in the event of the death or legal incapacity of an opponent the opposition proceedings may be continued by the EPO of its own motion. This means that, with a view to ensuring expeditious handling of the case, they can be continued even without the participation of the opponent's heirs or legal representatives. There is therefore no need to wait for the heirs to be identified and the inheritance to be accepted or for a legal representative to be appointed (**T 1533/07**).

The appointment by the courts of an insolvency administrator under German law does not mean that the opponent is legally incapacitated within the meaning of R. 84(2), first sentence, EPC. Rather, under German insolvency law the administrator is an ex officio

party. By way of a change of party by operation of law, the administrator thus becomes a party to the proceedings, and takes the place of the opponent (**T 1533/07**, **T 917/01**).

4. Withdrawal of opposition

Rule 84(2), second sentence, EPC provides that the opposition proceedings may be continued by the EPO of its own motion if the opposition is withdrawn.

4.1. Form and effect of withdrawal on party status

A withdrawal requires an unambiguous statement. An opponent's statement explaining their lack of interest in the fate of the European patent to which their opposition relates cannot be construed as a withdrawal of the opposition (**T 798/93**, OJ 1997, 363). A declaration by the opponent that they have decided to "discontinue the opposition" clearly indicates that they want to cease their opposition and is to be interpreted in the sense that the opposition has been withdrawn (**T 789/89**, OJ 1994, 482).

An opponent who withdraws their opposition ceases to be a party to the proceedings (**T 283/02**). Where the proceedings continue and there are questions concerning the apportionment of costs, the opponent ceases to be a party with respect to the substantive issues, but remains a party as regards apportionment of costs (**T 789/89**, **T 1397/10**, **T 2350/10** and **T 2061/11**).

It is not possible to request that a withdrawal of an opposition be cancelled. The withdrawal is a procedural declaration by a party which takes effect on receipt by the EPO. An opponent who withdraws their opposition and as a result ceases to be an active party to the proceedings can no longer take procedural steps themselves (**T 283/02**).

In **T 558/95** the board noted that the main request had been refused by the opposition division before the opposition was withdrawn. The decision concerning this request was thus final; even after the withdrawal of the opposition, it could no longer be reviewed by the department of first instance. The continuation of the proceedings by the EPO of its own motion under R. 60(2), second sentence, EPC 1973 (R. 84(2) EPC) therefore applied only to the auxiliary request, which had not been the subject of a final decision.

4.2. Effect of withdrawal on opposition proceedings before the departments of first instance

After withdrawal of an opposition, the opposition proceedings should be continued if they have reached such a stage that they are likely to result in a limitation or revocation of the European patent without further assistance from the opponent and without the opposition division itself having to undertake extensive investigations (**T 197/88**, OJ 1989, 412; **T 36/11**). The continuation of the opposition proceedings under these circumstances follows from the EPO's general duty towards the public not to maintain patents which it is convinced are not legally valid at all or would be legally valid only with the necessary limitations (**T 156/84**, OJ 1988, 372; **T 197/88**).

In **T 1668/08** the respondent (opponent) withdrew its opposition during the appeal proceedings and was hence no longer a party to those proceedings. The board decided to remit the case to the department of first instance for further prosecution. The board emphasised that during that further prosecution the opposition division would first need to decide, in accordance with R. 84(2) EPC, whether or not to continue the opposition proceedings of its own motion in view of the withdrawal of the opposition. It warned that its decision to remit should not be taken as indicative of the conclusion to be reached in this respect. See also **T 1223/15**, in which the board decided to remit the case to the department of first instance, including first and foremost the question of whether the Office wished to continue the proceedings of its own motion according to R. 84(2) EPC.

In **T 36/11** the board held that an appeal by the patent proprietor against the decision of the opposition division to discontinue opposition proceedings after the withdrawal of the opposition was inadmissible because the patent proprietor had not been adversely affected by that decision.

In **T 228/14** the opposition was withdrawn after the opposition division had delivered its decision in oral proceedings to revoke the patent. The patent proprietor filed an appeal and the board concluded that the revocation decision had to be set aside. Regarding the continuation of the opposition proceedings, the board held that if the opposition proceedings had been terminated after the decision had been set aside, the patent would have stood as granted. But the proprietor had requested maintenance of the patent in amended form and thus no longer approved of the text of the patent as granted. The board stated that a decision to terminate the opposition proceedings would be contrary to the principle of party disposition as codified in Art. 113(2) EPC 1973. Moreover, the board took into account that the opposition division had been of the preliminary view that the subject-matter of the granted claims lacked inventive step. For both reasons, the board decided that the opposition proceedings had to be continued.

In **T 1860/13** the opponents withdrew their oppositions during opposition proceedings. The board held that the opponents thereby renounced their positions as parties to the proceedings and, accordingly, any active role in them. The fact that the opposition division continued ex officio with the examination of the oppositions did not affect this. Opponent III's submissions on appeal, filed after the appellant's (patent proprietor's) statement of grounds, were, therefore, regarded as third-party observations under Art. 115 EPC.

4.3. Effect of withdrawal on opposition appeal proceedings

The discretionary nature of an opposition division's decision whether or not to continue the proceedings pursuant to R. 84(2) EPC has to be distinguished from the much more narrow framework within which the boards of appeal decide on the effect of a withdrawal of an opposition. The effect of a withdrawal on the opposition appeal proceedings depends on whether or not the opponent is the sole appellant.

In **G 8/93** (OJ 1994, 887) the Enlarged Board held that if the **opponent** as **sole appellant** filed a statement withdrawing their opposition, this could only be regarded as a withdrawal of the appeal which immediately and automatically terminated the appeal proceedings as

far as all substantive issues were concerned (**G 7/91**, **G 8/91**, OJ 1993, 356, 346 and 478). This was irrespective of the patentee's consent. The proceedings were terminated even if in the board's view the requirements under the EPC for maintaining the patent were not met. The Enlarged Board emphasised the distinction between the power to initiate and continue proceedings and the power to clarify the facts in pending proceedings. According to its case law, in appeal proceedings the former was **exclusively** the province of the appellant, whereas the latter might be exercised by the board subject to Art. 114 EPC 1973 provided proceedings were pending.

In contrast, according to established case law the withdrawal of an opposition has no direct procedural consequences for the appeal proceedings if the opponent was the **respondent** and the contested patent was revoked by the contested decision (**T 629/90**, OJ 1992, 654; followed by numerous other decisions, including **T 789/89**, OJ 1994, 482, **T 194/90**, **T 627/92**, **T 46/10**, **T 727/10**, **T 2061/11**, **T 1216/12**, **T 289/16**). In such cases, the board must carry out a substantive examination of the opposition division's decision, and can only set aside this decision and reject the opposition if the grounds for opposition do not prejudice the maintenance of the granted patent. The board's examination can include the examination of evidence submitted by the respondent (opponent) prior to the withdrawal of the opposition (**T 629/90**; see also **T 900/03**, **T 340/05**, **T 46/10**, **T 727/10**, **T 817/12**). According to **T 46/10**, the board can also consider any arguments the respondent (opponent) submitted before the withdrawal (see also **T 1657/14**, **T 1635/15**, **T 2861/19**).

The opposition appeal proceedings are also continued if both the patent proprietor and the opponent have appealed but the opponent withdraws their opposition in the course of the appeal proceedings. The effect of the withdrawal of the opposition is that the appeal of the opponent is regarded as withdrawn and the opponent ceases to be a party to the appeal proceedings as regards the substantive issues (**T 789/89**, **T 922/01**, **T 1346/10**). In **T 943/22**, after the opponent withdrew their opposition and their appeal, the patent proprietor remained as the sole party in the opposition appeal proceedings. The board noted that, after allowing the proprietor's appeal, the board could not assess the remaining grounds of opposition raised by the former opponents/interveners. Hence, the board's finding that the ground for opposition under Art. 100(c) EPC did not preclude the maintenance of the patent as granted implied that the patent was to be maintained as granted.

R. Apportionment of costs

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1. Principle that each party must bear its own costs

Under Art. 104(1) EPC, each party to opposition proceedings must, as a rule, bear the costs it has incurred. However, the opposition division or board of appeal may, for reasons of equity, order a different apportionment of the costs. At the appeal stage Art. 16(1) RPBA also applies, allowing the board, subject to Art. 104(1) EPC, to order a different apportionment. It lists typical cases where costs arise as a result of: (a) amendments to a party's appeal case pursuant to Art. 13 RPBA; (b) extension of a period; (c) acts or omissions prejudicing the timely and efficient conduct of oral proceedings; (d) failure to comply with a direction of the board; or (e) abuse of procedure.

In **T 133/06** the board added that Art. 104 EPC belonged to the procedural provisions and so was subject to the general principle of law that a new procedural law was immediately applicable but had no retrospective effect unless otherwise provided. Hence when deciding whether the new Art. 104 EPC (i.e. Art. 104 EPC 2000) is applicable in appeal proceedings initiated under EPC 1973, the board must take into consideration not only the fact that, according to the transitional provisions (see decision of the Administrative Council of 28 June 2001, OJ SE 1/2007, 197), the new Art. 104 EPC is applicable to granted patents, but also the date of the event which gives rise to the application of this article. This is the only way to give the new procedural provision an immediate application without giving it a retrospective effect.

In **T 66/18** the board held that Art. 104(1) EPC applied only to adversarial proceedings such as opposition proceedings. An alleged abuse during examination, i.e. before and not during opposition proceedings, did not fall within the scope of Art. 104(1) EPC. It further observed that the possibility of apportioning costs was treated in the case law not as a means of imposing a fine but rather as a way of granting at least partial compensation for conduct during opposition proceedings that fell short of the due level of care.

2. Equity of a different apportionment of costs – case groups

There is no definition of equity in the EPC. The boards of appeal therefore had to develop the criteria determining whether costs were to be apportioned on a case-by-case basis. In a number of decisions it has generally been stated that apportionment of costs is justified if the conduct of one party is not in keeping with the care required, that is if costs arise from culpable actions of an irresponsible or even malicious nature (see, for example, **T 765/89**, **T 26/92**, **T 432/92** and **T 256/16**).

In **T 1714/14** the board held that "reasons of equity" exist when a party's costs arise from culpable actions of another party, or even abusive behaviour. If, however, there was nothing to indicate negligence, wrongdoing, or an abuse of procedure, a different apportionment of costs was not justified.

From the exceptional nature of the cost apportionment provided under Art. 104(1) EPC and the reference to abuse of procedure contained in Art. 16(1)(e) RPBA, the board concluded in **T 967/18** that more than just a mistake made by a party or a negligent delay in a procedural act, which may occur in proceedings and which may lead to additional activities and costs, was required for the order of a different apportionment. Abuse of procedure referred to such extreme situations where "the exercise of rights is predominantly intended to cause damage and other legitimate purposes take a back seat" (**J 14/19**). Therefore, while the board considered that negligent behaviour may also justify apportionment, the negligence had to be serious enough to be considered equivalent to wilful misconduct.

Requests for a different apportionment of costs are often filed in various scenarios in which costs are incurred due to:

- late submission of documents and/or requests (see in this chapter III.R.2.1.);

- acts or omissions prejudicing the timely and efficient conduct of oral proceedings (see in this chapter III.R.2.2.);

- filing of opposition or appeal (see in this chapter III.R.2.3.);

- withdrawal of opposition or appeal at short notice (see in this chapter III.R.2.4.);

- other cases (see in this chapter III.R.2.5.).

2.1. Late submission of documents and/or requests

Where facts and evidence supporting the opposition are submitted at a late stage in the proceedings and another party incurs considerably higher costs as a result, a different apportionment of the costs may be ordered for reasons of equity (see **T 10/82**, OJ 1983, 407; **T 117/86**, OJ 1989, 401; **T 101/87**, **T 326/87**, OJ 1992, 522; **T 416/87**, OJ 1990, 415; **T 323/89**, OJ 1992, 169; **T 596/89**, **T 622/89**, **T 503/90**, **T 611/90**, OJ 1993, 50; **T 755/90**, **T 110/91**, **T 867/92**, OJ 1995, 126; **T 719/93** and **T 970/93**). The relevant factor in deciding on the costs is whether or not there are cogent reasons justifying the late submission; it is regarded as irrelevant whether the material in question has any bearing on the merits of the decision. However, it should be pointed out that, in several cases, requests for apportionment of costs have been refused, despite an unjustified delay, because there was no proof that higher costs had been incurred (see, for example, **T 212/88**, OJ 1992, 28; **T 582/90**, **T 267/92**, **T 9/95** and **T 207/03**).

According to board of appeal case law, if a party introduces important facts or evidence at a late stage of the proceedings, without cogent reasons for the delay, this may be taken into account in the apportionment of costs (see **T 117/86**, OJ 1989, 401; **T 326/87**, OJ 1992, 522; **T 97/90**, **T 611/90**, OJ 1993, 50; **T 847/93**, **T 1016/93**, **T 574/02**, **T 931/06**, **T 493/11**). If the reasons for the late citing of a document do not point towards negligence or other circumstances that would amount to an abuse of procedure, there is no reason of equity which would justify an apportionment of costs in the other party's favour (**T 1016/93**). But see also **T 561/19**, in which the board held that negligence, will to harm or abuse of procedure was not a prerequisite for a different apportionment of costs. It sufficed that there was no good justification for the late filing and that the late filing was the cause of both the adjournment of the oral proceedings and extra costs for the other party.

Preparations for discussing the admission of late-filed documents into the proceedings during the opposition-appeal proceedings and, if they are admitted, preparations for discussing their relevance in respect of the patentability of the claimed subject-matter are part of the normal work that can be expected of any party and/or its representative (**T 1848/12**). See similarly **T 101/17** for late-filed requests.

In **T 1781/13** the board found that, since the EPC did not treat late-filed submissions as automatically inadmissible and the RPBA 2007 similarly did not treat amendments to a case this way, both instead leaving it to the boards to decide on admission at their discretion (Art. 114(2) EPC; Art. 12(4) and 13(1) RPBA 2007), it was clear that a party's amending its case could not be regarded as unfair per se and so held against it. Generally

speaking, additional circumstances were therefore needed for equity to dictate ordering a party to pay the other's costs because it had amended its case at a late stage (see also **T 467/15**). In the case in hand, no such circumstances were apparent to the board and the party requesting that it be awarded costs, although bearing the burden of substantiating that request, had not made a case for them.

2.1.1 Late submission was unjustified

a) Different apportionment of costs ordered

In **T 514/01** the board found that the late allegation of **public prior use** during the first oral proceedings before the opposition division had given rise to additional costs because a second oral proceedings before the opposition division were then needed to investigate the alleged public prior use.

Similarly, in **T 561/19** the opponent (appellant) filed document D15 during the first oral proceedings before the opposition division. D15 was admitted and the oral proceedings were adjourned. The opposition division ordered that the costs incurred as a result of the second oral proceedings be borne by the opponent. Since there was no good justification for the late filing and the late filing was the cause of both the adjournment of the oral proceedings and extra costs for the other party, the board confirmed the opposition division's decision.

In **T 117/86** (OJ 1989, 401) the appellant had produced, together with their statement of grounds, two new prior art documents and an affidavit in support of the contention that the opposed patent lacked an inventive step. The board concluded that the fact that new documents were presented **after the nine-month period** for filing opposition could itself give rise to additional expenditure for the other party, and that the costs should be apportioned differently for reasons of equity.

The board in **T 416/87**, expressly referring to **T 117/86**, regarded it as an abuse of the opposition procedure that the appellant had in its statement of grounds of appeal relied exclusively on three new documents and had even raised for the first time the **issue of novelty** on the basis of a document already discussed in the patent in suit. By introducing arguments and documents which bore little relation to the content of those filed in the original opposition, the appellant had produced virtually a new opposition at the appeal stage. This could not, by definition, be the purpose of an appeal. Although the respondent clearly envisaged requesting a decision on costs in the event of oral proceedings only, the abuse of procedure justified the apportionment of costs incurred during the taking of evidence.

The board in **T 83/93** held that it was also an abuse of the appeal procedure to submit **five new documents** as evidence 40 months after the end of the opposition period (without giving reasons) and to revive an objection under Art. 100(c) EPC 1973 on the basis of new facts and evidence 51 months after the end of the opposition period.

In **T 867/92** (OJ 1995, 126) the claims had been amended during the opposition proceedings. Eighteen months after the claims had been amended, the appellant (opponent) cited in the statement of grounds of appeal a **new prior art** document. The board held that the EPC does not impose a time limit for citing new prior art in response to an amendment of the claims. However, an opponent who cites new prior art with a considerable delay with no special reason justifying the delay runs the risk of having to bear the proprietor's costs incurred in attending oral proceedings which cannot bring the case to an end because of the new citation. However, as there was no suggestion that the appellant wilfully abused the procedure in the case at issue, the board considered that it would be equitable to order the appellant to pay only half those costs.

In **T 416/00** the appellant (opponent) submitted a **document** which had been cited in the patent in suit and mentioned in the opposition proceedings but **had never been discussed between the parties** until the appeal proceedings, and had even been expressly excluded before the opposition division. The board found that the opponent's attempt to make surprising use of a document that it had disregarded in the oral proceedings before the opposition division ran counter to the speedy conclusion of the proceedings before the two departments. Even if this was not a deliberate tactic on the opponent's part, the result was the same in terms of the principle of fairness governing proceedings. The respondent's request for a different apportionment of costs was granted.

In **T 2549/12** documents which the appellant had filed with its statement of grounds of appeal amounted to new submissions that opened up a new discussion and a fresh case that had not been dealt with in the first-instance decision. The board refused to admit the documents. On the apportionment of costs, the board held that, where an **entirely new case** was first made on appeal (here, through filing the new submissions) and there were no mitigating circumstances that might excuse its being made so late, opportunities to make it at first instance having been missed and no explanation or justification for that being provided, it was appropriate to order a different apportionment of costs within the meaning of Art. 104(1) EPC.

In **T 671/03** document D18 was first filed in the appeal proceedings and deemed to constitute an **amendment to the appellant's submissions** pursuant to Art. 10b RPBA 2003. If it had been filed within the opposition period, there would have been no need to discuss its admission during the oral proceedings in the appeal. The costs for preparing and attending the oral proceedings before the board, which mainly discussed the admission of D18, could have been avoided. For reasons of equity the board ordered a suitably modified apportionment of costs.

In **T 493/11** the respondent (opponent) introduced important evidence at a late stage of the proceedings, namely only two months before the date of the scheduled oral proceedings before the board, without cogent reasons for the delay and, in particular, without submitting all the necessary information. The board stressed that the **responsibility for stating its complete case** lay exclusively within the respondent's own sphere. As a consequence, any delay causing the incurring of additional costs by the other party remained within the respondent's sphere and liability and, in the case in hand, justified an apportionment of costs.

Similarly, in **T 2165/08** of 6 March 2013 the appellant (patent proprietor) filed its auxiliary requests 1 to 3 **one month before the oral proceedings** in appeal and further supporting documents even closer to the oral proceedings. The board stated that it would always be unacceptable for a party to produce evidence without any explanation – unless conceivably its relevance was self-evident. But to produce evidence at the virtual end of the proceedings accompanied only by a statement that the explanation would be provided even later was not only discourteous but a clear, and apparently deliberate, attempt to frustrate the respondent's preparation for the oral proceedings. That was both an act prejudicing the efficient conduct of oral proceedings and an abuse of procedure, which merited an apportionment of costs.

In **T 1763/12** the board admitted document O6A into the proceedings even though it was filed **only three days before the scheduled date for the oral proceedings**. The appellant (opponent) did not give any reason why document O6A had only been submitted at such a late stage of the proceedings and why it could not have filed this document earlier. The consequence was that the discussion at the oral proceedings before the board was limited to the issue of admittance of O6A without considering any substantive matter. This would have been avoided if the document had been filed earlier. The board held it to be equitable that the expenses incurred by the appellant (patent proprietor) in connection with the oral proceedings be borne by the appellant (opponent).

In **T 2233/09** the appellant (opponent) announced its change of name and filed a copy of a merger certificate the day before the oral proceedings. The board concluded that it would have been possible for the appellant to submit the evidence necessary to prove transfer of appellant status well ahead of the oral proceedings and that it was its conduct that had caused the adjourning of the oral proceedings. Therefore, for reasons of equity, the respondent's costs for the new oral proceedings had to be borne by the appellant.

In **T 874/03** a new prior art document and its translation were filed during the oral proceedings on appeal. The board admitted this document and it ruled that when late filing of facts and evidence necessitated remitting the case to the department of first instance, the costs of any oral proceedings in the appeal proceedings were normally to be borne by the party responsible for the late filing.

In **T 1033/09** the oral proceedings had been adjourned following the **admission of an auxiliary request** submitted by the respondent during those proceedings. For the board, there was no doubt that this auxiliary request constituted an amendment to the respondent's case after it had filed its reply to the statement of the grounds of appeal, and so one within the meaning of Art. 13(1) RPBA 2007. The board therefore found it equitable to apportion the costs in the appellant's favour.

b) No different apportionment of costs ordered – no disadvantage

In **T 336/86** the appellant submitted a prior patent belonging to the respondent for the first time during oral proceedings on appeal, which destroyed the novelty of the patent in suit. The respondent requested an apportionment of costs as the oral proceedings would not have been necessary had the patent been presented earlier. The board agreed that the

late submission was not justified and that higher costs had been incurred as a result. However, as the respondent either had – or should have – been aware of the **existence of their own patent**, it took the view that an apportionment of costs was not justified.

In **T 330/88** the respondent filed a new document two days prior to the oral proceedings. The board took the view that the late filing was unjustified but that an apportionment of costs would not be equitable as the appellant had had **sufficient time** to deal with the document, especially since the decision was not taken until four months after the oral proceedings and following the opportunity to present comments.

In **T 525/88** the late filing was unjustified, but the request for apportionment of costs was rejected because the documents were of **no relevance** and did not affect the decision see also **T 876/90**, **T 1714/14**. In **T 882/91** the board did not look into whether the unjustified late submission had led to higher costs because it was of the opinion that the other party had not had to spend very **much additional time and energy** on the documents which had been submitted late and that there was therefore no reason to apportion costs (see the decisions on similar cases in **T 737/89**, **T 685/91**, **T 556/90**, **T 231/90** and **T 875/91**).

In **T 28/91** three documents which had already been submitted to the opposition division were re-submitted at a later stage in the appeal proceedings. The board ruled that the late submission was not disadvantageous as no new arguments had been introduced, and therefore no additional work had been necessary (see also **T 133/06**).

In **T 931/97** the opponent had submitted new evidence in appeal proceedings, which was **already known to the patentee** from earlier proceedings before the German Patent Office. The board held that where the patentee knew the documents and could assess their prospects a different apportionment of costs was not justified.

In **T 1182/01** the board admitted into the appeal proceedings several documents filed late by the appellant and held that its decision to **remit** the case immediately to the department of first instance meant that the respondent had not incurred any undue cost burden in relation to the appeal in hand.

In **T 633/05** the appellant referred for the first time in the statement of grounds of appeal to a document which had been cited in the European search report but not considered in the opposition proceedings. In the board's view, the appellant sought to provide new evidence in support of a line of argument already put forward in the opposition proceedings, namely the fact that certain features of the present invention were known in the art. As the said **document was cited in the statement of grounds** of appeal and was anyway part of the examination file, the respondent had had ample time to study the content of this fairly short document and prepare a rebuttal against the appellant's allegation that it disclosed some key features of the contested patent. Thus, the board had no reason to suspect that the appellant's late filing might have been aimed at delaying the appeal proceedings, or that it resulted in the respondent being burdened with unreasonable additional costs.

In **T 273/10** the board found that the **opponent had abusively withheld the document** in question, which ought to have been submitted for adversarial scrutiny in good time. However, it also observed that this had not been the only reason why further oral proceedings before the opposition division had been necessary. At the stage when the initial proceedings had been adjourned, it would anyway have been impossible to close them the same day. The board noted that a full day had been needed for the second oral proceedings and, moreover, that continuation of the proceedings had given the proprietor an opportunity to put forward new auxiliary requests. It followed that, since both parties had benefited from the holding of further oral proceedings, it would not be equitable to order the opponent to bear the costs alone.

In **T 213/14** the board exercised its discretion under Art. 13(1) RPBA 2007 not to admit auxiliary requests into the proceedings; it also refused a different apportionment of the costs. It held that a **proprietor filing new requests** in order to defend its position subsequent to oral proceedings being appointed or to receiving a negative preliminary opinion from the board was, with regard at least to the case in hand, not seen as an extraordinary circumstance justifying an apportionment of costs. Whilst the requests could arguably have been filed as part of the appellant's complete case, the later filing of these could not be understood to have resulted in significantly greater work for the respondent. The respondent should have considered what objections were to be made, including, where appropriate, possible objections as regards admittance of such requests into the proceedings.

In **T 101/17** the board refused the respondent's (opponent's) request for a different apportionment of costs. The respondent argued that the **filing of auxiliary requests at the appeal stage** – rather than at the stage of opposition – amounted to an abuse of procedure; although the auxiliary requests were not admitted, it had nonetheless been necessary to prepare for the scenario that they would be admitted and to subsequently address them content-wise. The board considered that the case law of the boards of appeal did not support a different apportionment of costs. It concurred with the approach taken in **T 1848/12**, namely that preparations for discussing the admission of late-filed documents were part of the normal work that can be expected of a party, as an application of the principle that each party bears its own costs. It further observed that in order to establish any causal link between the respondent's expenses and the appellant's behaviour, the respondent would have to show that it was particularly the belated filing of requests that caused the expense rather than the filing of requests as such. As a discussion on the admissibility of requests was a not uncommon occurrence in proceedings in general, this could hardly be credited with separately identifiable expenses.

In decision **T 2175/15** of 11 June 2024 on the apportionment of costs, the board held a different apportionment of costs under Art. 104(1) EPC und Art. 16(1) RPBA not to be equitable. In the case in question, the appellants (patent proprietors) had filed an auxiliary request exclusively covering the granted process claims in the first oral proceedings before the board of appeal. The board was of the opinion that it would have been reasonable to deal with that auxiliary request in those oral proceedings. Therefore, their adjournment had not been necessitated by the late filing of the auxiliary request. Contrary to the view of the opposing appellant (opponent), the board could not see any breach of fundamental

procedural due care obligations on the part of the patent proprietors in withdrawing the appeal a few days before the second oral proceedings were scheduled (see **T 490/05**).

2.1.2 Late submission was justified

In principle, costs are not apportioned differently if the late submission of facts and evidence appears justified. The boards have assumed in particular that belated submission is justified or that no abuse of procedure has taken place if new documents are filed for the first time at a later stage in the proceedings as a reaction to communications from the board, comments from the other party or amendments of the patent or decisions of the department of first instance which make such documents necessary in the first place (see **T 582/88**, **T 638/89**, **T 765/89**, **T 472/90**, **T 556/90**, **T 334/91**, **T 875/91**, **T 81/92** and **T 585/95**).

a) No different apportionment of costs ordered

In **T 712/94** the board allowed the appellant (opponent) to introduce facts and evidence on alleged prior use at the appeal stage, whilst refusing the respondent's (patentee's) request for apportionment of costs. The patentee had been made aware of the prior-use documents during negotiations conducted well before the first-instance decision was taken; so they had not taken him by surprise when submitted after the failure of those negotiations.

In **T 29/96** a new document which was fairly simple and straightforward in content had been filed together with the statement of grounds of appeal. The board ruled that this was the earliest possible moment that the document could have been submitted. In addition, the introduction of the new document could not be regarded as having given rise to a new opposition; the appellant had not introduced a new item of closest prior art but merely a new secondary information source, in an attempt to **fill the gap referred to in the impugned decision** so as to improve its position with respect to the assessment of inventive step.

In **T 1171/97** the board rejected a request for apportionment of costs because it was satisfied that the new documents which had become known to the appellant (opponent) in the course of another search had not been filed in order to obstruct the proceedings, but because they contained aspects which, **according to the statement of the opposition division**, had not been found in the previously available references.

In **T 554/01** the appellant submitted a number of documents following the negative decision taken by the opposition division. The board held that the mere fact that certain documents had been submitted at a late stage did not justify a finding that there had been an abuse on the part of the appellant, especially where they had been submitted as a result of a legitimate desire **to supplement the line of argument** which had been unsuccessful before the department of first instance. Moreover, the respondent had not shown that they had incurred additional costs as a result of the documents' introduction into the proceedings.

In **T 507/03**, as a reaction to the reasons given in the impugned decision, the opponent (appellant) filed a new set of documents in the appeal proceedings. Refusing the request for a different apportionment of costs due to the late filing, the board argued that, according to Art. 108 EPC 1973 and R. 65 EPC 1973 (now R. 101 EPC), a statement of grounds of appeal had to identify the extent to which amendment or cancellation of the decision was requested. This, however, did not forbid a losing opponent from filing new pieces of prior art if it was felt that they could counter the reasons given in the appealed decision. Further, the new documents were all **easily understandable** and had not caused **an unreasonable amount of extra work** such as to justify departing from the normal rule that each party meets its own costs pursuant to Art. 104 EPC 1973.

In **T 242/04** the board considered that the respondent's late filing was made **in response to a communication of the opposition division** for making written submissions and took place roughly one month before expiry of the final date accorded in the communication as well as roughly two months before the date for oral proceedings. The circumstances were therefore not such that there was no justification for the late filing or that it could be held that the respondent acted in bad faith. In addition, the appellant who requested an apportionment of costs and, in particular, reimbursement of the travel costs of a technical expert, neither gave any reasons let alone any evidence for the necessity of the technical expert's presence at the hearing before the opposition division, nor provided any evidence that the respective trip was caused only by the said late filing. Therefore, a different apportionment of costs was not regarded as justified.

In **T 333/06** the board found that the appellant's maintenance of their request for admission of the fresh ground for opposition – lack of inventive step – and of the new supporting documents, after being notified of **the board's preliminary negative opinion**, did not constitute abuse, as that opinion was not a final decision. Furthermore, even if the appellant had acknowledged that the new documents were not relevant to novelty, objectively they could not be blamed for having maintained them in the hope that their oral presentation would result in the admission of lack of inventive step as a fresh ground for opposition and hence of the new documents relevant to inventive step. Thus, while this had admittedly made the respondent's preparations for oral proceedings more difficult than they would have been if the appellant had withdrawn the new documents, the procedural conduct on the part of the appellant which had necessitated those preparations was not abusive but one of the appellant's legitimate prerogatives.

In **T 1167/06** the board did not consider it an abuse of procedure that two weeks before the oral proceedings the appellant filed three further auxiliary requests, additional arguments and four short documents, the latter illustrating common general knowledge on issues that had already been discussed. The need to **translate the requests and documents** and the resultant costs were in the nature of the European procedure with three official languages and affected all parties in equal measure. As the language of the proceedings for the patent was German, the respondent (opponent) had to expect many submissions to be made in that language. The respondent stated that an additional representative had had to deal with the late filing and travel to the oral proceedings because the **representative assigned the case had been on leave** at the time in question. In the board's view, however, the representative's absence on leave was not the

fault of the other party. Moreover, the respondent had been represented by the same two representatives before the opposition division, so the additional representative had not needed much time to familiarise himself with the latest dossier updates.

In **T 467/15** the board set aside the opposition division's order apportioning costs in favour of the opponent. The opponent had contended that it had been unable to prepare for the oral proceedings before the opposition division due to the **large number of diverging auxiliary requests**, the point in time at which they were submitted and the reasons for them, which it considered inadequate. In this case, however, the board decided, contrary to the opposition division, that submitting 22 auxiliary requests before the date specified under R. 116(1) EPC could not be deemed an abuse of proceedings or unreasonable. Since amending a case even at an advanced stage of the proceedings was not necessarily inadmissible under the EPC, doing so could not in itself be considered an abuse of proceedings or unreasonable. As a general rule, there needed to be further circumstances to justify awarding costs for reasons of equity because a case had been changed at a late stage (see **T 1781/13**). In the case in hand, the board did not consider the large number of auxiliary requests and the fact that they were diverging to adequately justify an award of costs.

In **T 403/17** the board admitted the submissions filed by the appellant one month before the oral proceedings. It refused a different apportionment of costs because these submissions did not lead to any amendment to the appellant's case within the meaning of Art. 13 RPBA (different from **T 2165/08** of 6 March 2013, where the board had regarded submissions made shortly before oral proceedings as an amendment to the appellant's case and an abuse of procedure). Considering these submissions and preparing to discuss their relevance to the patentability of the claimed subject-matter were regarded as being part of the normal preparatory work for the oral proceedings that could be expected by any party to the appeal proceedings (see **T 1848/12**). The board also noted that it was the appellant's right to write its submissions in German; R. 3(1) EPC stipulated that in written proceedings, any party may use any official language of the EPO.

According to the board in **T 964/21**, the fact that the patent proprietor did not contest the earliest priority claimed for D22 in view of the embodiment "A" until the first oral proceedings before the opposition division could not justify a different apportionment of costs. In this regard it had to be taken into account that a novelty objection based on this embodiment was raised for the first time in said oral proceedings. Even if a novelty objection based on the embodiment "B" of D22 was already in the proceedings, this did not mean that the patent proprietor would have been obliged to consider the validity of the priorities of D22 in relation to that objection.

b) Different apportionment of costs ordered for reasons of equity

In **T 847/93** a new prior art document was cited in the statement of grounds. Mitigating circumstances for the late filing of new facts and evidence were put forward by the appellant and were held to be credible by the board. However, the board was also of the opinion that it was credible that the costs incurred by the respondent were higher as a result of the introduction of an entirely fresh case than if the facts and evidence had not

been filed at a late stage. It therefore decided to order an apportionment of costs under Art. 104(1) EPC 1973 according to which the appellant had to pay the respondent 50% of the costs incurred by the respondent – after remittal to the department of first instance – in respect of the subsequent oral proceedings and the taking of evidence as well as in any subsequent appeal (on the issue of future costs, see chapter III.R.3.2.).

In **T 1137/97** a belatedly submitted document was admitted into the proceedings and a different apportionment of costs was ordered. In determining the costs, the board itself, exercising its discretion under Art. 111(1) EPC 1973, awarded a fixed sum of EUR 2 500 to avoid the need for an exact investigation of the amount, which would have been more burdensome for the parties.

In **T 937/00** the board found that all the requests presented by the appellant (patent proprietor) in writing in advance of the oral proceedings before the board were clearly inadmissible and their filing could hardly be considered appropriate in the circumstances of the case, in which the appellant had chosen to file an exceptionally high number of independent claims in response to the notice of opposition. At the very end of the oral proceedings, the appellant had even filed a third auxiliary request according to which all the claims which had been contested in the appeal procedure were simply abandoned. In these circumstances, the board felt compelled to admit the belated auxiliary request (had the board rejected the appellant's third auxiliary request, the appeal would have been dismissed and the revocation of the patent would have become final) and to remit the case to the department of first instance, none of the remaining claims having ever been considered by the opposition division. However, the board ordered for reasons of equity an apportionment of the costs of the oral proceedings.

2.2. Acts or omissions prejudicing the timely and efficient conduct of oral proceedings

2.2.1 Failure of a party to appear at oral proceedings

The boards consider it highly undesirable for summoned parties to announce too late, unclearly or not at all that they will not be attending. Such conduct is inconsistent both with the responsible exercise of rights and with the basic rules of courtesy (see for example **T 434/95**, **T 65/05**).

There is an equitable obligation on every party summoned to oral proceedings to inform the EPO as soon as they know that they will not be attending as summoned (**T 212/07**), regardless of whether they or another party requested the oral proceedings and of whether or not a communication accompanied the summons to oral proceedings. If a party who has been summoned to oral proceedings fails to attend as summoned without notifying the EPO in advance, an apportionment of costs in favour of another party, who has attended as summoned, may be justified for reasons of equity (established case law, see for example **T 930/92**, OJ 1996, 191; **T 123/05**, **T 972/13**). As one party's non-attendance does not automatically put the other party at a disadvantage (**T 273/07**, **T 544/94** and **T 507/89**), one essential question here is whether the appellant's failure to attend rendered the oral proceedings unnecessary (**T 10/82**, OJ 1983, 407; **T 275/89**, OJ 1992, 126).

a) Different apportionment of costs ordered

In **T 909/90** oral proceedings had been appointed at the appellant's request. Without giving the board or opponent any advance notice, the appellant did not attend the oral proceedings. Nor did it comment on the board's communication. For this reason in particular the oral proceedings contributed nothing new to the case. The board ordered the apportionment of costs without examining whether higher costs had been incurred as a result of the appellant's failure to appear. The appellant's failure to inform the board **in time or at all** that they would not be appearing at the oral proceedings was likewise the reason for ordering them to bear the costs in **T 434/95**, **T 641/94** and **T 123/05**.

In **T 693/95** and **T 338/90** costs were awarded because notice of the appellant's absence had been given, in the former case, only an hour before the oral proceedings and, in the latter, at the time when the oral proceedings were due to start.

In **T 937/04** the appellant (patent proprietor), by fax sent only to the EPO after business hours on Friday, 17 February 2006, informed the board, without giving reasons, that it would not be attending the oral proceedings on 21 February 2006. The board stated that the appellant, in informing only the EPO and not the other parties, had failed to exercise all due care required and concluded that, for reasons of equity, an apportionment of costs should be accorded in favour of the respondent 01. See also **T 301/12**.

In **T 53/06** the appellant requested oral proceedings "in case the board considers not to set the decision aside". As soon as it received the board's summons to oral proceedings and communication, the appellant knew not only that oral proceedings would take place but also that the condition it had itself placed on its own request for oral proceedings had been fulfilled, since the communication clearly indicated that the board's provisional opinion was that the decision under appeal would not be set aside. However, the appellant neither replied to the communication nor indicated at all, let alone as soon as it knew, that it would not attend oral proceedings. Since the respondent had, in the absence of any submissions from the appellant additional to those in the grounds of appeal, nothing to add to its own case in its reply to the grounds of appeal, the **oral proceedings proved to be unnecessary**. In those circumstances, an apportionment of costs in favour of the respondent was held to be appropriate under Art. 16(1)(c) and (e) RPBA 2007. See also **T 212/07**, **T 2179/09**, **T 258/13**.

In **T 301/12**, in reply to the board's communication, the appellant had announced in writing that it would "probably not be represented at the oral proceedings", while explicitly upholding its request for oral proceedings, and without providing further arguments on the substance. The board held that this submission had been unclear and left the respondent in the dark as to the appellant's true intentions. Therefore, the respondent had to properly prepare for the case on the basis that the appellant would be attending the oral proceedings. The appellant's failure to clearly state its intentions on its attendance at the oral proceedings was a culpable failure in its duties.

In **T 280/15** the board held that since the appellant's notice of non-attendance at the oral proceedings had been received only the **evening before** them, the respondent had

incurred costs which could have been avoided had the appellant conducted itself properly and observed the basic rules of courtesy. Moreover, the appellant's conduct, and particularly the fact that it had not informed the respondent directly, had prevented the respondent from limiting, if not avoiding, further costs for attending the oral proceedings.

In **T 2350/15** the appellant (opponent) informed the board that it would not be attending the hearing, but that this did not mean that it was withdrawing its appeal or its request for oral proceedings. The board considered that since it had intended to maintain the patent according to the main request of the patent proprietor, the oral proceedings (in the absence of the opponent) served no purpose and could have been cancelled, had it not been for the opponent's request. Indeed, the patent proprietor was not adversely affected by the decision to maintain the patent on the basis of its main request, and would thus not have needed any oral proceedings to defend its case. By maintaining its request for oral proceedings, the opponent thus not only obliged the board to hold them but also obliged the patent proprietor to come to the oral proceedings and to prepare for them. The board found it equitable that the appellant bore the costs (for preparation, travel and presence) for the oral proceedings before the board. But see also **T 256/16**, in which under similar circumstances the board considered that the respondent (patent proprietor) was not "obliged to come to the oral proceedings and to prepare for them" and rejected the request for apportionment of costs.

b) Refusal of a request for apportionment of costs

The non-appearance of a party generally does not adversely affect the party which did attend. As a rule, a different apportionment of costs will not be ordered if the parties which are affected have neither shown nor claimed that they incurred additional costs because the other party was not present (**T 544/94**, **T 632/88** and **T 507/89**).

In **T 591/88** both parties had requested that oral proceedings be held – both in fact filing an **"unconditional"** request. Without giving any advance notice, the respondent failed to appear. The appellant requested apportionment of costs on the grounds that the oral proceedings would not have been necessary had they known that the respondent would not be attending. The board rejected a different apportionment of costs because the appellant had made an "unconditional" request for oral proceedings, i.e. also covering the eventuality that the other party would not appear.

In **T 275/89** (OJ 1992, 126) the appellant's representative filed a request that the oral proceedings scheduled for 3 May be adjourned, on the grounds that the appellant was unable to attend the oral proceedings owing to **illness**. The request was submitted so late, i.e. in the afternoon of 30 April, that it was impossible in view of the public holiday the following day to notify the respondent in time: they had already departed in the afternoon of 1 May. The request for adjournment was refused however and the oral proceedings took place without the appellant and his representative. The respondent requested a different apportionment of costs on the grounds that they would not have attended either had they known that the appellant would not be appearing. The board, however, took the view that the appellant could not be made responsible for the fact that the respondent had chosen to make an early start to the journey. Furthermore, the only matter of importance

was whether the appellant's absence rendered the oral proceedings unnecessary. This question had to be answered in the negative. The request for costs was therefore rejected. The same decision was reached in **T 1856/10**, where a **medically certified, sudden and unexpected illness** of the appellant's representative had made him unable to attend. Here it was deemed acceptable that the board and the other party had not been informed of the first signs of his illness on the morning of the day before the oral proceedings, but only on the afternoon of that day, after he had seen a doctor.

In **T 838/92** the appellant stayed away from the oral proceedings. The respondent requested a different apportionment of costs as it had appeared with **seven witnesses**. The board rejected the request because the witnesses had been summoned at the respondent's instigation in order to prove the prior uses alleged by the latter. There was therefore no reason to impose the costs on the appellant (see also **T 273/07**).

In **T 91/99** the board stated that, where an appellant failed to give notice that they would not be attending the oral proceedings until **two working days** before the date set for the proceedings, this could constitute negligent or wilful conduct; however, in the case at issue, there was no culpable conduct on the part of the appellant which could justify an apportionment of costs under Art. 104(1) EPC 1973. See also **T 105/14** for a case in which the party announced its non-attendance **three days** before the oral proceedings and a different apportionment was not ordered.

In **T 849/95** the respondent submitted a request for apportionment of costs, as the appellant had not informed the EPO in good time that it would not be taking part in the oral proceedings. The board rejected the request, as the oral proceedings were arranged not only at the request of both parties, but also because the board itself required further airing of facts on the part of the respondent. The oral proceedings would not have been cancelled even if the appellant had informed the EPO in good time.

In **T 435/02** both the appellant and the respondent had filed an **auxiliary request** for oral proceedings. When filing its request, the respondent had wanted to attend the oral proceedings to ensure that the board would not overturn the decision under appeal without it having had the opportunity to present its case orally. In response to the appellant's announcement not to attend the oral proceedings, the respondent gave notice that it too would not be attending and commented that it had wished to attend "merely to rebut statements/arguments made by the patentee during these proceedings". Although the board expressly informed the parties that the oral proceedings would be held as planned, the respondent failed to attend. The respondent requested a different apportionment of costs because the appellant had withdrawn its request for oral proceedings so late that the respondent had incurred costs which no longer could be recovered. The board refused the request on the grounds that, contrary to the respondent's claim, its failure to appear was not a response to the appellant's decision not to attend but the result of a choice not to take the opportunity which it had requested to present its case orally.

In **T 65/05** the respondent (patent proprietor) maintained that, like the appellant, it would not have attended the oral proceedings if it had been informed in time that the appellant would not be appearing. In the case in point the board considered it doubtful that the oral

proceedings could therefore have been waived or that the respondent would then at any rate not have attended them or would have withdrawn its request for oral proceedings. Both parties had submitted auxiliary requests for oral proceedings. The board had issued the summons without an opinion on the merits, in particular without any announcement or intimation that it was likely to decide in the respondent's favour. Therefore the respondent could not rely on a favourable decision purely on the basis of its written submissions if it stayed away from the oral proceedings. In these specific circumstances the board deemed it likely that the respondent would have appeared at the oral proceedings to defend its interests even if it had known that the appellant would not be there. The request for a different apportionment of costs was therefore rejected (see also **T 190/06** and **T 1361/09**).

In **T 1441/06** the respondent (patent proprietor) had not requested oral proceedings. It had not reacted to the board's communication, nor had it apparently had the intention to come or to notify the EPO of its intended absence at all. It was the appellant who had requested oral proceedings, albeit conditionally. In addition, the oral proceedings were not only arranged at the request of the appellant, but also because the board itself wished to be in a position to give a decision on the case. The oral proceedings would therefore not have been cancelled by the board even if the respondent had at an early time indicated that it would not attend. In these circumstances the board saw no sufficient reason to depart from the ordinary rule that each party bears its own costs.

In **T 1071/06** the appellant had announced that it would not be attending the oral proceedings about a month after receiving the board's opinion with the summons. For the board, the time taken was entirely reasonable because appellants had to be afforded an opportunity to review their **appeal's prospects of success** in the light of the opinion accompanying the summons (among other things) before deciding how then to proceed.

According to the board in **T 1079/07**, to inform the EPO and any other party to the proceedings about the intention not to attend oral proceedings in due time is a matter of courtesy and respect rather than a procedural obligation to be met (see also **T 69/07**). In order to judge a late announcement of an intended absence from oral proceedings as constituting a "culpable action of an irresponsible or even malicious nature" (see **T 937/04**), strong supporting evidence for such an allegation would be required.

In **T 383/13** the respondent (opponent) asked the board to order a different apportionment of costs under Art. 104(1) EPC, having attended oral proceedings for which the appellant had announced its absence by letter dated just two days beforehand. The board held that if a party was late in deciding not to attend oral proceedings or in informing the board or other party of that decision, awarding costs against it may well be justified – if those costs were directly caused by not letting them know in time. In exercising that discretionary power, the board should apply the standard laid down in **T 1079/07**. In the case in point, the oral proceedings were not superfluous: the board would not have cancelled them even if informed of the appellant's absence well in advance, because it wanted to be able to decide the case at the oral proceedings and close it on that date. That the board's provisional opinion had been in the respondent's favour was immaterial. Any diligent professional representative had a duty to attend oral proceedings even if the provisional opinion was in their favour and the other party did not come. The board concluded that it

was not appropriate in the present case to order a different apportionment of costs under Art. 104(1) EPC.

In **T 2377/13** the board decided that it was the standard laid down in **T 383/13** and **T 1079/07**, not that used in **T 937/04**, which it had to apply in exercising its discretion as to whether to order a different apportionment of costs. In the case in hand, the board would certainly not have cancelled the oral proceedings, even if informed well in advance of the appellant's absence, because it had wanted to be able to decide on and close the case on the date scheduled for them, and so they had definitely not been superfluous.

In **T 1389/13** both appellants had requested oral proceedings. Therefore, oral proceedings were scheduled and the board summoned the parties. The board considered that even if appellant II's (opponent's) declaration that it would not attend oral proceedings amounted to a withdrawal of its request for oral proceedings, appellant I's (patent proprietor's) request for oral proceedings remained pending, meaning that the oral proceedings had to be held. Therefore, appellant II's perceived misconduct in that it should have notified its intention not to attend the oral proceedings earlier than it did, was not the cause of appellant I attending the oral proceedings. Accordingly, the board held that appellant II's conduct was not disadvantageous for appellant I.

In **T 938/14** both parties to the appeal proceedings had requested oral proceedings in case the board was not inclined to concur with their respective positions. From the board's communication it was clear that oral proceedings had to take place, as the appellant's request to maintain the patent based on its main request could not be granted. Even if the appellant's representative could have informed the respondent's representative, as a matter of professional courtesy, that it would not attend oral proceedings, the respondent could have made an attempt to ask for clarification. Thus, the board could not see any culpable actions of an irresponsible or even malicious nature in appellant's letter that would justify an apportionment of costs incurred by the respondent in attending the oral proceedings. See also **T 256/16** and **T 876/16**.

In **T 1699/15** the appellant (patent proprietor) gave notice that it would not attend the oral proceedings only at a late stage: the day before them, at 2 p.m. The board decided not to apportion costs differently, in particular because there was no objective evidence to suggest deliberately ambiguous or abusive conduct. The parties had been summoned to the oral proceedings not only because of the auxiliary request of the respondent (opponent) but also in view of the need to discuss, among other matters, the question of a technical prejudice, as indicated in the board's preliminary opinion. In the absence of any further information from the board to say that the oral proceedings might be cancelled following the appellant's notice of absence, the respondent had had no guarantee that the decision would be in its favour and so had had to prepare to defend its case.

In **T 846/22** the appellant had only informed the board the day before the oral proceedings that it would not attend them. The respondent requested that its costs incurred for the preparation of the oral proceedings be charged to the appellant, since the costs for the preparation of at least part of the oral proceedings would not have been incurred, in view of the board's preliminary opinion, which was favourable to the respondent in respect of a

number of issues. The board noted that the oral proceedings would have had to take place anyway because of the respondent's auxiliary request for oral proceedings. Moreover, even when all parties attend oral proceedings, it is possible that not all the issues addressed in the preliminary opinion will be discussed. The respondent could not be sure that the preliminary opinion would be maintained in the oral proceedings. Deciding not to be prepared for an issue which could potentially be discussed at the oral proceedings, irrespective of the board's preliminary view on the issue, always involves some risk and it is the parties' responsibility to decide what to prepare for. In any case, it could not be asserted beforehand that the board's preliminary opinion would have rendered the oral proceedings unnecessary.

2.2.2 Request for scheduling or postponement of oral proceedings; withdrawal of request for oral proceedings

a) Request for scheduling or postponement of oral proceedings

On the basis of Art. 116(1) EPC 1973 any party has the exclusive right to request oral proceedings if it considers them to be necessary. The fact that one of the parties has to travel a longer distance than the other does not make the request for oral proceedings abusive. Furthermore, an objection of abuse based on the fact that the problems to be discussed in oral proceedings are simple ones and could easily be presented in writing cannot be sustained (**T 79/88**).

In **T 297/91** it had, for a number of reasons, not been possible to decide all the issues during the first oral proceedings, with the result that the respondents had requested that oral proceedings be held for the second time. One of the respondents further requested that the costs incurred be borne by the appellant (patent proprietor). The board rejected the request for apportionment of costs because the **further oral proceedings had become necessary** for reasons beyond the patent proprietor's control.

In **T 432/92 postponement** of the oral proceedings was requested two days prior to the agreed date as the father of the respondent's representative had died on the previous day. The appellant requested a different apportionment of costs because its representative had already travelled from America to the EPO, thereby incurring unnecessary costs. It argued that the respondent could have been represented by someone else from their patent attorney's firm. The board refused the request because there had been no recognisably wrongful or irresponsible conduct on the part of the other party. The board was of the opinion in particular that the respondent could not be expected to be represented by a different patent attorney, who would have had to prepare two oral proceedings in one day (one for an ongoing parallel case) and to travel as well.

In **T 42/99** appellant I announced, as early as **one month prior to oral proceedings**, that experts would attend those proceedings. Only shortly before the appointed date for the proceedings, appellant II submitted a request that statements by an expert be admitted at the oral proceedings. Appellant II also requested the postponement of the oral proceedings so that its expert would have enough time to prepare. The board decided to postpone the appointed date, however, in doing so, the board also regarded it as equitable

to order a different apportionment of costs. In its reasons the board took the view that, although a reply from appellant II to the announcement by appellant I that experts would attend the oral proceedings would not have been possible within the time limit set by the board, a "response" to the aforementioned announcement should have followed immediately and not shortly before the appointed date for oral proceedings. At this late stage, it was plausible that the representative of appellant I had made arrangements for the trip to Munich and a hotel reservation, which could not be cancelled without a financial loss.

In **T 99/05** the appellant submitted, **13 days before the oral proceedings**, a new experimental report in view of which the respondent asked for postponement of the oral proceedings. The appellant strongly objected to such a postponement. Since, in the board's view, the question of postponing the oral proceedings was linked to the question of whether the late-filed experimental report should be introduced into the proceedings, the board deemed it appropriate to maintain the oral proceedings in order to hear the arguments of the parties concerning the relevance of the late-filed experimental report of the appellant, and hence to decide on the introduction or not of this report into the proceedings. However, the oral proceedings did not result in a final decision with regard to patentability and second oral proceedings were scheduled in order for the respondent to be allowed sufficient time to file counter-experiments. Whilst the late filing did not represent an abuse of proceedings, it was evident that the final outcome of the proceedings had been delayed. Therefore, the board found it appropriate for reasons of equity to order a different apportionment of costs. **T 561/19** deals with a similar case.

In **T 1771/08** the board held that an apportionment of costs under Art. 104(1) EPC could be ruled out from the outset for lack of equity if the representative of the party requesting a different apportionment owing to postponement of the oral proceedings had **unreservedly agreed** to their postponement.

In **T 1292/21** the appellant's representative requested a postponement of the oral hearing due to the cancellation of his flight on the evening prior to the hearing because of a warning strike by ground staff at the destination airport. In response, the board proposed that the hearing be held by video conference. However, the appellant's representative did not agree to this proposal and the hearing was postponed to a later date. The board noted that its proposal to hold the hearing by videoconference was merely an offer. It was rejected and thus the format chosen by the board for this hearing, i.e. an oral hearing in person, was ultimately retained. The board was unable to identify any breach of his duty of care on the part of the appellant's representative and rejected the respondent's request for a different apportionment of costs.

b) Withdrawal of request for oral proceedings

Nothing in the EPC prevents a party from **withdrawing a request for oral proceedings** at any stage of the procedure. The withdrawal of such a request is not culpable conduct as such and cannot be a factor in assessing whether reasons of equity exist in accordance with Art. 104(1) EPC 1973 (**T 91/99**).

In **T 154/90** (OJ 1993, 505) the opponent had initially insisted on oral proceedings, although the opposition division did not consider that they were necessary. However, **eight days** before the arranged date the opponent informed the opposition division that they wished to cancel the oral proceedings. For reasons of internal organisation at the EPO, the opposition division did not receive this letter until after the date of the oral proceedings. The board of appeal ruled that eight days was a sufficient period of time for the oral proceedings to be cancelled, since no evaluation of new facts or arguments was needed (the case was different in **T 10/82**, OJ 1983, 407). Since the letter was received too late for purely internal reasons, the opponent was not at fault. It was not obliged to bear a part of the costs of the other party. A change of opinion regarding the necessity of oral proceedings could not be regarded as culpable conduct either (see also **T 383/05**).

In **T 721/96** of 15 September 1998 the respondent informed the board and the appellant, **four working days** before the date set for oral proceedings, that it was abandoning the patent and no longer requesting oral proceedings. However, the declaration abandoning the patent was not completely unambiguous. The board refused the appellant's request that costs be awarded against the respondent; it had been clear that the oral proceedings would probably be superfluous and the appellant could have contacted the Registry of the board to find out about the course the proceedings would be taking.

In **T 556/96** the appellant (patent proprietor) informed the EPO and the respondent **early in the afternoon preceding the oral proceedings** that it would not attend the oral proceedings. By that time, the respondent's representative had already departed for Munich. The board found that the appellant had communicated its intention not to attend the oral proceedings too late. The fact that the other party had also unconditionally requested oral proceedings was irrelevant; it too could have withdrawn the request, had it known in time that the appellant would not be attending. The board therefore ordered the appellant to pay the costs incurred by the respondent in preparing and attending the oral proceedings. See also **T 939/21**.

In **T 490/05**, **on the day before oral proceedings**, the appellant (patent proprietor) had withdrawn both its request for oral proceedings and its request to have the impugned decision set aside. Thus, even before oral proceedings it was clear that the impugned decision revoking the patent was sure to be made final. This gave the respondent the advantage of being able to focus its preparations for the oral proceedings on the proprietor's request for apportionment of costs. Thus, there were no reasons of equity for sharing the costs incurred by the opponent.

In **T 258/13** the appellant withdrew its request for oral proceedings **two days before the oral proceedings**, which de facto amounted to only one day in view of the lateness in the day (5 p.m.). This was not notification in good time. Citing **T 556/96**, the board held that the appellant's request had to be treated as having been received so late that the respondent would already have had to be fully prepared, taking further into account the necessary travelling time during the day before the oral proceedings. An apportionment of costs in favour of the respondent was appropriate. However, for the oral proceedings only the presence of an authorised representative was necessary. The attendance or not of an accompanying person had no bearing on the conduct of the oral proceedings and was a

matter of a deliberate choice by a party in which the other party did not need to be involved. Also to charge the appellant costs incurred by the accompanying person would contravene the principle of equity.

In **T 169/14** the board held that there was an equitable obligation on every party summoned to oral proceedings to inform the EPO and the other party as soon as possible, once it had decided that it would not be attending or was withdrawing its request for them. Consequently, in cases where a party unduly delays its decision not to attend the oral proceedings, or the withdrawal of its request for them, or its communication of this to the board, an apportionment of costs in favour of the other party could be justified if the costs were directly caused by the fact that the notice was not filed in due time. In the case at issue, the appellant withdrew its request for oral proceedings only one week before the scheduled date. However, the appellant at the same time submitted observations in reply to the board's preliminary opinion and requested that they be taken into consideration by the board in reaching its decision. Had the board found the appellant's new submissions admissible and convincing, oral proceedings would have had to take place in view of the respondent's conditional request for them. Additionally, there were no facts on file indicating that the appellant had unduly delayed his notice or conducted himself in a clearly improper or irresponsible manner.

2.2.3 Other cases concerning oral proceedings

An apportionment of costs is justified if excessive costs are incurred for the oral proceedings and caused mainly by one party (see **T 49/86**). The right to oral proceedings is absolute and therefore not subject to any conditions (**T 614/89**, **T 26/92**, **T 81/92** and **T 408/02**). If the party that requested oral proceedings fails to produce new arguments during them, that does not constitute abuse of procedure and is not a reason for awarding of costs, as consistently ruled in **T 303/86**, **T 305/86**, **T 383/87**, **T 125/89** and **T 918/92** (but not in **T 167/84**, OJ 1987, 369).

In **T 1022/93** the oral proceedings, which only the appellant had requested, were **superfluous**. Even in the written appeal procedure the appellant had refrained from communicating why, in its opinion, the amended process claims should be considered inventive and from specifying that the additional example described a process according to the amended set of claims. This made it impossible either to remit the case without oral proceedings or to deal with the substance of the case at the oral proceedings. For reasons of equity, therefore, the appellant was required pursuant to Art. 104(1) EPC 1973 to reimburse to the respondent the costs incurred as a result of the participation at the oral proceedings before the board.

In **T 905/91** the respondent had requested a different apportionment of costs on the grounds that **the appellant had not brought prepared auxiliary requests to the oral proceedings**, which had therefore continued into the afternoon. The board rejected the request for the following reasons. Firstly, the appellant had endeavoured to take account of the reservations expressed by the board and had filed new documents. Secondly, oral proceedings served specifically to clarify the situation completely through the direct exchange of arguments and, if necessary, to rephrase the patent application in the light of

the outcome of the discussion. The duration of oral proceedings depended on the particular case; at any rate it was not unusual for such proceedings to continue into the afternoon, and the parties should be prepared for this.

In **T 210/98** the respondent requested an apportionment of costs on the ground that the appellant **had withdrawn three auxiliary requests at the beginning of the oral proceedings** for which the preparation had been time-consuming. The board refused the request, stating that it was normal for parties to prepare themselves thoroughly for oral proceedings. A change of view was one of the situations with which a professional representative could be confronted during oral proceedings. As it was not exceptional for requests to be changed or withdrawn during oral proceedings as a result of the discussion held, no abuse of procedure could be seen in the withdrawal of requests at the beginning of the oral proceedings, which had apparently been a reaction to convincing written arguments.

In **T 461/88** (OJ 1993, 295) the board decided that the appellants' insistence on **hearing witnesses** was clearly compatible with the principle of the responsible exercise of rights, as this may well have been the only means of proving the alleged public nature of the prior use. The board refused the respondent's request for apportionment of costs.

In **T 668/03** the appellant requested an apportionment of costs in view of the fact that **oral proceedings had to be held for a second time**. As a matter of fact, the former oral proceedings had to be adjourned because the identity of one of the opponents had been drawn into doubt by the appellant during the first oral proceedings. The board pointed out that it was the duty of the respondent to make it clear throughout the procedure who belonged to the group of common opponents. However, had the appellant raised this issue before the first oral proceedings, it could have been dealt with in writing and thus the costs for further oral proceedings could have been avoided. Therefore, the board could not detect any reasons of equity which could be used to order a different apportionment of costs (likewise **T 1404/10**).

In **T 1807/15** of 2 December 2022 the board stressed that the postponement of oral proceedings due to a request for a referral of a question of law to the Enlarged Board which had not been announced in advance by the party making the request would normally not justify apportionment of costs. Since there was no guarantee that such a request would be successful, all parties would normally have to prepare for a discussion on the substance of the case irrespective of whether the request was announced in advance or not. The board further noted that it was a party's right to request a referral, and exercising this right was not a reason for a different apportionment of costs. The exercise of this right should in particular not be limited by the threat of apportionment of costs.

In **T 490/13** the board considered that the appellant (proprietor) had manifestly failed to act with due care during the opposition proceedings in that, even if the appellant considered the objections, which had been raised by the respondent and had been endorsed by the opposition division in its summons to oral proceedings, to be unfounded, it still **ought to have come up in time with a fall-back position** to counter them. Its failure to do so had led to its appeal, the need for oral proceedings before the board and the

remittal to the opposition division for an examination of claims that the opposition division could already have assessed the first time round. Responsibility for the remittal in this case lay with the appellant, so the board decided to apportion costs differently (Art. 104(1) EPC) and ordered the appellant to pay those which the respondent had incurred in relation to the oral proceedings at the appeal stage.

In **T 2313/15** the respondent (opponent) requested an award of costs in the event that the case was remitted to the department of first instance. The board decided to remit the case but not to order a different apportionment of costs pursuant to Art. 104(1) EPC. The board noted that the patent proprietor in the proceedings before the opposition division had dealt with all the objections raised by the opponent in the reply to the notice of opposition. That it did so only by argument, without submitting auxiliary requests and without requesting oral proceedings, was a legitimate defence against an opposition, though it ran the calculated risk of an immediate adverse decision. Thus, the **patent proprietor had no particular obligation to request oral proceedings before the opposition division**. Nor did the board consider it equitable to impute to the patent proprietor the fact that the opposition division had chosen to decide the case on the basis of only one of the various issues raised and without summoning to oral proceedings (and was within its rights to do so). Finally, the fact that upon appeal the appellant argued only against novelty over D2 as the sole ground for revocation was not in any way reprehensible as it was all the appellant was required to do.

In **T 2061/19** the board considered that parties were by no means procedurally obliged to respond, let alone within a time limit, to a communication pursuant to Art. 15(1) RPBA, even where the board's preliminary opinion was prejudicial to their interests. The **absence of a reaction to such a negative preliminary, non-binding opinion of the board** (Art. 17(2) RPBA) could not constitute per se malicious or irresponsible behaviour that automatically amounted to an abuse of procedure within the meaning of Art. 16(1)(e) RPBA.

2.3. Filing of opposition or appeal

An apportionment of costs is often requested on the grounds that the notice of opposition or appeal has been incorrectly filed. The fact that an appeal proves **clearly inadmissible** does not justify an award of costs if the appellant evidently has the subjective impression that it is adversely affected. A party who is of the opinion that the first-instance department has not acceded to its request may consider that it is adversely affected by the decision. In such a case it has the **legitimate right to make use of the appeal procedure** provided for in the EPC and to have the decision reviewed. Occasionally having to seek defence against unfounded or even inadmissible appeals is just one of the general risks of life and thus, in the absence of any further circumstances, does not justify a different apportionment of costs. The EPC makes no distinction between successful and unsuccessful appeals for the purposes of cost apportionment; so it cannot be argued that apportionment is justified if an appeal appears to be clearly inadmissible (**T 614/89**, **T 772/95**, **T 2177/12**, **T 964/14**).

In **T 170/83** the opponent had used an incorrect form for payment of the opposition fee, thereby giving rise to a decision by the Formalities Section to deem the opposition not to have been filed; the opponent thereupon filed an appeal against this decision. The patent proprietor (respondent) requested that the appeal costs be awarded against the appellant, since it was its error which had rendered the proceedings necessary. The board rejected the request, taking the view that the appeal proceedings were not improper. An abuse justifying the apportionment of costs could only be rooted in the party's conduct **during the proceedings**.

In a number of cases the boards took the admissibility or allowability of an opposition or an appeal to be an indication that no abuse had taken place (e.g. **T 7/88** and **T 525/88**). Similarly, in **T 506/89**, the board found that the opponent's filing of an appeal did not constitute an abuse of procedure and therefore rejected the request for a different apportionment of costs, since it had decided, in the oral proceedings, to maintain the patent as amended. Nor was there an abuse of procedure where the appeal was filed without new arguments (**T 605/92**) or where the appellant's chances of success were considered to be low (**T 318/91**). According to **T 717/95** no abuse has taken place if a party to the proceedings misinterpreted the content of a citation when comparing it with the subject-matter claimed in the disputed patent.

In **J 22/12** it was disputed whether an appeal against a communication issued on behalf of the examining division could be admissible. The board found that this was not the case. It considered that the filing of an opposition and of a subsequent appeal in the matter could not be considered as an abuse of procedure as they were actions which used the provisions of the EPC for the ends envisaged by those provisions. Thus the board found it appropriate that each party should bear its own costs.

In **T 846/22** the respondent had argued that its costs from the first and second instance proceedings should be charged to the appellant because they were incurred through an abuse of procedure by the appellant, namely acting throughout the opposition and appeal proceedings whilst being a dormant company. However, the board concluded that there had been no abuse of procedure and refused the request for apportionment of costs.

2.4. Withdrawal of opposition or appeal at short notice

An appellant is entitled to withdraw its appeal at any time. Based on the principle of free party disposition, this right may not be restricted, even implicitly by the threat of cost apportionment, on the grounds that oral proceedings have been scheduled and the opposing party cannot be notified in time. As a rule, the benefits that respondents derive from the withdrawal of the appeal will offset the costs that they incur, even if they are avoidable. That is the case even if the appeal is only formally pending on account of the request for cost apportionment (**T 490/05**). See also **T 2175/15** of 11 June 2024.

In **T 85/84** the appellant withdrew the appeal in a telex to the EPO and the respondent's representative **48 hours** before the date of the oral proceedings. By the time the respondent's representative found out, he had already departed in order to prepare for the oral proceedings in Munich. The board conceded that the appeal had been withdrawn at

extremely short notice but did not order apportionment of the costs, as the respondent's representative had still been informed in due time that the oral proceedings would not be taking place. Internal delays in forwarding the communication were not the fault of the appellant. The representative's departure for Munich the day before the oral proceedings was not warranted by the distance and therefore not necessary from the point of view of the oral proceedings.

In **T 614/89** and **T 772/95**, in which the appeals were withdrawn respectively **four and three days** before the date set for oral proceedings, the boards ruled that the short notice alone did not constitute an abuse of procedure.

The same conclusion was reached in **T 674/03**, where the opponent withdrew its appeal **nine days** before the date set for the oral proceedings. The board held that the exercise of an absolute procedural right did not, in principle, constitute abuse and that there was no evidence of improper or negligent conduct (see also **T 626/15**).

In **T 1663/13** the opponent waited until the **last working day** before the scheduled oral proceedings to withdraw both its request for oral proceedings and its appeal. The board cancelled the oral proceedings. The board agreed with the principles set out in **T 490/05**. However, it held that the case was not simply about withdrawing an appeal on the last working day before scheduled oral proceedings. Rather, the board noted the **special circumstances of the case**, inter alia, that the opponent did not follow the board's direction to declare whether it maintained its request for oral proceedings in view of the board's negative opinion on the admissibility of the appeal, but instead twice requested an extension of time limit without filing any substantive reply. The board decided to apportion costs and fix the amount both for preparing the oral proceedings and for travel. Also in **T 40/17** the appeal was withdrawn the day before the oral proceedings, which were then cancelled. The board held that in the absence of any additional circumstances, it could not be concluded that the appellant had neglected the level of care towards the respondent that could be reasonably expected of it. Thus, the respondent's request for apportionment of costs was refused.

2.5. Other cases

In **T 952/00** the board found that the wrongful act, whether intentional or simply the result of culpable negligence, had to be judged in the light of the normal behaviour of an ordinarily diligent party. It also had to be the direct cause of the costs in suit. In the case in point, it transpired that the proprietor had culpably made **inaccurate statements** in the course of the proceedings. The board concluded that without those false statements the opponent (appellant) would not have been required to go to the expense of gathering further evidence. Its request for an apportionment of the costs it had incurred during taking of evidence after notification of the decision at first instance was therefore granted.

In **T 1714/14** the respondent (patent proprietor) had **not filed a full copy** of P1 but only one page. According to the appellant (opponent), this behaviour confirmed the patentee's intention to withhold information relevant for the issues to be decided. The board held that, even if the impression resulting from the content of the sole page of P1 could be misleading

in the context of the proceedings, nothing pointed in the direction of the appellant's costs incurred by the opposition proceedings being attributable in any causal fashion to negligent or even abusive behaviour by the respondent. For this reason alone, no apportionment of these costs could take place. The case in hand also differed from **T 952/00**, where inaccurate statements had culpably been made, as well as from **T 273/10**, where documents had abusively been withheld.

In **T 269/02**, according to the respondent, the appellant had been given sufficient opportunity before the opposition division to amend its claims to overcome the problem under Art. 123(2) EPC 1973. However, the appellant had chosen not to do this, with the result that the patent was revoked on this ground, rendering necessary the appeal proceedings, which dealt solely with the issue of amendment. Contrary to the respondent's assertions, the board stated that in cases such as the present, where the patent had been revoked in opposition proceedings, the appellant must be given the opportunity to study the decision of the opposition division duly substantiated in writing in order to enable it to decide on the **formulation of appropriate requests** for the appeal proceedings. In these circumstances, the board did not find that the appellant had abused or exceeded its legitimate rights, in a way which arbitrarily caused the respondents to incur costs which, in all fairness, ought to be reimbursed. The request for an apportionment of costs was therefore refused.

In **T 162/04** the respondent requested a different apportionment of costs because it had had to invest a considerable amount of time and effort in considering the numerous requests submitted by the appellant during the appeal proceedings. However, the appellant's **requests were later withdrawn** rendering the time and effort of the respondent, in its view, useless. In the board's judgment, such conduct did not amount to an abuse of procedure. Indeed, the conduct of the appellant, who by withdrawing the contested requests and by **replacing them with other requests** was apparently trying to overcome the objections which had been raised, was not as such objectionable but had to be considered as a legitimate defence of its case. The request for an apportionment of costs was therefore refused (likewise **T 967/12**).

In **T 1087/20** and **T 1549/22** the board recalled that the withdrawal of an appeal, even shortly before the oral proceedings, did not per se constitute a reason to impose costs on another party in the absence of additional circumstances amounting to an abuse of procedure. In the board's view, the same principles also applied to an applicant's or patent proprietor's unfettered freedom to withdraw their consent to the text of a patent at any time during the appeal proceedings (see e.g. **T 1484/19** of 4 July 2023). The withdrawal of the consent some two weeks before the oral proceedings was clearly not a sufficient indication of such an abuse of procedure, particularly in light of the complexity of the case, regardless – at least in principle – of the motivation for the withdrawal.

In **T 916/05** the circumstances did not justify a different apportionment of costs. The fact that some of the arguments had not been presented before and could have been filed in oral proceedings before the opposition division, had such proceedings taken place, was in the board's opinion irrelevant and could not be regarded as an abuse of procedure. In fact,

an appellant could not be prevented from choosing a **different line of argument** when making its case before a board of appeal.

In **T 248/05** the board held that the alleged **lack of clarity** of the category of the claimed subject-matter and the possible associated additional costs which could be incurred by a clarification of this subject-matter would not justify apportioning the respondent's costs to the appellant. Firstly, the criticised elements of claim 1 and the alleged vagueness of the statement setting out the grounds of appeal were entirely irrelevant for the subject-matter of the appeal in point, i.e. the findings of the opposition division on added subject-matter. Secondly, lack of clarity of a claim or of a submission could hardly be regarded as an abuse of procedure unless this were intentional.

In **T 854/12** the board decided that a different apportionment of costs was justified where procedural stages had needlessly had to be repeated because a **lack of clarity as to the owner** of the company purportedly acting as a party had been deliberately exploited or at least knowingly allowed to persist during the proceedings.

In **T 967/18** the patent proprietor had only informed the EPO of its entry into voluntary administration three years earlier in the context of a request for registering a change of ownership. The Legal Division then ordered ex officio an interruption of the proceedings under R. 142(1)(b) EPC with effect as of 11 November 2016, to resume 4 November 2019. As a result of this interruption, the appealed decision of 5 February 2018 to revoke the patent was found to be "invalid". The board held that the patent proprietor's conduct in failing to notify the EPO of its entry into voluntary administration was the result of an error of assessment. This error was not due to such a gross lack of care that could be considered equivalent to wilful misconduct.

In **T 194/21** the respondent (patent proprietor) argued that the circumstances of the case demonstrated the appellant's intention to divert the proceedings from their purpose for tactical ends, namely to keep the opposition proceedings pending for as long as possible in order to delay the outcome of the infringement proceedings in France. The board considered that the facts put forward demonstrated a certain carelessness but were not sufficient to characterise an abuse of procedures. Furthermore, a request for apportionment could only succeed if there was a proven causal link between the allegedly improper conduct and the costs at issue. In the case in question, the respondent had not specified what additional costs would have resulted from the purported tactical extension of the opposition proceedings. As for the costs incurred in defending themself in the appeal proceedings, they were inherent in the appellant's exercise of their right to appeal. Finally, the appellant's absence from the oral proceedings had not rendered them superfluous.

In decision **T 2175/15** of 11 June 2024 on the apportionment of costs, the board did not consider it justified, for reasons of equity, to order the appellant (opponent) to pay the costs of the opposing appellants (patent proprietors) for filing a total of five partiality objections. It did not share the patent proprietors' view that the option afforded by the EPC to file a partiality objection should only be used in exceptional cases. Furthermore, the board could see no reason why the opponent's behaviour should be culpable or an abuse of procedure.

3. Expenses that may be apportioned

Under R. 88(1) EPC (R. 63(1) EPC 1973) the decision on apportionment of costs in opposition proceedings may consider only the expenses necessary to ensure proper protection of the rights involved (**T 167/84**, OJ 1987, 369; **T 117/86**, OJ 1989, 401; **T 416/87**, OJ 1990, 415; **T 323/89**, OJ 1992, 169). The order for apportionment of costs should be such as to compensate a party for the unnecessary costs it has incurred as the direct result of the other party's failure in its duty (**T 952/00**, **T 212/07**). On the costs of interpreting at oral proceedings, see chapter III.C.9.2.

According to Art. 16 RPBA (Art. 16 RPBA 2007), **the costs ordered to be paid in appeal proceedings** may be all or part of those incurred by the receiving party and may inter alia be expressed as a percentage or as a specific sum. In the latter event, the board's decision is a final decision for the purposes of Art. 104(3) EPC. The costs ordered may include costs charged to a party by its professional representative, costs incurred by a party itself whether or not acting through a professional representative, and the costs of witnesses or experts paid by a party but shall be limited to costs necessarily and reasonably incurred.

In **T 964/21** the board emphasised that an order for the apportionment of costs under Art. 104 EPC must clearly state (at least) the kind of costs to be borne by the burdened party. In the case in hand the order of the opposition division was so vague that it was not possible to clearly determine (a) whether the representatives' costs of preparing for the oral proceedings were included, and (b) whether the representatives' costs for both oral proceedings were included. A ruling without any limitations of the specific costs to be borne in relation to the oral proceedings and without providing sound reasons would not comply with the right to be heard in oral proceedings as enshrined in the EPC. The decision on the apportionment of costs was therefore to be set aside.

3.1. Necessary expenses

Under R. 88(1), third sentence, EPC, the costs include the remuneration of the parties' representatives. In **T 854/09** the board stated that the costs concerned were those reasonably incurred by the opponent. In this case, where an adjournment of oral proceedings was necessary, this included the expense of a single representative preparing for and attending the second proceedings, including travel and accommodation.

In **T 930/92** (OJ 1996, 191) the board held that, when fixing the amount of costs to be paid to a party, in addition to the remuneration of the professional representative of that party, the expenses incurred by an employee of that party in order to instruct the professional representative before and during oral proceedings could be taken into consideration under R. 63(1) EPC 1973, if such instruction was necessary to assure proper protection of the rights involved. In **T 326/87** (OJ 1992, 522), all the costs incurred as a result of the remittal to the department of first instance were deemed to be apportionable.

In **T 301/12** the board considered that, in the absence of exceptional circumstances, the attendance of accompanying persons in addition to a professional representative at the oral proceedings was as a rule a matter of choice, but not a necessity within the meaning

of R. 88(1) EPC (**T 258/13**; see also **T 930/92**, where the presence of one member of the respondent's company was considered justified under the circumstances). In the case in hand, no such exceptional circumstances had arisen that would have justified the apportionment also comprising the costs of two experts accompanying the respondent's representative. In particular, based on the submissions on file, no expert discussion would have been expected.

In **T 280/15** the appellant's notice of non-attendance at the oral proceedings had been received only the evening before them. In the board's view, the respondent had incurred costs that could have been avoided, such as travel and accommodation expenses and its professional representative's fee for 12 hours' preparation.

3.2. Future costs

The prevailing view in the boards' case law is that they should not take a decision on the apportionment of future costs because they have no basis for assessing them and lack jurisdiction (**T 1178/04**, OJ 2008, 80; **T 1801/17**). Thus the board in **T 758/99** held that a decision on the apportionment of **future** costs in appeal proceedings caused by the late filing of documents depended on the course of the subsequent procedure and, in the absence of the necessary facts, could not be decided at that stage (see also **T 133/06**). For these reasons the board deviated from the judgment given in **T 611/90**, in which the legitimately incurred future costs had been apportioned. The board remitted the case to the department of first instance and ordered that a decision on the request for apportionment of costs would be taken at a later stage (see also **T 223/95**, **T 758/99**, **T 48/00**, **T 890/00** and **T 1182/01** as examples of cases where the boards left it to the opposition division to decide on the apportionment of costs incurred in subsequent first-instance proceedings).

In **T 369/08** the board also stated that it was apparent that the costs arising would depend on the course of the future proceedings. According to the board, the consequence of this is that the board necessarily is not in possession of the necessary facts to decide upon an apportionment of costs. Consequently the board considered it appropriate not to make an open-ended order of apportionment of costs as had been done in the aforementioned **T 611/90**.

In **T 1282/08** the board noted that in some cases some boards of appeal ordered the apportionment of future costs (see **T 847/93**, **T 715/95**) and the scenarios facing these other boards might have been different in the above-cited cases. Nevertheless, the board had difficulty seeing how it could make a decision, at the remittal stage, on the apportionment of costs yet to be incurred in subsequent proceedings, the course and outcome of which were still open to speculation. Hence the possible apportionment of opposition costs was to be decided by the opposition division at the end of the opposition proceedings.

In **T 1777/15** the board held that it followed from the wording of the relevant provisions that a decision on an apportionment of costs could not be made in respect of future costs:

Art. 104(1) EPC ("costs [a party] **has** incurred", emphasis by the board); R. 88(2) EPC, which requires submitting a bill of costs; and Art. 16(1) RPBA 2007.

3.3. Procedure for fixing costs

Under R. 88(2) EPC, costs to be paid under a final decision apportioning them will be fixed only at the request of the entitled party. The request is not subject to a time limit. The request must be accompanied by a bill of costs and supporting evidence. Costs may be fixed once they have been established as credible. The board in **T 475/07** exceptionally took the view that a detailed cost calculation was superfluous. It worked on the assumption that the representative could calculate on the basis of one day for preparing the additional oral proceedings and one day for attending them. The cost estimate of EUR 2 300 thus seemed credible.

Under R. 88(3) EPC, a request for a decision by the opposition division may be filed within one month of the communication on the fixing of costs. It must be filed in writing and state the grounds on which it is based. It is not deemed to be filed until the fee prescribed in Art. 2(1) item 16 RFees has been paid.

In **T 668/99** the question was raised as to whether the prohibition of reformatio in peius also applied if the proceedings were not referred to a higher level of jurisdiction but were continued within the same level of jurisdiction, as was the case with a **legal remedy against the fixing of the costs** by the opposition division registry. The board recalled that an appeal and a request for an opposition division decision have far more similarities (suspensive and devolutive effect) than differences, and so the position of the sole requester is comparable to that of the sole appellant. The board was therefore satisfied that the prohibition of reformatio in peius also had to apply to a request under Art. 104(2), second sentence, EPC 1973.

Where the **boards of appeal** have to rule on the apportionment of costs, they have the power under Art. 104 and 111(1) EPC, and having due regard to Art. 113(1) EPC, not only to apportion but also to fix the costs (see e.g. **T 934/91**, OJ 1994, 184; **T 323/89**, OJ 1992, 169; **T 930/92**, OJ 1996, 191 applying the EPC 1973; for a more recent decision in which the board fixed the amount of the costs, see **T 1663/13**). The scope of the apportionment depends on the specific circumstances of the individual case. The party to the proceedings who caused the additional costs may be ordered to pay all or a part of those costs (**T 323/89**, OJ 1992, 169).

3.4. Appeal against decision fixing amount of costs

According to R. 97(2) EPC, the decision fixing the amount of costs of opposition proceedings cannot be appealed unless the amount exceeds that of the fee for appeal.

In **T 161/17** the appellant had contested only the opposition division's decision fixing costs and not its earlier interlocutory decision (on maintenance of the patent in amended form), which also provided a different apportionment of those costs. The board considered that this decision apportioning costs had become final. Since, in its appeal against the fixing of

costs, the appellant had in fact objected only to their apportionment, the appeal had to be dismissed. It did not follow from R. 97(1) EPC that a decision apportioning costs was necessarily open to challenge together with the decision fixing them. See e.g. **T 2024/20** for an appeal against the decision fixing the costs of opposition proceedings under R. 97(2) EPC.

4. Procedural aspects

4.1. Filing a request for apportionment of costs

The practice before the boards of appeal is that all requests by parties, including any requests as to costs, should be made before any decision is announced in oral proceedings, as the decision on apportionment is part of the final decision. See **T 1556/14** of 15 October 2020, where the board held that R. 88(1) EPC implied that the request for apportionment was submitted before the decision of the opposition division was taken. Where a request for apportionment cannot be submitted before termination of the proceedings, for example when the only appeal is withdrawn and the timing of that withdrawal or other related circumstances are the alleged grounds for requesting apportionment of costs, the request must be accepted as being admissible despite being submitted after termination of the proceedings (**T 1556/14** of 15 October 2020). However, in the case in hand the board was not convinced that the appellant had been unable to file a request for apportionment of costs prior to the termination of the proceedings.

A different approach was taken in **T 1484/19** of 4 July 2023 where the board left open whether and, if so, to what extent legal certainty imposed limitations as to the admissibility of a request for apportionment of costs filed after termination of the appeal proceedings. The board stated that by analogy to the withdrawal of an appeal, it could be argued that the decision **T 1484/19** of 29 November 2022 brought the appeal proceedings to a close for the substantive merits of the appeal (which were no longer open for consideration in view of the respondent's withdrawal of its approval of any text for maintenance of the patent) while leaving ancillary questions open to a decision. Consequently, the board would have the power to decide on the request for apportionment of costs filed after the completion of the internal decision-making process.

There is no basis for deciding on a different apportionment of costs if the party which would benefit from the decision did not request apportionment and even made it known that it would not enforce any such decision (**T 408/91**, **T 125/93**).

In **T 896/92** the request for a different apportionment of costs was rejected for lack of substantiation and because of the absence of obvious reasons. In **T 193/87** (OJ 1993, 207) the board likewise refused to apportion costs because the respondent had provided no evidence and it was unable to see any reasons of equity that might have justified such an apportionment. In several decisions, the boards of appeal have stressed the importance of submitting evidence to support a request for a different apportionment of costs (e.g. **T 49/86**, **T 193/87**, **T 212/88**, OJ 1992, 28; **T 404/89**, **T 523/89**, **T 705/90**, **T 776/90**, **T 306/93**).

In **T 967/18** the board pointed out that the request for apportionment filed under Art. 16(1) RPBA constituted an amendment of the appeal case and was subject to Art. 13(2) RPBA.

4.2. Competence issues

In **T 765/89** it was stressed that the board was still responsible for deciding on the request that costs be awarded against the appellant even if the latter had withdrawn its appeal. See also **T 85/84**. Where an opponent (respondent) withdraws its opposition during appeal proceedings, it ceases to be a party to the appeal proceedings as far as the substantive issues are concerned but retains its party status in so far as the question of apportionment of costs is still at issue (**T 789/89**, OJ 1994, 482).

According to the board in **T 1059/98**, apportionment of the costs of proceedings before the opposition division could not be requested for the first time on appeal, because the boards of appeal could only review decisions taken by a department of first instance and so had no competence to decide on such requests (see also **T 1273/11**). As a matter of principle costs are not apportioned in transfer proceedings (**J 38/92**).

4.3. Appeal solely against the decision on apportionment of costs inadmissible

Rule 97(1) EPC (Art. 106(4) EPC 1973) states that the apportionment of costs of opposition proceedings cannot be the sole subject of an appeal. As a rule, therefore, an appeal relating to apportionment of costs must be regarded as inadmissible if the appeal relating to the revocation of a patent is rejected as inadmissible for lack of merit and there is no other admissible request. However, if the impugned decision did not take into account the withdrawal of the request for oral proceedings and is thus based on a substantial procedural violation, the part of the impugned decision relating to apportionment of costs must be set aside (see e.g. **T 154/90**, OJ 1993, 505).

In **T 753/92** respondent I was adversely affected by the decision under appeal only in so far as their request for apportionment of costs was rejected. If respondent I had lodged an appeal against this decision, the appeal, with the apportionment of costs as its sole subject, would have been inadmissible under Art. 106(4) EPC 1973. The fact that respondent I submitted the request for apportionment of costs merely as a party to the appeal proceedings as of right (Art. 107 EPC) could not render such a request admissible without contravening the principle of equal treatment. See also **T 514/01**.

In **T 1237/05** the board found that the opponent, not being adversely affected by the patent's revocation, was not entitled to appeal solely against the apportionment of costs. The opponent's appeal, in view of Art. 106(4) EPC 1973, was inadmissible on that count alone. The mere fact that an appeal, in this case the proprietor's, was admissible did not in itself make the opponent's appeal admissible (the opponent in any case not being adversely affected by the first-instance decision on the merits) because it related only to apportionment of costs. A distinction had to be drawn between appeal proceedings (initiated by at least one admissible appeal) and an appeal lodged by a party; the wording of Art. 106(4) EPC 1973 clearly referred to an appeal lodged by one of the parties to the proceedings, regardless of the existence of other appeals lodged by the other parties.

In **T 2197/16** the respondent (patent proprietor) was adversely affected by the decision under appeal only in so far as it had apportioned costs to it. The board stated that the general considerations of decisions **T 753/92** and **T 762/96** were applicable mutatis mutandis, since, if the respondent had lodged an appeal against the opposition division's decision on apportionment of costs, the appeal, with the apportionment of costs as its sole subject, would have been inadmissible under Art. 106(3) and R. 97(1) EPC. The respondent was only a party to the proceedings under Art. 107, second sentence, EPC and did not have the right to file a "cross-appeal" without limit of time and, unlike the rights the respondent would have as appellant, its requests were therefore subject to restrictions. Moreover, the board stressed that the notice of appeal clearly showed that the appellant (opponent) had not appealed the opposition division's decision on the apportionment of costs. Nor did the statement of grounds of appeal refer to the issue of the apportionment of costs. Therefore, the opposition division's decision in this respect was not the subject of the appeal.

In **T 668/99** the board took the view that, since no appeal had been lodged against the opposition division's decision on costs, that decision had become final upon expiry of the time limit for filing a notice of appeal (see also **T 161/17**). It found that the decision on costs mentioned in the request had not been submitted with the appeal, nor was there any indication of an implicit challenge to that decision. The board held that, unlike general procedural requirements, which – as had been consistently held – had to be reviewed at all times, including in the appeal procedure, the issuance of a decision on costs by the EPO did not necessarily mean that a decision had also to be reviewed by the EPO. The review of a decision at a higher level of jurisdiction required an appeal by one of the parties.

In **T 420/03** the question arose whether the "additional decision" concerning the apportionment of costs fell within the scope of appeal. While the notice of appeal remained completely silent as regards the decision on the apportionment of costs, the request for cancellation of this decision was contained in the statement setting out the grounds of appeal. In the case before it, the board found that the notice of appeal did not contain any explicit statement concerning the apportionment of costs, and there was no other statement in the notice of appeal which could be interpreted – at least indirectly – that this was also the subject of the appeal.

S. Notifications

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Notifications are governed in detail by Art. 119 EPC and R. 125 to 130 EPC. Notification may be made by postal services (R. 126 EPC), means of electronic communication (R. 127 EPC), delivery by hand (R. 128 EPC) or by public notification (R. 129 EPC).

For the calculation, determination and extension of time limits, see chapter III.D.1.

1. Documents subject to formal notification

R. 125(1) EPC was amended on 1 April 2015 to clarify the scope of documents subject to notification. The amended provision provides an explicit legal basis for the EPO's practice of not formally notifying notices and communications from which no time limits are reckoned (CA/D 6/14, OJ 2015, A17).

Hence, as a matter of course, the EPO notifies those concerned of decisions and summonses, and of any notice or other communication from which a time limit is reckoned, or of which those concerned must be notified under the EPC, or of which notification has been ordered by the President of the EPO (R. 125 EPC and notice of the EPO dated 30 March 2015, OJ 2015, A36). Other communications are not subject to formal notification.

2. Forms of notification

2.1. Notification by postal services

R. 126 EPC lays down the provisions relating to notification by postal services. All notifications by postal services are by registered letter.

In R. 126 EPC, and also in R. 125(2) and 133(1) EPC, references to "post" were replaced by "postal services" and "postal service providers" in 2015 (CA/D 6/14, OJ 2015, A17). This gave the EPO the freedom to choose any postal service provider it regarded as suited to serving notification.

In view of the low return rate of advices of delivery and the notable administrative burden associated with their processing, R. 126(1) EPC was amended to discontinue the use of advices of delivery (CA/D 2/19, OJ 2019, A31). Decisions incurring a period for appeal or a petition for review, summons and any notice or other communication triggering a time limit must instead be notified by registered letter only, if not notified electronically (OJ 2019, A57). Notices and communications from which no time limit is reckoned, or which do not require notification under the EPC or by order of the EPO President, may continue to be sent by ordinary mail. Amended R. 126(1) EPC came into force on 1 November 2019.

Following the decision to discontinue the use of advices of delivery (OJ 2019, A31), until 1 February 2024, the EPO continued to enclose an acknowledgement of receipt form (EPO Form 2936) with both notifications by registered letter of decisions incurring a period for appeal, as well as summonses. Addressees were requested to date and sign the form and return it immediately (see **T 1529/20**, summarised below in III.S.5.1., in which the board established that the case in hand did not contain a confirmation of receipt of the decision of the opposition division from the appellant). Notifications by the boards which concerned decisions, summonses, communications drawing attention to formal deficiencies or noting a loss of rights, and such other documents as determined by a board in a particular case, were also effected by registered letter and included the relevant acknowledgment of receipt form (EPO Form 3936). The same applied to notifications by the Enlarged Board. The practice of requesting and sending postal acknowledgments of receipt was abolished with effect from 1 February 2024 (OJ 2023, A108).

With effect from 1 November 2023, R. 126(2) EPC was amended to abandon the ten-day legal fiction for notification and to introduce the notification legal fiction based on the date of the document (CA/D 10/22, OJ 2022, A101). In the case of a postal notification, under EPO practice, the date of the document is the date on which it is handed over to a postal service provider. To facilitate this, the EPO post-dates its documents to allow them to be processed internally and issued on the date they bear. See notice from the EPO of 25 November 2022 concerning legal changes to support digital transformation in the patent grant procedure (OJ 2022, A114) and notice from the EPO of 6 March 2023 concerning amended R. 126, 127 and 131 EPC (OJ 2023, A29). On the practice of post-dating written decisions see **G 12/91**.

In **T 1693/13**, the EPO had notified the contested decision using courier service UPS before R. 126 EPC as amended in April 2015 had entered into force. The board held that the appellant had been entitled in the circumstances to assume that the UPS courier service was treated as "post" within the meaning of R. 126 EPC as then still in force and that it made no difference to how the appeal period was determined under that provision whether a decision had been sent by post or by UPS. In contrast, in **G 1/14** (OJ 2016, A95) the Enlarged Board took the view that old R. 126(1) EPC related solely to notification by post using a "registered letter with advice of delivery" and not to any other kind (by UPS in the case in hand).

On the question of the burden of proof and safeguards in connection with notification irregularities, see in this chapter III.S.5.

In **T 1596/14** the board noted in obiter dictum that there was no evidence or indication that the alleged unequal treatment of the parties induced by different dates of notification of the same decision had been detrimental to any party's interests. There did not appear to be any consequences for the admissibility of the appeals or for the due course of the ensuing appeal proceedings. The board noted that there was no specific sanction or remedy foreseen in the EPC for this situation and it seemed to the board that it was difficult to assume that appellant I's suggestion to re-send the decision with a new common notification date would be a remedy, since the parties in the case in hand were already aware of each other's arguments.

2.2. Notification by means of electronic communication

Under R. 127 EPC, notification may also be effected by means of electronic communication as determined and under the conditions laid down by the President of the EPO. However, for this to happen, users must have agreed to receive communications by such means (see notice of the EPO dated 30 March 2015, OJ 2015, A36).

With effect from 1 November 2023, R. 127(2) EPC was amended to abandon the ten-day legal fiction for notification and to introduce the notification legal fiction based on the date of the document (CA/D 10/22, OJ 2022, A101). In the case of a notification by means of electronic communication, under EPO practice, the date of a document is the date of its electronic transmission. See notice from the EPO of 25 November 2022 concerning legal changes to support digital transformation in the patent grant procedure (OJ 2022, A114) and notice from the EPO of 6 March 2023 concerning amended R. 126, 127 and 131 EPC (OJ 2023, A29).

Electronic notification is effected by electronic communication to an activated Mailbox. A document reaches its destination within the meaning of R. 127(2) EPC on the date the document has been made available in the corresponding Mailbox. For further details, see the decision of the President of the EPO dated 9 February 2024 concerning the web-based online service MyEPO Portfolio and electronic notification to the Mailbox in proceedings under the EPC and the PCT (OJ 2024, A20) and the notice from the EPO dated 9 February 2024 concerning new features of the MyEPO Portfolio (OJ 2024, A21). As from 1 July 2024, the Mailbox may only be accessed via MyEPO Portfolio (see the decision of the President of the EPO dated 22 April 2024 concerning the decommissioning of certain online services (OJ 2024, A43) and the notice from the EPO dated 22 April 2024 concerning the decommissioning of certain online services (OJ 2024, A44)).

From 1 June 2021, the Boards of Appeal began to notify documents in appeal proceedings electronically via the Mailbox (notice of the President of the Boards of Appeal dated 13 April 2021 concerning the extension of electronic notification via the EPO Mailbox to appeal proceedings; OJ 2021, A37).

On 1 September 2020 the EPO launched a pilot project permitting examining divisions to use email to notify important information about oral proceedings (see decision of the Vice-President Legal and International Affairs (Directorate-General 5) of the EPO dated 23 July 2020, OJ 2020, A89). The pilot project came to an end on 31 August 2021

(OJ 2021, A67). In **T 762/20** the board explained that D5 had only been introduced into the first-instance proceedings by email. However, the electronic file, which was the sole official file relating to the application (R. 147(1) EPC) and the record of the first-instance proceedings available for file inspection and used by the board in its judicial review, did not contain this email. The board thus agreed that the appellant had not been officially informed of an inventive-step objection based on D5 prior to the notification of the contested decision.

Facsimile ("fax") transmission of notifications is generally not admissible (**J 27/97**) and therefore does not constitute valid notification even if receipt is proven. The situation was different in **T 580/06** where notification of a shortfall under point 6.4 ADA was sent only by fax. However, this form of notification was in keeping with point 6.4 ADA in conjunction with R. 77(2)(d) EPC 1973. The President of the EPO had not laid down conditions for notifications by fax within the meaning of that rule; in particular, postal confirmation of the fax had not been made compulsory. Thus the notification had been made in an appropriate form. In the board's view, the "OK" on the fax transmission report was to be regarded as evidence of complete and error-free transmission, on which the fax became the recipient's responsibility.

2.3. Notification by delivery by hand and public notification

Under R. 128 EPC notification may be effected on the premises of the EPO by delivery by hand of the document to the addressee, who must on delivery acknowledge its receipt. Notification is deemed to have been effected even if the addressee refuses to accept the document or to acknowledge receipt thereof.

If the address of the addressee cannot be established, or if notification in accordance with R. 126(1) EPC has proved to be impossible even after a second attempt, notification shall be effected by public notice (R. 129(1) EPC). In this case, the document is deemed to have been notified one month after publication of notification in the European Patent Bulletin. See the decision of the President of the EPO dated 14 July 2007 concerning public notification under R. 129 EPC (OJ 2007, Special edition No. 3, 127).

3. Notification to representatives

Notifications must be addressed to the appointed representative (R. 130(1) EPC, previously R. 81(1) EPC 1973). If several representatives have been appointed for a single party, it is sufficient to notify any one of them (R. 130(2) EPC). If several parties have a common representative, it is sufficient to notify the common representative (R. 130(3) EPC).

In **T 812/04** the board pointed out that R. 101(6) EPC 1973 (R. 152(8) EPC), in conjunction with R. 81(1) EPC 1973, clearly indicated that, until the termination of an authorisation had been communicated to the EPO, the latter was obliged to notify communications, decisions or other documents to the duly appointed representative and that these notifications alone would have valid effects. The fact that the appellant had filed the notice of appeal himself imposed no obligation on the Registry of the Boards of Appeal

to inquire about the legal status of relations between the applicant (client) and the duly appointed representative or to send the documents and communications subsequently directly to the client direct.

With regard to the question to whom notifications under R. 130(1) EPC must be addressed, the legal situation at the date of issue of the communication is relevant (**T 7/17**). A notification had to be made on the basis of the facts on file at the time of posting (**J 22/94**). In **J 19/92** the Legal Board held that notifications to an applicant's representative were duly made if they were despatched before the representative relinquished his brief. The notification to the applicant did not therefore have to be repeated after the brief had been relinquished. On the contrary, it was the representative who was obliged to inform his client of the notification. In **T 247/98** the board confirmed that what determined whether a R. 81(1) EPC 1973 (R. 130(1) EPC) notification was to be sent to the representative was the legal situation at the time when the document was despatched.

In **T 128/18** it was discussed whether the further representative was merely sub-authorised to act before the EPO only at certain stages of the proceedings. The board was unable to find literal and/or unequivocal support for this understanding in any of the documents on file. As two representatives had been appointed, notification to the further representative was sufficient (R. 130(2) EPC). If there had remained any doubt as to the correct recipient of notifications at that stage, the appropriate course of action would have been for either the original or the further representative to clarify the matter with the EPO. In the absence of any action or indication to this effect, the board concluded that notifications were correctly addressed to the further representative.

The facts underlying **T 1281/01** were different to those in **T 128/18**. In **T 1281/01** a formal change of representative had been duly and clearly communicated to the EPO, and the last appointed representative had actively pursued the case, so that he was able to react immediately and notify the EPO of the error.

However, in **T 703/92** the written decision and minutes of the oral proceedings were sent not to the authorised representative but to the opponents. The board found that, as the provision relating to notification had not been observed, the question whether a notification had effectively taken place depended, in accordance with R. 82 EPC 1973 (R. 125(4) EPC), on whether and when the representative had received the full decision.

For details on representation, see chapter III.V.

4. Notification to third parties

In **T 261/07** the decision to revoke the patent was delivered to a person who was not an employee of the patentee (to whom the notification was addressed), but of a company that received letters on behalf of the patentee. No acknowledgement of receipt was on file for the patentee, who claimed never to have received the decision. Following **T 172/04** and **T 743/05**, the board held that for reasons of legal certainty, delivery to the addressee is effected once a person authorised by the addressee has received the letter (similarly **T 261/07** and **T 2210/10**). In **T 1535/10** too, the board held that, where the recipient did

not operate his own mail office and instead made use of an external mail office, he had to accept that the external office would be treated as if it were his own in matters relating to the delivery of communications subject to deadlines. Any delay in forwarding such communications on the part of the external office would thus be attributed to the recipient's sphere of risk.

In **J 35/97** a communication was handed to a third party not authorised by the appellant to accept it. The said party was in the addressee's business premises, but not an employee. In the Legal Board's view, that meant that notification according to the relevant German provisions had not occurred. Nor did the party qualify under any of the categories of "substitute addressee". There was also no evidence that the appellant had ever seen the communication. The board therefore found the EPO had not shown notification to have been properly effected.

In **J 28/10** the representative's office was located in a large building in a business-park and incoming mail for the law firm was left at the doorman's desk. The doorman was the employee of a security company, this company having a contractual relation with the company that administrated the business-park where the representative rented office space. This led the Legal Board to the conclusion that the representative was fully aware of the details and functioning of this system of reception of postal mail, including any risk associated with it. By using an external service for receiving postal mail, the representative accepted that this external service would be treated as if it were its own in matters relating to the delivery of communications subject to deadlines.

5. Burden of proof and safeguards

5.1. Burden of proof where notification is disputed

In the event of any dispute concerning the delivery of a document, it is incumbent on the EPO to establish that the document has reached its destination and to establish the date on which it was delivered to the addressee (R. 126(2) EPC for documents notified by postal services and R. 127(2) EPC for documents notified by means of electronic communication).

In **T 2054/15**, citing **J 3/14** and **J 14/14**, the board explained that the party seeking application of R. 126(2) EPC had to set out the facts justifying it. The burden of proof on the EPO could not be taken to mean that the party was under no obligation to help clarify the circumstances within its own sphere of responsibility (e.g. **T 247/98**, see chapter III.G.5.1. on apportioning the burden of proof). The EPO was liable for risks arising both in its own sphere and during "transport", but the recipient was liable for those within its own sphere of organisation and influence (e.g. **T 1535/10**). When a registered letter had been delivered to the address of the representative, it was incumbent on him to establish that the letter was not received by a person authorised to take delivery of it, or that it did not actually reach him for some other reason.

In **T 1535/10** the board held that responsibility for obstacles to and delays in the receipt of decisions to be notified under R. 126(1) EPC had to be assigned according to spheres of

risk. The EPO was liable for both the risks arising in its own sphere and "transport risks". However, it distinguished such risks from those within the recipient's sphere of organisation and influence, e.g. the risk that employees or other authorised recipients failed to forward a letter delivered to the business address, or delayed in doing so. For a presumption that a letter had entered the recipient's sphere of organisation and influence, it sufficed that it had been delivered to his address and that he was in a position to take note of it, irrespective of whether he had actually taken (final) possession of it and noted its content (see also **T 580/06**).

In **J 14/14**, in keeping with the bulk of the boards' case law, the Legal Board held that it was clear from the wording of R. 126(2) EPC that, in the event of any dispute as to whether a notification had been received by the addressee, the onus was on the EPO to establish the fact and date of delivery (see also **J 3/14**). In the case in hand, the only proof of delivery that the EPO had in respect of the communication in question was a letter from Deutsche Post, referring to a registered letter sent to the appellant's representative and stating that it had been delivered to a person authorised to receive it. This was deemed insufficient to fulfil the requirements of R. 126(2) EPC since there was no proof that the appellant's representative or any other named individual had signed a document acknowledging receipt of the letter and no communication from the foreign postal service was disclosed (see also **J 9/05** and **J 18/05**, where a similar confirmation letter by Deutsche Post was held not to be sufficient to prove the receipt of an EPO notification since the appellant had filed a considerable amount of counter-evidence and pointed out specific reasons why the letter might not have been received by the representative's office). See also **T 691/16**.

In **T 1529/20** the board agreed with the appellant that a party submitting that something had not happened, i.e. that a communication had not been received, would have difficulty in trying to prove a negative (negativa non sunt probanda, see also **T 2037/18**, **R 15/11**, **R 4/17**). The filing of cogent evidence showing that a letter had not been received was hardly ever possible (see also **J 9/05**). Therefore, the respondent's arguments that the appellant allegedly had the duty to register mail incoming at their premises but had failed to provide an excerpt of such register was not pertinent, since there was no trace in the file that the EPO had discharged its burden of proving delivery. Under such circumstances, the appellant did not have to bear the risks normally falling in their sphere of responsibility (**T 1535/10**), so that they had to be given the benefit of the doubt (**J 9/05**).

In **T 258/19**, a letter was returned to the EPO by the post office as "Non reclamé". However, an acknowledgement of receipt that had apparently been signed by the representative of the appellants was also present on file. The board held that, in view of the return of the letter by the post office, the allegation by the appellants that signing and returning the acknowledgement of receipt had been a misunderstanding did not seem improbable. Moreover, the burden of proof for establishing whether the document was received was on the EPO. This implied that in case of doubt, like in the present case, the appellant must be given the benefit of the doubt.

In **T 529/09**, however, the board held, distinguishing the case in hand from **J 9/05** and **J 18/05**, that unlike in these cases, the appellant had not submitted any further arguments or evidence in order to demonstrate that the Deutsche Post's confirmation had failed to

establish that the registered letter had reached its destination. The evidence on file therefore had to be regarded as sufficiently reliable and complete for proving the proper delivery of the letter (see also **T 1304/07**, **T 1934/16**).

In **T 247/98** the board stated that when establishing the meaning of the term "im Zweifel" in the German version of R. 126(2) EPC, account should be taken of the French and English versions, which assume that there is a dispute ('en cas de contestation', 'in the event of any dispute'). A dispute ('Zweifel', literally 'doubt' in the German version) within the meaning of this rule could only arise if it was maintained that a letter had in fact been received more than ten days following its posting. The mere absence of the advice of delivery or the receipt from the file was not in itself sufficient to give rise to a dispute ('Zweifel') within the meaning of this rule.

In **T 2210/10** the board explained that R. 126(2) EPC could not mean that it was the duty of the EPO to start enquiries as soon as a party, against the evidence on file, considered that the mail had not been properly notified. The EPO could not be expected to undertake exhaustive investigations to establish on their own the date of notification in the absence of serious doubts.

As regards differences in the signature on the advice of delivery recording that notification is effected, the board in **T 691/16** pointed out that notification did not necessarily have to be effected by means of delivery to the actual recipient, but could also be effected by means of delivery to people living in the building or with the necessary authorisation. That was generally what happened at companies. There was therefore no reasonable doubt that the intervener had received the notice of action as claimed.

If the EPO is unable to prove that a document has been delivered, the document in question will be reissued with a new date, resulting in the application of the notification legal fiction based on that later date (see notice from the EPO of 6 March 2023 concerning amended R. 126, 127 and 131 EPC (OJ 2023, A29).

5.2. Notification under Rule 125(4) EPC

Where a document has reached the addressee, but the EPO is unable to prove that it has been duly notified, or if provisions relating to its notification have not been observed, the document is deemed to have been notified on the date established by the EPO as the date of receipt (R. 125(4) EPC). In cases where the EPO is not able to prove the actual date of notification, a letter, for instance, sent by the addressees themselves and indicating the date of receipt, is accepted as proof. If it is evident from a reply from the addressees that they have received the document, although they do not mention the date of its notification, the date on which that reply was written is to be regarded as the date of notification (Guidelines E-II, 2.6 – April 2025 version, regarding R. 125(4) EPC). See also **T 1535/10**, **T 1553/13** and **J 4/13**.

5.3. Safeguards in case of late delivery

Where a document has been delivered exceptionally late, a new safeguard introduced in the last sentence of revised R. 126(2) EPC and R. 127(2) EPC will apply. In particular, if the EPO cannot show that a document has reached the addressee within seven days of the date it bears, the relevant period will be extended by the number of days by which these seven days are exceeded. See notice from the EPO of 25 November 2022 concerning legal changes to support digital transformation in the patent grant procedure (OJ 2022, A114) and notice from the EPO of 6 March 2023 concerning amended R. 126, 127 and 131 EPC (OJ 2023, A29).

T. Applications by non-entitled persons

Article 61 EPC deals with the remedies available where a person other than the patent applicant is held by a national court to be the person entitled to the grant of a European patent. For further details, see R. 16 and 17 EPC. See also R. 14(1) EPC in chapter III.M.3 for stay of proceedings before the EPO in case of entitlement suit.

In **G 3/92** (OJ 1994, 607), the Enlarged Board was called upon to consider the application of Art. 61(1)(b) EPC 1973 (Art. 61 EPC left unchanged in substance by the EPC 2000 revision) in the following circumstances: the appellant had lodged a European patent application in 1988. The search report revealed the existence of a prior application filed in 1985 for substantially the same invention by a third party, to whom the appellant had revealed the invention in confidence in 1982. This prior application had been published, and in 1986 deemed to be withdrawn for non-payment of the examination fee. Thereupon the appellant claimed from the UK Patent Office Comptroller, and was granted, entitlement to a patent for the invention disclosed in the prior European application under Section 12(1) UK Patents Act 1977. The appellant was thus allowed under Section 12(6) UK Patents Act 1977 to file a new application in the UK to be treated as having the same filing dates as the prior European application. The appellant then filed a new European patent application in respect of the invention disclosed in the prior application under Art. 61(1)(b) EPC 1973 in 1990.

The referring Legal Board took the view in its interlocutory decision **J 1/91** (OJ 1993, 281) that the Comptroller's decision was a final decision within the meaning of Art. 61 EPC 1973. However, whilst entitlement to a patent was a matter for national courts to decide, those courts had no power directly to provide a remedy under the EPC, that being a matter to be dealt with by the EPO under Art. 61 EPC 1973.

The Enlarged Board held that when it has been adjudged by a **final decision** of a national court that a person other than the applicant is entitled to the grant of a European patent, and that person, in compliance with the specific requirements of Art. 61(1) EPC 1973, files a new European patent application in respect of the same invention under Art. 61(1)(b) EPC 1973, it is not a pre-condition for the application to be accepted that the earlier original usurping application is still pending before the EPO at the time the new application is filed.

The Legal Board therefore ruled in **J 1/91** of 25 August 1994 that the conditions of Art. 61(1)(b) EPC 1973 had been met and accordingly remitted the patent application to the Receiving Section for further prosecution.

In **J 1/23** the Legal Board disagreed with the appellant's assertion that the national court's decision did not qualify as a decision adjudging that the third party was entitled to half of the European patent application within the meaning of Art. 61 EPC. Although it was undisputed that the national court decision was a **final decision**, the appellant contended that the national court could not decide on entitlement to the application because a passage referring to the "patent applications" had been removed from the third party's request in the national (appeal) proceedings. According to the Legal Board, the key

question was whether, in the particular case, the EPO interpreted the decision as a final entitlement decision within the meaning of Art. 61 EPC. In the case in hand, even in the absence of an explicit reference to "all patent applications and patents that may be issued thereof", the entitlement to the invention as specified in the application inherently implied entitlement to the grant of a European patent based on the application (see also in chapter IV.A.4).

U. Rules relating to Fees

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1. General

The RFees determine the amounts of the fees levied by the EPO and the ways in which they are to be paid (Art. 51(4) EPC). They also contain provisions regulating the due date for fees, the particulars to be indicated concerning payments, the date of payment, insufficient payments and certain refunds and reductions.

According to **J 7/07**, no provision of the EPC states explicitly that the EPC takes precedence over the RFees in cases of conflict between them. However, the EPC is clearly the higher legal norm and, in case of conflict, by analogy with Art. 164(2) EPC 1973, the provisions of the EPC should take precedence. Also on general legal principles, the Implementing Regulations should take precedence over the RFees. See also summary of **J 7/07** in chapter III.D.1.2.2.

The EPC 2000 required a revised version of the RFees, which also entered into force on 13 December 2007 (see Administrative Council decision of 7 December 2006, OJ 2007, 10; also Administrative Council decision of 25 October 2007, OJ 2007, 533). For subsequent amendments see the regularly updated HTML version of the RFees, and its "Version history" function, on the EPO website. The relevant chapter of the Guidelines (April 2025 version) is Part A-X. Up-to-date fee information is available in the OJ under the rubric "Guidance for the payment of fees, expenses and prices" and at *epo.org/applying/fees/fees*.

Besides the cases set out below, decisions concerning individual procedural fees are to be found in the relevant chapters of this book.

2. Payment of fees

2.1. Methods of payment

Fees due to the EPO may be paid by the methods foreseen in Art. 5 RFees (see also **R 2/09**). Article 5(1) RFees provides for payment or transfer to a bank account held by the EPO. Under Art. 5(2) RFees further fee payment methods may be allowed by the President of the EPO. These are payment by debit order from a deposit account held with the EPO (see next section) and payment by credit card (since 1 December 2017 – see decision of the President, OJ 2017, A72, and notice, OJ 2022, A18). On the establishment of the online Central Fee Payment system (CFP), see OJ 2020, A130, OJ 2021, A61 and OJ 2022, A81.

2.2. Debit orders

2.2.1 Governing provisions

Under Art. 5(2) and 7(2) RFees the EPO makes deposit accounts available for paying fees to the EPO (not, however, for the fees according to Art. 17 REE, Supplementary publication 2, OJ 2019 – see **D 9/17**). They are governed by the ADA and their annexes. For the current version and accompanying notice, see Supplementary publication 2, OJ 2024 and decision of the President of the EPO dated 25 September 2024, OJ 2024, A81. Payments from a deposit account are made by debit order, and most fees are paid by this method.

2.2.2 Accepted means of filing a debit order

Since 2017, debit orders submitted to the EPO must be filed in an electronically processable format by an accepted means (point 7.1.2 ADA; see also decision of the President of the EPO dated 25 September 2024 concerning the revision of the ADA and their annexes, OJ 2024, A81). With that, the previous payment form EPO Form 1010 in particular became obsolete (for more on debit orders that are invalid because submitted in another way or format, see point 7.1.3 ADA, see also **T 590/18** of 4 July 2018 in chapter III.A.2.2.1, **T 703/19** and **T 1146/20**). It follows that some of the decisions in this section are now of limited application.

In **T 480/21** the board concluded that an extension of the period for paying the opposition fee was provided under point 5.5 ADA 2017 (point 11 ADA 2024). The evidence strongly suggested that the inability to file the debit order was due to a malfunction of the EPO's Online Filing software, which, in this case, was attributable to the EPO. See also **T 2053/20** in chapter III.A.3.2.

2.2.3 Authority to sign

In **T 1878/18** the board held that the absence of the signatory of the debit order from the law firm's letterhead and the list of professional representatives did not call into question their authority to make a payment. The board also indicated that, according to the ADA,

the EPO is not obliged to perform an ex officio assessment to determine authority to sign, as this is solely a matter for the account holder.

2.2.4 Types of debit orders

The debit order may be a debit order for individual fees or an automatic debit order, in each case for one or more patent applications. By filing an automatic debit order, the deposit account holder authorises the EPO to debit fees automatically as the proceedings progress (see AAD, Supplementary publication 2, OJ 2024, and e.g. **T 1474/19** and **T 342/21**). The automatic debiting procedure is open only to applicants, patent proprietors and their representatives, but not to opponents (whether in first-instance proceedings or as a party to appeal or review proceedings), third parties or persons (other than the applicant or patent proprietor) who inspect the file (see point 1.3 AAD, point II of Annex A.2 to the ADA and e.g. **T 71/21** in this chapter III.U.2.2.5; see also **T 2053/20** in chapter III.A.3.2.).

2.2.5 Interpretation and correction of debit orders

a) Interpretation of debit orders

In **T 1474/19** the board summarised the jurisprudence of the boards concerning the validity of a debit order submitted under the ADA. According to one line of jurisprudence (see (i) below), notwithstanding formal deficiencies, a debit order in line with the prescribed filing requirements has to be assessed on its substance, in view of the party's clear intention objectively expressed in the order to pay a particular fee (e.g. the appeal fee) from an identifiable account. No fee amount needs to be specified. On this basis, the EPO is authorised to and has to debit the intended fee in the applicable, i.e. correct, amount. Another line of jurisprudence (see (ii) below) takes a "more literal" approach in the interpretation of a debit order, putting more emphasis on the incorrect amount specified in the order. According to yet another line of case law (see (b) below), correction of a debit order under R. 139 EPC is possible under the requirements set by **G 1/12.**

(i) Substance of a debit order – clear intention to pay

The EPO's long-standing practice of correcting debit orders of its own motion dates back to **T 152/82** (Debit order I, OJ 1984, 301), according to which a debit order must be carried out notwithstanding incorrect information given in it (here the wrong fee amount), if the intention of the person giving the order is clear (see Headnote II.).

In **T 17/83** (Debit order II, OJ 1984, 306) the board concluded, with reference to **T 152/82**, that if a submission to the EPO stated that a debit order for payment of a fee had been issued, this statement could, if need be, itself be considered such a debit order in the absence of any record of the original (see headnote). These decisions were followed by **T 170/83** (Debit order III, OJ 1984, 605), which held that for payment by debit order the question was whether the EPO was authorised in due time to avail itself for a clearly specified purpose of funds deposited with it, notwithstanding formal deficiencies (here use of a national form in error). Applying the same approach, the board in **T 152/85**

(OJ 1987, 191) concluded that no document had been timely filed which could be construed as a debit order.

In **T 1265/10** the board considered in the particular circumstances of the case that the crossing of Section X of the notice of opposition (EPO Form 2300) to indicate enclosure of a fee payment voucher (which enclosure, however, was not found at the EPO) was a declaration of the intention to pay the opposition fee. A debit order had to be unambiguously recognisable and show a clear and unambiguous intention to make a particular payment (**T 170/83**, **T 152/82**, **T 152/85**). As stated in **T 170/83**, an authorisation to be derived from the circumstances required that the authorising person (account holder) was known and clearly identifiable, and that certain fees due to the EPO for a known procedure were meant to be paid by the withdrawal from such account (and not in any other way). Following **T 806/99**, which was based on almost identical facts, the board found these conditions to be fulfilled. This was sufficient for payment of the fee.

In **J 14/12** the question was whether for the renewal fees paid on a divisional application additional fees were also due. The board found that, for some of the renewal fees, a submission filed within the four-month period of R. 51(3), second sentence, EPC requesting (in general terms) debiting of the fees falling due with the filing of that divisional application was, when read in conjunction with the internal fee calculation sheet filed with the application, sufficient to fulfil the requirements for the content of a valid debit order (see former point 6.3 ADA, as published in Supplement to OJ 3/2009). Hence, those renewal fees were timely paid and additional fees were not due.

In **T 1474/19** the appellant had filed a debit order using Form 1038E which specified a reduced amount of the appeal fee to which the appellant was not entitled (see in this chapter III.U.5.2). The amount lacking was paid outside the time limit. Following **T 152/82**, the board concluded that the appellant's clear intention was to pay the appeal fee to file a valid appeal, the applicable amount (here) being the full amount of the fee. That an incorrect, i.e. the inapplicable, reduced amount was specified in the debit order was irrelevant to the question of validity of the payment. As there were sufficient funds in the deposit account on the date the debit order was received by the EPO, such date was to be considered the (full) payment date.

According to the board in **T 1678/21**, both **T 152/82** and the summary of the subsequent case law endorsing it given in **T 1474/19** could be followed, but only under the condition that it was known to a board from the file as it stood at the end of the appeal period that the appellant, at the point in time of authorising the debit of the reduced appeal fee, was not entitled to the reduction of the appeal fee under R. 6(4) and (5) EPC. As this condition was not met in the case in hand, the statements made by the appellant in the notice of appeal and Form 1038E could not be assessed as reflecting a clear intention to pay the regular appeal fee. See also b) below on the appellant's request for correction under R. 139 EPC.

(ii) More literal approach

Some decisions have put more emphasis on the incorrect amount specified in the order. This has led to appeals being considered not validly filed (see e.g. **T 17/83** and **T 79/01**).

In **T 198/16** the board held that the statement in the electronically filed notice of appeal "The appeal fee is paid via the enclosed form 1010" (which form was not enclosed) was not a "clear, unambiguous and unconditional" debit order under point 6.3 ADA 2015 (which required that the fee amount be specified in the debit order). It was rather considered to be a mere statement that such a debit order was supposed to be given, and thus payment made, by means of a different document, i.e. Form 1010. Deviating explicitly from **T 1265/10**, the board held that the intention to authorise debiting of the deposit account did not already allow the EPO to act on such authorisation and carry out such intent where the EPO, under the deposit account system, already holds such money in trust. **T 1000/19** also rejected the approach in **T 1265/10** in view of the ADA 2017, which required a debit order to be filed in a specific electronically processable format. However, the board in that case favoured a correction under R. 139 EPC and concluded that the fee had been validly paid (see b) below).

In **T 1060/19** the appellant had filed a debit order using EPO Form 1038E which specified a reduced amount of the appeal fee to which the appellant was not entitled (see in this chapter III.U.5.2). The amount lacking was paid outside the time limit. The board held that an express instruction to debit the full fee had only been given outside the appeal period, and no declaration of entitlement to the reduced fee had been filed (see also **T 1222/19** and **T 333/20**).

b) Correction of errors in a debit order under Rule 139 EPC

In early decision **T 170/83** (OJ 1984, 605 – see above), the board observed that, because the running of deposit accounts fell outside the grant or opposition procedures, it was not governed by the correction provisions of R. 88, first sentence, EPC 1973 (cf. R. 139, first sentence, EPC). To make a payment was to perform an act, namely to make a given amount available to the EPO at a particular time (Art. 9(1), first sentence, RFees; see now Art. 8, first sentence, RFees). A similar conclusion was reached in **T 152/85** (OJ 1987, 191). However, R. 139, first sentence, EPC has been applied to correct an error in debit orders in subsequent board of appeal decisions since the introduction in point 5 (now point 7) ADA of stricter conditions for filing debit orders (see e.g. **T 130/19**, **T 317/19**, **T 1000/19** and **T 1146/20**). Rule 139, first sentence, EPC has also been applied in the context of debit orders which had mistakenly indicated the reduced rather than the full appeal fee (see e.g. **J 8/19**, **T 2620/18**, **T 3098/19**, **T 444/20**, **T 1678/21**, **T 1538/19** and chapter V.A.2.5.4). See also **T 186/22** concerning correction of a debit order specifying an incorrect deposit account number.

In **T 71/21** the appellant (opponent) had attempted to pay the appeal fee within the appeal period by setting up an automatic debiting procedure. This could not succeed because this online payment method is inadmissible for opponents (see also in this chapter III.U.2.2.4). Applying R. 139 EPC and taking into account the principles set out in **G 1/12**, the board

concluded that it was not possible to retroactively correct the payment method and deem the deadline for payment met. According to the board, both the notice of appeal and Form 1038 objectively showed, in view of the wording chosen, the appellant's clear and unambiguous intention to pay the appeal fee by means of the automatic debiting procedure. The fact that the appellant was not entitled to use this debiting procedure and had therefore chosen an inadmissible payment method had no bearing on the objectively recognisable unambiguity of this intention (see also in chapter III.A.4.2.2).

In **T 2170/21** the appeal fee had not been paid within the appeal period in the prescribed amount because the appellant (patent proprietor) had issued the debit order on the wrong electronic form for an opposition fee. The board saw no reason to question the possibility in principle of correcting an erroneous fee payment under R. 139 EPC, in line with **T 71/21** and the further decisions cited therein. In the board's view, a correction was possible without replacing the entire form. Contrary to the respondent's view, the conditions for allowing a correction as established by the Enlarged Board and developed in the case law of the boards of appeal (**G 1/12**, point 37 of the Reasons, conditions (a) to (d)) were also met.

The board in **T 1678/21** held that the four criteria for assessing whether a request for correction of a document filed with the EPO pursuant to R. 139 EPC could be granted were principles (a) to (c) of **G 1/12** (see point 37 of the Reasons), complemented by a further criterion (d), namely, balancing of the public interest in legal certainty with the interest of the party requesting correction, with factors relevant to the specific case. As a rule, criteria (a) to (d) were to be assessed in the order (c), (a), if applicable, together with (b), and (d). In the case in hand, the board concluded that the criteria for correction applicable in this case had been met (see also **T 1678/21** in this chapter III.U.2.2.5a)(i) above).

According to the board in **T 3098/19**, the relevant point in time for the question as to whether a request for correction had been filed without delay could only be the date on which the mistake had been discovered by the relevant person (see also **J 1/20** and **T 1678/21**). Since the appellant filed the request immediately after having been informed by the EPO about the payment of the reduced appeal fee, the board considered that the criterion of **G 1/12** had been met.

See also **T 1474/19** in this chapter III.U.2.2.5a)(i).

2.2.6 Processing of debit orders

In **T 773/07** the appellant's deposit account held insufficient funds to cover the appeal fee. The board rejected the argument that this fee could or should have been booked before six other fees on the relevant date. It was not for the EPO cashier to choose priorities between fees to be paid, all the more so since under the ADA it was the responsibility of the account holder to ensure that the account contained sufficient funds at all times.

In **T 871/08** of 23 February 2009 the opponent had indicated that the appeal fee would be paid by online debit order, but also requested that, if this was not done by one day before

expiry of the Art. 108 EPC 1973 time limit, the EPO should debit the fee. The board held that the payment of the appeal fee was exclusively the responsibility of the appellant or its representative, who could not discharge themselves by shifting the responsibility to the EPO, let alone with a conditional order. However, in **T 2364/12** a different conclusion was reached in the circumstances of that case. It is to be noted that the requirement that debit orders must be "unconditional" was introduced in the ADA 2009, remaining in the ADA versions of 2014 and 2015 and being removed from the ADA 2017.

2.2.7 Date of payment of amounts paid by debit order

Provided that there are sufficient funds in the deposit account on the date the EPO receives a debit order, this date will be considered the date on which the payment is made (see point 10 of the ADA and e.g. **T 1474/19** and **T 1678/21**). The debit order may also specify that a payment order should be executed at a date later than the submission date (point 10.2 of the ADA).

In the case of automatic debit orders, the debit is effected in the amount applicable for the fee on the date considered the decisive payment date. The EPO automatically debits the appropriate amounts of all fees due in the proceedings for which the order has been filed and treats the payment as received in due time (see AAD). In **T 342/21** the board held that not debiting the fee automatically (in the case at issue, the fee under R. 82(2) EPC and the surcharge under R. 82(3) EPC) constituted a substantial procedural violation on the part of the EPO. As confirmed in **T 270/00**, if an automatic debit order is revoked after the decisive payment date for the appeal fee, this is too late to affect the payment. Valid payment of the appeal fee is a matter of fact, which cannot be undone and is not at the disposal of the appellant. See also **J 6/21** concerning revocation of an automatic debit order on its execution date.

2.3. Indication of purpose of payment

Article 6 RFees (previously Art. 7 RFees) regulates the particulars concerning payments, which include those necessary to enable the EPO to establish a payment's purpose.

According to **J 16/84** (OJ 1985, 357, headnote), if when a fee is paid the purpose of the payment has evidently been given incorrectly, this deficiency is not prejudicial if the intended purpose can be established without difficulty from the remaining information. The inadvertent use of a fee by the EPO for a different purpose from that evidently intended by the person making the payment has no effect on the purpose intended by that person.

J 23/82 (OJ 1983, 127) and **J 19/96** concerned designation fees for individual contracting states under the earlier law. In **J 19/96** the board noted that **J 23/82** held that the indication of the purpose of a payment within the time limit for payment was not a mandatory requirement for payment to have been made in due time and, according to Art. 7(2) RFees (now Art. 6(2) RFees), could thus still be given later. However, the current board doubted whether this meant that it was generally possible to change the purpose of a payment after expiry of the relevant time limit with retroactive effect to the date on which the payment was made.

For decisions concerning payments by debit order, see also the previous section.

3. Date of payment

3.1. Payment to a bank account held by the EPO

Where an amount is paid into or transferred to a bank account held by the EPO, the date on which the amount of the payment or transfer is actually entered in its account is considered to be the date on which the payment has been made to the EPO (Art. 7(1) RFees). Thus, dates relating to the mistaken transfer of an appeal fee to a bank account of the German Patent Office were held not to be relevant to establishing whether a fee due to the EPO had been paid in time (see **T 45/94** and **T 1130/98**).

3.2. Payment by credit card

Payment by credit card is deemed to have been made on the date on which the transaction is approved (see OJ 2017, A72 and A18).

3.3. Payment by debit order

For date of payment of amounts paid by debit order, see in this chapter III.U.2.2.7.

3.4. Fiction of fee payment in due time – fail-safe arrangement

If payment of a fee is considered not to have been made until after expiry of the period for payment, the period is considered to have been observed upon evidence that the payer took certain steps to initiate the payment within the period (Art. 7(3), (4) RFees, as amended with effect from 1 April 2020, see OJ 2020, A3 and e.g. **T 315/19**). There is no longer a surcharge under Art. 7(3) RFees (**T 842/90**, **J 20/00**, **J 25/12** concern the former surcharge).

Article 7(3), (4) RFees also apply to the payment of a renewal fee, because in effect the due date for payment of this fee marks the last day of a period (R. 51(1) EPC; R. 37(1) EPC 1973) during which this fee can be validly paid (**J 20/00**).

Article 7(3) RFees does not apply to key dates after which payments reaching the EPO are affected by a fee increase (**J 18/85**, OJ 1987, 356).

Article 7(3) RFees does not apply where payment is made through (or, as in this case, a transfer order is given to) a banking establishment which is not in an EPC contracting state, even if the bank has a subsidiary in a contracting state (**J 10/20**, citing **T 401/97**).

A period for payment may be deemed to have been observed within the meaning of Art. 7(3) RFees (cf. Art. 8(3) RFees 1973) even if the receipt of the funds after the expiry of the period is no longer attributable to the original transfer order, but to another payment transaction initiated in the meantime (**J 7/08**; see also **J 22/85**, OJ 1987, 455).

3.5. Prepayment of a fee

Unless otherwise expressly stated (e.g. payment of the renewal fee under R. 51(1) EPC), a fee cannot be validly paid before its due date (**G 1/18**).

4. Insufficient payments – small amounts lacking

A time limit for payment is in principle deemed to have been observed only if the full amount of the fee has been paid in due time (Art. 8, first sentence, RFees).

However, the EPO has the discretion, where this is considered justified, to overlook any small amounts lacking without prejudice to the rights of the person making the payment (Art. 8, fourth sentence, RFees).

It is established in the jurisprudence of the boards and in the practice of the EPO that a "small amount" means around 10% of the relevant fee (see e.g. **T 130/82**, OJ 1984, 172; **J 11/85**, OJ 1986, 1; **T 109/86** of 20 July 1987). In **T 343/02** of 20 January 2003, an underpayment of less than 2% due to the unexpected deduction of bank charges was overlooked.

In **T 290/90** (OJ 1992, 368) and **J 27/92** (OJ 1995, 288), by contrast, it was held in the circumstances of each case that an underpayment of 20% of the relevant fee could be considered a small amount. Among the factors which the board took into account was that this percentage would allow the provision to be applied to cases in which a party mistakenly sought to take advantage of the (then generally available) 20% language-based fee reduction.

However, these have remained isolated cases. Already in **T 905/90** (OJ 1994, 306, Corr. 556) the board found that the meaning of "smallness" could best be determined by comparing the amount of shortfall with the amount of the full fee. A difference of 20% clearly could thus not, on purely arithmetical grounds, be regarded as small. It was with very small or trifling amounts that the former Art. 9 RFees (see Art. 8 RFees) was designed to deal so as to prevent a loss of rights where an inadvertent error of some kind had led to a slight underpayment of an amount due in respect of the relevant proceedings. This decision was confirmed in **T 642/12**, in which the board considered that "small amounts lacking" are to be read as "insignificant or negligible amounts". The legislator had presumed that a fee reduction of 20% pursuant to R. 6(3) EPC was not merely symbolic, but would effectively alleviate the burden of having to prepare translations. Therefore it could not have intended this fee reduction to be considered small in the sense of negligible or insignificant.

The question of what constitutes a "small amount lacking" has also arisen more recently in cases concerning the payment of the reduced rather than the full fee for appeal (see in this chapter III.U.5.2) where the appellant was not entitled to the reduction. See in particular the analysis of the board in **T 3023/18**, and its conclusion that the underpayment of the appeal fee by about 17% was not "small" within the meaning of Art. 8, fourth sentence, RFees. According to the board, it was furthermore reasonable to assume that

the legislator saw the fee reduction under Art. 2(1), item 11, RFees as being of genuine financial assistance to the listed categories of person, and not merely as symbolic. See, similarly, **T 2422/18**, **T 2620/18** and **T 637/21**, and chapter V.A.2.5.4c).

The board in **J 25/12** did not doubt that the underpayment in that case could be regarded as a small amount, but stressed that the EPO could exercise its discretion to overlook small amounts only if justified. This was not so here since the representative had been informed about the changed fee rates and invited to pay the amount lacking within a time limit – which, however, he had failed to do. The board in **T 2620/18** similarly observed that there were two cumulative requirements in Art. 8, last sentence, RFees, namely that the amount lacking be "small" and that overlooking it be "justified". It conceded that overlooking the underpayment might be justified in the case in hand, because the appeal fee had later been paid in full, but it could not do so because the difference between that full fee and the amount initially paid was not small.

5. Fee reductions

5.1. Filing fee, examination fee

The RFees contain provisions regulating fee reductions for certain categories of applicant. By decision of 14 December 2023 (OJ 2024, A3), the Administrative Council amended R. 6 EPC and Art. 14 RFees and adopted new R. 7a and 7b EPC. These changes introduced a new fee reduction scheme specifically for micro-entities, which complements the existing support measures for small entities, and in particular the language-related fee reductions. The eligibility requirements for any language-related fee reductions are now provided for in Art. 14(4) EPC and R. 7a(1) and (2) EPC (previously R. 6(3) and (4) EPC).

Article 14(1) RFees defines the percentage of the language-related reduction of the filing fee and the examination fee provided for in R. 7a, paragraphs 1 and 3, EPC. For relevant decisions, see chapter III.F.6.

Article 14(2) RFees defines the percentage reduction of the examination fee for certain Euro-PCT applications having entered the regional phase. The reduction does not apply to divisional applications (**J 1/09**, confirming **J 14/07**).

5.2. Fee for appeal

Under Art. 2(1), item 11 RFees, as in force from 1 April 2024, the persons and entities listed in R. 7a, paragraphs 2(a) to (d) EPC, pay a reduced fee for appeal (see decision of the Administrative Council of 14 December 2023, OJ 2024, A3). Relevant board decisions are reported in chapter V.A.2.5.4c).

6. Fee refunds

As a general rule, once a fee has been validly paid it will not be refunded, unless a refund is provided for in the EPC or RFees.

In **T 2069/18** the board held that the examining division had rightly found the renewal fees in issue to have been duly incurred and imposed. The refund arrangements laid down in e.g. Art. 9 to 11 RFees, albeit inapplicable in the case in hand, showed that the EPC 1973 legislator had provided for the possibility of refunds in certain cases. Otherwise too, the EPO regularly refunded payments made without a legal basis of its own accord, on the grounds of equity. Renewal fees which had been duly imposed and paid were not retrospectively deprived of their legal basis because the EPO had been slow to act in examination proceedings. See also **T 1284/09**.

See also decision of the President of the EPO dated 25 September 2024 concerning the revision of the ADA and their annexes – changes regarding the repayment of renewal fees that are not due (OJ 2024, A81).

For decisions on the refund of specific procedural fees, see the relevant chapters of the book, in particular chapter II.B.3.3, III.E.9 and V.A.11.

6.1. Partial refund of the examination fee

The Legal Board ruled in **J 25/10** (OJ 2011, 624, see headnote) that following the withdrawal of a European patent application, a refusal by the examining division of a request for a 75% refund of the examination fee, on the basis that substantive examination has already begun (Art. 11(b) RFees), must be based on facts which objectively demonstrate that this is so. See also **J 9/10**. Following these two decisions the EPO made adjustments to the system for refunding search and examination fees – see notice dated 29 January 2013 (OJ 2013, 153).

V. Representation

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1. Overview

Article 133 EPC lays down the general principles applying to representation. Art. 134 EPC governs representation before the EPO. Art. 134a EPC concerns the Institute of Professional Representatives before the EPO.

Article 133 and 134 EPC together with R. 152 EPC and the decision of the President of the EPO dated 12 July 2007 on the filing of authorisations (OJ SE 3/2007, 128, L.1.) provide a complete, self-contained code of rules of law on the subject of representation in proceedings established by the EPC. Art. 133(1) EPC stipulates that, subject to Art. 133(2) EPC, no person is compelled to be represented by a professional representative in proceedings established by the EPC. However, according to Art. 133(2) EPC, natural persons not having their residence in an EPC contracting state must be represented by a professional representative (Art. 134(1) EPC) or a legal practitioner (Art. 134(8) EPC) and act through him in all proceedings established by

the EPC, other than in filing the European patent application (**T 578/14**). That the set of rules on representation is complete and self-contained was reaffirmed in **T 1893/22**.

The Guidelines (April 2025 version) contain detailed information on the practice relating to representation, most notably in: A-III, 2; A-VIII, 1 and D-I, 7.

2. Professional representatives

2.1. List of professional representatives (Article 134(1) EPC)

Article 134(1) EPC stipulates that professional representation of natural or legal persons in proceedings established by the EPC may only be undertaken by professional representatives whose names appear on a list maintained for this purpose by the EPO. The requirements for entry in this list are laid down in Art. 134(2) EPC. In the context of Art. 134(1) EPC, it is also useful to consult R. 154 EPC "Amendment of the list of professional representatives", as well as the related decision of the President, OJ 2013, 600, notice from the EPO, OJ 2015, A55, and Administrative Council decision, OJ 2018, A57; Notice from the EPO dated 13 May 2024, OJ 2024, A57.

The objective of the list of professional representatives is to provide a survey of particularly qualified representatives in patent matters (**D 14/93**, OJ 1997, 561).

In **J 1/78** (OJ 1979, 285) the appellant was entered on the list of professional representatives before the EPO under the letter "V" as "von F., A.". The object of his appeal was to obtain a ruling which would enable him to be entered under the letter "F" as, for example, in the telephone directory. The decision found that the entry was made in accordance with the principles laid down by the President of the EPO whereby the full surname must be entered in alphabetical order. Under German law, former titles of nobility ("von") form part of the surname. The board noted that the purpose of entry on the list was to confer upon the person whose name was entered the right to appear in the European patent grant procedure. A distinction had to be made between entry for the purposes of conferring a right and publication of the list, which latter was not prescribed in the EPC 1973. The EPO issues a directory from time to time for the purposes of meeting public demand for information. In this directory, the person entered on the list could be allowed an additional entry under another letter should he so desire.

2.2. Party having its seat in an EPC contracting state

Under the EPC there is no obligation for parties having their residence or principal place of business in a contracting state to be represented in proceedings before the EPO (Art. 133(1) and (2) EPC). If a European professional representative – qualified in accordance with Art. 134 EPC – is appointed, the party acts "through" them in all proceedings established by the Convention (Art. 133(2) EPC) and notifications are made to them (R. 130(1) EPC) (see e.g. **J 1/20**).

In **T 1893/22**, the proprietor contested the admissibility of the opposition inter alia on the basis that the opponent's professional representative could not represent the French

company since he was simultaneously managing the legal entity he represented. The board reminded that a legal person having its seat in an EPC contracting state is not obliged to be represented by a professional representative (Art. 133(1) EPC). Furthermore, persons whose names appear on the list of professional representatives are entitled to act in all proceedings established by the EPC (Art. 134 EPC). A legal person having its seat in an EPC contracting state can act in proceedings before the EPO through its legal representatives. At the time the opposition was filed, Mr N in his capacity as President of the company was entitled to represent the company since under French law (Art. L. 227 Commercial Code) he was entitled to act on behalf of the legal person in all circumstances. Mr N as a professional representative would have been entitled to act not only as the president of the company, but also as a professional representative appointed by that legal person. For the sake of completeness, the board detailed why neither the references to French law (Civil Code) nor German law, nor the reference to general principles under Art. 125 EPC could, in its view, prevent the company from appointing Mr N as its professional representative before the EPO.

2.3. Duty of persons without residence nor place of business within a contracting state to be represented by a professional representative

According to Art. 133(1) EPC, no person shall be compelled to be represented by a professional representative in proceedings established by the EPC. However, Art. 133(2) EPC stipulates that natural or legal persons not having either a contracting state residence or their principal place of business within the territory of one of the contracting states must be represented by a professional representative and act through him in all proceedings established by the Convention, other than in filing a European patent application. The Implementing Regulations may permit other exceptions. **T 1157/01** reviews the applicable law.

In **J 1/04** the board stated that there is no obligation for an applicant having a principal place of business within an EPC contracting state to be represented in proceedings established by the Convention. If, however, the applicant wishes to be represented, he must authorise either an employee or a professional representative or legal practitioner.

Regarding an employee of a **group of companies**, **T 2308/10** says that an employee of a company in such a group is not entitled to represent another company belonging to the same group. **T 298/97** had already established that, there being no provision in the Implementing Regulations pursuant to Art. 133(3), last sentence, EPC, the EPC did not currently allow the representation of one legal person by an employee of another economically related legal person.

In **T 213/89** the Japanese inventor replied directly to the EPO with a set of revised application documents, and accompanied by a letter to his representative indicating that the revised documents had also been sent to the representative. The board noted that no confirmation by the representative was received that any of the submissions directly received from the inventor should be regarded as an official reply to an EPO action. Since persons not having a residence or their principal place of business within the territory of

one of the contracting states must act through their representative in the proceedings, the said submissions received direct could not be taken into account.

In **T 717/04**, a letter from the appealing applicant, a natural person with an address not within the territory of one of the contracting states, was faxed to the EPO with arguments and a new set of claims to be taken into account. According to Art. 133(2) EPC 1973, since the appealing applicant's address was not within the territory of one of the contracting states, the board concluded that filing claims and arguments such as those in the appealing applicant's letter would have required professional representation. As these submissions were neither made nor endorsed by the representative, the board could not take them into account.

In **T 578/14** Mr S., as a resident of New Zealand, had to act through a representative in the appeal proceedings. Therefore, the board could not take into account requests and submissions, which were made neither by the representative nor endorsed by him (**T 213/89**, **T 717/04**, and **J 4/10**). This did not apply to submissions which exclusively concerned the appointment or change of a representative or the filing of an authorisation or of any information that the representative's authorisation has terminated.

In **J 9/13** the Receiving Section refused the European patent application pursuant to Art. 90(5) EPC, because the applicant, resident in Moscow, had not appointed a professional representative as required by Art. 133(2) EPC. The appellant (applicant) contended that Art. 133(2) EPC did not apply to residents of the Russian Federation. The Russian Federation was a party to the "Partnership and Cooperation Agreement (PCA). The board stressed that neither the European Patent Organisation nor the EPO is part or member of the European Union. Therefore, neither the European Patent Organisation nor the EPO are bound by the provisions of the PCA, neither of them is a "party" or "other party" pursuant to Art. 98 of the PCA. The appeal was deemed not to have been filed.

2.4. Professional representatives during the transitional period

One of the conditions for including a professional representative on the EPO list is that he has passed the EQE. During a transitional period after the EPC 1973 first entered into force, this requirement could be waived under the conditions laid down in Art. 163 EPC 1973 (see **J 19/89**, OJ 1991, 425; **J 10/81**). For all states acceding to the EPC 1973 at its inception, this period ended on 7.10.1981 (decision of the Administrative Council dated 6.7.1978, OJ 1978, 327). Art. 163 EPC 1973 was one of the transitional provisions, now superseded, and has therefore been deleted in the new EPC 2000.

Article. 163(6) EPC 1973 retains all its significance as a grandfather clause and is therefore preserved in the EPC 2000 to deal with the situation of national representatives of states acceding to the EPC in the future. The substance of the grandfather clause of Art. 163 EPC 1973 has therefore been integrated in Art. 134(3) EPC 2000 in simplified form, as a permanent provision of the EPC.

The reunification of Germany posed its own problems, in **J 18/92**, **J 30/92**, **J 31/92**, **J 32/92** and **J 33/92**, regarding the admission of professional representatives. The appellants argued that the provisions of Art. 163(6) EPC 1973 should be applied to patent attorneys, even where they had qualified in West Germany and not the former GDR. In the board's view, Art. 163(6) EPC 1973 could only be applied by analogy to those finding themselves in a similar situation to the patent agents of a country acceding to the EPC. This requirement was fulfilled only by patent agents from the former GDR and not by their colleagues who had already been admitted in the West.

2.5. Procedural steps performed by a person other than the professional representative

A procedural act performed by a non-entitled person is to be treated in the same way as a missing signature (**G 3/99**, OJ 2002, 347; **T 665/89**; **T 1048/00**).

In **J 28/86** (OJ 1988, 85) the Legal Board held that a request for examination filed by a person who was not entitled to act as a representative in accordance with Art. 134 EPC 1973 was invalid. The board noted that the situation did not change because the representative had later been entered on the list of professional representatives. In this capacity he had neither approved nor resubmitted the invalid request he had made earlier.

In **T 665/89** the board addressed the question of the admissibility of an opposition by an opponent whose residence was not in a contracting state, where the notice of opposition was signed by a person who was neither a professional representative nor an employee of the opponent. The board of appeal concluded that the actions of the unauthorised person ought to be judged as if the signature were missing, and thus assumed that the **deficiency** was remediable. The opponent supplied the missing correct signature at the EPO's invitation within the time limit laid down. The document thus retained the original date of receipt in accordance with R. 36(3), third sentence, EPC 1973 (R. 50(3) EPC). See also **T 1427/09** of 17 November 2009.

R 18/09 the Enlarged Board, referring in detail to **G 3/99** (OJ 2002, 347), stated that concerning the principle that a plurality of persons acting in common be treated as a single party (a "group party") and the requirement that such a group party acts through a common representative which both apply to petition proceedings. It was also held in **G 3/99** (point 20 of the Reasons) that there is no practical need to acknowledge the validity of procedural acts of one member of a group party who is not its common representative. Such a procedural act is treated by the EPO in the same way as a missing signature. Where an appeal is filed by a non-entitled person, it shall be considered as not duly signed and the common representative be invited to sign it within a given time limit. (See also **G 3/99** under III.V.3.3.2 "Common representative").

In **J 32/86** the board held that the mere appointment of a professional representative to meet the requirement of Art. 133(2) EPC 1973 (the appellant had his residence in the USA) did not automatically have the legal effect of validating acts previously performed by an applicant himself. The EPO was however obliged to give the representative a fair

chance to remedy any deficiency of this kind that might have occurred before his appointment and which could still lawfully be remedied by him.

2.6. Submissions by a professional representative after transfer of opponent status

In **T 1204/13**, Mr S., the representative acting for the original opponent, submitted that it had since merged with its parent company. The board held that, if so, its opponent status would have been automatically transferred to its universal successor in title but, if not, it remained the opponent. In any event, Mr S. was entitled to act as professional representative in either case and so to make submissions on behalf of whichever opponent he now represented.

3. Legal practitioners entitled to act as professional representative

3.1. General issues

According to Art. 134(1) EPC, professional representation of natural or legal persons in proceedings established by the EPC may only be undertaken by professional representatives whose names appear on the above list. However, Art. 134(8) EPC (former Art. 134(7) EPC 1973) provides that professional representation in such proceedings may also be undertaken, in the same way as by a professional representative, by any legal practitioner qualified in one of the contracting states and having his place of business within such state, to the extent that he is entitled, within the said state, to act as a professional representative in patent matters. The arrangements for legal practitioners set out in Art. 134(8) EPC therefore constituted an exception.

In **J 8/10** (OJ 2012, 472), the board observed that, if a legal practitioner wishes to act under Art. 134(8) EPC, the EPO considers whether he meets the conditions of that provision (i.e. is qualified in a contracting state and has his place of business and the right to act as a professional representative in patent matters in that state). If the legal practitioner fulfils the conditions, the EPO enters his name on a list which – like the list of associations of representatives – it keeps as an internal working tool and does not publish.

In **J 19/89** (OJ 1991, 425) it was observed that the last clause of Art. 134(7), first sentence, EPC 1973 (Art. 134(8) EPC) prevented a "Rechtsanwalt", "legal practitioner" or "avocat" from having more extensive powers of representation before the EPO than he was entitled to before his national patent office. Art. 134(7) EPC 1973 was therefore a special rule limited in scope to the corpus of legal practitioners, which existed under various designations in all the contracting states.

In **J 18/99** the board pointed out that under the current Spanish law, any legal practitioner qualified in Spain and having his place of business in Spain was entitled to represent clients in patent matters before the Spanish Patent and Trademark Office if he presented an authorisation from the party.

See also Guidelines A-VIII, 1.3 – April 2025 version.

3.2. Register of legal practitioners

The register of legal practitioners must be clearly distinguished from the list of professional representatives established in accordance with Art. 134(1) to (4) EPC.

The objective of the list of professional representatives is to provide a survey of particularly qualified representatives in patent matters; it would be jeopardised if legal practitioners without such qualifications were included on the list. Accordingly, the conditions for entry on the list of professional representatives under Art. 134(2) EPC 1973 also apply to legal practitioners (**D 14/93**, OJ 1997, 561).

Whereas, according to Art. 134(4) EPC 1973, the entry of a person's name in the list of professional representatives entitles them to act in **all proceedings** established by the EPC 1973, the EPC 1973 does not contain any corresponding provision for legal practitioners. Their competence to undertake representation before the EPO is not general, but depends directly on their complying with the provisions of Art. 134(7) EPC 1973 (**J 27/95**).

3.3. Qualifying conditions according to Article 134(8) EPC

3.3.1 Representation by a legal practitioner

In **J 19/89** (OJ 1991, 425) the Legal Board considered whether a patent attorney under national law should, in view of his legal qualifications and entitlement to act as a professional representative in national patent matters, be regarded as a "legal practitioner" within the meaning of Art. 134(7) EPC 1973 and hence be authorised to act before the EPO. The board decided that irrespective of his specialist qualifications and powers of representation in national patent matters, a **patent attorney** under national law could not be regarded as a "legal practitioner" within the meaning of Art. 134(7) EPC 1973, and therefore was not entitled to act as a professional representative before the EPO (see also **D 14/93**, OJ 1997, 561).

In **J 27/95**, the Legal Board first made it clear that the competence of legal practitioners to undertake representation before the EPO depended directly on their complying with the provisions of Art. 134(7) EPC 1973. Thus, each time a legal practitioner made a request to act as a professional representative in proceedings before the EPO, the Legal Division had the right to examine whether he or she satisfied the conditions under Art. 134(7) EPC 1973. In its decision the board pointed out that a legal practitioner qualified in a contracting state had to have "his place of business in such State". The place of business within the meaning of Art. 134(7) EPC 1973 was the place (if any) at which a person practised his or her profession as legal practitioner.

See also **T 643/01** (French lawyer) and **T 1846/11** (no authorisation filed for legal practitioner, nor any subsequent approval by appellant submitted for steps taken by legal practitioner without such authorisation).

3.3.2 Common representative

In **G 3/99** (OJ 2002, 347) the Enlarged Board dealt with the question of the admissibility of joint oppositions and joint appeals. The decision makes it clear that an opposition filed in common, apart from the fact that it is filed by more than one person, is as much a single opposition as an opposition filed by only one person. In an opposition filed in common, there must in all cases be a **common representative** (Art. 133(4) and R. 100 EPC 1973) (R. 151 EPC), and only that common representative is entitled to act in the opposition proceedings on behalf of all the common opponents taken as a whole.

If the opposing party consists of a plurality of persons, an appeal must be filed by the common representative under R. 100 EPC 1973. Where the appeal is filed by a non-entitled person, the Board of Appeal shall consider it not to be duly signed and consequently invite the common representative to sign it within a given time limit. The non-entitled person who filed the appeal shall be informed of this invitation. If the previous common representative is no longer participating in the proceedings, a new common representative shall be determined pursuant to R. 100 EPC 1973.

In order to safeguard the rights of the patent proprietor and in the interests of procedural efficiency, it has to be clear throughout the procedure who belongs to the group of common opponents or common appellants. If either a common opponent or appellant (including the common representative) intends to withdraw from the proceedings, the EPO shall be notified accordingly by the common representative or by a new common representative determined under R. 100(1) EPC 1973 in order for the withdrawal to take effect.

G 3/99 was applied in **T 1154/06** in connection with the necessity of appointing a professional representative if the first-named of multiple patent proprietors was not resident in a contracting state. (See **R 18/09**, in which the Enlarged Board referred to these two decisions and held that both the principle that a plurality of persons acting in common must be treated as a single party (a "group party") and the requirement that such a group party acts through a common representative apply to petition proceedings.)

In **T 1654/13** it was submitted that the appeal filed by the common representative of the joint patent proprietors had to be understood as having been filed on behalf of both patent proprietors as joint appellants. The wording used in the notice of appeal, referring only to the first of the two patent proprietors, i.e. Unilever N.V., thus had to be understood only in relation to the request for the reduction of the appeal fee. The board, citing Art. 118 EPC and calling to mind **R 18/09** and **T 1154/06**, decided that there was no doubt that Unilever N.V. and Unilever PLC were joint appellants. The appeal was admissible.

In decision **T 1366/04** the appeal had been filed by the first of two joint patent proprietors only. The board held that the requirements of Art. 118 EPC were met and that there was no doubt about the identity and appellant status of the two patent proprietors.

Decision **T 418/07** concerns a different case, where shortly before the oral proceedings the respondent (patent proprietor) appointed a second firm of representatives as joint representatives in addition to the firm already acting and asked the board to send copies

of all correspondence to both firms. In this case of **multiple representatives**, the board held that while it is open to a party to appoint as many representatives as it may wish, the board is not aware of any requirement on it or on other parties to send correspondence to more than one representative of one party. If a party wants to retain multiple representatives, it must make its own arrangements for copying correspondence to them all. Parties cannot expect the board to provide copying services for their convenience.

In **T 1907/20** the appellant (patent proprietor) argued in support of its appeal's admissibility that, as professional representative acting for the two joint patent proprietors (Bosch und Samsung) under R. 151(1) EPC, the representative who had filed and signed its notice of appeal ("representative on appeal") had been entitled to do so even without a special authorisation. His acting in addition to the representative who had filed the patent application was covered by R. 152(10) EPC. The board agreed that the representative on appeal had already been entitled at the time of filing the appeal to act as the joint proprietors' common representative under R. 151(1) EPC, even without meeting any further formal requirements, because he personally had performed this act as professional representative. The appointment of another common representative was likewise no obstacle to acknowledging the representative on appeal as yet another common representative of the proprietors within the meaning of R. 152(10) EPC. It was not necessary to provide the EPO with any special declaration. The opponent had also not disputed that, as professional representative under Art. 134 EPC, the representative on appeal did not need to produce an authorisation from Samsung within the meaning of Art. 1 of the President's decision dated 12 July 2007 on the filing of authorisations. Moreover, the EPO had no grounds for considering that there had been a change of representative. Both the representative previously dealing with the application and the representative on appeal were just two of several representatives acting for Bosch under R. 152(10) EPC. At the oral proceedings before the board, the respondent argued that the representative on appeal's lack of authority to act did not result from a missing authorisation but instead from the fact that there had been no appointment of a common representative as expressly envisaged in R. 151 EPC. The board, however, held that R. 151 EPC did not require that the representative be appointed in the form of a special declaration by the applicant or proprietor in addition to the authorisation issued for the purposes of R. 152 EPC. Hiring a professional representative or issuing a professional representative with an authorisation (and, as the case may be, subsequently filing that authorisation with the EPO for the purposes of grant or opposition proceedings) was deemed to be an appointment of a common representative within the meaning of R. 151 EPC.

See also **J 35/92** (common professional representative appointed; application withdrawn) and **J 10/96** (appointed common professional representative withdrew from case during the proceedings), **T 464/20** (board applied R. 151(1) EPC in a case where opposition had been filed jointly by two companies in which a letter from the representative had stated that the second one was in liquidation but no supporting evidence was produced).

4. Authorisations for appointment of a representative

At various points in the following sections there are references to the issue of whether an authorisation actually exists, a problem in a number of cases.

4.1. Filing of the authorisation

R. 101 EPC 1973 has been redrafted as R. 152 EPC 2000. R. 152(6) EPC, in particular, now reads: "If a required authorisation is not filed in due time, any procedural steps taken by the representative, other than the filing of a European patent application, shall be deemed not to have been taken, without prejudice to any other legal consequences provided for by this Convention." See also the decision of the EPO President dated 12 July 2007 on the filing of authorisations (OJ SE 3/2007, 128, L.1.), and **J 8/10** (OJ 2012, 470).

The **new law now applicable** is laid down in the decision of the EPO President dated 8 July 2024 on the signing and filing of authorisations (OJ 2024, A75; see also the notice explaining the new system in OJ 2024, A77 – the rules introduced also apply in proceedings relating to European patents with unitary effect, OJ 2024, A76). On its entry into force on 1 November 2024, this decision dated 8 July 2024 superseded the decision dated 12 July 2007 on the filing of authorisations (OJ SE 3/2007, L.1.). See also Guidelines A-VIII, 1.6-1.9 and 3 – April 2025 version. No board decisions applying the new law have been issued so far.

Under R. 152(1) EPC and Art. 1(1) of the EPO President's decision (OJ SE 3/2007, 128, L.1.), professional representatives whose name appears on the EPO's list and who identify themselves as such need file a signed authorisation only in certain specified circumstances (change of representative without notification that the previous representative's authorisation has terminated or where the EPO has doubts about the representative's entitlement to act), **T 1204/13** (see also **T 548/13**).

In **T 1105/16** the board stated that, even if Mr K. (a professional representative) were acting as an employee of the patent proprietor, a signed authorisation would not be required since an employee has to file a signed authorisation only if the employee is not a professional representative (see Art. 3 decision of the President, (OJ SE 3/2007, 128, L.1.).

In **T 924/17** the new representative filed in due time on 6 June 2017 a signed authorisation, following the invitation by the EPO according to R. 152(2) EPC. The authorisation bore a signature with date of 23 May 2017, i.e. after lodging the notice of appeal. The board stated that there was no requirement for the signature's date to be prior to the filing date of the notice of appeal, let alone a requirement that any procedural step taken before the signature's date be explicitly approved in the signed authorisation. This would be tantamount to requiring proving the existence of a previous informal oral or written authorisation, which entitles the representative to act on behalf of a party ("Bevollmächtigung") and further, this would also be contrary to the intended purpose of R. 152(2) EPC, which is clearly to allow to remedy the missing filing of the authorisation,

as it appears implicit and evident that the authorisation generally relates to and encompasses any action by the new representative during specific ongoing proceedings before the EPO.

In **J 12/88** it turned out that the former representative of the appellant had acted before the EPO on behalf of the appellant without being instructed to do so and using a forged authorisation. The board considered all these proceedings to be null and void. All fees paid to the EPO on behalf of the appellant never had been due and had to be reimbursed.

In **T 850/96** the appellant had alleged that the opposition was not admissible because the signatories of the notice of opposition did not file an authorisation. According to him an employee must declare with the notice of opposition that he acts as a professional representative. Otherwise he must file an authorisation. In the case under consideration both signatories of the notice of opposition were professional representatives. The board held that Art. 1(1) of the decision of the President of the EPO of 19 July 1991 (OJ 1991, 489) stipulates that a professional representative whose name appears on the list maintained by the EPO **and who identifies himself as such** shall be required to file a signed authorisation only in the circumstances set out in Art. 1(2) and (3) of this decision of the President (now decision of 2007, OJ SE 3/2007, 128, L.1.). In the case at issue, the deficiency had not been the lack of a signed authorisation, but the failure of the signatories of the notice of opposition to identify themselves as professional representatives (see also **T 1744/09** citing **T 850/96** saying that a professional representative identifying himself retroactively is not precluded).

In **T 425/05**, the respondent (patent proprietor) requested the board at the start of the procedure to declare the appeal inadmissible, on the one hand because it had been filed at a date when the original opponent (company I) had been dissolved and had therefore ceased to have legal existence, and on the other because the mistake in the notice of appeal could not be a mere clerical error on the part of the professional representative which could easily be corrected, since the representative manifestly could not act on behalf of company F, which had not yet authorised him to do so. The board began by establishing that the representative's authorisation to act on behalf of company I had never been contested or rescinded. It was equally evident that the original opponent, company I, no longer had legal existence, as it had been dissolved and its assets had passed into the hands of company F, its associate and sole shareholder. The board concluded that company F had succeeded company I as opponent, and therefore also as the client of the representative. Thus the appeal filed by the representative, whose authorisation, confirmed in the meantime, had never been rescinded, had been implicitly, but necessarily, filed on behalf of his actual client, company F; the identification of company I as the opponent in the notice of appeal was due to a clerical error which had since been corrected.

In **T 267/08** a change of representation had been notified by the new representative together with the notice of appeal. The previous representative had not contacted the EPO to indicate that his authorisation had terminated. The decision of the President of the EPO (OJ SE 3/2007, 128, L.1.) stated that in cases of a change of representation, and where the EPO had not been notified of the termination of the previous representative's

authorisation, "the new representative must file, together with the notification of his appointment, an individual authorisation (original and one copy) or a reference to a general authorisation already on file. If he does not, he shall be requested to do so within a period to be specified by the EPO." In the case at issue, the board invited the new representative under R. 152(2) EPC to file an authorisation, as the board had realised that the authorisation failed to name the correct opponent. The new representative sent the authorisation by fax but failed to file the original version. The board stated that the filing of a valid authorisation for the opponent must, of necessity, entail the **filing of the original**, and a professional representative should know this. The legal consequence of this was that the procedural steps taken by the new representative were deemed not to have been taken (R. 152(6) EPC). Consequently the notice of appeal was deemed not to have been filed and an appeal did not exist.

In **T 637/09** the appellant informed the board and the respondent that Mr M, who was already acting as its professional representative, would be joined by Mr S, another professional representative. Mr S's authorisation to represent the appellant was challenged by the respondent at the start of the oral proceedings. The board observed that under R. 152(10) EPC a party may be represented by **several representatives** acting jointly. Mr S was not required to file a signed authorisation in order to be able to represent the appellant. There was no need to file a (further) authorisation under Art. 1(3) of the decision of the President of the EPO (OJ SE 3/2007, 128, L.1.). The board concluded that Mr S was duly authorised to represent the appellant along with Mr M.

The board in **T 1700/11** ruled that if a European representative files an opposition on behalf of a party but fails to file a signed authorisation in due time in response to a request to do so from the board, the opposition is deemed not to have been filed (R. 152(1) and (6) EPC). The board held that this legal fiction resulted in a loss of rights (R. 112(1) EPC) and that an examination of the admissibility of the opposition, which had not been filed according to the legal fiction, was out of the question. (Decision cited by **T 7/17**).

In case **J 19/13** the representative who electronically signed the request for grant (EPO Form 1001E) was not a valid signatory for the applicant. A procedural act performed by a non-entitled person is to be treated in the same way as a missing signature. For the electronic filing of a document accompanied by the electronic signature of an unauthorised person, the same principle applies, as confirmed, for instance, in **T 1427/09** of 17 November 2009. Therefore, the request for grant form was to be considered not signed.

4.2. General authorisations

This subsection deals inter alia with the extent of the powers conferred.

In **J 9/99** (OJ 2004, 309) the board decided that the Legal Division had authority to check the authorisation of a representative named in a general authorisation and to issue a formal decision to reject the registration of a general authorisation. A decision not to register a general authorisation can only be issued in respect of a request from a party to the proceedings within the meaning of R. 101(2) EPC 1973, i.e. either an authorising or an authorised party.

In **J 11/93** the applicant submitted in his statement of grounds of appeal that the official communication should have been sent to the authorised European representative since he had been duly empowered to act on behalf of the applicant by a general authorisation filed with the EPO in respect of another European patent application. Instead of this the communication was sent directly to the applicant, a US company. The board confirmed that the authorisation in suit had never been registered by the EPO as being a general one, and that even if it had been so registered it would then have been incumbent on the applicant to communicate the number allotted to the general authorisation so that the Receiving Section could take it into consideration before sending the communication to the applicant at its last known address, rather than to the representative. Under these circumstances the board considered that when the letter sent directly to the applicant was issued no European professional representative had yet been appointed by the applicant.

In **J 17/98** (OJ 2000, 399) the Legal Board had to rule on whether communications concerning the deemed withdrawal of applications had been correctly notified to the applicants, who were residents of a non-EPC contracting state, even though general authorisations were held by the EPO on their behalf. The applicants argued that the communications relating to deemed withdrawal should in fact have been notified to the representatives appearing in the general authorisations on file with the EPO. The board held that the filing of a general authorisation to act on behalf of a specific applicant and the notification of the appointment of a representative in an individual application were two **separate** procedural acts. By definition, general authorisations did not refer to specific cases and did not allow the EPO to assume, without further information from the applicant, that a specific representative had been appointed in a particular case. From the EPC it was clear that the filing of a general authorisation did not imply the appointment of a professional representative in a specific case (see also chapter III.S.3. "Notification to representatives").

In **J 1/04**, the relevant question in this case was whether the notifications of the communications were correctly addressed to the appellant. The appellant criticised the EPO's practice of sending communications directly to the applicant, even if the latter had appointed a national representative in the international phase. The board pointed out that an authorisation for the international phase did not comprise an authorisation for the European phase and that disregard thereof could lead to a loss of rights. Furthermore, as long as the applicant did not appoint a representative who was entitled to represent him before the EPO, the general principle applied that procedural acts had to be performed by the EPO in relation to the registered applicant as being the party to the proceedings. Thus, notifications had to be addressed to the registered applicant and they had been correctly made if they were addressed to the applicant (appellant) in the case at issue. The appeal was dismissed.

In **T 1865/07**, the board noted that, in the circumstances of the case, giving an incorrect general authorisation number was of no consequence.

In **T 846/22** the assessment of potential financial relationships between a dormant company and an appointed representative was of no relevance to establishing the legal status of the company as a legal person either. Moreover, the opponent's representative

was appointed in accordance with the requirements of the EPC. Hence, there was no reason for the board to doubt that the representative was duly authorised.

4.3. Sub-authorisations

In **T 227/92** it was held that a sub-authorisation from a professional representative to a person who was not a professional representative within the meaning of Art. 134 EPC 1973 was invalid. The latter person's role was therefore limited to that of technical adviser to the professional representative.

In **T 382/03** the previous representative, Mr E. of UDL, filed a fax to announce that Mr U., who was not a member of that association, would appear for respondent 1 at the oral proceedings before the board. Mr E. did not notify the board that his association's authorisation was terminating. Hence, that was a situation where the President's decision required the new representative, Mr U., to prove that he was authorised to act on behalf of respondent 1. As Mr U. did not refer to a general authorisation from respondent 1, proof of an individual authorisation had to be provided to the board. In principle, that could be done by filing a direct individual authorisation from opponent 1, or by filing a sub-authorisation from an authorised representative who was entitled to sub-authorise a third representative. In view of the sub-authorisation from UDL submitted by Mr U. at the oral proceedings, the only issue remaining was whether or not UDL was entitled to give such a sub-authorisation.

For an example of a professional representative entitled by a chain of sub-authorisations to make submissions on behalf a party, see **T 1081/06**.

In **T 953/21** the board noted in its communication under Art. 15(1) RPBA dated 6 December 2023 that, with regard to the sub-authorisation on file for Mr D, a legal practitioner, the required individual authorisation or a reference to a general authorisation which indicated that the patent proprietor's representative was entitled to sub-authorise was lacking from the file. With its letters dated 16 January 2024, the patent proprietor filed an authorisation for its newly appointed representatives which entitled them to give sub-authorisations. In its reasons, the board then wrote that it was clear from the authorisation on file that the patent proprietor's representative was authorised to grant sub-authorisations. Mr D was therefore validly authorised.

In **T 1676/08**, the board had no reason in the circumstances of the specific case to doubt that Mr S, a legal practitioner entitled to act as a representative, was duly sub-authorised. Moreover, on the same day of the oral proceedings, the professional representative, Mr M, stated as a precautionary measure that he endorsed any submission made by Mr S during these oral proceedings.

In **T 1693/10**, the contested sub-authorisation given to a second professional representative had eventually been withdrawn. This second representative was regarded from then on as assisting the first representative as an "accompanying person" within the meaning of **G 4/95** (OJ 1996, 412) but was not permitted to speak at the oral proceedings

because at least one of the criteria laid down in that decision for such permission had not been met.

In **T 2453/12** opponent 2's notice of opposition had been filed under the name of an already defunct company and rejected as inadmissible by the opposition division at the oral proceedings. Its representative had then been issued with authorisation to act for opponent 1 during the remaining proceedings. The patent proprietor (respondent) took the view that one opponent's representative could not now act for the other opponent too. The opponents argued that opponent 1's original representatives – who were anyway its employees – remained authorised to represent it and that the appeal lodged by those representatives was therefore admissible. Opponent 1 had merely issued opponent 2's representative with a sub-authorisation during the opposition proceedings. The board observed that, under Art. 133(1) and (3) EPC, legal persons having their principal place of business in an EPC contracting state were not compelled to be represented by a professional representative in EPO proceedings and were instead free to have a duly authorised employee act for them. That applied irrespective of whether they chose also to authorise a professional representative in parallel.

4.4. Authorisation of an association of representatives

R. 152(11) EPC provides that an authorisation of an association of representatives is deemed to be an authorisation of any representative who can provide evidence of being member of the association. On this point, see the Administrative Council's decision CA/D 9/13 of 16 October 2013 on the interpretation of the term "association of representatives" (OJ 2013, 500). For more information on this subject, see also the notice dated 28 August 2013 on matters concerning representation before the EPO (OJ 2013, 535).

As explained in **J 8/10** (OJ 2012, 470), the EPO keeps a list of associations of representatives as an internal working tool which it does not publish.

In **J 16/96** (OJ 1998, 347) the EPO Legal Division had informed a company X that its patents department could not be registered as an association of representatives. Such an association meant one consisting solely of professional representatives in private practice. The Legal Board concluded that there was no basis in the EPC for the EPO's practice of restricting R. 101(9) EPC 1973 (now R. 152(11) EPC) to professional representatives "in private practice". An **association** within the meaning of that provision could therefore **also** be formed by **professional representatives not in private practice**. There was no reason to interpret the term "association of representatives" in a way which limited its meaning. (**J 16/96** cited on this point in **T 656/98**). As mentioned in the introduction to this point, Decision CA/D 9/13 endorsed the Legal Board's interpretation in **J 16/96**.

Case **J 8/10** (OJ 2012, 470) was about whether legal practitioners too could belong to associations of representatives under R. 152(11) EPC. The board interpreted R. 152(11) EPC as referring to an association of professional representatives. Therefore, legal practitioners were not covered by the legal fiction of R. 152(11) EPC (see also **T 1846/11**).

4.5. Termination of authorisation

According to R. 152(8) EPC, a representative is deemed to be authorised until the termination of his authorisation has been communicated to the EPO.

In **T 578/14** the board stated that if, or for as long as, the termination of an authorisation was not communicated to the EPO, the authorisation remained effective vis-à-vis the EPO even though, the contract between the party and its representative had been dissolved, or the party had – vis-à-vis the representative – revoked the authorisation that it had given him. In the case of a change of representative involving professional representatives, the provisions of Art. 1(2) of the decision of the President of the EPO (OJ SE 3/2007, 128, L.1.) also apply, i.e. usually either the termination of the authorisation of the previous representative is communicated to the EPO or the new representative files an individual authorisation (original and one copy) or a reference to a general authorisation already on file. In view of R. 152(8) EPC and the decision of the President, the responsibility for informing the EPO about the termination of the contract between a party and its representative before the EPO lies with the represented party, irrespective of whether or not it has its residence in an EPC contracting state, or with its representative. It is only when the EPO receives such information that it might have to determine on the basis of the documents filed whether a contract between a party to the proceedings before the EPO and its representative has indeed been terminated. The board added that informing the EPO about an intention to change the representative could not be equated with a clear withdrawal of an authorisation under R. 152(7) EPC or with the communication of the termination of the authorisation as mentioned in R. 152(8) EPC. Both cases concern a procedural declaration which in the interest of legal certainty has to be unambiguous.

5. Oral submissions by an accompanying person

5.1. Enlarged Board's landmark decision G 4/95

In **G 2/94** (OJ 1996, 401) and **G 4/95** (OJ 1996, 412), the Enlarged Board answered questions referred to it in **J 11/94** (OJ 1995, 596) and **T 803/93** (OJ 1996, 204) as to whether, and if so in what circumstances, a person not qualified to act as a representative before the EPO (an "accompanying person") might make oral submissions on either legal or technical issues on a party's behalf during oral proceedings under Art. 116 EPC 1973 in ex parte or inter partes proceedings.

According to the decision **G 4/95** oral submissions by an accompanying person in opposition or opposition appeal proceedings cannot be made as a matter of right, but only with the permission and at the discretion of the board. According to the decision **G 2/94** a board of appeal has a discretion to allow an accompanying person to make submissions during oral proceedings in ex parte proceedings, in addition to the complete presentation of a party´s case by the professional representative.

In **G 4/95** the Enlarged Board noted that the appointment of a professional representative by a party involved the authorisation and identification of the professionally qualified person who was responsible for the presentation to the EPO of all submissions made by

the party. Such presentation of a party's case was the essential core of the function of a professional representative under Art. 133 EPC 1973. During oral proceedings, a professional representative was expected to present the entire case of the party that he or she represented.

As to the presentation of **facts or evidence** by an accompanying person, the Enlarged Board held that such oral submissions during oral proceedings – in addition to the complete presentation of the party's case by the professional representative – are not excluded under the EPC. They may be allowed under the overall discretionary control which the EPC gives to the EPO with respect to the filing of facts and evidence.

As to the question whether an accompanying person may make oral submissions during oral proceedings by way of **argument**, the Enlarged Board pointed out that Art. 133 EPC 1973 made no distinction between written and oral proceedings in connection with the requirements for representation. Thus a professional representative was responsible for all written and oral submissions made on behalf of the party who had appointed him.

The Enlarged Board further held that such oral submissions could not be made as a matter of right, but only with the permission of and at the discretion of the EPO. The following **criteria** should be considered by the EPO when exercising its discretion:

(i) The professional representative should request permission for such oral submissions to be made. The request should state the name and qualifications of the accompanying person and should specify the subject-matter of the proposed oral submissions.

(ii) The request should be made sufficiently in advance of the oral proceedings so that all opposing parties are able properly to prepare themselves in relation to the proposed oral submissions.

(iii) A request made shortly before or at the oral proceedings should, in the absence of exceptional circumstances, be refused unless each opposing party has agreed to the making of the oral submissions requested.

(iv) The EPO should be satisfied that oral submissions by an accompanying person were made under the continuing responsibility and control of the professional representative.

5.2. Application of the case law established by the Enlarged Board

5.2.1 Introduction

The decisions reported below show how the criteria established by the Enlarged Board have been applied, both in oral proceedings before the boards and when scrutinising decisions taken by the department of first instance.

In the following cases, the accompanying person was **not authorised** to make oral submissions: **T 334/94** (request not made early enough); **T 1208/06** (inventor not the

proprietor); **T 89/04** (classed as accompanying person – request made just three days before the oral proceedings); **T 2135/08** (no information on experts' qualifications and subject-matter of oral submissions); **T 1706/06** (request not made early enough – consent not given by the other party); **T 302/02** (submissions of the expert of a party on subject-matter not specified in some detail beforehand); **T 1676/08** (examination of the criteria – numerous procedural points raised); **T 2552/11** (insufficient information to enable other party to prepare); **T 520/07** (request made during oral proceedings – same submissions by same person at first instance – appeal proceedings separate); **T 8/13** (person closely followed the whole case from beginning); **T 484/17** (request not properly substantiated); **T 634/16** (request not made early enough).

In the following cases, the accompanying person was **authorised** to make oral submissions: **T 899/97** (request made early enough in circumstances); **T 475/01** (persons accompanying both parties – one party representing itself); **T 1212/02** (professional representative's colleague – pragmatic approach); **T 754/08** (former patent attorney); **T 1207/06** (presentation of the entire case – not established); **T 919/07** (accompanying persons authorised if contribution relevant to discussion); **T 1458/11** (trainee in professional representative's law firm – objection on appeal to scope of submissions not upheld), **T 661/14** (right to speak on legal issues – no distinction between legal or technical issues)

In **T 2198/15** the board allowed an accompanying person to make oral submissions on specific technical issues. Had permission been refused, it was likely that the respondent would have repeatedly requested that the oral proceedings be interrupted to enable it to consult the accompanying person (see also **T 1212/02**).

In **T 765/21**, by submission shortly (two weeks) before the oral proceedings, the proprietor indicated that Mr. X, an employee of the proprietor, would attend the oral proceedings and requested that he be allowed to make oral contributions as a technical expert at the hearing. In view also of the fact that no request had been made to summon Mr. X under Art. 117(1)(e) EPC and R. 118 EPC, the board concluded that Mr. X should be considered as an accompanying person within the meaning of decision **G 4/95**. As indicated in **G 4/95**, oral submissions by persons accompanying professional representatives but not covered by Art. 117 EPC cannot be made as a matter of right, but only at the discretion of the board. Without any indication of his qualification or the nature of his intended contribution, the request did not meet the criteria in **G 4/95**. And the opponent did not agree.

In the following decisions, the boards held that **G 4/95** did not apply: **T 621/98** (patent proprietor); **T 1687/08** (lawyer).

5.2.2 Trainee patent attorneys

In **T 1431/12**, the reason given for Mr W.'s making submissions was that he was a trainee patent attorney familiar with the case. It was therefore unlikely that his submissions (unlike, for example, an expert's) would go beyond those of a patent attorney specialising in the subject-matter and so would not mean that the appellant would have to commission an expert to counter them. Given those circumstances, the board exercised its discretion to

permit Mr W. to provide any technical information necessary to supplement the submissions made by the professional representative supervising him.

For a classic application of the requirements set out in **G 4/95** to a party's contention that, since the accompanying person was preparing for the European qualifying examination, he ought to be given a training opportunity, see **T 378/08**, in which permission for the person to make oral submissions was refused.

5.2.3 Distinction between party to proceedings and accompanying person

In **T 2036/12**, the opposition division had refused to permit Mr S. to make submissions on the basis that they had to be considered those of a "technical expert". The board rejected its line of argument, observing that **G 4/95** concerned "accompanying persons", i.e. people who were not parties to the proceedings and generally not entitled to make their own submissions as a matter of right, whereas Mr S., as the **proprietor's managing director** with the power to sign for it, was a direct party to the proceedings. It made no difference that a professional representative had likewise been present; as a party to the proceedings, he was entitled in his own right to make submissions in support of his case. The opposition division's refusal to permit his submissions was thus a breach of the right to be heard under Art. 113(1) EPC.

In **T 621/98**, during oral proceedings, the board was faced with the question of whether the patent proprietor, who was professionally represented, needed to announce in advance his intention to make submissions during the proceedings, pursuant to **G 4/95**. The board ruled that the patent proprietor was a party to the proceedings and as such was not to be treated as an accompanying person. As a party to the proceedings he had a right to take part in them.

In **T 89/04** Mr D. was a vice-president of the company OpenTV. Since the company ACTV, Inc. was recorded in the Register as the patentee, OpenTV, which was a different legal person, was not a party to the proceedings in accordance with Art. 99(4) and 107, second sentence, EPC 1973. Mr D. was considered to be a person accompanying the representative.

In **T 475/01** the board took the view that neither the EPC nor the above Enlarged Board decision could be held to imply that **a party that represented itself** in proceedings was to be treated differently to a professional representative in respect of oral submissions by accompanying persons.

In **T 754/08**, in the respondent's/patent proprietor's view, since Mr R. was the former patent attorney of the appellant in this case, his submissions would be those of a professional representative. Since he was not authorised to act in the latter function, he should not be allowed to speak during the oral proceedings. The board decided that the conditions set out in the decision **G 4/95** were applicable to **any accompanying person**. Therefore, there was no reason to exclude a former European patent attorney as such. Since the conditions were met the board saw no reason not to allow Mr R. to make oral submissions during the oral proceedings.

In **T 1687/08**, at oral proceedings held before the opposition division on 25 February 2008, the division had refused Mr J permission to speak on behalf of the patent proprietor/ appellant. The board found in the case at issue that the requirements for representation by a legal practitioner were fulfilled, i.e. that the letter dated 16 January 2008 represented an authorisation which established that Mr J was entitled to represent the patent proprietor. The board stated that from the minutes of the oral proceedings and the decision under appeal it was apparent that the opposition division had not considered Mr J to be a legal practitioner under Art. 134(8) EPC. Instead, it had treated him as an accompanying person, and therefore applied the requirements set out in decision **G 4/95**. Since the patent proprietor had requested Mr J's participation in the oral proceedings as a legal practitioner under Art. 134(8) EPC, not as an accompanying person within the meaning of decision **G 4/95**, the division's decision not to allow him to speak had been taken under the wrong legal provision.

In a communication the board in **T 8/13** stated that the request to allow another person who was not a professional representative to make submissions on behalf of the appellant (opponent) during the oral proceedings would not be allowable in view of the conditions set by Art. 134 EPC and having regard to decision **G 4/95**. Ms. L was neither a representative according to Art. 134 EPC nor was she presented as a technical expert to be heard on a technical question. The personal involvement with the case or her relationship to the appellant also did not qualify Ms. L to have made submissions as an accompanying person in accordance with the conditions set out in **G 4/95**.

In **T 1212/02** the board held that an employee of the opponent's holding could make submissions only as a person accompanying its professional representative and so subject to the conditions set out in **G 4/95**, even though he worked alongside the professional representative on the opponent's affairs in the holding's patent department.

5.2.4 Inventor as accompanying person

In **T 1208/06** the inventor was not identical to the patent proprietor. The board held the opposition division to have acted correctly by categorising the inventor as an "accompanying person" and not as a party to the proceedings within the meaning of Art. 99(3) EPC and by rejecting the proprietor's request.

The board in **T 1150/12** agreed to hear the inventor as an accompanying person, if necessary to supplement the professional representative's submissions. It was anyway bound to treat an inventor's submissions or comments just as impartially as it would the naturally one-sided submissions made by the parties' representatives.

5.2.5 Name, qualifications and subject-matter to be specified

Professional representatives must request permission for oral submissions to be made by an accompanying person, stating that person's name and qualifications and specifying the subject-matter of the proposed oral submissions.

In **T 1668/14** the board considered that **G 4/95** did not deal explicitly with the question of whether an accompanying person may ever be allowed to speak on matters other than those previously notified. However, the fact that the EPO has a discretion to decide that a proposed accompanying person may not be heard at all suggests that such discretion extends also to the nature of the submissions to be permitted. The board therefore judged, in the case in hand, that it fell within the discretion of the EPO to decide whether an accompanying person might be allowed to speak on matters other than those previously notified, and that this discretion was to be exercised taking into account the facts of the particular case and the principles set out in **G 4/95**. Permission should only be granted where it is clear that it would not unexpectedly disadvantage the opposing party.

Concerning the admissibility of oral presentations by three technical experts, the board in **T 2135/08** concluded that none of the three criteria i), ii) and iii) of **G 4/95** were met, among other reasons since the requesting party had failed to state -even at the oral proceedings- the qualifications of these three persons and to specify the subject-matter of their proposed oral submissions.

The board in **T 302/02** did not allow the expert to make submissions. If an expert were allowed to make submissions on subject-matter not specified in some detail beforehand, the other party or parties would be placed at a disadvantage since they could not prepare themselves properly, and this would be against the spirit and purpose of decision **G 4/95** and should only be permitted if none of the parties to the proceedings objects.

In **T 2552/11**, the board did not permit oral submissions from Mr J. The statement by the appellant (opponent) that Mr. J would "refer to the prior art documents cited by the opponent" was very general, and not sufficient to enable the respondent (patent proprietor) to prepare itself properly.

In **T 919/07**, where the requests in writing concerning oral submissions by accompanying persons did not indicate what such submissions could contribute to the evidence on the file, the board exercised its discretion by deciding that the accompanying persons should be heard in the event that the board wished to ask them questions.

In **T 1624/20** the minutes of the oral proceedings before the opposition division mentioned that the appellant (opponent) had objected to Mr S.'s right to speak, citing the **G 4/95** criteria as a basis. The opposition division, however, had allowed it, likewise relying on the **G 4/95** criteria. In particular, it had considered that there was adequate information about Mr S.'s qualifications in the respondent's request, which described him as "an inventor and research engineer, expert, employee of C-TEC Constellium Technology Center". In its view, it was not essential to specify his academic qualifications. The board agreed that **G 4/95** did not impose any obligation to specify academic qualifications or experience in the industry or to provide a curriculum vitae. The appellant had therefore failed to adduce convincing evidence that the opposition division had not exercised its discretion in accordance with the right principles or exercised it in an unreasonable way, and so exceeded the proper limits of its discretion. The board further considered that whether Mr S. belonged to the company of the respondent's representative (as opposed to the respondent's company) was irrelevant in this connection.

In **T 2112/22**, the representative had requested that an accompanying person, who was a partly qualified German patent lawyer (Patentassessor), be allowed to make oral submissions. The board noted that the person in question was not on the list of professional representatives before the EPO, and although they were indeed a Patentassessor, they were not a legal practitioner qualified in a contracting state within the meaning of Art. 134(8) EPC. Nor were they an expert in the particular technical field. The board pointed out that making oral submissions was not a right. Further, an accompanying person was not entitled to present all or most of the essential submissions in place of a representative unless there were special circumstances to justify that, such as the training of a future professional representative. The board, in the exercise of its discretion, had taken into account that the request had been made in good time and that the name and qualification of the person had been provided, but that the subject-matter of the submissions had not been specified in any concrete way. In the end, the board had given the floor to the accompanying person during the oral proceedings in so far as it had deemed it necessary to supplement the representative's presentation.

5.2.6 Oral submissions to be requested sufficiently in advance

Any request should be made sufficiently in advance of the oral proceedings to enable all opposing parties to prepare themselves properly for the proposed submissions.

In **T 334/94** the board emphasised that a party wanting such submissions to be made had to ask permission sufficiently in advance of the oral proceedings to give the other parties time to prepare. The board noted that the Enlarged Board had not defined what "sufficiently in advance" meant, or laid down a deadline for making such requests. In its view, the **deadline of one month** before the proceedings for filing submissions or new sets of claims was a minimum. On that basis, nominating an accompanying expert one week before the proceedings was not acceptable.

In **T 899/97** the appellant (opponent) requested that a technical expert be allowed to speak during the oral proceedings in order to explain the physical phenomena that occurred when a prior art separator was used. Pointing out that the relevant letter from the appellant had reached him only two weeks before the oral proceedings, and referring to **G 4/95** and **T 334/94**, the respondent requested that this technical expert be refused permission to speak. The board considered the particular circumstances of the case, i. a. that this technical expert was one of the authors of the test report (R2) filed by the appellant with the statement of grounds, that the board had raised some questions on this specific technical issue in the annex to the summons to oral proceedings, and that these technical issues had already been discussed before the department of first instance. With these circumstances in mind, the board held that the appellant's request that the technical expert be heard had been submitted sufficiently in advance of the oral proceedings.

In **T 634/16** there was still just over a month to go before the date of the oral proceedings when the appellant (patent proprietor) requested permission for an accompanying person to make oral submissions, but the festive holiday period fell in the time in between. The respondents (opponents) argued chiefly that they had been unable in the short time available between receiving the letter with the appellant's request and the start of that

general holiday period and then until the date of the oral proceedings to find technical experts who would have been able to help their representatives to refute the arguments made in any such oral submissions. The board considered it plausible that this had made it at least very difficult to prepare any defence against the oral submissions, it being unknown what technical matters they would cover as those announced by the appellant in its letter had been vague. Since there were no exceptional circumstances that might have served as justification, the board therefore refused to allow the oral submissions.

The board in **T 89/04** refused a request that an accompanying person be permitted to make oral submissions as it had been filed only three days before the opposition proceedings.

5.2.7 Exceptional circumstances

Save in exceptional circumstances, a request made shortly before or at the oral proceedings should be refused unless each opposing party has agreed to the making of the oral submissions requested.

In **T 520/07** the board did not share the respondent (patentee's view) that the appellant could not be surprised by its request, the same accompanying person having already made submissions in oral proceedings before the opposition division. In all procedural matters, appeal proceedings were completely separate from first-instance ones, so requests made in the latter had no effect for the former.

The board in **T 953/21** considered that, of the criteria established in **G 4/95**, criteria (i) and (iv) were met, and so the remaining issue was the timing of the request made by the appellant (patent proprietor) (criteria (ii) and (iii)). On that issue, it found that Ms B was only to respond to new technical arguments that might be submitted by the opponent at the oral proceedings. Hence no specific oral submissions were proposed which would have required time for the opponent to properly prepare themselves. In these exceptional circumstances, the board saw no reason to refuse the patent proprietor's request that Ms B be allowed to make oral submissions as accompanying person at the oral proceedings, even though the request had been filed only shortly before the oral proceedings.

5.2.8 Professional representative's responsibility

The EPO must be satisfied that an accompanying person's oral submissions were made under the continuing responsibility and control of the professional representative.

In **T 1027/13**, on the day of the first-instance oral proceedings, the chair had categorically forbidden Mr H (accompanying person) to address the opposition division and to communicate with Mr W (representative), apparently under the impression that Mr H had not only been present to make submissions regarding some specific legal or technical points, but had actually been **intending to present the complete case** in place of the **newly appointed representative** Mr W. The patent proprietor and the opposition division had concluded that Mr H was trying to act as the representative of the opponent, thereby circumventing the provisions of Art. 133 and 134 EPC. The patentee also contested that

there was proper control and supervision by Mr W since he had declared that he was not prepared to defend the case in oral proceedings. The board stated that as a consequence of this conduct of the oral proceedings, the representative of the opponent appeared to have been totally deprived of any support he was expecting to get from the announced accompanying person Mr H, i.e. a person very familiar with all aspects of the case from its very beginning. The categorical refusal in effect had been keeping the opponent from taking position in an "efficient and effective manner" on the contentious issues of the case, which would also have included the obviously very important supporting oral contributions by Mr H.

In case **T 1458/11** appellant 2 (patent proprietor) was represented by a professional representative, Mr Ch, accompanied by Mr H, a **trainee in the law firm** of Mr Ch. Mr H had not been announced prior to the oral proceedings before the opposition division. Appellant 2 requested that Mr H be allowed to speak "on selected issues during the oral proceedings under his (Mr Ch's) supervision and responsibility". Appellant 1 (opponent) agreed to this with the proviso that Mr H would "not make the complete case". The opposition division allowed this. After the impugned decision was pronounced, appellant 1 submitted that, according to its observations, Mr H had spoken "for more than 50% of the time" and that this was not what had been agreed at the beginning of the oral proceedings. It was incumbent on appellant 1 to inform the opposition division of any alleged negligence of the opposition division's duty as soon as it became aware of it. This immediate reaction was required since a party to the proceedings must take an active part and must on its own initiative submit in due time whatever will support its position (see **R 2/08**). Furthermore, nothing indicated that appellant 1 was taken by surprise or that it was not prepared, or at least could not have been prepared, for the oral submissions made by the accompanying person.

5.2.9 Procedural objection under R. 106 EPC

In **R 3/08** the question arose whether an accompanying person can validly raise a procedural objection pursuant to R. 106 EPC. However, in the circumstances this question did not need to be answered since, based on the affidavit of Mr S.L., it was credible that the professional representative himself explicitly supported his procedural objections. Even if, in the absence of further evidence, the exact circumstances of the representative's intervention was not established, the board was prepared to assume in favour of the petitioner that the objections raised in that phase of the oral proceedings met the requirements of R. 106 EPC.

5.3. Oral submissions by former members of the boards of appeal

In **J 11/94** (OJ 1995, 596) the authorised representative was accompanied during oral proceedings by a former chair of the Legal Board who had retired about a year and a half previously. The professional representative requested permission for the former board member to make submissions in addition to his own arguments. The case referred to the Enlarged Board therefore encompassed the question whether special criteria applied to the exercise of a board's discretion in relation to a request for the making of additional oral submissions by a former board of appeal member.

The Enlarged Board noted in **G 2/94** (OJ 1996, 401) that there was a potential conflict between what might be seen as a right of former board of appeal members to seek subsequent employment on the basis of their special knowledge by making oral submissions during proceedings before the EPO, and the need for proceedings before the EPO to be conducted free from any suspicion of partiality. The existence of such a potential conflict was well recognised in the context of national judicial systems where it was clear that persons accepting appointments as judges were subject to restrictions if they wished to work in private legal practice after having served as judges. The Enlarged Board concluded that the above potential conflict had to be resolved with a view to avoiding any suspicion of partiality during the conduct of proceedings before the EPO. The public interest in the proper conduct of proceedings before the EPO had to prevail over the personal interests of former board of appeal members who wished to make oral submissions on behalf of parties to the proceedings.

It was therefore necessary to place **restrictions** on the admissibility of such oral submissions, at least for a reasonable period of time following termination of a person's appointment as a member of a board of appeal. In the absence of specific legislation, the point in time following termination of his or her appointment after which a former member of the boards of appeal might make oral submissions in proceedings before the board of appeal was **a matter within the judicial discretion** of the boards of appeal. The Enlarged Board found that during either ex parte or inter partes proceedings, a board of appeal should refuse permission for a former member of the boards of appeal to make oral submissions during oral proceedings before it, unless it was completely satisfied that **a sufficient period of time** had elapsed following termination of such former member's appointment to the boards of appeal, so that the board of appeal could not reasonably be suspected of partiality in deciding the case if it allowed such oral submissions to be made.

After **three years** have elapsed, permission should be granted except in very special circumstances.

T 585/06 dealt with the presence of a former member of the boards of appeal at the oral proceedings before the opposition division and acting as consultant of the patent proprietor. The former member had not acted as an authorised representative but only as the patent proprietor's consultant. He had not addressed the opposition division. This amounted to an important difference from the facts of case **G 2/94**.

5.4. Oral submissions by qualified patent lawyers of non-EPC contracting states

Another question of law decided in **G 4/95** was whether, having regard in particular to the provisions of Art. 133 and 134 EPC 1973, a person who was not qualified in accordance with Art. 134 EPC 1973 but was a qualified patent lawyer in a country which was not an EPC contracting state might present some or all of a party's case as if he were qualified under Art. 134 EPC 1973. The Enlarged Board decided that no special criteria applied to the making of oral submissions by qualified patent lawyers of countries which were not contracting states to the EPC. The criteria set out above were equally applicable to such patent lawyers (see **T 774/05** with respect to "US patent attorney").

In case **T 756/09**, the request for oral submissions by Dr M, an Australian patent attorney, was made only ten days before the oral proceedings and the appellant (opponent) had denied its agreement both in writing and at the beginning of the oral proceedings. In support of its request, the respondent (patent proprietor) essentially submitted that Dr M would not make submissions in the capacity of a technical expert, but as a patent attorney who was very familiar with the case, had advised the professional representative before the oral proceedings and would continue to do so during the oral proceedings. Taking into account the circumstances of the case, in particular that Dr M was not a technical expert and thus was **not** expected to elaborate on technical aspects of the case in a manner which might take the appellant **by surprise**, the board concluded that submissions made directly by Dr M under the supervision of the professional representative would not put the appellant (opponent) at a disadvantage and might contribute to an efficient debate. Hence, despite its late filing, the board decided to accede to the respondent's request for oral submissions by an accompanying person with the proviso that such submissions would be stopped if new technical facts or arguments were introduced into the debate.

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In accordance with Art. 10(2)(a) EPC, the President of the EPO adopted, effective as at 1 June 1978, the Guidelines for Examination in the EPO. Since the decision of the President dated 28 July 2015 the Guidelines have been amended pursuant to Art. 10(2) EPC in accordance with the policy of revising them annually. The latest version of the Guidelines is the April 2025 edition. There is now greater user involvement in

drafting new editions. The section of the EPO website devoted to the Guidelines presents the steps in their revision cycle, along with useful documentation on the topic that has likewise been made available online. The revised April 2025 edition of the Guidelines entered into force on 1 April 2025 and supersedes the March 2024 edition. It is available online at *www.epo.org*. Notices giving general information about the changes made in each revision round are published in the OJ: for the November 2015 version, in OJ 2015, A74; for the November 2016 version (the last version published as a hard copy), in OJ 2016, A76; for the November 2017 version, in OJ 2017, A75; for the November 2018 version, in OJ 2018, A73; for the November 2019 version, in OJ 2019, A80; for the March 2021 version, in OJ 2021, A6; for the March 2022 version, in OJ 2022, A10; for the March 2023 version, in OJ 2023, A6; for the March 2024 version, in OJ 2024, A9; and for the April 2025 version, in OJ 2025, A4. Please note that the Guidelines do not constitute legal provisions. For the ultimate authority on practice at the EPO it is necessary to refer firstly to the EPC itself, including the Implementing Regulations, and secondly to the interpretation put upon the EPC by the boards of appeal and the Enlarged Board (Guidelines General Part, 3 – April 2025 version). With the exception of important aspects relating to interlocutory revision, the appeals procedure is not dealt with in the Guidelines (Guidelines General Part, 5 – April 2025 version).

Article 20(2) RPBA (OJ 2019, A63, unchanged in the consolidated version in OJ 2024, A15), just like Art. 20(2) RPBA 2007 before it, stipulates that: "If, in its decision, a Board gives a different interpretation of the Convention to that provided for in the Guidelines, it shall state the grounds for its action if it considers that this decision will be more readily understood in the light of such grounds."

It should be borne in mind that the edition of the Guidelines referred to in the following abstracts of board decisions is that applied by the board in question and may have been worded differently from the April 2025 version. The various different editions of the Guidelines are archived at *epo.org/en/legal/guidelines/archive*.

1. Guidelines not binding on boards

The Guidelines for Examination are not binding on the boards of appeal.

In **T 1561/05** the board confirmed that the Guidelines were not binding on the boards of appeal (applying **T 162/82**, OJ 1987, 533). **T 1561/05** of 17 October 2006 is also referred to in **J 7/10**.

In **T 740/98** the board noted, among other things, that the legal system established under the EPC did not treat the Guidelines as binding.

In **T 1063/06** (OJ 2009, 516), the board held that the appellant could not successfully rely on the Guidelines to support its right to a functional definition of chemical compounds before the boards. It could be left open whether or not the appellant's contentions with respect to the Guidelines' content were correct, because the Guidelines were issued by the President of the EPO and had no normative binding effect on the boards of appeal (with reference to **T 162/82** and Art. 23(3) EPC).

In **T 1356/05** the board stated that no provision of the Guidelines could override an article or rule of the EPC (see also **T 1360/05**, and **T 861/02**, in which the board, while noting the advice in the Guidelines on decisions consisting of references to communications, stated that R. 68(2) EPC 1973 (R. 111 EPC) must always be complied with).

In **T 500/00** the appellant argued that the disclaimer had been made in good faith according to the Guidelines and in accordance with the practice of the boards of appeal at the time of making the disclaimer. The board pointed out that the Guidelines were not rules of law and noted that what counted was not whether the opposition division had acted in accordance with the Guidelines, but whether it had acted in accordance with the EPC.

As to the alleged lack of consistency between what was in fact the established case law and the Guidelines, the board in **T 1741/08** noted that it was not bound by the Guidelines, an important factor in the judicial independence of the boards of appeal (Art. 23(3) EPC). An alleged divergence between the Guidelines and case law therefore could not be a sufficient basis for challenging the case law by means of a **referral** to the Enlarged Board. Decision **T 438/22** also stated that a referral to the Enlarged Board whose sole purpose was to correct the Guidelines and which was not necessary either for ensuring uniform case law within the boards or for the board's decision was not admissible. Such a referral could be perceived as an attempt to encroach on the President's powers under Art. 10(2)(a) EPC (Catchword and point 8.2.2 of the Reasons).

In **T 1363/12** the board stated that it is to be noted that the principles established by the Enlarged Board for the assessment of the requirement of Art. 123(2) EPC could not be changed **by issuing amended Guidelines**.

In ex parte case **T 1090/12**, the appellant drew the attention to the Guidelines G-VII, 3.1 – November 2016 ("an assertion that something is common general knowledge need only be backed by documentary evidence (for example, a textbook) if this is contested") and submitted that this passage was binding on the boards of appeal when exercising the power of the examining division. The appellant requested the referral of the following question to the Enlarged Board: "To what extent is a Board of Appeal, when exercising power within the competence of the first-instance department which was responsible for the decision appealed under Art. 111(1) EPC, subject to the same constraints on that power as the first-instance department, such as the duty to follow the Guidelines?". The board refused this request and stated that the Guidelines are not part of the EPC (see Art. 164(1) EPC 1973) and therefore cannot be binding upon the members of the boards of appeal (see Art. 23(3) EPC 1973).

In **T 246/22**, on the question what was meant by "**admissibly raised**" (Art. 12(4) RPBA) before the opposition division, the board said that one viable approach would see a board slip into the shoes of the opposition division. That board would then have to infer, from its perspective, how the opposition division should have exercised its discretion on the basis of the applicable procedural basis, e.g. in view of the current Guidelines. However, one of the possible consequences of that approach could arguably be that the boards would have to closely monitor the currently applicable Guidelines to derive guidance as to how the opposition division concerned should have exercised discretion. Another reason this

approach failed to convince the board was that the Guidelines are not binding on the boards and the RPBA are approved and adopted specifically to govern the proceedings before the boards. The board proposed another approach (See also for an assessment made independently of the Guidelines: **T 1135/22**, **T 506/23**). Compare further on the topic interpretation of "admissibly raised" based on the applicable Guidelines with: **T 364/20**, **T 1800/20**, **T 446/22**, **T 731/22**, **T 924/22**, **T 1178/23**.

The board in **T 364/20** (request admissibly raised and maintained) deviated from the Guidelines E-VI, 2.1 and E-VI, 2.2.2 – 2023 version.

The fact that the Guidelines are not binding on the boards of appeal does not mean that the boards do not apply them or quote them as a source of inspiration (see in this chapter III.W.3.).

2. Guidelines binding (in principle) on departments of first instance

The Guidelines state (General Part, 3 – April 2025 version): "The Guidelines cannot cover all possible occurrences and exceptions in every detail, but must be regarded as general instructions that may need to be adapted to the individual case. The application of the Guidelines to individual European patent applications or patents is the responsibility of the formalities officers and examiners. As a general rule, parties may expect the EPO to act in accordance with the Guidelines. It should be noted also that the Guidelines do not constitute legal provisions. For the ultimate authority on practice in the EPO, it is necessary to refer firstly to the European Patent Convention".

In **T 647/93** (OJ 1995, 132) the board stated that it was normally desirable for examining divisions to act in accordance with the Guidelines, but pointed out that these were not rules of law, so failure to follow a procedure set out in them was not in itself a substantial procedural violation (**T 51/94**, **T 937/97**).

In **T 162/82** (OJ 1987, 533) and **T 42/84** (OJ 1988, 251), two boards of appeal ruled on the discretionary power of examining divisions to depart from the Guidelines. According to these two decisions, the Guidelines were only general instructions intended to cover normal occurrences. Thus, an examining division could depart from them provided it acted in accordance with the EPC. In reviewing the decision of an examining division, a board of appeal would wish to ensure uniform application of the law and judge whether the division had acted in accordance with the EPC, not whether it had acted in accordance with the Guidelines.

In **T 500/00** the board noted that what counted was not whether the opposition division had acted in accordance with the Guidelines, but whether it had acted in accordance with the EPC.

In **T 1388/10**, the board observed that the Guidelines merely offered general guidance covering normal occurrences. Their application in specific individual cases was the responsibility of the examining division, which could depart from them in exceptional cases. Also, the Guidelines were not the law – unlike the EPC and its Implementing

Regulations. When reviewing examining division decisions, the boards did not assess whether the division had complied with the Guidelines. Rather, they considered whether it had exercised its discretion within the limits set by the EPC and its Implementing Regulations.

In **J 27/94** (OJ 1995, 831) the board stated that there might be cases in which the public had a legitimate expectation that the department of first instance would not deviate from the established case law. This might apply if the relevant case law had become enshrined in the consistent practice of the department of first instance, and in particular if this had been made known to the public in published Guidelines, legal advice or notices from the EPO. In such a situation, an applicant might legitimately expect that a practice allowing or even recommending a particular way of proceeding would not be changed without appropriate advance information. In the case at issue, the Guidelines had remained unchanged, which in fact led to the reasonable expectation that the practice based on them would likewise not be changed.

The board in **T 1607/08** recalled that the Guidelines were one of the sources of legitimate expectations. Therefore, where the Guidelines gave the clear indication that the continuation of the opposition proceedings had to be communicated to the patent proprietor, the latter was entitled to expect that such information would be given before a decision on the substantive issues was issued. Otherwise, as in the case at issue, the decision to revoke the contested patent would come as a surprise to the patent proprietor.

In **T 182/90** (OJ 1994, 641), **T 119/91**, **T 523/91**, **T 366/92** and **T 397/94** the boards of appeal stated that it was **not** a substantial procedural violation within the meaning of R. 67 EPC 1973 (R. 103 EPC) if a request to be called back by or have an interview with the primary examiner was ignored. It was a matter for the examiner's discretion to decide whether to conduct such informal discussions in accordance with the Guidelines, bearing in mind the particular circumstances of the case (see also **T 300/89**, OJ 1991, 480).

The examining division's failure to follow a procedure set out in the Guidelines is not in itself a substantial procedural violation unless it also constitutes a violation of a rule or principle of procedure governed by an article of the EPC or one of the Implementing Regulations. This is because the Guidelines are not legally binding (**T 42/84**, OJ 1988, 251; **T 51/94**; **J 24/96**, OJ 2001, 434).

In **T 246/08** the board saw, in the particular circumstances of the case, the examining division's deviation from the Guidelines as a matter for approval rather than reproach.

In **T 313/10** the examining division had argued, using their own criteria, that a method performed by a computer was excluded. This was contrary to the established jurisprudence as set out in the Guidelines.

In **T 1020/15** the board cited, in addition to applicable EPC provisions, numerous passages from the Guidelines in support of its finding that the examining division's decision was vitiated by four substantial procedural violations.

According to the board in **T 755/14**, contrary to the appellant's view, although the search and examining divisions had failed to follow the procedure established in the Guidelines for considering unity, their substantively incorrect assessment of the unity issue could not be regarded as or equated to a substantial procedural violation within the meaning of R. 103(1) EPC, especially as the Guidelines were not legally binding. The board was also unable to identify any substantial procedural violation in the action then taken by the examining division.

In **T 679/14**, the board found, in line with the Guidelines (regarding postponements at the instigation of the division; see Guidelines E-III, 7.1.2 – April 2025 version), that it is unacceptable to repeatedly postpone oral proceedings without serious reasons, especially if it is done several times in the same examination proceedings after long delays have already occurred. In the case in hand, although the individual delays caused by the (eight) postponements were short, the examining division had acted against the interests of procedural efficiency, at the same time as ignoring clear rules given in the Guidelines to avoid such delays.

In **T 1655/21**, in relation to a request for acceleration of the opposition proceedings after remittal, the board drew the opposition division's attention to the instructions in the Guidelines D-VII, 1.2. – March 2024 version.

In **T 2240/22**, ruling on the opposition division's exercise of its discretion in relation to changing its position on novelty, as compared with its preliminary opinion, at the oral proceedings, the board cited the Guidelines (E-VI, 2.2.2, last bullet point, – March 2024 version) and stated that the opposition division appeared to have taken the right approach.

See also **T 1946/21** in chapter III.A.3.7.

3. The boards' application of the Guidelines in specific cases

Although the boards are not bound by the Guidelines, this does not mean that they do not take them into account or turn to them for inspiration when reaching their decisions. It should be borne in mind that the edition of the Guidelines referred to in the decisions summarised below to illustrate the related case law is that applied by the board in the specific case concerned and not necessarily that currently in force (April 2025 version).

In **T 651/91** the board cited with approval the Guidelines, confirming that a generic disclosure did not normally deprive any specific example falling within that disclosure of novelty.

In **T 523/89** the board saw no reason to disagree with the general principle of interpretation laid down in the Guidelines.

In **T 631/97** (OJ 2001, 13) the board found that the interpretation of R. 46(1) EPC 1973 (R. 64 EPC) was in agreement with that of the Enlarged Board in Opinion **G 2/92**. It also found that the Guidelines were fully consistent with **G 2/92** and R. 46 EPC 1973.

In **T 587/98** (OJ 2000, 497) the board found that the claims were not "conflicting" claims within the meaning of the Guidelines.

The Enlarged Board in **G 3/14** (OJ 2015, A102) observed that neither the EPC itself nor the Implementing Regulations made any distinction between independent and dependent claims when it came to their compliance with the requirements of the EPC at the examination stage. Although not part of the express legal framework of the EPC, the Guidelines likewise made no distinction between independent and dependent claims when it came to objections of lack of clarity (Guidelines F-IV, 4.1, – November 2014 version).

In the ex parte case **T 655/13** (examining division's reasoning based on a pertinent prior art document in a non-official EPO language), the board based its reasoning partly on the Guidelines.

In **T 300/89** (OJ 1991, 480) the board held, in relation to the appellant's complaint as to the failure of the examiner to telephone as requested, that the practice in relation to such informal communications was clearly set out in the Guidelines.

The applicant's request "to render a decision on the record" was not to be construed as a waiver of the right to a fully reasoned first-instance decision, even in the light of the suggested procedure in the Guidelines (see **T 1309/05**, **T 1356/05**, **T 583/04**). In **T 1709/06** the board noted that although the Guidelines E-X, 4.4, suggested a procedure for issuing a decision "on the state of the file" taking a standard form, a number of decisions of the boards of appeal had pointed out that such a standard decision form did not meet the "reasoned" requirement of R. 68(2) EPC 1973 (R. 111(2) EPC).

In **T 1123/04** the board noted that R. 68(2) EPC 1973 (R. 111(2) EPC) stipulated that decisions of the EPO which were open to appeal had to be reasoned. The criteria for the "reasoning" were, for instance, elaborated in the Guidelines.

In **T 2068/14** the board had to consider whether the decision of the examining division was adequately reasoned. The board endorsed the following statement in the Guidelines, as it reflected the jurisprudence of the boards of appeal: "It is particularly important that special attention should be paid to important facts and arguments which may speak against the decision made. If not, the impression might be given that such points have been overlooked" (Guidelines E-IX, 5 – September 2013 version then applicable; idem Guidelines E-X, 2.6 – April 2025 version). The board in **T 1998/10** (use of standard form) backed up its reading of the R. 111(2) EPC provision on the need to give reasons for decisions by referring to the same section of the Guidelines E-IX, 5, according to which the reasons given in a decision should be "complete and independently comprehensible, i.e. generally without references".

In **T 833/99**, which concerned a number of alleged prior uses, the board observed that, contrary to what the appellant (opponent) had argued, it was not the conditions set out in the first paragraph of Guidelines D-V, 3.1.3.1 (later covered in G-IV, 7.2.1 – for example in the April 2025 version) that applied but those in the last sentence of the final paragraph (in G-IV, 7.2.1 – April 2025 version: "... however, any concealed features which could be

ascertained only by dismantling or destroying the object cannot be regarded as having been made available to the public.").

The board in **T 2362/13**, referring to the Guidelines G-II, 3.5.3 – November 2019 version, and **T 983/11**, stated that logistics was generally considered to fall within the categories of excluded matter in Art. 52(2) EPC.

In **J 12/18** the board found that the reasoning in the appealed decision and the Guidelines cited there (Guidelines A-IV, 1.3.4) were in line with its interpretation of Art. 76(2) EPC (reached in accordance with recognised rules of interpretation).

In **T 261/15**, in respect of the argument that a selected sub-range has inter alia to be sufficiently far removed from the end-points of the known range, the board pointed out that it was not aware of any jurisprudence stating this condition in such a general way. It was true that the Guideline, G-VI, 8 – November 2017 version, recited under point (ii)(b) this criterion as a condition for acknowledging novelty of a numerical selection. However, neither decision **T 198/84** nor **T 279/89**, which are cited in this passage of the Guidelines, stipulates this condition.

In interpreting R. 116(1) EPC and deciding whether or not the department of first instance had applied it correctly, the board in **T 1750/14** applied a literal reading of its provisions in conjunction with those of R. 132(2) EPC, as found in the Guidelines D-VI, 3.2 – September 2013 version, last sentence.

In **T 2431/19**, the examining division had invoked R. 137(5) EPC as a basis for exercising discretion. The board was aware that the Guidelines used terminology relating to "admittance" in connection with R. 137(5) EPC (see Guidelines F-IV, 3.3 – November 2018 version, fourth paragraph: "such amendments may not be admitted"; H-II, 6.2, third paragraph: "such amendments are not admissible"). However, the board held that R. 137(5) EPC, as opposed to R. 137(3) EPC, did not give the examining division any discretionary power.

In **T 944/15** the board disagreed with the statement in the Guidelines G-II, 4.2.1 – November 2019 version, last paragraph, to which the appellant had referred and which read as follows: "Claims to medical devices, computer programs and storage media which comprise subject-matter corresponding to that of a method for treatment of the human or animal body by surgery or therapy or to that of a diagnostic method practised on the human or animal body are not to be objected to under Art. 53(c) EPC, because only method claims may fall under the exception of Art. 53(c) EPC."

The reasons given in the EPO notice of 8 November 2013 on handwritten amendments for changing a practice that had been applied for years at first instance and was also recognised in the Guidelines do not warrant changing the established practice of the boards of appeal and the related case law (**T 37/12**, citing **T 1635/10**, point 5 of the Reasons).

The board in **T 736/14**, whilst observing that the EPC contains no explicit provisions about how to proceed if an applicant whose application is non-unitary responds unclearly or in a misleading way to an invitation from the examining division to specify which searched invention it wishes to prosecute further, nevertheless found that Guidelines H-II, 7.1 – September 2013 version should not have been applied at all when refusing to admit the auxiliary request, since the applicant had not clearly indicated the invention to be further examined at that stage of the examination proceedings.

The board in **T 2015/20** stated that neither **T 609/02** nor the case law that had developed from that decision signalled a deviation from the established case law or an interpretation differing from the Guidelines F-III, 1 – November 2019 version, in particular with respect to the precondition of serious doubts for a convincing argument of lack of sufficiency.

When dealing with internet disclosures, the boards have referred to the Guidelines (see Guidelines G-IV, 7.5.2 – April 2025 version) and established the balance of probabilities as the applicable standard of proof (**T 2227/11**, **T 1711/11**, **T 353/14**, **T 545/08**). Earlier decision **T 1134/06** that the stricter standard of proof "beyond reasonable doubt" had to be applied to internet disclosures has been refuted by the later case law cited above.

In **T 314/18** the board stated that no provision of the EPC required that an alleged prior use be conclusively proven within the opposition period. When referring to the EPO Guidelines G-IV, 7.2, and E-IV, 1.2, and arguing that the lack of adequate substantiation of the prior use in the notice of opposition could not be overcome by hearing the witness, the opposition division had mixed up the submission of facts and the proof required to establish them.

In **T 967/17** the board decided that, contrary to what had been implied by the appellant, the Guidelines F-IV, 4.14 – November 2019 version, did not state that a claim directed towards a first entity and referring to a second entity that was not part of a claimed first entity could be (re-)directed towards a combination of those two entities. Rather, it had to be verified, for each case individually, whether such a combination fell within the boundaries set by Art. 123(2) EPC.

In **T 879/18** the board concluded, with reference to the Guidelines E-VI, 2.2(a) – November 2017 version, that the opposition division had exercised its discretion unreasonably in not admitting the amended main request (now first auxiliary request) in response to the opponent's fresh objection. The board decided to admit the auxiliary request into the appeal proceedings.

The board in **T 1121/17** stated (in the catchword) that the criteria set out in the Guidelines H-IV, 3.5 – November 2016 version, which concerned the allowability of amendments under Art. 123(3) EPC, were inappropriate for the assessment of compliance with Art. 123(2) EPC.

When examining whether a substantial procedural violation had occurred before the examining division (need for complete and detailed reasoning), the board in ex parte case **T 625/21** stated that **T 763/04** fully applied to the case in hand. Moreover, the reasoning

in **T 763/04** was reflected in the passages of the Guidelines (2019 version) that concerned drafting decisions. Decision **T 625/21** also includes findings on file inspection that were made by reference to the Guidelines, according to which any exchange of emails should be properly documented in the file.

In **T 2486/22**, in relation to allowability of amendments, the appellant referred to the Guidelines (H-IV, 2.2), which state that "the examining division needs to avoid disproportionally focusing on the structure of the claims as filed to the detriment of the subject-matter that the skilled person would directly and unambiguously derive from the application as a whole." The board noted that this statement was based on decision **T 2619/11**. It agreed with the appellant's argument that the examining division, contrary to the guidance given in the aforementioned section of the Guidelines and therefore contrary to decision **T 2619/11**, had relied almost entirely on the claim structure to support the assertion that the combination of features of claim 1 of the main request was not originally disclosed.

In **T 1762/21** the appellant (opponent) argued that a number of essential features had been inadmissibly omitted and that this amounted to an unallowable intermediate generalisation. In its arguments, the appellant cited the Guidelines. The board first set out in detail the "gold" standard for assessing any amendment and then said that the passage in the Guidelines H-V, 3.2.1, concerning intermediate generalisations had to be understood in this context.

As to the interpretation of Art. 109(1) EPC, the board in **T 682/22** pointed out, with reference to Art. 20(2) RPBA, that the case law and the Guidelines (E-XII, 7.4.2) were inconsistent with each other.

In ex parte case **T 3000/19**, which concerned a refusal decision based on prior art consisting of a YouTube video that was no longer accessible on the date of the board's decision, the board stated that the measures recommended in the Guidelines, B-X, 11.6 – November 2018 version, which had been followed by the examining division, were not adequate to preserve relevant electronic evidence and guarantee its accessibility over time.

In **T 727/19** the board observed that the Guidelines E-XI set out the procedure whereby the reasons for a decision by the superior responsible to reject a challenge to the impartiality of a division can be appealed. This procedure did not make the superior's decision formally appealable. The statement in the Guidelines that the reasons for the director's decision "will be part of and appealable together with the final decision" was easy to misunderstand.

In **T 222/21** the board concluded that the examining division, in relying solely on the Guidelines H-II, 2.4, i.e. extensiveness per se, when exercising its discretion, had failed to consider the correct factor, i.e. the time for examination that the amendments might require and thus the potential delay in the preparations for the grant of the patent. The Guidelines H-II, 2.4 had to be read in conjunction with H-II, 2.5.1.

In **T 111/21** the board noted that the examining division's analysis of inventive step was based on mere references to passages of the Guidelines and did not consider whether technical effects might occur within the claimed computer-implemented process by specific adaptations to data transfer or storage mechanisms (see **G 1/19**, point 85 of the Reasons).

In ex parte case **T 1910/20** the appellants' argument on the issue of a mathematical method and building a therapy plan seemed to build on a misleading blanket statement they had cited from the Guidelines. As regards the particular passage of the Guidelines, the board found that, at least at its level of generality ("those steps make a technical contribution regardless of what use is made of the results"), it was wrong.

The board in **T 1741/22** stated in its Catchword that the mere generation of further data from measurement data already collected from the human body was not a technical effect (**T 2681/16** and the Guidelines not followed). Concerning the Guidelines (G-II, 3.3 – March 2024 version), the board in its Reasons further referred to Art. 20(2) RPBA.

IV. PROCEEDINGS BEFORE THE DEPARTMENTS OF FIRST INSTANCE

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1. Introduction

The EPO first examines whether a patent application satisfies the requirements for the **accordance of a date of filing** in accordance with the Implementing Regulations (Art. 80 EPC, Art. 90(1) EPC and R. 40 EPC). Only if an application is accorded a date of filing is the **examination as to formal requirements** commenced (Art. 90(3) EPC).

2. Responsibility for formalities examination

Under Art. 16 EPC, the Receiving Section is responsible for the examination on filing and the examination as to formal requirements of European patent applications. It retains responsibility up to the time when the examining division becomes responsible for the examination of the European patent application under Art. 94 EPC (R. 10 EPC).

The limitation in time of the Receiving Section's responsibility was previously in Art. 16 EPC 1973. The move to the Implementing Regulations ensures greater flexibility in determining when competence passes within the EPO from one department to another.

The Receiving Section is also no longer limited to the EPO's branch in The Hague as it was under Art. 16 EPC 1973. According to **T 1012/03**, the amendments to Art. 16 and 17 EPC deleting the allocation of the search divisions and Receiving Section to the branch at The Hague clearly indicate that the EPC no longer restricts the competence of the President of the EPO to decide which transactions shall be carried out at Munich and which at The Hague.

In **G 1/02** (OJ 2003, 165) the Enlarged Board pointed out that Art. 90 EPC 1973 and Art. 91 EPC 1973 entrusted to the Receiving Section certain duties relating to formalities examination of applications on filing, and that the section's decisions may give rise to a loss of rights (see Art. 91(3) EPC 1973) which are appealable (see Art. 106 EPC 1973). The Receiving Section is composed entirely of formalities officers who – just like their counterparts working with opposition divisions – receive specialist training but are not required to have studied a technical subject or law at university.

In **J 18/84** (OJ 1987, 215) the Legal Board distinguished the respective areas of responsibility of the Receiving Section and the Legal Division regarding the designation of the inventor. It held that the examination of an initial designation of inventor complying with Art. 81 EPC 1973 fell exclusively to the Receiving Section as one of its formalities examination responsibilities under Art. 16 and 91 EPC 1973. (These responsibilities are now in Art. 16 and 90(3) EPC). However, once entries began to be entered in the Register – which under Art. 127, second sentence, EPC 1973 coincided with the publication of the

European patent application – the Legal Board found that the Legal Division would be competent for any disputed corrections.

In **J 13/02**, the Legal Board took the view that the fact that the EPC 2000 versions of Art. 16 to 18 EPC were already applicable in accordance with Art. 6 of the Revision Act did not alter the fact that the Receiving Section's competence came to an end once a valid request for examination had been made with the result that the examining division had to examine whether the application met the requirements of the EPC 1973 (Art. 94(1) EPC 1973 in conjunction with Art. 96(2), 97(1) and 97(2) EPC 1973).

See in this chapter IV.A.5.5.3 for the extent of competence of the Receiving Section vis-à-vis the examining division in respect of requests for correction under R. 139 EPC.

3. Where and how applications may be filed

Under Art. 75 EPC a European patent application may be filed with the EPO or, if the law of a Contracting State so permits, (and subject to Art. 76(1) EPC) with the central industrial property office or other competent authority of that State.

According to **J 3/80** (OJ 1980, 92), the obligation to forward European patent applications filed nationally to the EPO rests upon the relevant central industrial property office and not upon the applicant (see also **J 1/12** in this chapter IV.A.5.1.; see also chapter III.E.2.2. "Re-establishment only in cases of failure to observe a time limit for which it was for the applicant to observe").

The form of filing is governed by R. 2 EPC; it can be by hand, by postal services or by means of electronic communication. Details and conditions are laid down by the President of the EPO.

As from 1 July 2024, European patent applications may not be filed by fax at the EPO. Any transmission of a patent application by fax to the EPO shall be deemed not to have been received (see the decision of the President of the EPO and the notice from the EPO dated 22 April 2024 concerning the abolition of facsimile (fax) as a means of filing patent applications and other documents (respectively in OJ 2024, A41 and OJ 2024, A42)). The decision of the President of the EPO dated 20 February 2019 concerning the filing of patent applications and other documents by facsimile (OJ 2019, A18) applies only to patent applications and documents received by fax at the EPO on and before 30 June 2024.

The filing of European patent applications by other means such as email is not allowed (see the notice dated 12 September 2000 concerning correspondence with the Office via email (OJ 2000, 458)).

4. Persons entitled to file application

A European patent application may be filed by any natural or legal person, or any body equivalent to a legal person by virtue of the law governing it (Art. 58 EPC). An application

may also be filed either by joint applicants or by two or more applicants designating different contracting states (Art. 59 EPC). If the applicants for a patent are not the same for different contracting states they will be regarded as joint applicants in proceedings before the EPO (Art. 118 EPC).

In proceedings before the EPO, the applicant is deemed to be entitled to exercise the right to a European patent (Art. 60(3) EPC). This fiction only relieves the EPO of any need to investigate the existence of the entitlement. Art. 61 EPC deals with the remedies available where a person other than the patent applicant is held to be the person entitled to the grant of a European patent in a final decision by a national court.

In **J 1/23** the board explained that in cases where a final sovereign decision of a national court had determined that a person other than the applicant was entitled to the grant of the European patent under Art. 61(1) EPC, the matter of how and by whom the right to the patent had been acquired was considered and settled by the competent national court, and the EPO was bound by the court's conclusion (Protocol on Jurisdiction and the Recognition of Decisions in respect of the Right to the Grant of a European Patent). The EPO was not competent to examine the substance and merits of the court's decision (**G 3/92**).

The Enlarged Board held in **G 3/92** (OJ 1994, 607) that when it has been adjudged by a final decision of a national court that a person other than the applicant is entitled to the grant of a European patent, and that person, in compliance with the specific requirements of Art. 61(1) EPC, files a new European patent application in respect of the same invention under Art. 61(1)(b) EPC, it is not a pre-condition for the application to be accepted that the earlier original usurping application is still pending before the EPO at the time the new application is filed.

5. Accordance of a date of filing

5.1. Requirements for according a date of filing

The date of filing of the European patent application shall be the date on which the requirements laid down in the Implementing Regulations are fulfilled (Art. 80 EPC, which is applicable to European patent applications filed on or after 13 December 2007). Detailed provisions concerning the requirements have been moved to the Implementing Regulations (R. 40 EPC). The requirements include:

- an indication that a European patent is sought;

- information identifying the applicant or allowing the applicant to be contacted (see in this chapter IV.A.5.2.);

- a description or reference to a previously filed application.

The patent application must be filed with the EPO or other competent authority in accordance with Art. 75(1) EPC.

It is not necessary for the applicant to provide any claims to obtain a filing date. If the application is filed without claims but satisfies all requirements for obtaining a filing date, the applicant will be requested to provide at least one claim later according to R. 57(c) EPC and R. 58 EPC.

Where the description is filed by reference to a previously filed application, the reference must contain the information required in R. 40(2) EPC.

If a date of filing cannot be accorded following the examination under Art. 90(1) EPC, the application is not dealt with as a European patent application (Art. 90(2) EPC).

According to **G 2/95** (OJ 1996, 555), Art. 80 EPC 1973 stipulated the minimum requirements which had to be met in order for a filing date to be accorded. Under Art. 80(d) EPC 1973 (see now R. 40 EPC, which no longer includes this requirement), the documents filed by the applicant had to contain a description and one or more claims (complying with Art. 14 EPC 1973, which was substantially amended in the EPC 2000).

In **J 18/86** (OJ 1988, 165) the Legal Board stated that under R. 24 EPC 1973 in conjunction with Art. 75(1)(b) EPC 1973 the date of filing of a European application was always the date on which the application documents were actually received, either by the EPO directly or by a competent national authority. The Legal Board found that nothing in the EPC 1973 allowed for the possibility of applying a provision of any national law to the determination of the date of filing of a European patent application.

In **J 4/87** (OJ 1988, 172), the Legal Board held that in the event of an unforeseeable postal delay causing non-compliance with a time limit, if R. 85(2) EPC 1973 (relating to general interruption or subsequent dislocation in the delivery of mail in a Contracting State) was not applicable so as to extend the time limit, the EPO had no discretion to extend it. Applying the principles set out in **J 18/86** above, in the case in hand the date of filing was the actual date of receipt by the EPO or a competent national authority. See also **J 13/05**.

In **J 12/05**, the Legal Board, citing **J 4/87** and **J 18/86**, held that the EPC did not permit backdating of the filing date. It went on to state that, even where the conditions for extending the priority period under either R. 84a EPC 1973 or R. 85 EPC 1973 were met, this did not result in a change of the actual filing date. Instead, there arose a legal fiction that the priority period had been observed, even though the filing date was actually later than that period's expiry date.

In **T 382/94** (OJ 1998, 24) the board held that if the drawings were filed in full on the date of filing, they formed part of the application as filed, even if they contained text in an official language other than the language of the proceedings. There was nothing to prevent the application being amended on the basis of a translation of this text into the language of the proceedings. The language requirements for a European patent application were amended under the EPC 2000, see chapter III.F.1. "Language of filing and date of filing of a European patent application".

In **J 1/12** the appellant had filed a European patent application with the UK Patent Office with the same documents as those underlying the later application before the EPO. The application in the UK never reached the EPO. The Legal Board therefore had to consider whether, contrary to Art. 80 EPC 1973, it would be justified to assign the application the earlier filing date (Art. 75(1)(b) EPC 1973). Art. 77(2) EPC 1973 provided that European patent applications filed within the member states were to be forwarded to the EPO within six weeks after filing. Art. 77(5) EPC 1973 supplemented this provision by providing that European patent applications which did not reach the EPO before the specified time limit were deemed to be withdrawn. It followed that the application filed with the UK Patent Office was deemed to have been withdrawn. No re-establishment of rights was provided for. In such a situation the legislator expressly provided in the last sentence of Art. 77(5) EPC 1973 for the refund of the filing, search and designation fees. In addition, Art. 135(1)(a) and 136(2) EPC 1973 provided facilities for a conversion of the lost European patent application into national patent applications. It followed that the legislator of the EPC clearly recognised the harsh consequences of Art. 77(5) EPC 1973 for an applicant. But, having recognised the problem, the legislator did not provide the applicant with any means to regain the lost application.

5.2. Identity of applicant

5.2.1 Requirement for information identifying the applicant (Rule 40(1)(b) EPC)

R. 40(1)(b) EPC provides that the date of filing of a European patent shall be the date on which the documents filed by the applicant contain, inter alia, 'information identifying the applicant or allowing the applicant to be contacted'. The requirement for information identifying the applicant was previously contained in Art. 80(c) EPC 1973.

In **J 25/86** (OJ 1987, 475) it was pointed out that the requirement under Art. 80(c) EPC 1973 for "information identifying the applicant" was to be considered as having been met whenever it was possible to establish beyond reasonable doubt the identity of the applicant on the basis of all data contained in the documents filed by the applicant or his representative.

As noted in this chapter IV.A.4., under Art. 60(3) EPC the EPO assumes the applicant to be entitled to the European patent.

In **T 948/10** the EPO was wrongly informed that the applicant company's name had changed, and amended it accordingly. As neither the appellant's representative nor the examining division/Client Data Registration department had had any reason to believe that the party to the proceedings was anyone other than the original applicant, the board found that this error did not invalidate the procedural steps taken by the applicant before the first-instance departments ("falsa demonstratio non nocet"), and that the EPO should correct the mistake itself.

5.2.2 Correction of designation of applicant (Rule 139 EPC)

Under the first sentence of R. 139 EPC, linguistic errors, errors of transcription and mistakes in any document filed with the EPO may be corrected on request. The boards, in particular the Legal Board, have developed a large body of case law on corrections, namely that the correction must introduce what was originally intended; where the original intention is not immediately apparent, the requester bears the burden of proof, which must be a heavy one; the error to be remedied may be an incorrect statement or an omission; and the request for correction must be filed without delay (see **G 1/12**, point 37 of the Reasons). The decisions below consider the application of the EPC 1973 (R. 88 EPC 1973, which was not amended in substance). On R. 40(1)(b) EPC, see in this chapter IV.A.5.2.1.

In **J 7/80** (OJ 1981, 137), the Legal Board held that if the wrong applicant was named in an application and the wrong applicant and the correct applicant were both companies forming part of the same group of companies then the mistake could be corrected under R. 88 EPC 1973, if there was sufficient evidence to support the request for correction.

Following **J 7/80** (OJ 1981, 137) it was held in **J 18/93** (OJ 1997, 326), **J 17/96** and **J 31/96** that a correction substituting the name of the applicant was allowable under R. 88 EPC 1973 if there was sufficient evidence to support the request for correction. This rule was not in conflict with the provisions of Art. 61 EPC 1973, which concerned ownership disputes. R. 88, second sentence, EPC 1973 was not applicable. It was only necessary to verify whether there was sufficient evidence to support the request under R. 88 EPC 1973 for correction of the applicant's name; where the correction of a mistake was requested and R. 88, second sentence, EPC 1973 was not applicable, the EPO had to be satisfied that a mistake had been made, what the mistake was and what the correction should be. In **J 8/80** (OJ 1980, 293), the Legal Board added that, in order to avoid any abuse, the burden of proving the facts had to be a heavy one.

A correction under R. 88, first sentence, EPC 1973 was retroactive to the original date of filing (**J 3/91**, OJ 1994, 365; **J 2/92**, OJ 1994, 375) and the application was restored to the form which it should have taken on the filing date if the error had not been made (**J 4/85**, OJ 1986, 205).

In **J 17/97** and **J 18/97** the representative had filed the parent application in the name of Int. Inc., but the divisional application in the name of S.medica. Due to the different identities of the applicants, the Receiving Section had refused to treat the application as a divisional application. In its decisions, the Legal Board did not allow the request for correction to replace the name of the applicant of the divisional application with the name of the applicant of the parent application pursuant to R. 88 EPC 1973 because the appellant had not proved that the divisional application had been filed in error by S.medica and should have been filed by Int. Inc.

5.3. Legal effect of accordance of a date of filing

According to **T 1409/05** (OJ 2007, 113) a legally effective – in the terminology of the EPC, an accorded – filing date had several different legal consequences. Amongst others:

(a) it marked the beginning of the pendency of a European patent application; Art. 80 EPC 1973 in conjunction with Art. 90(1)(a), 90(2) EPC 1973;

(b) it marked the notional date on which the applicant formally claimed to have deposited his invention with the EPO; and

(c) the filing date defined the state of the art and hence the extent of search and examination, for the purposes of Art. 54(2) and (3) EPC 1973.

The legal effects (a) to (c) ensued immediately when the filing date was accorded. Further legal effects of the filing date unfolded upon publication of the patent application:

(d) It marked the date which counted as the filing date so as to affect other applications for the purposes of Art. 54(3) EPC 1973.

The filing date unfolded still further legal effects on grant:

(e) it marked the starting date for the granted protection envisaged by Art. 64(1) EPC 1973, see also Art. 63(1) EPC 1973; and

(f) the filing date marked the legally confirmed date by which the applicant had deposited the invention for which protection was granted, and as such, recognised the claim of (b).

The board went on to point out that the difference between the legally relevant dates (a) to (f) was clearly shown by the fact that logically they did not need to coincide, although this was the core assumption in the patent-granting system established by the EPC.

A filing date for a "normal" application was accorded as soon as the requirements of Art. 80 EPC 1973 were met – apart from other formal issues, such as language etc. If an application was deemed to have been accorded a filing date, an application came into existence. In other words, there was a pending application, with the legal consequences (a) to (c) above.

Conversely, a pending application had always to be deemed to have been accorded a filing date. It was true that the EPC used the notion of an application that was not deemed to have been accorded a filing date; see Art. 90(2) EPC 1973. However, such a purported application would legally never be pending, as there would be no application; see Art. 90(2) EPC 1973. Such a purported application would neither be searched nor examined, and neither filing, search, examination nor annual fees needed to be paid thereafter. A purported application which did not have a filing date simply did not exist as an application sensu stricto for the purposes of the EPC. This showed that a pending application without a filing date would be in a legal limbo. In other words, the notion of

according a filing date was synonymous with the legal recognition of the existence of a pending European patent application.

5.4. Subsequent filing of missing parts of the description or missing drawings (Rule 56 EPC)

5.4.1 Legal provisions

In the context of the system as a whole, R. 56 EPC relates to Art. 80 EPC (date of filing) (**J 3/06**). If the examination under Art. 90 EPC to determine whether the application satisfies the requirements for the accordance of a date of filing reveals that parts of the description, or drawings, appear to be missing, the EPO invites the applicant to file the missing parts within two months (R. 56(1) EPC).

Where the applicant files missing parts of the description or missing drawings within two months of the date of filing or of an invitation from the EPO to file the missing parts, the application is re-dated to the date on which the missing parts were filed. However, if the application claims priority, the missing parts of the description or the missing drawings are completely contained in the earlier application and all the requirements of R. 56(3) EPC are fulfilled, the application is not re-dated but retains the date on which the requirements laid down in R. 40(1) EPC were fulfilled (R. 56(3) EPC). R. 56(3) EPC implements Art. 5 PLT. It is based on the concept introduced in the EPC 2000 whereby the documents required for the accordance of a date of filing do not, under certain circumstances, immediately have to be physically present. Instead, they can be introduced into the proceedings by being contained in another application (**J 10/07**).

Even though it is not expressly stipulated in R. 56 EPC, it follows from the wording of R. 56(2), first sentence, EPC that applicants may also file missing parts of the description or missing drawings of their own motion. This approach is in line with the legislator's intention, as expressed in the travaux préparatoires; see **T 1963/17**.

Rule 56 EPC applies only to applications filed after the entry into force of the EPC 2000 (**J 3/06**, OJ 2009, 170, and **J 10/07**). Its counterpart under the EPC 1973, R. 43 EPC 1973, referred only to missing drawings.

For more on the correction of erroneously filed application documents or parts for applications filed on or after 1 November 2022, see new R. 56a EPC (IV.A.5.6.).

5.4.2 Interpretation of Rule 56 EPC

According to **J 27/10**, the same interpretation is to be given to the term "parts of the description ... appear to be missing" in R. 56(1), first sentence, EPC as to the term "missing parts of the description" in the subsequent paragraphs of R. 56 EPC for deciding if a part is missing from the description. The term "description" in "missing parts of the description" in R. 56 EPC refers to the description which was originally filed in order to obtain a filing date and not to any other description. The incomplete originally filed description is to be completed by the missing parts which must be added to the already filed text of the

description. Thus an interpretation of R. 56 EPC that some, or all, of the description that was originally filed in order to obtain a filing date could be amended, replaced or deleted is incorrect (see also **T 1963/17** and **J 16/13**).

In **J 15/12** the Legal Board made it clear, with reference to **J 27/10**, that R. 56 EPC could also not be used to replace drawings. R. 56(1), first sentence, EPC was confined to drawings referred to in the description or claims but which appeared to be missing. See also **T 1183/21**. In **J 12/14** the Legal Board stated that the filing of drawings where the reproduction of the figures is of low visual quality cannot be remedied by R. 56 EPC.

In **J 2/12** the Legal Board found that where (a) the description as filed with an application includes references to numbered drawings and (b) drawings with corresponding numbering are also filed with the application, different drawings may nevertheless be filed later under R. 56 EPC as "missing drawings" if it can be established without having to apply technical knowledge that the drawings originally filed with the application are not the drawings referred to in the description and that the later-filed drawings are the drawings referred to in the description. In the case at issue, it was immediately apparent that the figures referred to in the description were not the figures as originally filed. In other cases it might be that such a conclusion could not be reached so readily, but as it was so clear in this case, the Legal Board did not have to consider where in general the dividing line should be drawn.

5.5. Corrections under Rule 139 EPC

5.5.1 Legal provisions

Under R. 139 EPC (formerly R. 88 EPC 1973), mistakes in any document filed with the EPO may be corrected on request. However, if the request for such correction concerns the description, claims or drawings, the correction must be obvious in the sense that it is immediately evident that nothing else would have been intended than what is offered as the correction. Regarding corrections under R. 139, second sentence, EPC see also chapter II.E.4. "Correction of errors in the description, claims and drawings – Rule 139 EPC".

5.5.2 No replacement of invention

The decisions below are mainly about applying R. 88 EPC 1973, which however has not substantively changed; in R. 139 EPC, only minor editorial amendments to all three language versions have been made.

In **G 2/95** (OJ 1996, 555) the Enlarged Board held that the complete documents forming a European patent application, that is the description, claims and drawings, cannot be replaced by way of a correction under R. 88 EPC 1973 by other documents which the applicants had intended to file with their request for grant (overruling **T 726/93**, OJ 1995, 478). The interpretation of R. 88 EPC 1973 had to be in accord with Art. 123(2) EPC 1973. This meant that a correction under R. 88 EPC 1973 was thus bound by Art. 123(2) EPC 1973, in so far as it related to the content of the European patent

application as filed (see **G 3/89** (OJ 1993, 117). Such a correction could therefore be made only within the limits of what a skilled person would derive directly and unambiguously, using common general knowledge and seen objectively and relative to the date of filing, from the whole of the documents forming the content of the European patent application (referring to **G 3/89**).

The content of the European patent application was formed by the parts of the application which determined the disclosure of the invention, namely the description, claims and drawings (referring to **G 3/89**). As a result of the prohibition of extension under Art. 123(2) EPC 1973, documents other than the description, claims and drawings could only be used in so far as they were sufficient for proving the common general knowledge on the date of filing (referring to **G 3/89**). On the other hand, documents not meeting this condition could not be used for a correction even if they were filed together with the European patent application. These included, inter alia, priority documents, the abstract and the like (referring to **G 3/89**). See also **J 5/06**.

In **J 21/94** and terminating the appeal proceedings following the referral to the Enlarged Board dealt with in **G 2/95** (OJ 1996, 555), the Legal Board concluded that the originally disclosed invention B could be accorded a filing date even if there were contradictions between the request for grant (which related to invention A) and the application documents (which disclosed invention B). If a further invention (here invention A) was disclosed during grant proceedings, it could not be given a filing date unless it was clear that protection for this invention was now sought.

In **J 5/06**, the Legal Board referred to **J 21/94** and stated, if an application is accorded a date of filing pursuant to Art. 80 EPC 1973, the technical content of the application is definitively established (**G 2/95**). Exchanging this technical content with another one is a technical modification. The application of the strict requirements of either Art. 123(2) or R. 88, second sentence, EPC 1973 is not limited to those circumstances when a minor part of a complete description needs to be interpreted relative to the rest, but these requirements are applicable to any suggested amendment or correction. This means that the technical content of the application as filed cannot simply be discarded, even if it does not correspond to the intention of the applicant, but must be considered when deciding whether an amendment or correction is allowable or not. The intention of the applicant at the time of filing (or even later) is immaterial in establishing the technical content of a patent application.

In **J 16/13** the appellant requested correction of the wrongly filed description and claims under R. 139 EPC. The Legal Board stated that the skilled person would have immediately recognised the mismatch between the drawings and the other parts of the description. However, it was not "immediately evident that nothing else would have been intended than what is offered as the correction". R. 139 EPC required certainty as to the only correction possible; here, that was lacking. The Legal Board noted that the case before it was similar to **J 5/06**, in which it had been confirmed that the earlier case law (up to **T 726/93**) holding that R. 88 EPC 1973 had to be applied in the light of the applicant's intentions had clearly now been overturned (see **G 2/95**, **J 21/94**, **G 3/89**), and the request that the patent specification be corrected under R. 139 EPC was refused. See also **T 158/21**.

In **J 3/21**, the Legal Board observed that the ban on corrections aimed at replacing the description, established in **G 2/95** on the basis of Art. 123(2) EPC and further developed in e.g. **J 5/06** and **J 16/13**, was categorical and followed from the principle reflected in R. 40(1)(c) EPC that the accorded filing date is inseparable from the description as originally filed. An exchange of the description by way of correction would directly result in the separation of the filing date from the description in contravention of Art. 123(2) EPC. This principle applied irrespective of any intention of the applicant.

5.5.3 Extent of competence of the Receiving Section for corrections under Rule 139, second sentence, EPC

Rule 139, second sentence, EPC (previously R. 88, second sentence, EPC 1973) lays down as a condition for acceptance of a request for correction concerning a description, claims or drawings that a correction must be obvious in the sense that it is immediately evident that nothing else would have been intended than what is offered as the correction. This often requires a technical examination of the file, so that the question has arisen under R. 88 EPC 1973 whether the Receiving Section was competent to deal with the correction in such a case.

In **J 4/85** (OJ 1986, 205) the Legal Board made it clear that the duties of the Receiving Section did not include a technical examination of the file (recently endorsed in **J 11/20**); it should not, therefore, take a decision on a request for correction necessitating such an examination, but should leave the request in abeyance until the file had been transferred to the examining division (likewise **J 5/12**).

However, in **J 33/89** (OJ 1991, 288) the Legal Board pointed out that the Receiving Section remained competent for decisions on requests for correction of drawings under R. 88, second sentence, EPC 1973 unless the request necessitated a technical examination. In **J 12/14** the Legal Board agreed, and decided that the question of what technical features the figures in the drawings showed with respect to the claimed invention was not part of the formal examination procedure before the Receiving Section.

In **J 3/21** the Legal Board observed that the Receiving Section had not exceeded its competence (Art. 16 EPC in conjunction with R. 10(1) EPC) when deciding on the request by the applicants to correct the description of the European patent application, which had been filed in Chinese, by replacing it with that of the English translation filed on the same day. The ban on such corrections was categorical. An exchange of the description by way of correction would directly result in the separation of the filing date from the description in contravention of Art. 123(2) EPC. Refusing such a request for correction did not require any technical examination and technical qualifications.

In **J 5/01** the Legal Board decided that the wording of Art. 16 and 18 EPC 1973 as they stood left no room for an interpretation according to which the responsibility for a European patent application could be split between the Receiving Section and the examining division. The clear and mutually exclusive allocation of this responsibility in the EPC prevailed over considerations of procedural or cost economy (likewise **T 2411/10**; contrary to **J 8/82**, OJ 1984, 155). Thus, relying on the point in time at which a request for correction

was made rather than on the two acts mentioned in Art. 16 EPC 1973 (request for examination or indication under Art. 96(1) EPC 1973) would be contra legem. The Legal Board pointed out that corrections under R. 88 EPC 1973 were not a matter which formed part of the examination on filing or of the examination as to formal requirements (Art. 90 and 91 EPC 1973). Rather, the wish or the need for a correction might arise during the whole grant procedure and even afterwards, e.g. during opposition proceedings. For corrections necessitating a technical examination see **J 4/85**, OJ 1986, 205.

5.6. Erroneously filed application documents or parts (Rule 56a EPC)

New R. 56a EPC entered into force on 1 November 2022 (OJ 2022, A3). This new rule was introduced to align the EPC with R. 20.5*bis* PCT. New R. 56a EPC allows for the correction of erroneously filed application documents in EPC procedures for applications filed on or after that date. If the applicant shows that the correct application documents or parts thereof are completely contained in the claimed priority application, the initial date of filing is maintained. If this is not the case, the date of filing is changed to the date of receipt of the correct application documents. For further details, see the notice from the EPO in OJ 2022, A71.

5.7. Change of date of filing

The date of filing may change in cases where the applicant inserts missing parts of the description or missing drawings under R. 56 EPC (see IV.A.5.4.) or corrects erroneously filed parts under R. 56a EPC (see IV.A.5.6.) after the date of filing. This subsection deals with other situations where a re-dating of the application was requested.

The Legal Board held in **J 14/90** (OJ 1992, 505) that re-dating an application could not be justified on the grounds that the later date would permit the granting of a European patent for a new Contracting State. The designation of a state formed part of the request for grant of a patent, and hence belonged to the documents making up a patent application, which meant that in principle there was no reason why the filing date of an application should not be changed to the date on which a further state was designated. What was lacking were the necessary legislative provisions which would make this possible. In the case before the Legal Board there were no special circumstances, as had been the case with **J 5/89**. On the contrary the public interest and the need for consistency ruled out a re-dating.

In **J 5/89** the Legal Board had stated that it was clear that Art. 80 EPC set a date **before** which a date of filing could not be accorded to an application, but it did not follow that an application could not be given a **later** filing date with the consent of the applicant, provided that there was no detriment to the public interest, in circumstances in which the applicant had been **misled** by the EPO into not filing a new application entitled to that later filing date. See also chapter III.A. "The principle of the protection of legitimate expectations".

J 18/90 (OJ 1992, 511) followed **J 14/90** (OJ 1992, 505) in holding that the express designation of a new Contracting State in a European patent application shortly before entry into force of the EPC for that state was no justification for deferring the filing date until the date of entry into force. However, the Legal Board added in **J 18/90** that such

express designation might, after checking with the applicant, be interpreted as meaning that the applicant did not want a filing date earlier than the date on which the EPC entered into force for the state concerned.

In **T 683/06** the appeal had been lodged against a decision of the examining division to refuse a divisional application. The parent application had been sent by fax during the night. Some of the documents had arrived before midnight, some of them after midnight. According to the examining division's contested decision, the divisional application extended beyond the content of the parent application (Art. 76(1) EPC) because the claims in the divisional application were supported only by those parts of the documents for the parent application which had arrived by fax after midnight and in the light of the applicant's decision in favour of the earlier filing date did not belong to the parent application.

In its main request, the appellant sought to have the date after midnight recognised as the parent application's date of filing. However, the EPC makes no provision for a filing date once fixed to be changed subsequently. Only R. 56 EPC enables the filing date to be moved back if missing drawings or parts of the description are filed later. The correction of errors in filed documents in accordance with R. 139 EPC may also result in a change of filing date. But the case in point involved no such correction. Nor was a correction possible under R. 140 EPC.

6. Examination of formal requirements

Under Art. 90(3) EPC, if the patent application is accorded a date of filing, the EPO examines, in accordance with the Implementing Regulations, whether the requirements set forth in the following provisions have been satisfied:

- Art. 14 EPC, concerning the language of the European patent application (see chapter III.F.1.);

- Art. 78 EPC, concerning the requirements of a European patent application (see in this chapter IV.A.6.1.);

- Art. 81 EPC, concerning the designation of the inventor (see in this chapter IV.A.6.2.);

as well as any requirements laid down in the Implementing Regulations, and, where applicable;

- Art. 88(1) EPC, concerning claiming priority (see in this chapter IV.A.8.);

- Art. 133(2) EPC, concerning general principles of representation (see chapter III.V.);

- any other requirement laid down in the Implementing Regulations (see in this chapter IV.A.6.3.).

Under Art. 90(4) EPC, where the EPO notes that there are deficiencies which may be corrected, it shall give the applicant an opportunity to correct them. If any deficiency noted

under Art. 90(3) EPC is not corrected, the patent application shall be refused unless the EPC provides a different legal consequence (Art. 90(5) EPC).

In **J 18/08**, the Legal Board held that, where an application was refused under Art. 90(5) EPC, the deficiency on which the refusal decision was based could be corrected at the appeal stage. From this it followed that if an appeal was filed against such a refusal under Art. 90(5) EPC, the board had to examine whether the deficiency noted had been corrected or not. The Legal board explained that the present case was different from the situation where the non-observance of a time limit automatically led to the application being deemed to be withdrawn. In such a case the legal consequence automatically ensued when an act required within a specific time limit was not performed, without any decision to be taken concerning the refusal of the application.

In **J 11/20** the applicant appealed a decision of the Receiving Section refusing their application under Art. 90(5) EPC in conjunction with R. 58 EPC. The sole reason for the refusal was that the four amended drawings filed by the applicant to remedy formal deficiencies in the application documents were not in agreement with the application documents as originally filed and, despite the invitation by the Receiving Section, the applicant had not corrected this deficiency in due time. The Legal Board observed that when the appeal was filed, the formal deficiency had already been remedied, albeit late, with the filing of the correct drawings. Considering that the ground for refusal of the application under Art. 90(5) EPC had been remedied, the Legal Board established that the Receiving Section should have granted interlocutory revision in accordance with Art. 109 EPC.

6.1. Requirements of a European patent application (Article 78 EPC)

Under Art. 78(1) EPC a European patent application shall contain:

- a request for the grant of a European patent;

- a description of the invention;

- one or more claims;

- any drawings referred to in the description or the claims;

- an abstract

In addition it shall satisfy the requirements laid down in the Implementing Regulations.

Under Art. 78(2) EPC a European patent application is subject to the payment of the filing fee and the search fee. If the filing fee or the search fee is not paid in due time, the application shall be deemed to be withdrawn.

In **J 13/04**, the patent application had been validly filed with the French Patent Office INPI. The Legal Board observed that, under Art. 78(2) EPC 1973, the time limit for payment of

the filing and search fees in the case at hand could not be determined on the basis of either the date on which the application was forwarded to the EPO or the date on which the receipt had been issued under R. 24(2) EPC 1973 but rather only on the basis of the date on which the application had been received by the competent national authority, provided that the date of that filing was also the date of filing within the meaning of Art. 80 EPC 1973.

6.2. Designation of the inventor

Designation of the inventor is governed by Art. 81 and R. 19 EPC. The inventor is to be designated in the European patent application. If the applicant is not the inventor or is not the sole inventor, the designation must contain a statement indicating the origin of the right to the European patent (Art. 81 EPC).

Under R. 19 EPC, the request for grant of a European patent shall contain the designation of the inventor. For the requirements of the designation of inventor, see also the notice from the EPO dated 22 February 2021 concerning the amendment of Rules 19 and 143 EPC (OJ 2021, A12). Amended R. 19 EPC entered into force on 1 April 2021 (CA/D 11/20, OJ 2021, A3).

If the designation of the inventor is not made in accordance with R. 19 EPC, the EPO shall inform the applicant under R. 60(1) EPC that the application will be refused unless the designation is made within sixteen months of the date of filing of the application, or, if priority is claimed, of the date of priority. This period is deemed to have been observed if the information is communicated before completion of the technical preparations for the publication of the patent application.

Rule 21(1) EPC (R. 19(1) EPC 1973) requires consent to the rectification of a designation of inventor to be given by a "wrongly designated" person. In **J 8/82** (OJ 1984, 155), the Legal Board held that a person already named whose name is not to be cancelled from the designation is not a "wrongly designated" person within the meaning of the Rule and his consent to the addition of the name of another person is not required. (The Legal Board's finding in this decision on the allocation of responsibility between the Receiving Section and examining division for making a decision concerning such requests was overruled in **J 5/01**, see in this chapter IV.A.5.5.3).

The issue which arose in **J 1/10** was whether the legal position regarding designation of the inventor is changed by early publication of the European patent application at the applicant's request under Art. 93(1)(b) EPC, which can mean that the European patent application as published does not tell the public who the inventor is. In the Legal Board's judgment, early publication under Art. 93(1)(b) EPC did not affect the time period under R. 60(1) EPC for filing the designation of the inventor. If it did, it would shorten the 16-month period for filing that designation. However, there was no legal basis for assuming any connection between early publication and a reduction in the 16-month period. Nor could this be inferred from R. 60(1) EPC or the provisions governing the procedure for rectifying deficiencies (Art. 90(3) and (4) EPC).

The questions addressed by the Legal Board in **J 8/20** (and in **J 9/20** which is almost identical) were, firstly, whether an applicant could designate an entity which was not a natural person as the inventor (Art. 81, first sentence, EPC); secondly, what were the requirements of the statement indicating the origin of the right to the patent (Art. 81, second sentence, EPC) and, thirdly whether and to what extent the EPO could examine and object to the designation of inventor and the statement indicating the origin of the right to the patent filed under Art. 81 EPC.

Regarding the first question, the Legal Board held that the designated inventor had to be a person with legal capacity. This was the ordinary meaning of the term inventor. With the secondary legislation (R. 19 EPC) supporting this interpretation, it was not necessary to resort to the travaux préparatoires. The purpose of the provisions dealing with the inventor and its designation was primarily to confer and to protect the rights of the inventor, to facilitate the enforcement of potential compensation claims provided under domestic law, and to identify a legal basis for entitlement to the application. Designating a machine without legal capacity could serve none of these purposes. Furthermore, whether the designation of the inventor was published or corrected depended only on a unilateral decision of the inventor. Third parties had no rights in this regard. These provisions were not reconcilable with the theory that the public had a right under the EPC to know who the inventor was.

As to the second question, the Legal Board held that Art. 81, second sentence, EPC referred to the "origin of the right to the European patent". Art. 81 EPC thus established a link to Art. 60 EPC, where the right to a European patent was mentioned and provided for. Art. 60(1) EPC envisaged two ways to acquire the right to a European patent: either by developing the invention ("inventor") or by deriving the right from the inventor ("successor in title"). In view of the normative link between Art. 60(1) and Art. 81 EPC, only a declaration which identified the origin of the right in a manner consistent with Art. 60(1) EPC could be considered to comply with the EPC. Therefore, the statement that the appellant had derived the right to the European patent as owner and creator of the machine did not meet the requirements of Art. 81, second sentence, EPC in conjunction with Art. 60(1) EPC.

As to the third question, the Legal Board explained that, under Art. 90(3) EPC, the EPO shall examine whether the requirements in Art. 81 EPC have been satisfied. This examination was only a formal assessment. It was not necessary to assess whether, according to the relevant law, the applicant was de jure entitled to file the application, or if the relevant transaction or relationship was valid and really occurred. Such an examination was consistent with the principles set out in Art. 60(3) EPC and R. 19(2) EPC.

6.3. Any other requirement laid down in the Implementing Regulations

6.3.1 Presentation of the application documents (Rule 49 EPC)

Until 31 January 2023, R. 46 EPC prescribed the form of drawings and the general provisions governing the presentation of the application documents were found in R. 49 EPC. These included, among others, the requirement in R. 49(2) EPC that the

documents making up the application shall be presented so as to allow electronic and direct reproduction in an unlimited number of copies (**J 4/09**), the requirement in R. 49(7) EPC that the lines of each sheet of the description and of the claims shall preferably be numbered in sets of five (**T 3181/19**) and the requirement in R. 49(10) EPC that only the technical terms, formulae, signs and symbols generally accepted in the field in question shall be used (**T 1981/15**).

By decision of 13 October 2022, the Administrative Council adopted a set of legal changes to the Implementing Regulations aiming at supporting the ongoing digital transformation in the patent grant procedure at the EPO and strengthening alignment with the PCT (OJ 2022, A101). In this context, it delegated the authority to decide on the presentation requirements of the application and other documents to the President of the EPO (R. 49(2) EPC), including the formal requirements of drawings. These rule changes and a decision of the President restating the requirements previously set forth in R. 46 and R. 49 EPC (OJ 2022, A113) entered into force on 1 February 2023. For further details, see the notice from the EPO published in OJ 2022, A114.

In **J 11/20** the Legal Board explained that, in the context of the examination, with respect to formal requirements of the application, the Receiving Section was competent under R. 58 EPC to identify inconsistencies in the application documents which were immediately apparent, including whether formal discrepancies were present between amended documents and the documents as originally filed, provided no technical knowledge was required. Citing **J 4/09**, the Legal Board said that the question of what exactly the drawings showed with respect to the claimed invention was not part of the formal examination before the Receiving Section. An analysis by the Receiving Section going beyond the points to be examined on filing under R. 46, R. 49(1) to (9), and R. 49(12) EPC (as applicable until 31 January 2023) was impermissible. In particular, it was not permissible to allow the filing of improved drawings resulting in a disclosure which could not be found in the original version of the application; nor could the applicant be compelled to change the drawings and so sacrifice a disclosure which, in their view, could only take this form.

7. Designation of states

7.1. Legal provisions

Under Art. 79(1) EPC **all** the contracting states which are party to the EPC at the time of filing of the patent application are deemed to be designated in the request for grant of a European patent. This is different from the situation under the EPC 1973, where contracting states had to be positively designated in the request for grant. This practice caused problems since, in principle, a later designation made after the filing date of the European patent application was inadmissible. Applicants continue to have the option of withdrawing designations pursuant to Art. 79(3) EPC.

Under Art. 79(2) EPC the designation of a contracting state **may** be subject to the payment of a designation fee (under the EPC 1973 it was stated, 'The designation of a Contracting State **shall** be subject to the payment of the designation fee.' – emphasis added).

Since 1 April 2009, a flat designation fee has been payable for one or more contracting states designated (Art. 2(1) item 3 RFees).

The time limit for the payment of designation fees is within six months of the date on which the European Patent Bulletin mentions the publication of the European search report (R. 39 EPC, formerly Art. 79(2) EPC 1973).

The revised Art. 79 EPC is applicable to all European patent applications filed on or after 13 December 2007.

For case law on Art. 79(2) EPC 1973 (as in force until 30 June 1997), please refer to the CLB, 5th edn. 2006, VII.A.4.1. "Article 79(2) EPC (old version)".

7.2. Effect of non-payment of the designation fee

7.2.1 Deemed withdrawal

Since 1 April 2009 a single designation fee has been payable in respect of **all** the contracting states of the EPC. R. 39 EPC in force from that date provides that the designation fee shall be paid within six months of the date on which the European Patent Bulletin mentions the publication of the European search report. Where the designation fee is not paid in due time or the designations of all the contracting states are withdrawn, the European patent application shall be deemed to be withdrawn. Under the EPC 1973 the same time limit was to be found in Art. 79(2) EPC.

For the effect of a designation if the relevant designation fee had not been paid within the applicable time limit, see **G 4/98** in this chapter IV.A.7.2.2.

Under Art. 121 EPC, where a designation is deemed withdrawn for any contracting state in respect of which the designation fee has not been paid (R. 39(2) EPC), the applicant may now apply for further processing, unless he has waived his rights to receive a R. 112(1) EPC communication and to request further processing by crossing the appropriate box in the Request for grant form.

Rule 39 EPC as amended from 1 April 2009 applies to European patent applications filed on or after that date, as well as international applications entering the regional phase on or after that date.

7.2.2 Designation of states in divisional applications

Article 76(2) EPC 1973 stipulated that a European divisional application could not designate contracting states which were not designated in the earlier application.

In **G 4/98** (OJ 2001, 131), the Enlarged Board held, overruling **J 22/95** (OJ 1998, 569), that, without prejudice to Art. 67(4) EPC 1973, the designation of a contracting state party to the EPC 1973 in a European patent application did not retroactively lose its legal effect

and was not deemed never to have taken place if the relevant designation fee had not been paid within the applicable time limit.

The Enlarged Board further held that since in its opinion no general retroactive effect was attached to the fact that a designation was deemed to be withdrawn, the deemed withdrawal necessarily took effect upon expiry of the time limits mentioned in Art. 79(2) EPC 1973 and R. 15(2), 25(2) and 107(1) EPC 1973, as applicable, and not upon expiry of the period of grace provided by R. 85a EPC 1973.

Article 76(2) EPC has therefore been amended to ensure that only those contracting states which remain designated in the earlier application at the time of filing of a divisional application are deemed to be designated in the divisional application. (Similarly, the EPO can only act as the "designated Office" for states designated in an international application in respect of which the EPC was in force on the date on which the international application was filed; **J 30/90**, OJ 1992, 516).

7.2.3 No correction of non-payment of fee under Rule 88 EPC 1973

In **J 21/84** (OJ 1986, 75) it was held that if the designation fee for a state was paid, neither within the time limit under Art. 79(2) EPC 1973 nor within the period of grace under R. 85a EPC 1973 together with the surcharge, such failure could not be corrected on the basis of and in conjunction with the correction of an error according to R. 88 EPC 1973. See also **J 27/96**, **J 16/01** and **J 6/02**.

Concerning the indication of the purpose of fee amounts paid in respect of designation fees under the earlier law, see CLB, 6th edn. 2010, VI.F.2.4. "Designation fees".

7.3. Correction of designation of states (Rule 139 EPC)

7.3.1 Decisions considering the application of the EPC 1973

Under Art. 79 EPC 1973 the request for the grant of a European patent had to contain the designation of the Contracting State or States. This was substantially changed with the EPC 2000. The decisions below consider the application of the EPC 1973. (Unlike Art. 79 EPC 1973, R. 88 EPC 1973 (now R. 139 EPC) was not amended in substance).

According to **J 10/87** (OJ 1989, 323) a request for retraction of a withdrawal of the designation of a Contracting State filed after publication of the patent application may have been allowable under R. 88 EPC 1973 in appropriate circumstances, in particular if;

(a) the public had not been officially notified of the withdrawal by the EPO at the time the retraction of the withdrawal was applied for;

(b) the erroneous withdrawal was due to an excusable oversight;

(c) the requested correction did not result in a substantial delay of the proceedings; and

(d) the EPO was satisfied that the interests of third parties who may possibly have taken notice of the withdrawal by inspection of the file are adequately protected.

J 17/99 explained that with respect to corrections of designations in Euro-PCT applications, the same principles applied as for Euro-direct applications (see also chapter VI. "The EPO acting as a PCT authority").

J 27/96 concerned a Euro-PCT application which originally designated all the contracting states for a European patent, but on entry into the regional phase only designated and paid fees for ten. The Legal Board acknowledged that correction of a mistake pursuant to R. 88 EPC 1973 by adding the designation of a state had in principle been allowed by the Legal Board (see **J 3/81**, OJ 1982, 100). However, it could remain undecided whether R. 88 EPC 1973 could have been applied to the designations purported to be missing, as the lack of fee payment in due time was not a mistake that could be corrected under R. 88 EPC 1973 and was therefore a failure which could not be remedied (referring to **J 21/84**, OJ 1986, 75). Nor could the appellant's auxiliary request to replace expressly designated states with other non-designated states succeed – the designated states were not designated erroneously – rather the error lay in the omission of the non-designated states. Moreover, were there a retroactive effect of the correction, this did not mean that the applicant would be reinstated into the procedural phase when designations had to be made and fees paid or that, in consequence, the whole procedure in that phase would be available to him again. Correction of a mistake was an isolated procedural measure and not a case of re-establishment into a procedural phase as a whole.

In **J 3/01** the Legal Board was concerned with the same problem, in that the appellant's request was aimed at a reinstatement into an earlier procedural phase by means of a correction under R. 88 EPC 1973. The Legal Board held that correction under R. 88 EPC 1973 did not reverse the effect of decisions already taken on the basis of the uncorrected document and did not re-open a procedural phase already terminated or a time limit already expired. In other words, a procedural loss of right only indirectly caused by the incorrect document would not be remedied by a later correction of the document pursuant to R. 88 EPC 1973. This principle also characterised the functional and essential difference between a correction under R. 88 EPC 1973 on the one hand and restitutio in integrum pursuant to Art. 122 EPC 1973 on the other hand (see also **J 25/01**). The Legal Board concluded that correction under R. 88 EPC 1973, to include designation of the UK following failure to pay the designation fee, was not allowable, as it would be in breach of Art. 122(5) EPC 1973, according to which re-establishment into periods for payment of designation fees was not allowable.

In **J 16/08** the request for correction of the designation of states was allowed in the unusual circumstances of the case. Following the case law summarised in **J 7/90** (OJ 1993, 133) and endorsed in **J 6/02**, the Legal Board applied the three conditions to be met by such a request for correction in order for it to be allowable – firstly, that the error was an excusable oversight; secondly, that the request for correction was filed without undue delay upon discovery of the error, and thirdly, that the request for correction was, in the public interest, made early enough to enable publication of a warning with the European patent application. No such warning was required in the circumstances of this case, as the

application had erroneously been published showing all contracting states as designated. Third parties were therefore not prejudiced by the correction, since no publication had ever indicated that the territorial scope of the invention was limited to two contracting states.

7.3.2 Decisions considering the application of the EPC 2000

Under Art. 79(1) EPC **all** the contracting states which are party to the EPC at the time of filing of the patent application are now deemed to be designated in the request for grant of a European patent. Applicants continue to have the option of withdrawing designations pursuant to Art. 79(3) EPC (see in this chapter IV.A.7.1.).

J 9/14 confirmed the established jurisprudence of the Legal Board on the correction of errors according to which the withdrawal of the designation of a contracting state could not be retracted once it had been published in the European Patent Bulletin. The Legal Board referred to **J 1/11** where it had been held that with regard to the progress of technology and the implementation of internet technology by the EPO a distinction between public file inspection and publication in the European Patent Bulletin was no longer relevant.

The Legal Board in **J 9/14** re-emphasised that the public had a legitimate interest in relying on the information published by the EPO. The official notification to the public of the withdrawal is a key step and legal certainty would suffer unacceptably if thereafter, even for only a short period, a correction of the withdrawal were allowable (see also **J 25/03**, **J 37/03**, **J 7/06**).

8. Priority

This section deals with the requirements for filing priority documents and correcting priority declarations. Further details on priority can be found in chapter II.D.

8.1. Filing of priority documents

An applicant desiring to take advantage of the priority of a previous application must file a declaration of priority and any other document required, in accordance with the Implementing Regulations (Art. 88 EPC). Under R. 52(2) EPC, a declaration of priority shall preferably be made on filing the European patent application, but it may still be made with sixteen months of the earliest priority date claimed. This is a significant relaxation of the requirements as compared to R. 38(2) EPC 1973, under which at least the date and the state of the previous application had to be indicated on filing.

Similarly, R. 53 EPC (R. 38(3) EPC 1973) provides that an applicant claiming priority shall file a copy of the previous application within sixteen months of the earliest priority date claimed.

In **J 1/80** (OJ 1980, 289) it was stated that as R. 38(3) EPC 1973 permitted an applicant to file certified copies of the priority documents at any time before the end of the sixteenth month after the date of priority, there was only a deficiency which he must be given an invitation to correct if the priority documents had not been filed at the end of the period.

8.2. Correction of priority declarations

Under the EPC 1973, the correction of priority declarations was allowed under R. 88 EPC 1973. The possibility to correct the declaration of priority was expressly introduced into the EPC 2000 in R. 52(3) EPC. This additional possibility of correcting priority data under R. 52(3) EPC is not exhaustive and R. 139 EPC therefore continues to be applicable, too (see e.g. **J 11/18**, **J 15/18**).

8.2.1 Requirement for mistake to have been made

Under the EPC 1973, the Legal Board allowed correction of state designations under R. 88, first sentence, EPC 1973 (now R. 139 EPC), early on (**J 8/80**, OJ 1980, 293; **J 12/80**, OJ 1981, 143; **J 3/81**, OJ 1982, 100; **J 21/84**, OJ 1986, 75). Shortly afterwards the rather strict principles developed in these decisions were also applied in cases where correction of priority declarations was at stake. Although a mistake correctable under R. 88, first sentence, EPC 1973 could be an incorrect statement or the result of an omission, all the previous cases related to omitted priority declarations (**J 3/82**, OJ 1983, 171; **J 4/82**, OJ 1982, 385; **J 14/82**, OJ 1983, 121; **J 11/89** and **J 7/90**, OJ 1993, 133).

In the four decisions **J 3/91** (OJ 1994, 365), **J 6/91** (OJ 1994, 349), **J 9/91** and **J 2/92** (OJ 1994, 375), the Legal Board refined the principles to be applied to corrections of priority declarations. In **J 6/91** it analysed and summarised the previous case law, pointing out that the applicant had to prove a **mistake**, i.e. that the document filed with the EPO did not express the true intention of the person on whose behalf it was filed. In the earlier decisions the **burden of proof** on the applicant was defined as a heavy one. In **J 9/91**, however, the Legal Board took the view that the omission of a priority declaration would, in nearly every case, be an error. Thus, as a general rule, there was no need in cases of this kind to require special evidence to discharge the burden on the applicant of proving that a mistake had been made.

8.2.2 Time limit for request for correction

Despite the fact that R. 88, first sentence, EPC 1973 allowed correction without any time bar, the Legal Board followed the established case law requiring a request for correction of a priority claim to be made sufficiently early for a warning to be included in the publication of the application (**J 3/82**, OJ 1983, 171; **J 4/82**, OJ 1982, 385; **J 14/82**, OJ 1983, 121). This principle was upheld because the EPO, when exercising its discretionary power under R. 88, first sentence, EPC 1973 had to balance the applicant's interest in gaining optimum protection and a third party's interest in maintaining legal security and, in particular, in ensuring that the published application data were correct.

The Legal Board in **J 6/91** noticed, however, that the previous case law in special circumstances already allowed the correction even without such a warning:

(i) if the EPO was partly responsible for the fact that no warning was published (**J 12/80**, OJ 1981, 143) and/or

(ii) if the interest of the public was not seriously affected because

- the mistake was obvious (in this sense, implicitly, **J 8/80**, OJ 1980, 293);

- under certain circumstances, where only a second or further priority was added (**J 4/82**, OJ 1982, 385; **J 14/82**, OJ 1983, 121; **J 11/89**);

- the public was otherwise informed about the full scope of protection sought by the applicant (**J 14/82**, OJ 1983, 121).

In **J 3/91**, **J 6/91** and **J 2/92** it was held that even after publication of a European patent application without a warning, the priority declaration could be corrected under R. 88, first sentence, EPC 1973 provided that there was an **obvious discrepancy** in the published application indicating that something was wrong. In such a case the interests of third parties were not adversely affected by the correction.

In **J 3/91** the Legal Board held that an experienced practitioner could have noticed the obvious discrepancy because the claimed Japanese priority date (31 December 1983) and the European application date (3 January 1984) were close together and the Japanese file number was mentioned.

In **J 6/91** the international application in suit claiming priority from a US continuation-in-part application was itself presented as a continuation-in-part application and referred back to an earlier US application. In view of this and other special circumstances, the Legal Board allowed the addition of a (first) priority claim referring to the earlier US application.

In **J 2/92** the US priority date claimed for a PCT application was, owing to a clerical error, a Saturday when the USPTO was closed, instead of the previous Friday. The correct date was indicated on the priority document. Owing to a further clerical error in the request for transmittal of priority documents under R. 17.1(b) PCT (a typing error in the document number), the Receiving Office – in this case the USPTO – transmitted the wrong document to WIPO. The Legal Board allowed its replacement even after publication of the international application, adding, however, that this might not always be possible (see also **T 33/06**).

In the parallel cases **T 972/93** and **T 973/93** the examining division had refused a request for the priority date to be corrected. European patent application E1 claimed the priority of a French application F1, from which two French divisional applications F2 and F3 were filed within the priority year claiming the priority of the parent application. At issue in **T 972/93** and **T 973/93** were European applications E2 and E3, which claimed the priority of F2 and F3 respectively. In error however, the filing date of F2 and F3 was given as the priority date. This mistake was detected during examination proceedings, after E2 and E3 had been published with the wrong priority date, because E1 was discovered as a prior right within the meaning of Art. 54(3) EPC 1973 (Art. 54 EPC has been substantially amended – see chapter I.C. "Novelty").

The board allowed the correction (following **J 6/91**, OJ 1994, 349), ruling that the mistake was apparent, because only eight months separated the filing date of E2 and E3 from the incorrect priority date, whereas the priority year was usually exploited to the full. The interests of third parties had not been adversely affected because the precautionary filing of two European divisional applications with respect to E1, which had the same content as F2 and F3, made it possible to gain protection for the subject-matters of E2 and E3 with the priority of F1.

On the other hand, in **J 7/94** (OJ 1995, 817) the Legal Board did not allow the correction. It held that the mere fact that an existing priority was not claimed could not justify adding this priority by correction. The correction of priority data, not requested sufficiently early for a warning to be included in the publication of the application, was only allowable if it was justified by special circumstances (confirming **J 6/91**, OJ 1994, 349). See also **T 796/94**.

In **J 11/92** (OJ 1995, 25) it was held that an incomplete priority declaration could be corrected, by the addition of an omitted priority in special circumstances, even after publication of the European patent application without a warning to the public that a request for correction had been made, provided that the public had been informed about the full scope of European patent protection sought, by way of a second European or Euro-PCT patent application, filed as a precautionary measure by the applicant in due time (referring to **J 6/91**, OJ 1994, 349).

In **T 713/02** (OJ 2006, 267), the board held that the examination of a request for correction of priority data after the publication of the application was not to be restricted to that portion of the facts and circumstances which in a decision of a board in another case were considered not to preclude the correction. Therefore, in the case before the board, it could not be ignored that the requested correction by addition of an earlier priority date would eliminate from the state of the art pursuant to Art. 54(2) EPC 1973 a highly relevant document, which the applicant had previously de facto accepted as comprised in that state of the art (see, however, the notice from the EPO regarding **T 713/02** (OJ 2006, 293a), according to which the EPO's departments of first instance do not, for the time being, follow the findings that no decisions, except where a total loss of rights should be remedied, may be taken in the applicant's favour prior to the decisions terminating the granting procedure).

8.2.3 Correction of the priority declaration under Rule 52(3) EPC

New R. 52(3) EPC introduced the possibility to correct the declaration of priority. New R. 52(2) EPC and (3) EPC apply the time periods laid down in the PCT for the addition or correction of priority claims to Euro-direct applications, with the necessary terminological adjustments, in order to avoid treating Euro-PCT and Euro-direct applications differently. Pursuant to R. 52(3) EPC, an applicant may correct a declaration of priority within 'sixteen months from the earliest priority date claimed, or, where the correction would cause a change in the earliest priority date claimed, within sixteen months from the correct earliest priority date, whichever sixteen-month period expires first, provided that such correction may be submitted until the expiry of four months from the date of filing accorded to the European patent application'. However, for easy publication, a declaration of priority may

not be made or corrected after a request for early publication of the European patent application (Art. 93(1)(b) EPC) has been filed (R. 52(4) EPC).

9. Fiction of withdrawal of the application (Rule 100(3) EPC)

Rule 100 EPC concerns the examination of appeals. If an applicant, as the appellant in ex parte appeal proceedings, fails to reply in due time to an invitation under R. 100(2) EPC, the European patent application is deemed to be withdrawn under R. 100(3) EPC, unless the decision impugned was taken by the Legal Division. These provisions were previously contained in Art. 110(2) and (3) EPC 1973 respectively.

The Legal Board held in **J 29/94** (OJ 1998, 147) that if the appellants failed to reply in due time to an invitation under Art. 110(3) EPC 1973, the European patent application was deemed withdrawn, even if the appeal related to formal points, as the effect of the appeal, namely that the board was now competent for the case, applied to the entire application (see chapter V.A.1. "Legal character of appeal procedure").

10. Publication of the application

Article 93 EPC concerns the publication of the European patent application, which should take place as soon as possible after the expiry of a period of eighteen months from the date of filing, or, if priority has been claimed, from the date of priority, unless the applicant requests earlier publication. Under R. 67(1) EPC (R. 48 EPC 1973), the President of the EPO shall determine when the technical preparations for publication of the patent application are deemed to have been completed (see the decision of the President of the EPO dated 12 July 2007 concerning the completion of technical preparations for the publication of European patent applications (OJ SE 3/2007, D.1)). The application shall not be published if it has been finally refused or withdrawn or is deemed to be withdrawn before the termination of the technical preparations for publication (R. 67(2) EPC).

In **J 5/81** (OJ 1982, 155) it was stated that the key date for completion of the technical preparations for publication under Art. 93 EPC 1973 specifiable pursuant to R. 48(1) EPC 1973 could be said to give the applicant a certain minimum period of time within which his withdrawal of the application also prevented its publication. If the application was not withdrawn until after the key date, the applicant could no longer rely on its not being published. Nevertheless, the EPO was allowed by law to prevent publication, at its own discretion.

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1. Stage before substantive examination

1.1. Amendments made by the applicant of their own volition under Rule 137(2) EPC

Following receipt of the search report and search opinion, and prior to the first communication from the examining division, the applicant must (subject to certain exceptions) respond to the search opinion, by filing amendments to the description, claims or drawings and/or filing their observations on the objections raised in the search opinion. Any amendments filed at this stage are made by the applicant of their own volition in accordance with R. 137(2) EPC (Guidelines C-II, 3.1 – April 2025 version).

Rule 137(2) EPC states that together with any comments, corrections or amendments made in response to communications by the EPO under R. 70a(1) or (2) EPC or R. 161(1) EPC, the applicant may amend the description, claims and drawings of their own volition. No further amendments may be made without the consent of the examining division (R. 137(3) EPC).

The applicant's response required by R. 70a EPC (or filed voluntarily in response to search opinions not requiring a response) will be taken into account by the examining division when drafting the first communication (Guidelines C-II, 3.1 – April 2025 version).

In **T 1178/08** the board stated that in accordance with Art. 123(1) EPC in conjunction with R. 137(2) and (3) EPC, an applicant is to be given at least one opportunity to amend the application of his own volition. No further amendments may be made without the consent of the examining division.

1.2. Request for examination (Rule 70 EPC)

1.2.1 General issues

According to Art. 94(1) EPC, the EPO shall, in accordance with the Implementing Regulations, examine on request whether the European patent application and the invention to which it relates meet the requirements of the EPC. The request shall not be deemed to be filed until the examination fee has been paid. Art. 94(1) EPC is nearly identical to Art. 94(1) EPC 1973. Only the word "written" was deleted and replaced by the

words "in accordance with the Implementing Regulations". As regards the requirement to use the written form, see R. 1 EPC. If no request for examination has been made in due time, the application shall be deemed to be withdrawn (Art. 94(2) EPC, which corresponds to Art. 94(3) EPC 1973).

Rule 70(1) EPC (Art. 94(2) EPC 1973) stipulates that the applicant may request examination of the European patent application up to six months after the date on which the European Patent Bulletin mentions the publication of the European search report. The request may not be withdrawn.

In **J 21/98** (OJ 2000, 406) the Legal Board stated that the request for examination constituted an autonomous step, which had to be kept quite separate from the (previous) step of filing the European patent application. In particular Art. 94(1) EPC 1973 showed that, according to the EPC, the patent application was not considered as the only necessary step to be taken by the applicant to obtain the grant of a patent, since a further step was necessary, consisting in a written request for examination – that meant a new declaration of intention to continue the grant procedure. Thus the applicant was given the right to know the outcome of the search report before deciding whether to ask for the prosecution of the grant procedure by means of the request for examination, which implied the payment of the related fee, or to drop said procedure.

In **J 12/82** (OJ 1983, 221) the Legal Board found that the unequivocal terms of Art. 94 EPC 1973 did not permit any wide interpretation; the article required that the request be written, filed within a certain period and accompanied by payment of the fee within the same period. It held that the mere payment of the examination fee within the time limits provided for in Art. 94(2) EPC 1973 could not be a substitute for filing the request itself in good time.

In **J 4/00** the Legal Board held that a request for examination under Art. 94 EPC 1973 required, over and above payment of the examination fee, that the underlying intention of an applicant that their application should proceed to examination was manifested in a written statement addressed to the EPO and received in time. To qualify as a request for examination, the only reasonable interpretation of the text filed with the EPO had to be that the applicant thereby wanted to inform the EPO that they wished to have the application examined pursuant to Art. 94 EPC 1973.

In **T 158/12** the board held there was no provision in the EPC which would allow the payment of multiple examination fees for a patent application. This was in line with the possibilities to argue in the examination proceedings that unity existed or to file divisional applications which allowed the principle of one invention - one examination (and one examination fee for one examination proceedings) to be maintained. Thus for one application, only one examination was to be carried out as the result of the single examination fee paid. Having chosen one invention (or one group of inventions) to be made the subject of examination, this choice could not be altered once examination of that invention had commenced. The board was of the opinion that this approach based on the statutory provisions of the EPC was confirmed in opinion **G 2/92** (OJ 1993, 591), which found that "at the examination stage, having regard to the requirement of unity of invention

and the fact that only one examination fee can be paid for each application, clearly only one invention in each application is to be examined" (point 2 of the Reasons). Hence, the appellant's view that the examination of an application could be based on more than one invention was not supported by this opinion of the Enlarged Board.

1.2.2 The invitation to confirm early request for examination (Rule 70(2) EPC)

Under R. 70(2) EPC (Art. 96(1) EPC 1973) if the request for examination has been filed before the European search report has been transmitted to the applicant, the EPO shall invite the applicant to indicate, within a period to be specified, whether they wish to proceed further with the application, and shall give them the opportunity to comment on the search report and to amend, where appropriate, the description, claims and drawings. In order to accelerate proceedings, the EPO offers the applicants the possibility to waive the right to receive the invitation to confirm early request for examination under R. 70(2) EPC (see Guidelines C-VI, 3 – April 2025 version).

Following **J 8/83** (OJ 1985, 102), the applicant is entitled to receive the invitation provided for in R. 70(2) EPC also in cases where a supplementary European search report is to be drawn up on a Euro-PCT application (see Guidelines E-IX, 2.5.3 – April 2025 version).

In **J 8/83** and **J 9/83** the Legal Board found that if a supplementary European search report had to be drawn up in respect of an international application which was deemed to be a European patent application, the applicant was entitled to receive the invitations provided for in Art. 96(1) EPC 1973 and R. 51(1) EPC 1973 (now R. 70(2) EPC). Since in the case of such an international application, responsibility for examination of the application did not pass to the examining division until the applicant had indicated under Art. 96(1) EPC 1973 that they desired to proceed further with their application, the applicant might obtain a refund of the examination fee if in response to the invitation under Art. 96(1) EPC 1973 they withdrew their application, or allowed it to be deemed to be withdrawn. The Legal Board noted that the provisions of Art. 96(1) EPC 1973 and R. 51(1) EPC 1973 encouraged applicants to review their applications critically and realistically in the light of the European search report, before substantive examination began. The opportunity given by the EPO to obtain a refund of the substantial fee for examination by withdrawing the application at that stage, or allowing it to be deemed to be withdrawn, provided an additional incentive to withdraw cases unlikely to succeed.

1.2.3 Transfer of the responsibility for examining the application to the examining division

Responsibility for examining the application passes from the Receiving Section to the examining division once a request for examination has been filed (R. 10(2) EPC). This is subject to two exceptions: (i) if a request for examination has been filed before the European search report has been transmitted to the applicant, then the examining division is responsible from the time when the EPO receives the confirmation of the request for early examination following an invitation under R. 70(2) EPC; (ii) if the applicant has also waived the right under R. 70(2) EPC, then the examining division is responsible from the time when the search report is transmitted to the applicant (R. 10(3) EPC and R. 10(4) EPC; Guidelines C-II, 1 – April 2025 version).

2. The first stage of substantive examination

2.1. Beginning of "substantive examination"

In **J 9/10** the Legal Board held that a communication pursuant to Art. 94(3) EPC on EPO Form 2001A entitled "Communication pursuant to Article 94(3) EPC" which was automatically generated by a computer and posted by a formalities officer without the involvement of an examiner appointed to the examining division did not constitute a legally effective act of the examining division and therefore could not be regarded as the beginning of "substantive examination" pursuant to Art. 10b(b) RFees (as amended by decision of the Administrative Council of 15 December 2005; now Art. 11 RFees as last amended by decision of the Administrative Council of 29 June 2016). The Legal Board noted that to ensure predictability and verifiability of the application of Art. 10b(b) RFees, the beginning of "substantive examination" had to be interpreted as requiring a concrete and verifiable act of the examining division as regards "substantive examination" after having assumed responsibility for the examination of the application (see also **J 25/10**, OJ 2011, 624). The Legal Board held that if a communication of a particular examining division was to be legally valid, it had to have been written on behalf of and represent the views of the members who had been appointed to that division to examine the issues forming the subject of the communication. There was, however, no indication in the file that the appointed primary examiner had actually authenticated the communication under Art. 94(3) EPC before it was despatched by the formalities officer. Therefore, the communication could not be attributed to the examining division, but only to the formalities officer whose name was indicated on EPO Form 2001A. Further, the Legal Board found that the formalities officer, although acting in good faith, had had no power to issue the communication pursuant to Art. 94(3) EPC. Following decisions **J 9/10** and **J 25/10** the EPO made adjustments to the system for refunding examination fees (see notice dated 29 January 2013, OJ 2013, 153). The examination starting date is now stored in the publicly available part of the electronic file to ensure that it is verifiable. For published applications, this date is visible in the European Patent Register.

In **J 17/92** the Legal Board held that allowing consolidation of proceedings was something both permissible and desirable under the EPC, in accordance with the desire expressed in the preamble to the EPC that protection be obtainable in the contracting states by means of a single procedure for the grant of patents. Consolidation was not only in the interest of applicants, but also in that of the public not to have to take into account two separate European patents with the same text. The Legal Board noted that the conditions to be imposed on consolidation should not be more restrictive than necessary. It therefore took the view that the condition that the two applications at issue as filed had to be identical was too stringent. In the case in hand, the Legal Board found that if the form of claims with which the applicant wished to proceed in the consolidated applications was acceptable either as an amended set of claims or as being identical to the set of claims as filed, consolidation should be possible. In the Legal Board's view, such an amended set of claims should prima facie not prevent consolidation.

2.2. Communications under Rule 71(1) and (2) EPC

2.2.1 Invitation to correct deficiencies and to propose amendments (Rule 71(1) EPC)

The applicant's response to the search opinion required by R. 70a EPC (or filed voluntarily in response to search opinions not requiring a response) will be taken into account by the examining division when drafting the first communication (Guidelines C-II, 3.1 – April 2025 version).

According to R. 71(1) EPC (R. 51(2) EPC 1973) in any communication under Art. 94(3) EPC the examining division shall, where appropriate, invite the applicant to correct any deficiencies noted and to amend the description, claims and drawings within a period to be specified.

Article 94(3) EPC states that if the examination reveals that the application or the invention to which it relates does not meet the requirements of the EPC, the examining division shall invite the applicant, as often as necessary, to file their observations and, subject to Art. 123(1) EPC to amend the application.

In **T 301/10** the board stated that according to the established case law developed in relation to Art. 96(2) EPC 1973 and also applicable to Art. 94(3) EPC, the expression "**as often as necessary**" in this article indicates that the examining division has discretion which has to be exercised objectively in the light of the circumstances of the case (see **T 162/82**; OJ 1987, 533; **T 300/89**, OJ 1991, 480; **T 726/04**). See also **T 1734/10**.

Neither Art. 113(1) EPC 1973 nor Art. 96(2) EPC 1973 (Art. 94(3) EPC) require that the applicant be given repeated opportunities to comment on the examining division's submissions if the main objections to the grant of a European patent remain the same (**T 84/82**, OJ 1983, 451; **T 161/82**, OJ 1984, 551; **T 162/82**, **T 243/89**, **T 958/99**). A further invitation to present comments following a substantiated communication in which deficiencies were recorded is only appropriate if it would appear likely that, in the light of the applicant's reply, the examination proceedings would terminate in the granting of a patent (see **T 84/82**, **T 161/82**, **T 162/82**, **T 243/89**, **T 300/89**, **T 793/92**, **T 516/93**, **T 201/98**).

In **T 17/22** the examining division had issued a communication headed "Invitation pursuant to R. 137(4) EPC and Art. 94(3) EPC". In the annex to this communication the examining division had raised an objection under Art. 123(2) EPC, and had added: "nota bene: The amendment appears also not suitable to remedy the deficiencies." The decision to refuse the application was based on Art. 123(2) EPC as well as on lack of novelty, inventive step and clarity. The board held that said communication could not be considered a substantive communication under Art. 94(3) EPC nor a communication which would obviate the need for such a communication. The communication under R. 137(4) EPC, with a period for reply of one month, was of a formal nature. The applicant was merely asked to identify the amendments and to indicate the basis for them in the application as filed, independently of whether these amendments complied with Art. 123(2) EPC. The objection raised by the examining division under Art. 123(2) EPC in the annex to the communication under

R. 137(4) EPC, and the added nota bene that the amendment appeared also not suitable to remedy the deficiencies did not turn this communication into a substantive communication under Art. 94(3) EPC and R. 71(1) EPC, especially as the period for a reply was still only one month. The mere reference to Art. 94(3) EPC in the heading of the communication did not affect this conclusion. The omission of a communication under Art. 94(3) EPC was, in the board's view, a substantial procedural violation, as it deprived the applicant of the opportunity to react to such a communication. See also chapter III.B.2.5.3 regarding the violation of the right to be heard.

2.2.2 Content of Article 94(3) EPC communication (Rule 71(2) EPC)

According to R. 71(2) EPC (R. 51(3) EPC 1973) any communication under Art. 94(3) EPC (Art. 96(2) EPC 1973), shall contain a reasoned statement covering, where appropriate, all the grounds against the grant of the European patent.

In **T 937/09** the board observed that R. 71(2) EPC contained two requirements: applicants had to be informed, first, of each EPC requirement deemed not to be met and, second, for each such requirement, of the legal and factual reasons why it was deemed not to be met.

If no search opinion has been issued, the examiner's first communication under Art. 94(3) EPC will, as a general rule and by analogy with the search opinion, cover all objections to the application (Guidelines C-III, 4 – April 2025 version).

In **J 32/95** (OJ 1999, 733) the Legal Board held that the objection raised by the appellant that the examining division had unduly dealt with the application in a piecemeal manner was unfounded. According to the Guidelines applicable at the time, the examiner's first letter should, as a general rule, cover all objections to the application. Pursuant to R. 51(3) EPC 1973 any communication shall, where appropriate, cover all the grounds against the grant of the European patent. Whether and to what extent this was to be done was a matter of procedural expediency. The Legal Board explained this meant that the examining division had to weigh the aspects of the case involved. In particular, the likelihood that the objection raised could be overcome, the kind of amendments which could be expected, and any objections which could yet remain thereafter had to be weighed against the amount of additional work involved for the examining division. In the case in hand, an objection concerning lack of novelty was raised in the first communication against all claims of the application. Such a far-reaching objection can normally only be overcome by substantial amendment of the claims. Therefore, claims amended in this way, if filed, have to be largely re-examined with respect to the prior art. In the view of the Legal Board, R. 51(3) EPC 1973 therefore did not require that an examining division should immediately raise the objection that the claims on file lacked inventive step in relation to other documents, if it was of the opinion that all the claims in the application were anticipated by one document. By contrast, in its second communication concerning the amended claims filed by the appellant, the examining division, although maintaining the non-novelty objection against new claim 1, also raised an objection of lack of inventive step. The Legal Board came to the conclusion that the appellant's submission that the examining division had breached R. 51(3) EPC 1973 by issuing several communications was unfounded. See also **T 937/09**.

In **T 2311/10** the board held that whether and to what extent the examining division covered all the grounds against the grant of the European patent in a communication was a question of procedural economy (see **J 32/95**) and a matter for the division's discretion.

In **T 20/83** (OJ 1983, 419) the board noted that Art. 96(2) EPC 1973 prescribed that the examining division had to draw all obstacles to patentability to the applicant's attention. This conclusion related to the requirements for patentability as laid down in the EPC itself. The board in **T 830/91** (OJ 1994, 728) noted however that the validity of a patent in various contracting states was not an immediate condition under the EPC.

In **T 98/88** the board pointed out that R. 51(3) EPC 1973 did not make it compulsory for communications in accordance with Art. 96(2) EPC 1973 to set out all the grounds against the grant of the patent. The board's view in this case was that deferral of the examination in respect of the requirements under Art. 52 EPC 1973 until a clear version of the claims had been received did not conflict with R. 51(3) EPC 1973. See also **T 677/97**.

2.3. Refusal after a single communication

2.3.1 Discretion of the examining division

In **T 821/96** the board stated that, according to the established case law, it was left to the examining division's discretion to decide whether to issue a further invitation to present comments under Art. 96(2) EPC 1973.

In **T 162/82** (OJ 1987, 533) the board held that the interests of orderly and economic examining procedures may preclude the sending of more than one communication where this would not appear to be likely to lead to a positive result. In **T 84/82** (OJ 1983, 451) the board found that it was within the discretion of the examining division to interpret the submissions on behalf of the applicant as complete and final, and to assume, in consequence, that no useful purpose would be served by the provision of further opportunities for filing observations, and to reject the application in the second communication, when this was justified by in the circumstances. See also **T 201/98**, **T 79/91**, **T 1969/07**, **T 2351/16**.

In **T 201/98** the board noted, with reference to the established case law of the boards of appeal (**T 84/82**, **T 300/89**, OJ 1991, 480) that an examining division did not exceed its discretionary power by an immediate refusal, provided that the decision complied with Art. 113(1) EPC 1973, i.e. was based on grounds on which the appellant had had an opportunity to present comments. In **T 162/82** the board held that neither Art. 113(1) nor Art. 96(2) EPC 1973 required that the applicant be given a repeated opportunity to comment on the argumentation of the examining division so long as the decisive objection against the grant of a patent remained the same (see also **T 300/89**, **T 95/04**). The board in **T 63/93** held that this was particularly the case when the claimed subject-matter had not been substantially modified (see also **T 304/91**). See also chapter III.B.2.6.3 "Immediate refusal after communication".

In **T 300/89** the board noted that the burden lay with an applicant to propose amendments which overcame the objections raised by the examining division in their observations in reply to the first communication in which such objections were raised.

In **T 640/91** (OJ 1994, 918) the board stated that the requirement in Art. 96(2) EPC 1973 that the examining division must invite the applicant to file their observations "as often as necessary" implicitly recognised that in certain circumstances the examining division would be legally obliged to invite further observations from the applicant before issuing a decision, for example before issuing a decision based on grounds or evidence on which the applicant had not previously had an opportunity to present their comments (Art. 113 EPC 1973). Having regard to Art. 113(1) EPC 1973, there was a "necessary" legal obligation for an examining division to invite further observations from an applicant before issuing a decision adversely affecting them in which the immediate issue of the decision was justified on the ground that the applicant had shown lack of good faith in their previous observations. The board pointed out, moreover, that it was in principle not the function of an examining division to assess either the degree of collaboration from applicants or their good faith when deciding whether or not to invite further observations in the exercise of its discretion under Art. 96(2) EPC 1973. The exercise of this discretion depended primarily upon whether or not there was a reasonable prospect that such an invitation could lead to the grant of a patent. See also **T 855/90**.

In **T 677/97** the board noted that R. 51(3) EPC 1973, by virtue of the phrase "where appropriate", allowed the examining division discretion to issue a first communication which was less than comprehensive. This interpretation of the EPC had also been approved in **T 98/88**. The board held it was incumbent on the examining division under Art. 96(2) EPC 1973 to send a second communication containing a reasoned statement as to why the objection under Art. 56 EPC was maintained. In making this finding the board stated it was not departing from the established case law of the boards of appeal which recognised that it was within the discretion of an examining division to issue a refusal decision after a single communication. In the circumstances of the case in hand, however, an immediate refusal was not a reasonable exercise of this discretion. The limits on the examining division's discretion in this respect were explained in **T 951/92** (OJ 1996, 53), in which decision the board stated that if a communication under R. 51(3) EPC 1973 and pursuant to Art. 96(2) EPC 1973 did not set out the essential legal and factual reasoning which would lead to a finding that a requirement of the EPC had not been met, then a decision based upon such a finding could not be issued without contravening Art. 113(1) EPC 1973, unless and until a communication had been issued which contained such essential reasoning. If a decision was issued in the absence of a communication containing such essential reasoning, Art. 96(2) EPC 1973 was also contravened, since in order to avoid contravening Art. 113(1) EPC 1973 it was "necessary" to issue a further communication (following **T 640/91**).

In **T 449/03** the board stated that the appellant's allegation that the applicant was generally entitled to receive at least two communications in the examination proceedings before a negative decision on patentability was unfounded (see **T 84/82**). However, where features are added to a claim in response to an official communication, it is only in exceptional cases that a further communication may be dispensed with (see **T 161/82**, OJ 1984, 551).

In **T 5/81** (OJ 1982, 249) the board noted that an appeal might relate only to a decision subject to appeal within the meaning of Art. 106(1) EPC 1973 and not to preparatory measures referred to in Art. 96(2) EPC 1973 and R. 51(3) EPC 1973. A failure to comply with these requirements could not be taken into consideration unless it had some influence on the decision to refuse, as in the case of a breach of Art. 113(1) EPC 1973 (see also **T 808/90**). The appellant's objection was unfounded, not only for this reason, but also because the examiner commented on the content of the claim in question by drawing attention to the possibility of formulating an independent claim based thereon. Since the appellant did not make use of that possibility, the examining division was not obliged to discuss it when refusing the application. The allusion thereto in the reasons for the decision did not form part of the ratio decidendi and was intended solely to demonstrate that the examining division was aware of the fact that the application might contain patentable subject-matter. A refusal under these circumstances was not open to challenge. See also **T 228/89**, **T 347/04**, **R 14/10**.

2.3.2 Bona fide attempt to deal with the examining division's objections

In **T 802/97** the board stated that when applying Art. 96(2) EPC 1973 to determine whether an applicant should be given a further opportunity to present comments or amendments before refusing an application after a single official communication, the established practice of the examining divisions as set out in particular in the Guidelines applicable at the time was to warn the applicant who had made a bona fide attempt to deal with the examining division's objections, e.g. by a telephone conversation or by a short further written action, that the application would be refused unless the applicant could produce further more convincing arguments or make appropriate amendments within a specified time limit. It held that only when the applicant had not made any real effort to deal with the objections raised in the first communication, should the examining division consider immediate refusal of the application, this however being an exceptional case. See also **T 89/93**, **T 201/98**, **T 587/02**.

In **T 201/98** the board accepted that in the case in hand the appellant's response to the single communication was a bona fide attempt to deal with the examining division's objections. However according to the established case law of the boards of appeal an examining division did not exceed its discretionary power by immediately refusing an application, provided that the decision complied with Art. 113(1) EPC 1973, i.e. was based on grounds on which the appellant had had an opportunity to present comments, see **T 84/82** (OJ 1983, 451) and **T 300/89** (OJ 1991, 480). In the case in hand, the board considered that the decision of the examining division was based on grounds on which the appellant had had an opportunity to present comments in accordance with Art. 113(1) EPC 1973.

In **T 1002/03** the board found that in the circumstances of the case no special warning (that the following stage might be the refusal of the application) in the official communication was necessary. The reasons given in the decision under appeal were essentially the same as those presented in the IPER on which the appellant had had an opportunity to present comments. The appellant's right to be heard (Art. 113(1) EPC 1973) had not been violated and the examining division had not exercised its discretion in an

unreasonable way by refusing the application after a single official communication (see also **T 1969/07**).

In **T 1388/10** the appellant argued that it had indeed made a "bona fide" attempt to overcome the examining division's objections and that its application should therefore not have been refused without a further "warning". The board noted that the Guidelines were not the law – unlike the EPC and its Implementing Regulations. It pointed out that when reviewing examining divisions' decisions it did not assess whether the division had complied with the Guidelines. Rather, it considered whether the division had exercised its discretion within the limits set by the EPC and its Implementing Regulations. In the case in hand, the board held that the examining division's decision not to issue a second communication under Art. 94(3) EPC fell within the discretion available to it, and its exercise of that discretion had not been flawed.

2.4. Amendments under Rule 137(3) EPC

Under Art. 123(1) EPC, a European patent application or a European patent may be amended in proceedings before the EPO, in accordance with the Implementing Regulations.

Before receiving the European search report, the applicant may not amend the description, claims or drawings of a European patent application unless otherwise provided (R. 137(1) EPC). Together with any comments, corrections or amendments made in response to communications by the EPO under R. 70a(1) or (2) EPC or R. 161(1) EPC, the applicant may amend the description, claims and drawings of their own volition (R. 137(2) EPC.

Rule 137(3) EPC stipulates that no further amendment may be made without the consent of the examining division.

2.4.1 Discretion of the examining division under Rule 137(3) EPC

The discretion given to the examining division under R. 137(3) EPC is intended to ensure that the examination procedure is brought to a conclusion in as few actions as possible. In exercising its discretion the examining division must consider all relevant factors; in particular, it must balance the applicant's interest in obtaining a patent which is legally valid and the EPO's interest in bringing the examination procedure to a close in an effective way possible (Guidelines C-IV, 3; H-II, 2.3 – April 2025 version). In giving or withholding such consent, the examining division has to exercise its discretion responsibly and in accordance with the principles as set out in **G 7/93** (OJ 1994, 775) which, although made in relation to amendments made in the pre-grant stage, can be considered generally applicable to new requests put forward at a late stage of the proceedings (see **T 1064/04**). Furthermore, the exercise of discretion under R. 137(3) EPC needs to be reasoned (see e.g. **T 182/88**, OJ 1990, 287; **T 183/89**; **T 755/96**, OJ 2000, 174).

In **G 7/93** the Enlarged Board pointed out that in the exercise of its discretion under R. 86(3) EPC 1973 (now R. 137(3) EPC), an examining division was required to consider

all relevant factors which arise in a case. In particular, it must consider both the applicant's interest in obtaining a patent which is legally valid in all of the designated states, and the EPO's interest in bringing the examination procedure to a close by the issue of a decision to grant the patent, and must balance these interests against one another (see also **T 1982/07**). Once an examining division has exercised such discretion, a board of appeal should only overrule it if it comes to the conclusion either that the examining division did not exercise its discretion in accordance with the right principles or that it exercised its discretion in an unreasonable way and had thus exceeded the proper limit of its discretion (see **T 237/96** with particular reference to **G 7/93** and **T 182/88**; see also **T 937/09**, **T 1214/09**, **T 918/14**).

In **T 573/12** the board noted that, as set out in **G 7/93**, an examining division, when considering whether to admit an amendment or not, is required to consider all relevant factors which arise in the case. In particular it must consider and balance the applicant's interest in obtaining a patent and the EPO's interest in bringing the examination procedure to a close. In the case in hand, the examining division's first communication was rather vague and assessed the invention in rather general terms, without analysing the individual features. The appellant's subsequent amendment added some features to the independent claims. In the board's judgment, this was a bona fide reaction. Additionally, it was the first amendment which was dependent on the examining division's consent and the minutes showed that the examining division could and did discuss the added features. Admitting the request would not have involved excessive or unjustified additional work. Furthermore, the Guidelines (Part C-VI, 4.7 – April 2010 version) stated: "Regarding less extensive amendments, the examiner should adopt a reasonable approach, trying to balance fairness to the applicant against the need to avoid unnecessary delay and excessive and unjustified additional work for the EPO." Given the above circumstances, the board held that the examining division did not properly balance all relevant factors and thus could not endorse the examining division's conduct.

In **T 1045/18** the board reiterated that an examining division had to take all relevant factors into account when exercising its discretion under R. 137(3) EPC; in particular, it had to strike a balance between the applicant's legitimate interest in obtaining a European patent and the EPO's interest in conducting the examination proceedings efficiently. The relevant factors included the stage reached in the proceedings and whether the applicant had already had sufficient opportunity to amend the application. Another important factor to be considered was the extent to which the amendments were suitable to overcome an existing objection and did not manifestly – i.e. unequivocally and in an immediately apparent way – give rise to new ones. Clear or prima facie allowability was at most a criterion for the admissibility of late-filed amendments (Guidelines H-II, 2.7.1) whereas the amended claim set at issue in this case had been filed within the period set under R. 116(2) EPC (see also **T 222/21**).

In **T 937/09** the board stated that a proper exercise of the examining division's discretion under R. 137(3) EPC as to whether to admit amendments to a European patent application after the first communication meant, in its view, that the examining division had to admit amendments filed by the applicant together with the reply to a communication giving reasoned notice of a particular deficiency for the first time, if it could already have raised

an objection to that deficiency in its first communication, and if the amendments could be regarded as an objectively suitable attempt to correct the deficiency.

In **T 166/86** (OJ 1987, 372) the board held that the examining division would not be able to refuse its consent to an amendment if, for good reasons, the applicant was only at that late stage in a position to request the amendment, or if the requested amendment was obviously essential for him and to take it into account would not appreciably delay the grant procedure.

In **T 229/93** the board found that in the circumstances of the case the examining division should have considered refusing to consent to the amendments pursuant to R. 86(3) EPC 1973, since the filing of such amendments after the expiry of the time limit for answering the first communication of the examining division in the form of a completely retyped description was contrary to the requirement of procedural economy (see **T 113/92**).

In **T 951/97** (OJ 1998, 440) the board held that it was easier to secure an amendment at an earlier rather than at a later stage of the procedure. See also **T 76/89**, **T 529/94**, **T 937/07**. For instance, the board in **T 674/17** exercised its discretion not to admit the new main request into the proceedings, in accordance with R. 137(3) and 100(1) EPC, since the new main request (submitted only after the board had sent a communication under Art. 15(1) RPBA 2007) amounted to the presentation of a fresh case.

In **T 2324/14** the examining division had found that the auxiliary request "prima facie [did] not overcome the objections under Art. 84 EPC and Art. 83 EPC", and thus it did not give its consent under R. 137(3) EPC to it. The board noted that the EPC does not define what it means for an examining division to give or deny its consent to an amendment under R. 137(3) EPC. The boards of appeal had, however, accepted that the examining division could base its decision to deny consent to an amendment on prima facie considerations and that it could deny its consent to an amendment with prima facie deficiencies. However, the examining division had not limited its examination of the auxiliary request to prima facie considerations. In fact, the examining division had considered the auxiliary request fully, since it was able to give sufficient reasons for its conclusion that a patent could not be granted on the basis of that request. The examining division thus having considered the auxiliary request fully, the board took the view that there was no discretion left for the examining division "not to admit" it. In **T 2026/15** the board confirmed these findings, adding that this meant that the examining division had implicitly admitted the auxiliary request and, equivalently, had given its consent under R. 137(3) EPC. See also **T 1585/19**.

In **T 1105/96** (OJ 1998, 249) the board noted that where an examining division had indicated that a further request in the form of an amended text for the main claim of an application would be allowable, it was difficult to imagine any circumstances in which it would be lawful for the examining division to deny the admissibility of such request, in the exercise of its discretion. Certainly, in the circumstances of the case in hand, the rejection in advance of such a further auxiliary request unless all preceding requests were

abandoned was an abuse of procedure, an unlawful exercise of discretion under R. 86(3) EPC 1973 and thus a substantial procedural violation.

In **T 2558/18**, the board dealt with the binding effect on an examining division of a remittal with precisely specified documents for the purposes of R. 71(3) EPC. It observed that, under Art. 111(1), second sentence, EPC, the boards could either exercise any power within the competence of the department responsible for the decision appealed (alternative 1) or remit the case to that department for further prosecution (alternative 2). It summed the situation up as follows in its Catchword: Where a board remits a case to the examining division for the grant of a patent in a precisely specified version, i.e. with precisely specified claims, description and drawings, the decision on this version is taken by virtue of the first alternative in Art. 111(1), second sentence, EPC. The version is binding on the examining division in accordance with the legal principle enshrined in Art. 111(2) EPC (res judicata), on the basis of which the remittal is also ordered. The procedure under R. 71(6) EPC is inapplicable in view of the binding effect arising from Art. 111(2) EPC by virtue of Art. 164(2) EPC. See chapter V.A.10.1.1b) "Binding effect on examining divisions".

2.4.2 Consent under Rule 137(3) EPC in oral proceedings

Rule 116(2) EPC supplements R. 137(3) EPC with a special provision on amendments to the application where oral proceedings are to be held, under which the examining division has discretion to disregard such amendments if they are not filed before the date fixed in the summons to such proceedings. However, whilst meeting the time limit for filing further requests for amendments to the application fixed in the summons under R. 116 EPC does not render R. 137(3) EPC inapplicable, requests filed by that time limit can only be refused under R. 137(3) EPC in a proper exercise of discretion (**T 937/09**, **T 2294/12** and **T 1411/21**).

2.4.3 The burden of proposing amendments

In **T 300/89** (OJ 1991, 480) the board pointed out that, even if it were possible for the examiner to envisage amendments which might lead to the grant of a patent, the burden lay with the applicant to propose amendments if they so wished (including various alternatives in the form of auxiliary requests). These amendments could be proposed in the applicant's observations in reply to the first communication (Art. 96(2) EPC 1973) from the examining division, where any objections were raised (see also **T 599/92**).

In **T 301/10** the board stated that it was incumbent upon the appellant to maintain unamended or to amend – optionally on an auxiliary basis – the application documents upon which examination was to be carried out and a decision eventually to be reached (Art. 94 and 97 EPC together with Art. 113(2) EPC 1973) (see **T 300/89**), and not upon the examining division to prolong the examination procedure beyond the procedural framework set out in the EPC (see in this respect Art. 123(1) EPC together with R. 86(3) EPC 1973) until the applicant opts for amending the application and eventually "exhausts" all possibilities for amendment, as this would seriously undermine the principle of procedural economy.

2.4.4 Converging or diverging versions of claims

In **T 2680/18** the board noted that in principle, the convergence of a plurality of requests may be taken into account when deciding on the admissibility of requests based on R. 137(3) EPC. What mattered was the "convergence" or "divergence" of the claim versions, i.e. whether they further developed the subject-matter of the independent claim of the main request by progressively limiting it in one direction or in the direction of one inventive idea, respectively, or whether they develop it along various directions by incorporating different features.

Also in **T 1411/21** the board stated that the convergence (or the divergence) of requests was in principle an accepted criterion for deciding on their admissibility under R. 137(3) EPC. It applied not only within a set of claims filed together but also with respect to earlier requests.

In **T 1074/10** the board noted that the convergence criterion (i.e. whether the respective versions of the sets of claims converge or diverge) had been accepted and also applied by the boards of appeal themselves (see e.g. **T 240/04**, **T 1685/07**, **T 1969/08**). The board observed that R. 86(3) EPC 1973 (R. 137(3) EPC) left open entirely how the examining division should exercise its discretion and in particular, neither defined a convergence criterion nor a criterion based on prima facie compliance with the requirements of the EPC. The board was of the opinion that the "divergence" of a request from earlier requests in the sense that it changed substantially the issues at stake could be contrary to the EPO's interest in bringing the procedure to a close. Therefore, the board agreed with the cited case law and considered that divergence of a request was one factor amongst others which a deciding instance may consider when exercising its discretion under R. 86(3) EPC 1973. The decision of the examining division not to admit a request was therefore not wrong merely because this criterion was used.

In **T 996/12** the board stated that, in general terms, the way in which the examining division should exercise its discretion to allow amendment of an application depended upon the circumstances of each individual case and on the stage of the pre-grant procedure which the application had reached. The board noted that the applicable Guidelines did not support the concept of converging claim sets being a requirement for allowing amendments or, conversely, a diverging claim set not being acceptable. The examining division referred to two board of appeal decisions, **T 1685/07** and **T 745/03**, for this criterion. Apart from the fact that these decisions apply particularly to the situation where a patent proprietor submits a plurality of auxiliary requests in addition to a main request in opposition appeal proceedings, it needed to be stressed that its underlining justification was to be found in the efficiency of these appeal proceedings, the latter being of a judicial nature in contrast to the purely administrative character of the proceedings before, for instance the examining division or the opposition division. The board found that this fundamental distinction eo ipso made the unqualified application of this criterion by the department of first instance of the EPO questionable.

2.4.5 Reasons for the exercise of discretion

In **T 182/88** (OJ 1990, 287) and **T 166/86** (OJ 1987, 372) the boards decided that a separate set of claims submitted at a late stage in the proceedings was admissible under the particular circumstances. They added that the EPO's user-friendly reputation should clearly be excluded from consideration during the exercise of any discretion by the EPO. The showing of consideration towards parties before the EPO should not be confused with the proper exercise of discretion according to the law. It was also held that when a decision hinged on the exercise of discretion, the reasons should be given (see also **T 183/89**; **T 755/96**, OJ 2000, 174).

In **T 309/09** the board doubted that the number of auxiliary requests could generally be considered a factor on the basis of which their admission under R. 137(3) EPC could properly be denied outright. Whilst it did not wish to rule out that a large number of auxiliary requests might be a sufficient reason in specific cases, it decided that the question could be left unanswered in the case in hand, as in any event six auxiliary requests could not automatically be considered excessive. Nor did it have to consider whether a lack of convergence among the requests was relevant in this connection, because the contested decision did not contain any explicit analysis of specific cases which might support such a conclusion, even though any convergence criterion applied would at any rate have had to be assessed separately for each individual request. The board concluded that the examining division had been entitled to exercise discretion and had done so in accordance with criteria which were essentially correct in the light of **G 7/93**, but that, contrary to R. 111(2) EPC, it had failed to give adequate reasons in support of its exercise of discretion in the contested decision. Discretionary decisions could not be taken arbitrarily and – like all decisions open to appeal – had to be substantiated.

In **T 246/08** the board stated that according to the established case law of the boards of appeal the power of the examining division to consent to amendments under R. 137(3) EPC was a discretionary power that had to be exercised after considering all the relevant factors of the specific case and balance in particular the applicant's interest in obtaining an adequate protection for their invention and the EPO's interest in bringing the examination to a close in an effective and speedy way. Moreover, the exercise of a discretionary power had to be reasoned, otherwise it would be arbitrary. It followed that a refusal of consent to amend made in advance of any amendment being submitted could not be a reasonable exercise of discretion pursuant to R. 137(3) EPC. Indeed it was ipso facto a substantial procedural violation since it risked deterring an applicant from making an amendment which could not reasonably have been forbidden. See also **T 872/90**, **T 1591/23**.

In **T 233/12** the board pointed out that the criterion that an amended set of claims was prima facie not allowable was, in general, an accepted principle (amongst others) to be taken into account in the assessment of whether consent under R. 137(3) EPC should be given to the amendment. While a prima facie finding that a claim was not allowable may, by its very nature, be justified in briefer terms than a fully reasoned conclusion, the reasons for a prima facie finding may not be so short as to reduce the finding to a mere allegation. Moreover, the amount of reasoning required to justify a prima facie finding was amongst

the parameters which the examining division had to balance in view of the circumstances of each individual case when exercising its discretion. In particular, if an applicant filed an amendment together with arguments as to why the amendment, in its view, satisfied a particular requirement of the EPC, the examining division could not merely assert the contrary without giving an indication as to why the applicant's argument failed. That is, a prima facie finding must not simply ignore the arguments on file which appear to directly contradict it.

In **T 431/21** the board concluded that the examining division had exercised its discretion under R. 137(3) EPC in an unreasonable manner, thereby exceeding the limits of its discretion. Citing **T 233/12**, the board agreed that the criterion of "clear non-allowability" was, in general, an accepted principle (among others) to be taken into account in the assessment of whether consent under R. 137(3) EPC should be given to the amendment. The examining division, however, had not duly balanced this criterion with the equally relevant principle of the legitimate interest of the appellant to obtain a valid patent. To come to this conclusion the board considered that the relevant requests were filed in due time, i.e. within the time limit set according to R. 116(1) EPC, and that they were convergent. Moreover, the amendments represented a fair attempt to overcome the prima facie objections raised by the examining division under Art. 84 and 123(2) EPC. The board found that the decision of the examining division to assess prima facie that all amendments were unsuitable for overcoming the objections raised was not justified. A separate discussion of the alleged "clear non-allowability" for each request, as wished by the appellant, would have been fair and appropriate and should not have been denied by the examining division at the oral proceedings. Moreover, the board noted that the reasoning presented in relation to the alleged "clear non-allowability" issue had failed to explain why the detailed arguments presented in writing by the appellant in support of the allowability of certain of their requests were not convincing. This deficiency in the decision under appeal gave rise to a substantial procedural violation (Art. 113(1) EPC and R. 111(2) EPC).

2.4.6 Requests for amendments filed at an advanced stage in proceedings

According to the Guidelines, when the applicant files an extensively revised request to replace the text of the application on the basis of which a patent could be granted , they must provide good reasons for proposing the changes only at this stage in the proceedings (Guidelines H-II, 2.4 – April 2025 version).

In **T 222/21** the board noted that Guidelines H-II, 2.4 (November 2019 version) was incomplete insofar as it merely referred to the criterion of whether the text was "extensively revised", i.e. a quantitative criterion. It held that this point should be read in conjunction with point H-II, 2.5.1 of the Guidelines ("Criteria for admitting such amendments"). It followed from these two points, read in conjunction, that what mattered for the exercise of the discretion to admit or not to admit, if the text was extensively revised, was the content of the amendments and the consequential amount of time for examination that the amendments prima facie required. It was this amount of time that determined whether the amendments were extensive.

2.4.7 Late-filed requests after summons to oral proceedings in examination

The examining division will first consider the requests before deciding on their admissibility. The mere fact that they are filed late is not per se a reason for not admitting them. In exercising its discretion under R. 137(3) EPC (see **G 7/93**), the examining division should take into account whether the applicant has good reasons for filing the request late (Guidelines H-II, 2.7 – April 2025 version).

The examining division will also apply the criterion of "clear allowability" in exercising its discretion under R. 137(3) EPC for treating requests filed after the final date set in accordance with R. 116(2) EPC without proper justification (Guidelines H-II, 2.7.1 – April 2025 version; see also **T 153/85**, OJ 1988, 1).

In **T 102/15** the board found that the examining division's reasons for refusing to admit the then auxiliary requests 6 to 8 – namely that, prima facie, they did not overcome the objections of a lack of inventive step and their extension beyond the content of the application as filed – showed that it had followed the approach set out in the Guidelines and concluded that the requests had already failed at the first hurdle in the assessment of admissibility. Auxiliary requests 6 to 8 were filed with the examining division the day before the oral proceedings, i.e. after the date fixed under R. 116 EPC in the summons. The examining division had, the board held, exercised its discretion under R. 137(3) EPC reasonably and – in applying the "clear allowability" test – in accordance with the right criteria. The board saw no reason to exercise its own discretion under Art. 12(4) RPBA 2007 differently.

2.4.8 Second communication under Rule 71(3) EPC: the consent of the examining division

If the examining division gives its consent to the amendments filed under R. 137(3) EPC and/or the correction of errors under R. 139 EPC and considers them allowable without issuing a further communication under Art. 94(3) EPC, it issues a second communication under R. 71(3) EPC based on the amended/corrected text, after which it then proceeds to the grant of the patent pursuant to Art. 97(1) EPC (see below in this chapter IV.B.3.1. "Informing applicant of the text intended for grant (Rule 71(3) EPC)").

In **T 816/19** the board accepted that, in the light of Guidelines C-V, 1.1 (November 2017 version), and the nature of the proposed amendments, it was debatable whether it was wise to propose these amendments in a communication under R. 71(3) EPC without first consulting the applicant. However, even if an amendment proposed in a communication under R. 71(3) EPC was inappropriate, no fundamental loss of rights was at stake since the applicant always retained the right to disapprove such an amendment (pursuant to Art. 113(2) EPC) thereby triggering either a new communication under R. 71(3) EPC or a resumption of examination proceedings, pursuant to R. 71(6) EPC.

2.5. Failure to reply to the communication from the examining division (Article 94(4) EPC)

According to Art. 94(4) EPC, if the applicant fails to reply in due time to any communication from the examining division, the application shall be deemed to be withdrawn. Art. 94(4) EPC corresponds in essence to Art. 96(3) EPC 1973.

2.5.1 Reply within the meaning of Article 94(4) EPC

In **J 37/89** (OJ 1993, 201), the Legal Board noted that requesting in good time a time-limit extension could also be regarded as a timely answer, even if it did not address the matter at issue. Applicants' answers did not have to contain relevant matter enabling the examining division to alter the view expressed in its communication for a loss of rights under Art. 96(3) EPC 1973 to be avoided. However, an applicant who merely requests an extension of the term for reply which request is then refused, "fails to reply" within the meaning of that sub-paragraph, with the consequence that the application must be deemed withdrawn.

In **T 160/92** (OJ 1995, 35) the board held that Art. 96(3) EPC 1973 did not require "a complete reply", but only "a reply" in order to avoid the consequence of having the application deemed to be withdrawn. A letter of reply to a communication of the examining division filed in due time by the applicant and dealing with substantial points of this communication constituted a reply within the meaning of Art. 96(3) EPC 1973 and thus, from the point of view of procedural law, ruled out the possibility of deemed withdrawal.

In **J 29/94** (OJ 1998, 147) the Legal Board observed – in relation to Art. 110(3) EPC 1973 – that there was another form of reply which could result in a refusal, and not in the deemed withdrawal of the application; if the applicant did not want to reply in substance to the communication, it was permissible for him to ask for a decision on the file as it stood. In **T 685/98** (OJ 1999, 346) the board noted that this type of reply was in effect a waiver of the right under Art. 113(1) EPC 1973 to present comments in relation to the disclosed deficiencies. It concluded, with reference also to **J 37/89** and **T 160/92** that prior to a valid refusal the applicant must either have exercised their right to comment or have waived this right.

In **J 5/07** the Legal Board held that the filing of a divisional application did not constitute a response to an invitation by the examining division in the parent application within the meaning of Art. 96(3) EPC 1973. The Legal Board noted that a divisional application was legally and administratively separate and independent from the grant proceedings concerning the parent application (see **G 1/05**, OJ 2008, 271; **T 441/92**). The filing of a divisional application left the text of the patent application objected to unamended.

In **T 861/03** the board found that filing a request for an interview with the processing examiner without also submitting substantive observations on deficiencies identified in the communication under Art. 96(2) EPC 1973 did not amount to an adequate reply for the purposes of Art. 96(3) EPC 1973, under which the legal consequence of failing to submit such a reply was that the application was deemed to be withdrawn.

2.5.2 Waiver of the applicant's right to present comments

In **T 685/98** (OJ 1999, 346) the board held that in unclear cases there could be no presumption that an applicant had waived their right to be heard under Art. 113(1) EPC 1973. The board noted that prior to a valid refusal under Art. 97(1) EPC 1973 the applicant must either have exercised their right to comment or have waived this right. It held that a simple procedural request made by the applicant after receipt of the R. 51(2) EPC 1973 communication could not be treated as a waiver of the right to present comments during the remainder of the four-month term set for reply. When the applicant neither replied in substance to the objections raised nor waived their right to present comments, then the refusal of the application was ultra vires and voidable ab initio because under Art. 97(1) EPC 1973 the application was to be refused if no different sanction was provided for by the EPC. However, Art. 96(3) EPC 1973 provided a different sanction for failure to reply, namely the deemed withdrawal of the application.

2.6. Issuing a further communication in light of Article 113(1) EPC

2.6.1 Introduction

If it appears that the previous communications were insufficiently reasoned or incomplete, or if the applicant has filed amendments and/or arguments since the previous communication, the examiner should carefully consider Art. 113(1) EPC before issuing a refusal. A further communication may have to be issued with sufficient reasoning, unless oral proceedings are to be held (see Guidelines C-V, 15.4 – April 2025 version).

Under Art. 113(1) EPC, the decisions of the EPO may only be based on grounds or evidence on which the parties concerned have had an opportunity to present their comments.

In **T 645/11** the board stated that Art. 113(1) EPC 1973 guaranteed that proceedings before the EPO would be conducted openly and fairly (see **J 20/85**, OJ 1987, 102; **J 3/90**, OJ 1991, 550). The right to be heard ensures that the parties to proceedings are not taken by surprise by grounds mentioned in an adverse decision (see e.g. **T 669/90**, OJ 1992, 739; **T 892/92**, OJ 1994, 664). That requires, firstly, that a party be given an opportunity to comment on the grounds and evidence alleged against it. In particular, it means that if a decision to refuse is taken on the basis of grounds which have not previously been presented to the applicant, then the decision does not comply with the provisions of Art. 113(1) EPC 1973. It is not sufficient that the applicant be presented with an assertion that the application fails to comply with some provision of the EPC. There must also be an explanation of why it fails to comply. The right to be heard also requires the deciding instance demonstrably to hear and consider any relevant comments (see **T 763/04**, **T 246/08**).

In **T 690/09** the board stated that if a request for amendment was refused, the examining division must inform the applicant of the reasons for not admitting the amendments in order to satisfy the right to be heard according to Art. 113(1) EPC. The applicant would typically be invited to request grant on the basis of a preceding acceptable version of the claim set

if such a version existed. Otherwise, if the applicant maintained their request for amendment, the application had to be refused under Art. 97(2) EPC, since there was no text which had been approved by the applicant and allowed by the examining division (see Art. 113(2) EPC 1973, see also **T 647/93**, OJ 1995, 132; **T 946/96**; **T 237/96**).

In **T 246/08** the board stated that established case law had interpreted Art. 113(1) EPC 1973 to mean that the comments presented must be considered in the ensuing decision (**J 7/82**, OJ 1982, 391). Thus a decision which failed to take explicitly into account potentially refutative arguments submitted by a party, i.e. arguments which may militate against or cast doubt on the decision in question, contravened Art. 113(1) EPC 1973, thereby constituting a substantial procedural violation. In brief, a decision must show that all potentially refutative arguments adduced by a party are actually refutable. See also **T 1170/07**.

In **T 1854/08** the applicant was informed by e-mail that the three newly filed requests were not admitted into the proceedings because they introduced substantial obscurities. The board stated that the applicant had not been given any opportunity to present their comments to overcome the negative position expressed in the e-mail. Contrary to that, the applicant had gathered from the e-mail that it was no longer possible to convince the examining division. This followed from the fact that the refusal to admit the newly filed request was not presented as a provisional opinion of the division but as a decision which could not be overturned. This contravened Art. 113(1) EPC.

2.6.2 Arguments taken into account in the decision of the examining division

According to the case law of the boards of appeal, the examining division does not have to address each of the party's arguments (see e.g. **T 1969/07**, **T 1557/07**, **R 19/10**).

In **T 1557/07** the board stated that with regard to the allegation that the examining division did not fully and accurately deal with all the relevant arguments submitted by the applicants, the examining division was under no obligation to address each and every argument presented by the party concerned. In the case in hand, the examining division had commented on the crucial points of dispute thus giving the applicants a fair idea of why their submissions were not considered convincing. This allegation was therefore not conclusive. In conclusion, the examining division had not committed a substantial procedural violation.

In **R 19/10** the petitioner submitted that Art. 113(1) EPC not only enshrined a party's right to be heard before a decision was issued against it, but also guaranteed its right to have the relevant grounds fully taken into account in the written decision. The Enlarged Board stated that this principle was not without any limitation, as explained in **T 1557/07**: provided that the reasons given enable the parties concerned to understand whether the decision was justified or not, the deciding organ is under no obligation to address each and every argument presented by the party concerned.

In **T 802/97** the board held that if a decision included several grounds, it should meet the requirements of Art. 113(1) EPC 1973 with respect of each of the grounds. In the board's

judgment, if a decision of the EPO included several grounds supported by respective arguments and evidence, it was of fundamental importance that the decision as a whole met the mandatory requirements of Art. 113(1) EPC 1973. Leaving it up to the deciding body to suggest which of the grounds were to be considered as the basis of the decision and which were not – and did not therefore need to comply with the requirements of Art. 113(1) EPC 1973 – could only lead to legal uncertainty and confusion of the parties. An exception from the above principle could be obiter dicta which were not part of the grounds on which a decision is based.

2.6.3 Inclusion of the essential reasoning

In **T 951/92** (OJ 1996, 53) the board held that if a communication under R. 51(3) EPC 1973 and pursuant to Art. 96(2) EPC 1973 did not set out the essential legal and factual reasoning to support a finding that a requirement of the EPC had not been met, then a decision based on such a finding could not be issued without contravening Art. 113(1) EPC 1973, unless and until a communication had been issued which did contain the essential reasoning. If a decision was issued in the absence of a communication containing essential reasoning, Art. 96(2) EPC 1973 was also contravened, since in order to avoid contravening Art. 113(1) EPC 1973 it was "necessary" to issue a further communication (see also **T 487/93**, **T 520/94**, **T 750/94**, OJ 1998, 32; **T 121/95**, **T 677/97**). Moreover, the board summed up the case law by stating that Art. 113(1) EPC 1973 was intended to ensure that, before a decision refusing an application for non-compliance with a requirement of the EPC was issued, the applicant had been clearly informed by the EPO of the essential legal and factual reasons on which the finding of non-compliance was based. This was so that in advance of the decision the applicant knew both that the application might be refused and why, and also so that they might have a proper opportunity to comment upon the reasons and/or to propose amendments so as to avoid refusal of the application. Thus the term "grounds or evidence" in Art. 113(1) EPC 1973 should not be narrowly interpreted. In particular, in the context of the examination procedure the word "grounds" did not refer merely to a ground of objection to the application in the narrow sense of a requirement of the EPC which was considered not to be met. The word "grounds" should rather be interpreted as referring to the essential reasoning, both legal and factual, which led to refusal of the application (**T 187/95**). In other words, before a decision was issued an applicant had to be informed of the requirement which they had to meet and had to have an opportunity of meeting it (see also **T 487/93**, **T 520/94**, **T 750/94**, **T 121/95**).

In **T 907/91** the examining division refused the application without informing the applicant of its grounds for not accepting the amended documents submitted after receipt of the first communication and after oral proceedings. The board held this action to be in breach of Art. 113(1) EPC 1973 because, prior to issuing the contested decision in written or oral proceedings, the examining division should have given its reasons for refusing to accept the amended documents. Such grounds could be of a formal nature or relate to substantive patent law, depending on the relevant provisions. However, other grounds could also be brought to bear, based on generally recognised principles of procedural law (see Art. 125 EPC 1973), such as the applicant's attempt to delay proceedings by submitting

an excessively large number of requests for amendments in clear abuse of the patent grant procedure.

In **T 763/04** the board stated that Art. 113(1) EPC 1973 enshrined a party's right to be heard before a decision was issued against it. In accordance with the established case law of the boards of appeal (see **J 7/82**, OJ 1982, 391 and **T 94/84**, OJ 1986, 337) this right also guaranteed the right to have the relevant grounds fully taken into account in the written decision. The board held that Art. 113(1) EPC 1973 would be contravened where, as in the case in hand, facts and arguments, which from the appellant's submissions were clearly central to their case and which may speak against the decision taken, were completely disregarded in the decision in question. The board stated that Art. 113(1) EPC 1973 required not merely that a party be given the opportunity to voice comments, but more importantly that the deciding instance demonstrably heard and considered these comments. In summary, the right to be heard in accordance with Art. 113(1) EPC 1973 was contravened if the decision of the first instance failed to mention and to take into consideration important facts and arguments which may speak against the decision in question. See also **T 206/10**, **T 246/08**.

2.6.4 Essential reasoning based on an International Preliminary Examination Report

In **T 275/99** the board held that the requirements of Art. 113(1) EPC 1973 were met if the appealed decision was entirely based on the grounds, facts and evidence which were already known to the appellant from the extensive IPER which had been drawn up for the description and the claims of the international application corresponding exactly to the European application refused and which had been incorporated by way of reference in an official communication of the examining division.

In **T 587/02** the board held that if the only communication preceding the decision to refuse an application merely drew attention to an IPER, the requirements of Art. 113(1) EPC 1973 were met provided the IPER constituted a reasoned statement as required by R. 51(3) EPC 1973, using language corresponding to that of the EPC.

In **T 1870/07** the single communication from the examining division pursuant to Art. 96(2) EPC 1973 merely signalled agreement with the IPER. The board did not see any objection to citing an IPER from an IPEA other than the EPO, provided that it constituted a reasoned statement (see, for example, **T 951/92**). However, in its view, the IPER failed to meet the requirements of a reasoned statement. In the communication of the examining division, there was no logical chain of reasoning which would have permitted the appellant to understand and deal with the novelty objection, either by amendment or counterargument. Art. 113(1) EPC 1973 was, therefore, not satisfied.

2.6.5 Fresh argument based on grounds and evidence communicated beforehand

According to the case law of the boards of appeal, the use of a fresh argument in a decision still based on grounds and evidence communicated beforehand is not precluded.

In **T 268/00** the board pointed out that the right to be heard pursuant to Art. 113(1) EPC 1973 only precluded a decision being taken on the basis of fresh evidence and grounds, while the use of a fresh argument in a decision still based on grounds communicated beforehand was not precluded. Hence the technical argument in the decision under appeal addressed by the appellant, whether fresh or not, did not violate any of the appellant's rights. As to the technical substance of that argument, whilst the appellant might neither agree with the finding of the examining division nor with the technical argument given, a divergence of views between the examining division and the appellant on the substantive issue of inventive step did not amount to a procedural violation. See also **T 1557/07**, **T 815/08**.

2.6.6 Bona fide attempt by the applicant to overcome the objections

In **T 734/91** the appellant had filed a fresh set of claims in reply to a communication of the examining division, the subject-matter of claim 1 being considerably changed in the light of the objection of lack of novelty raised by the examining division. The effort by the appellant was therefore considered to represent a bona fide attempt to overcome these objections. Claim 1 as amended had not been dealt with in the communication by the examining division but only in the contested decision. Thus the appellant did not have an opportunity to present their comments with regard to the grounds for refusal of this amended claim 1. The board stated that the examining division had to communicate the grounds against the grant of a patent to the applicant before refusing an application. In doing so it had to exercise its discretion to decide when it was deemed necessary and appropriate to invite the applicant's comments. This had to be done objectively in the light of the circumstances of each case (**T 162/82**, OJ 1987, 533). This did not mean that the applicant should be given repeated opportunity to comment on the same objections (**T 161/82**, OJ 1984, 551; **T 42/84**, OJ 1988, 251; **T 243/89**). In a case where an applicant had made a bona fide attempt to overcome the objections raised by the examining division, Art. 113(1) EPC 1973 may require such an attempt to be confirmed in the light of amended claims and substantial comments of the applicant. See also **T 582/93** and **T 998/05**.

In **T 763/04** the board held that the appellant, who had made a bona fide attempt to address the sole objection raised, could have legitimately expected the examining division out of fairness to use the discretion afforded by Art. 96(2) EPC 1973 to offer at least one further opportunity to address the objection. The board considered the refusal after the third communication, which was the first R. 51(3) EPC 1973 compliant communication as regards the ground of lack of novelty, without the issuance of a further communication, to represent a violation of the general principle of good faith and fair proceedings underlying the proceedings before the EPO.

In **T 92/96** the board found that, after notification of a correctly reasoned communication from the examining division, the applicants had had an opportunity to comment on the objections set out therein, but had confined themselves to suggesting a minor correction to the claim. The examining division decided to refuse the application, since the applicants had made no real effort to reply to the objections. In the board's view, the applicants had therefore suffered no prejudice. Consequently, the examining division had not committed a procedural violation, particularly with regard to Art. 113(1) EPC 1973.

2.6.7 Form of the communication under Article 113(1) EPC

In **T 1237/07** the board pointed out that the right to present comments enshrined in Art. 113(1) EPC 1973 did not necessarily need to be exercised in writing but could be satisfied by way of oral proceedings.

In **T 497/02** the board found that Art. 113(1) EPC 1973 merely required applicants to be afforded the opportunity to present their comments on the grounds on which the EPO had based its decision: it did not require a written communication nor did it specify how much time applicants should be afforded to consider and present their comments.

2.7. Informal communications

There are instances where personal consultation with the applicant can be helpful in advancing the procedure. Such consultations used to take place by telephone or in the form of interviews; nowadays they are preferably held by videoconference, thereby allowing, where necessary, the presentation of documents, the participation of other persons and the verification of the identity of the person(s) attending. However, consultations can still be held by telephone at the request of the applicant, if the situation so requires (see Guidelines C-VII, 2 – April 2025 version).

2.7.1 Telephone conversations

In **T 300/89** (OJ 1991, 480) the board held, in relation to the appellant's complaint as to the failure of the examiner to telephone as requested, that the practice in relation to such informal communications was clearly set out in the Guidelines. Such informal communications and the practice relating to them should be clearly distinguished from the formal examination procedure governed by Art. 96(2) EPC 1973 and R. 51 EPC 1973. The examiner's discretion as to whether to make such an informal communication had to be exercised in accordance with the Guidelines, having regard to the particular circumstances of each individual case. An exercise of such discretion adversely to an applicant, such as in the case in question, could not by its nature be a procedural violation, however, because the procedure for such conversations was informal in the sense that it was not governed by the EPC 1973, but was additional to the procedure provided by the EPC 1973. In any event, in the board's view, in the case in question no criticism could properly be made of the examiner in relation to their failure to telephone the appellant.

In **T 160/92** (OJ 1995, 35) the appellant claimed that in two telephone conversations with the primary examiner they were misled into believing that a refusal was not imminent, as a further communication would be issued as the next step of the procedure. The board observed that one should be warned against expecting too much from telephone calls in critical situations, as misunderstandings could happen more easily than in writing. It was with good reason that the procedure before the EPO was in principle, with the exception of oral proceedings under Art. 116 EPC 1973, a written procedure. Moreover, in the examination (as well as in the opposition) procedure the primary examiner was only one of a division of three examiners, it being well known that the individual statements of the primary examiner could not be binding for the division. Furthermore, telephone

conversations were not provided for in the EPC and did not, as such, form part of the formal procedure before the EPO. The board held that the answer to the controversial question whether the applicant was misled about the possibility of imminent refusal of the application must be sought by focusing on the procedurally relevant content of the file.

In **T 1905/07** the board pointed out that presenting new grounds in a telephone conversation should not be equated with presenting the same grounds in formal oral proceedings or in a formal written communication. First, mere verbal communication by telephone was more prone to misunderstandings. Secondly, a party also had a right to be heard by the organ which took the decision, i.e. the examining division in the case in hand. A telephone conversation with only one of the examiners of that division did not safeguard this right in the same way as oral proceedings. Whether or not a party's fundamental right to be heard had been infringed depended on the particular circumstances of the case.

2.7.2 Interviews

In **T 98/88** it was held that Art. 116 EPC 1973 gave every party the absolute right to oral proceedings, but not the right to an interview with a particular member of an examining division. It was for the examiner concerned to decide whether such an interview should take place (see also **T 589/93**). In **T 193/93**, the board held that examiners were under no obligation to grant an "interview" (**T 235/85**, **T 909/95**).

In **T 409/87** the board noted that a request for an interview was clearly not, by itself, a request for oral proceedings and there was thus no obligation upon the examining division to grant a request for an interview when, as set out in the Guidelines, the examiner believed that no useful purpose would be served by such a discussion (see **T 19/87**, OJ 1988, 268, **T 909/95**). As an interview, in contrast to oral proceedings, is not a procedural step provided by the EPC, the refusal to grant a request for an interview was not a decision open to appeal and, therefore, does not fall under the provision of R. 68(2), first half-sentence, EPC 1973. See also **T 283/88**.

In **T 299/86** (OJ 1988, 88) the board held that the right of a party to request oral proceedings under Art. 116 EPC 1973 was in no way affected by the fact that such party could have also requested and/or attended an interview with the examiner.

In **T 808/94** the board stated that informal interviews (also called "personal consultation") and/or informal consultations by telephone which were carried out by the primary examiner alone could not replace duly requested oral proceedings under Art. 116 EPC 1973, which were to take place before all members of the examining division (Art. 18(2) EPC 1973).

3. The grant stage in examination

By decision of the Administrative Council CA/D 2/10 of 26 October 2010 (OJ 2010, 637), R. 71 EPC's paragraphs 3 to 7 were amended, its paragraphs 8 to 11 were deleted and new R. 71a EPC was inserted. The provisions as amended entered into force on 1 April 2012. Among other changes, the requirement to file a translation of the claims each time that the applicant requested (or agreed to) an amendment or correction of the claims

was removed, and the pre-2002 practice concerning changes to the text intended for grant suggested by the examining divisions was reinstated.

Amended R. 71 EPC focuses on the work of the examining division and R. 71a EPC on issues which arise when the grant procedure is concluded and which are mainly dealt with by the formalities officer acting on behalf of the division (such as the filing of translations of the claims or the payment of the fee for grant and publishing).

3.1. Informing applicant of the text intended for grant (Rule 71(3) EPC)

The amended text of R. 71(3) EPC (R. 51(4) EPC 1973), which entered into force on 1 April 2012, reads as follows: "Before the examining division decides to grant the European patent, it shall inform the applicant of the text in which it intends to grant it and of the related bibliographic data. In this communication the examining division shall invite the applicant to pay the fee for grant and publishing and to file a translation of the claims in the two official languages of the EPO other than the language of the proceedings within four months."

Thus once the examining division has decided that a patent can be granted it must inform the applicant of the text on the basis of which it intends to do so. This text may include amendments and corrections made by the examining division on its own initiative which it can reasonably expect the applicant to accept (Guidelines C-V, 1.1 – April 2025 version).

In **T 1849/12** the appellant asked for the withdrawal of the examining division's communication, and requested that the examining division be instructed to issue the communication under R. 71(3) EPC without delay – specifically before the expiry of 18 months from the priority date – and therefore to grant the European patent as quickly as possible. The board noted that Art. 93(2) EPC provided for the possibility of granting a patent before the expiry of the 18-month period. An earlier grant was thus not ruled out, provided the examining division had already concluded that the application met all the requirements of the EPC. As this was not yet so in the case in hand, the possibility provided for in Art. 93(2) EPC of granting a patent before the 18 months expired did not apply. The board did not see any conflict in this regard between the provisions of Art. 93(2) and 97(1) EPC. Under the EPC, the granting of a patent was conditional upon the mandatory examination of all EPC requirements. A patent could only be granted if the examining division considered all examination requirements met. Contrary to the appellant's claim, the examining division had no discretion in this regard. It had to be taken into account that the EPO was responsible for safeguarding the interests of the public, in addition to those of the appellant, and the public had to be able to rely on it doing so.

In **T 1377/15** the board pointed out that a communication under R. 71(3) EPC, even when taken as a whole, did not have the character of a "decision". It was not designed to bring examination proceedings to a close but was instead a preparatory action (taken towards any later decision to grant a European patent) which was not open to appeal. The board observed that the communication the appellant had received under R. 71(3) EPC – unlike the one under R. 51 EPC 1973 at issue in **T 1181/04** – had expressly referred to the possibility of expressing disapproval and subsequently obtaining an appealable decision

giving the reasons for refusing the higher-ranking requests. It therefore held that the conditions set out in **T 1181/04** for exceptionally treating such a communication as an appealable decision were not met.

In **T 121/06** the board held that issuing a communication under R. 51(4) EPC 1973 (in the version that entered into force on 1 July 2002), in which amendments were proposed, which the applicant could not reasonably be expected to accept without further discussion, constituted a substantial procedural violation.

3.2. Approval of the text by the applicant

3.2.1 Clear and unambiguous approval of the text

A number of decisions commented on below relate to R. 51(4) EPC 1973. Nevertheless, they may also be applicable to R. 71(3) EPC.

In **J 12/83** (OJ 1985, 6) the Legal Board held that an applicant for a European patent could be "adversely affected", within the meaning of Art. 107 EPC 1973, by a decision to grant the patent if the patent were granted with a text not approved by the applicant, contrary to Art. 97(2)(a) EPC 1973. Approval, for the purposes of that article, had to be established "in accordance with the provisions of the Implementing Regulations" (here R. 51(4) EPC 1973).

In **J 13/94** the Legal Board observed that any approval of the text, in accordance with R. 51(4) EPC 1973, might thus have serious procedural consequences for applicants. Hence, according to the case law of the Legal Board, declarations by applicants should only be treated as valid approval under R. 51(4) EPC 1973 if they are clear and unambiguous which, in particular, implied that: the approval was not subject to any condition (**J 27/94**, OJ 1995, 831); it was clear to which text the applicant had given their approval (**J 29/95**, OJ 1996, 489).

In **J 27/94** (OJ 1995, 831) the Legal Board held that in the interests of legal certainty a procedural declaration had to be unambiguous (confirming **J 11/94**, OJ 1995, 596). This implied that it must not be subject to any condition, leaving it open whether the EPO could proceed further on the basis thereof. It found that the examining division should not have treated the letter in question as valid approval under R. 51(4) EPC 1973, because it contained a condition which made the approval invalid. The approval of the text intended for grant was a necessary requirement for the next step in the proceedings, i.e. the communication under R. 51(6) EPC 1973. It had to be clear for the EPO when receiving the declaration whether or not it was an appropriate basis for the despatch of this communication. In the interests of legal certainty the Legal Board stated that procedural declarations had to be unambiguous. The examining division should have objected to the invalid approval, with the eventual consequence foreseen in R. 51(5), first sentence, EPC 1973.

In **T 971/06** the board noted that the approval by an applicant or patent proprietor under Art. 97(2)(a) EPC 1973 was a principle underlying all decisions of the EPO (see

Art. 113(2) EPC 1973). Accordingly, it was perfectly clear that it was an absolute pre-condition of any decision of the examining division to grant a patent that an applicant had to have consented to the proposed text. If that pre-condition were not fulfilled, the only courses of action open to the examining division would be to refuse the application under Art. 97(1) EPC 1973 or, if possible amendments or corrections remained to be considered, to continue the examination. So strict was the approval condition that, as the case law showed, the only valid approval was that which was unconditional, unambiguous and clear (see **J 13/94**, **J 27/94**, **J 29/95**). The board held that in the absence of a valid approval, the examining division had no power to make a decision to grant and any decision to grant purportedly made without the applicant's valid approval could have no legal effect.

In **T 872/90** the board held that, in view of the requirement of Art. 113(2) EPC 1973 according to which the EPO would consider and decide on the European application only in the text submitted to it, or agreed, by the appellant, former claims which had been replaced by newly filed claims could no longer be considered to constitute a text agreed to by the applicant.

In **T 1/92** (OJ 1993, 685) the board held that the applicant's approval of the text was only binding if it was still unambiguously present at the expiry of the R. 51(4) EPC 1973 period. The appellant had first approved of the proposed text for grant, before submitting requests, within the period given in the R. 51(4) EPC 1973 communication, and before the communication under R. 51(6) EPC 1973, to disregard the prior approval and to extend the time limit for responding to the R. 51(4) EPC 1973 communication. The request to disregard the approval, being on time, made it impossible for the EPO to establish as required by R. 51(6) EPC 1973 that the approval still was maintained unambiguously.

The decisions below apply R. 71(3) EPC in the version applicable from 1 April 2012 (OJ 2010, 637).

In **T 2864/18** the appellant, in its reply to the first communication under R. 71(3) EPC, had requested certain corrections in the translations of the claims and then proceeded to state "All the other pages of the text enclosed to the Communication under R. 71(3) EPC do not require amendments or corrections and are hereby approved by the Applicant". From these statements the board inferred that the appellant was fully aware of the complete set of documents proposed as forming the basis for the intended grant. It found that the approval of the text was unequivocal and was repeated, albeit not explicitly in writing, but by reacting to the second communication under R. 71(3) EPC (payment of fees).

In **T 646/20** the board found no support for any obligation of the examining division to defer a decision of grant until the expiry of the four months period in a case where the applicant had at any given time within this period of time given approval to grant and thereby allowed the examining division to issue a corresponding decision. It found it would be rather strange if the examining division had to defer a decision for the eventuality that the applicant had second thoughts. In the case in hand, following the R. 71(3) EPC notification, the applicant gave their explicit approval to issue the decision to grant, however following the decision to grant, the appellant then voiced their disapproval. The board distinguished the case in hand from **T 1/92** (see above in this chapter). It was also

not convinced by the appellant's argument that an approval sent in response to a R. 71(3) EPC communication could not be interpreted as a waiver of further options or remedies. Every approval of the text of a patent implied a waiver of the remaining infinity of texts in which a patent could be granted.

3.2.2 Option to waive the right to a further communication under Rule 71(3) EPC

From 1 July 2015 until 30 June 2020, the EPO offered applicants the option of expressly waiving their right to receive a further communication under R. 71(3) EPC (see notice from the EPO dated 8 June 2015; OJ 2015, A52). This option was abolished by notice from the EPO dated 26 May 2020 (OJ 2020, A73).

3.2.3 Decisions with no text submitted or agreed by the applicant (Article 113(2) EPC)

a) General issues

Article 113(2) EPC states that the EPO shall examine, and decide upon, the European patent application or the European patent only in the text submitted to it, or agreed, by the applicant or the proprietor of the patent. See also Guidelines C-V, 4.9 – April 2025 version.

In **T 690/09** the board stated that the application would be refused under Art. 97(2) EPC, if there was no text which had been approved by the applicant and allowed by the examining division (see **T 647/93**, OJ 1995, 132; **T 946/96**; **T 237/96**).

In **T 1093/05** the board noted that to grant a patent in a text not approved by the applicant was in breach of Art. 97(2)(a) and 113(2) EPC 1973 and thus a substantial procedural violation. The board stated that in those circumstances it was established case law that an examining division was bound by its final decision on an application, which could be set aside only following an admissible, reasoned appeal (see **G 12/91**, OJ 1994, 285; **G 4/91**, OJ 1993, 707; **T 371/92**, OJ 1995, 324; **T 1081/02**; **T 830/03**). In view of this established case law, the board could not subscribe to the view expressed in **T 971/06** that an erroneous decision was a nullity and therefore no appeal needed to be filed against it.

In **T 237/96** the board noted that in circumstances in which, as in the case in question, amendments proposed by the applicant were not allowed by the examining division by virtue of R. 86(3) EPC 1973 and the applicant did not give its agreement to any other version of the application documents, the established practice of the EPO, sanctioned by consistent case law, was to refuse the application on the ground that there was no version approved by the applicant within the meaning of Art. 113(2) EPC 1973 on which a patent could be granted.

Some decisions showed a different approach concerning the legal basis for refusing an application where no agreed claim text existed. In **T 246/08** the board held that the substantive legal requirement for the continued presence of claims in an application was expressed in Art. 78(1)(c) EPC 1973, not in Art. 113(2) EPC 1973. It noted that Art. 78(1)(c) EPC 1973 was a requirement of the application not only for a filing date, but

also for substantive examination and grant, whereas Art. 113(2) EPC 1973 was silent as to the legal consequence of the absence of an agreed text (see also **T 2112/09**).

In **T 32/82** (OJ 1984, 354) the board held that in accordance with Art. 113(2) EPC 1973, it could only decide on the European patent application in the text submitted to it or agreed by the applicant. It followed that when deciding the appeal the board had no authority under the EPC to order the grant of a European patent containing claims which were different from those submitted by the applicant in their content or interdependency. Even if the board had indicated to an applicant that a dependent claim might be allowable if rewritten as an independent claim but the applicant had not expressly requested the board to consider it as such, the board was not obliged to do so.

In **T 647/93** (OJ 1995, 132) the board stated that the provision of Art. 113(2) EPC 1973, that the EPO shall consider and decide upon the European patent application or the European patent only in the text submitted to it, or agreed, by the applicant for or proprietor of the patent, was a fundamental procedural principle, being part of the right to be heard, and was of such prime importance that any infringement of it, even as the result of a mistaken interpretation of a request, must, in principle, be considered to be a substantial procedural violation. In any case, such violation occurred when, as in the case in hand, the examining division did not make use of the possibility of granting interlocutory revision under Art. 109 EPC 1973, after the mistake had been pointed out in the grounds of appeal. See also **T 121/95**.

b) Deemed approval under Rule 71(5) EPC

If applicants pay the fees and file the translations within the due period (and file or request no corrections or amendments to the text proposed for grant in the R. 71(3) EPC communication), they are deemed to have approved the text intended for grant (R. 71(5) EPC) (see Guidelines C-V, 1.1 – April 2025 version).

The above also applies where the R. 71(3) EPC communication was based on an auxiliary request, provided that the applicant does not reply to the R. 71(3) EPC communication by requesting that a grant be based on a higher ranking request. It also applies where the R. 71(3) EPC communication included proposals by the examining division for amendments or corrections of the text intended for grant. Consequently, provided the applicant does not reject these proposed amendments or corrections in their reply, the completion of the above acts constitutes approval of the text containing the amendments or corrections as proposed by the examining division (Guidelines C-V, 2 – April 2025 version).

In **T 1003/19** the board found that the decision under appeal did not comply with Art. 113(2) EPC and that the examining division had committed a substantial procedural violation; the granted version of the patent corresponded neither to a text submitted by the appellant nor to a text agreed by it, nor to a text deemed to have been approved by it. The appellant had not requested the grant of a patent with any other than the seven drawing sheets as initially submitted and published. The communication under R. 71(3) EPC, however, referred only to "drawings, sheets 1/1 as published". The board noted that

appellant did not expressis verbis approve the amended application documents as referred to in the communication and found that the appellant also could not be deemed to have approved the list of documents communicated to it in this communication according to R. 71(5) EPC. The consequence as stipulated in R. 71(5) EPC, i.e. "the applicant ... shall be deemed to have approved the text communicated to him under paragraph 3", only applied where the applicant, according to R. 71(3) EPC, had been informed "of the text in which it [i.e. the examining division] intends to grant" the patent. The board stated that under normal circumstances it was to be assumed that the text referred to in a communication under R. 71(3) EPC reflected the true will of the examining division and was therefore identical to the text on the basis of which the grant of the patent was intended. In the present case, however, it found sufficient evidence to conclude that this was not the case in respect of the communication under R. 71(3) EPC. The board further stated that the EPO may on its own initiative suggest minor amendments; however the removal of all drawing sheets showing embodiments of the invention could not be expected to be accepted by an applicant.

The board stated that it had not deviated from **G 1/10**, which based its consideration on the requirement according to R. 71(3) EPC that the applicant must be informed of the text in which the examining division intends to grant a patent (see point 10 of the Reasons) and deals with the applicant's possible reactions thereto, like the implicit approval of this text. In contrast thereto the board's decision in the case in hand was based on the fact that the text intended for grant by the examining division had, based on verifiable facts, not been communicated to the appellant and, therefore, R. 71(5) EPC did not (at that time) apply. As a result, no text had been approved by the appellant. The request for reimbursement of the appeal fee was however rejected; while the error was committed by the examining division, the appellant had several instances to spot this error and, at the latest, could and should have noticed it when comparing the text of the communication under R. 71(3) EPC and the "Druckexemplar".

In **T 2081/16**, the board found that where the text intended for grant is not communicated to the applicant under R. 71(3) EPC, the fact that the appellant subsequently files a translation and pays the fees for grant and publishing is not decisive. The provisions of R. 71(5) EPC, in this regard, refer to R. 71(3) EPC and therefore presuppose that the applicant has not been notified of any text but of the text *intended for grant* (emphasis added by the board). Only in this case would R. 71(5) EPC apply and would the filing of a translation and the payment of the relevant fees imply the approval of the text communicated to it. The board found that in the present case neither the documents referred to in Form 2004C nor the "Druckexemplar" reflected the text in which the examining division intended to grant the European patent. In arriving at its decision, the board stated that it had not deviated from **G 1/10** and that Art. 21 RPBA 2007 did not therefore apply. In **G 1/10**, the Enlarged Board found that R. 140 EPC was not available to correct the text of a patent. This question was not at stake in the case in hand, where no text had been approved by the applicant.

In **T 408/21** the board stated that when trying to clarify the intention behind an action or request, this was frequently done in the case law of the boards of appeal by identifying the "true will" of the actors in a case. Normally the documents indicated in a communication

according to R. 71(3) EPC corresponded to the applicant's request and to the examining division's intention; however, in a case where there appeared to be severe doubts as to whether the documents indicated in R. 71(3) EPC were actually those intended to be granted by the examining division, the board considered the above-mentioned clarification of the "true will" of the examining division an appropriate means. In line with the **T 1003/19** the board concluded that the examining division did not indicate in the communication according to R. 71(3) EPC the text it intended to grant in the case in hand. Following **T 2081/16** and **T 1003/19**, the board found that R. 71(5) EPC correspondingly did not apply in this case, as in the step preceding the deemed approval the applicant has to be informed of the text in which the examining division intends to grant the patent according to R. 71(3) EPC.

In **T 2277/19** the board held that the text referred to in the communication under R. 71(3) EPC had to be regarded as the text intended for grant. Since this text on the basis of which the patent was granted was approved by the appellant, the requirements of Art. 113(2) EPC were met. The appellant had approved the text intended for grant (subject to the correction of some minor errors in the description). Hence, the board considered that the examining division had legitimately expected the applicant to have checked and verified the Druckexemplar, in particular since the applicant had requested some amendments to the text intended for grant. The board found that the examining division did not have any reason to assume that the approval was based on the prerequisite that only drawing pages 1 to 7 were actually intended for publication. Moreover, the appellant expressly waived their right to the issue of a further communication under R. 71(3) EPC. The appellant argued that the facts in the case in hand were very similar to those of decision **T 1003/19** with reference also to **T 2081/16**, but the board did not follow those earlier decisions. In its view there was no legal basis in the EPC for a distinction between the text referred to in a communication under R. 71(3) EPC and that reflecting what the examining division actually intended. Moreover, R. 71(6) EPC addressed the possibility that the text communicated under R. 71(3) EPC did not reflect the appellant's requests. In the board's judgement, R. 71(3) EPC thus imposed on the applicant a duty to check and verify this text. The fact that an applicant did not exercise their right to request amendments under R. 71(6) EPC could therefore only be interpreted as approval of the communicated text, i.e. the text intended for grant. Whether the applicant noticed a possible error had no effect on the fact that this approval was binding.

In **T 265/20** the board held that the prerequisites for the legal consequence foreseen in R. 71(5) EPC were fulfilled. The legal consequence was that the applicant was deemed to have given approval to the text communicated to them under R. 71(3) EPC. The unambiguous wording of R. 71(5) EPC did not allow for an interpretation other than the foreseen legal consequence. Firstly, there was no legal basis in the EPC for a distinction between the text referred to in a communication under R. 71(3) EPC and the text really intended by the examining division (see also **T 2277/19**, point 1.3 of the Reasons). Secondly, it was not the content of the text which triggered the deemed approval under R. 71(5) EPC, but the applicant paying the fee and filing the translations according to R. 71(5) EPC. It followed that it was pointless to explore the "true will" of the members of the examining division when editing the communication pursuant to R. 71(3) EPC. It

was the applicant themself with whom the final responsibility for the text remained, not the examining division. The board further considered that decisions **T 1003/19** and **T 2081/16** did not amount to diverging case law; it had no doubt that the wording of R. 71 EPC did not allow it to be concluded that the "true will" of the examining division was something that had to be taken into consideration.

In **T 1823/23** the board confirmed **T 2081/16**, **T 1003/19** and **T 408/21**. The board noted that the case in hand was distinguished from **T 265/20**, not least in that the board in the present case could identify convincing reasons why the examining division's true intention was not reflected by the text of the R. 71(3) EPC communication.

c) Auxiliary request issues

Where it is not clear which higher request the applicant wishes to pursue, the examining division must request that the applicant clarifies this in resumed examination proceedings. (Guidelines C-V, 4.9 – April 2025 version).

In **T 1255/04** (OJ 2005, 424) the board held that in a case where a request was considered allowable on which a R. 51(4) EPC 1973 (now R. 71(3) EPC) communication was to be sent, but where higher-ranking requests were not allowed, the communication under R. 51(4) EPC 1973 would be deficient if it was not accompanied by reasons why the higher-ranking requests were not allowed. This communication should also expressly mention the option of maintaining the disallowed requests, thus reminding the applicant and the examining division of the possibility for the applicant of asking for a written appealable decision on these higher-ranking requests (**T 1181/04**, OJ 2005, 312, followed). It pointed out that if the applicant maintained a still pending higher-ranking request discussed at the oral proceedings before the examining division, that request could not be refused under R. 86(3) EPC 1973 (now R. 137(3) EPC). R. 86(3) EPC 1973 could not be used to deprive an applicant from obtaining a decision giving the substantive reasons for refusal of a request already considered in substance during the proceedings. A decision merely stating that the application was refused because there was no version approved of by the applicant within the meaning of Art. 113(2) EPC 1973 on which a patent could be granted, was inadequately reasoned because it did not give substantive reasons why what the applicant approved of was not in conformity with the patentability requirements of the EPC.

In **T 169/96** the board held that according to Art. 113(2) EPC 1973, the EPO was bound to the requests of the applicant or proprietor. In case of main and auxiliary requests, this meant that the EPO was also bound to the order of the requests. Before a decision could be taken on the basis of an auxiliary request, the main request had to be examined and decided upon (see also **T 484/88**). In the case in hand the applicants were only invited to indicate their approval of the text according to auxiliary request III. Therefore, their express disapproval related necessarily only to this version of the application. Hence, auxiliary requests I and II were pending when the decision under appeal was taken and the failure to give a decision on these requests was a violation of Art. 113(2) EPC 1973. The failure to deal with the requests preceding auxiliary request III violated also R. 68(2) EPC 1973 (now R. 111(2) EPC). If a decision related to several requests, it had to give reasons for

the rejection of each one (see **T 234/86**). The fact that the first examiner had expressed a preliminary view in a previous communication which might be applicable to these requests could not replace reasons in the decision itself. It had to be clear from the decision which considerations led the division to its conclusions (**T 234/86**, see also **T 1439/05**).

In **T 255/05** the board observed that the appellant's "auxiliary request" was not one single request but encompassed numerous requests. It was totally undefined in which order these four requests and any such combination requests should be considered by the board. The board noted that according to Art. 113(2) EPC 1973, the EPO should consider or decide upon the European patent application only in the text submitted to it, or agreed, by the applicant. It was therefore the applicant's responsibility to define the text on the basis of which it requested a patent to be granted. In the case of auxiliary requests this included the requirement that the applicant had also to indicate the order in which the requests were to be examined. As a consequence, when the appellant, even after having been invited to do so by the board, did not clearly indicate the order in which its several requests were submitted and what the exact content of each of these requests was, there was no text submitted or agreed by the applicant within the meaning of Art. 113(2) EPC 1973 and no request which could be considered by the board. Therefore, the appellant's "auxiliary request" had to be disregarded.

In **T 888/07** the board held that if the examining division refused to consent to the latest submitted set of amended claims, put forward to substitute the claims previously on file under R. 86(3) EPC 1973, the previous set of claims that the examining division had consented to consider but which the applicant had not maintained as an auxiliary request was not automatically revived. It noted that in accordance with Art. 113(2) EPC and established case law (see e.g. **T 237/96**) a decision could not be based on the previous set of claims. Art. 113(2) EPC 1973 stated that the EPO had to consider and decide upon the European application or patent only in the text submitted to it, or agreed to, by the applicant or proprietor. Deciding to refuse an application on the grounds that the claims previously on file were not allowable would have contravened Art. 113(2) EPC 1973, since these claims were no longer pending.

3.3. Amendments or corrections filed in response to the communication under Rule 71(3) EPC

3.3.1 Amendments where Rule 71(3) EPC communication is the first communication

By way of exception, in cases where the R. 71(3) EPC communication is also the first communication in examination proceedings, amendments filed in response thereto must be admitted into the proceedings under R. 137(2) EPC. However, where a further R. 71(3) EPC communication is sent in respect of such cases, any amendments filed in response thereto must be consented to by the examining division according to R. 137(3) EPC (see Guidelines C-V, 4.4 – April 2025 version).

3.3.2 Amendments and corrections requested according to Rule 71(6) EPC

Rule 71(6) EPC reads as follows: "If the applicant, within the period under paragraph 3, requests reasoned amendments or corrections to the communicated text or keeps to the latest text submitted by him, the examining division shall issue a new communication under paragraph 3 if it gives its consent; otherwise it shall resume the examination proceedings". On the possibility to waive the right to a further communication under R. 71(3) EPC (abolished as of 1 July 2020) see above in this chapter IV.B.3.2.2.

Where amendments or corrections are not admitted, or where they are admitted but not considered allowable, examination will be resumed (Guidelines H-II, 2.5.2 – April 2025 version).

In **T 1567/17** the board held that the applicant's remark in a response under R. 71(6) EPC that an amended feature "can also be omitted if regarded as violating Art. 123(2) EPC" could not be construed as waiving their right to be heard and their right to a reasoned decision in case the application were to be refused. Rather, this remark merely intimated that the applicant would accept the issue of a new communication under R. 71(3) EPC on the basis of the amended set of claims without said feature. The appellant had been given no opportunity to respond to the division's opinion on this issue and the board held that the direct refusal of the application by the examining division was in violation of Art. 113(1) EPC. Surrender of a right cannot be simply presumed (referring to **G 1/88**, OJ 1989, 189; **T 685/98**, OJ 1999, 346).

3.3.3 Criteria for admitting amendments filed in reply to the Rule 71(3) EPC communication

The criteria for accepting or refusing requests for amendment under R. 137(3) EPC (R. 86(3) EPC 1973), or correction under R. 139 EPC (R. 88 EPC 1973), have not been changed by amended R. 71 EPC (R. 51 EPC 1973), which entered into force on 1 April 2012 (OJ 2010, 637).

Decision **G 7/93** (OJ 1994, 775) dealt with the criteria for assessing the admissibility of late-filed amendments in examination. In particular, applying the principles of **G 7/93** to amendments filed in response to the communication under R. 71(3) EPC means that this communication does not constitute an opportunity for the applicant to call into question the outcome of the earlier procedure (**T 375/90**). The Enlarged Board noted that the question whether an approval submitted under R. 51(4) EPC 1973 becomes binding once a communication in accordance with R. 51(6) EPC 1973 has been issued depended rather upon the proper interpretation of Art. 123(1) EPC in conjunction with R. 86(3) EPC 1973. The Enlarged Board came to the conclusion that said approval did not become binding. It stated that, in general terms, the way in which the examining division should exercise its discretion to allow an amendment of an application must depend upon the circumstances of each individual case, and must also depend upon the stage of the pre-grant procedure which the application has reached. It was clear from the wording of the provisions in R. 51(4) to (6) EPC 1973 that the underlying object of the R. 51(6) EPC 1973 communication was to conclude the granting procedure on the basis of the previously

notified and approved text of the application. Thus although the examining division still had a discretion to allow amendments at this stage of the pre-grant procedure, such discretion must be exercised with the above underlying object in mind. In particular it held that admission of amendments at a late stage of the proceedings was to be the exception and not the rule.

In **T 1064/04** the board stated that the principles in **G 7/93** could be considered generally applicable to new requests put forward at a late stage of the proceedings, where the applicant had already had at least one opportunity to amend the application and the examining division has already completed substantive examination of the application. In the case in hand, the board found that the examining division had exercised its discretion in a reasonable way in accordance with the applicable principles. A late stage of the examination proceedings had been reached at the end of the oral proceedings, and any amendments thereafter fell to be considered under the principles derivable from decision **G 7/93**. **T 1064/04** summarised the principles derived from decision **G 7/93** (OJ 1994, 775) on admission of amendments at a late stage of proceedings (see also **T 1540/11**, **T 1326/11**). The principles that can be derived from the decision of the Enlarged Board are:

(a) Until the issue of a decision to grant the patent, the examining division does have discretion under R. 86(3), second sentence, EPC 1973 (now R. 137(3) EPC) whether or not to allow the amendment of the application at a late stage, irrespective of whether the applicant has already agreed to a text (**G 7/93**, point 2.1 of the Reasons).

(b) The examining division is required to exercise its discretion considering all relevant factors, in particular the applicant's interest in obtaining a patent which is valid in all designated states, and the EPO's interest in bringing examination to a close, and must balance these against one another (**G 7/93**, point 2.5 of the Reasons).

(c) Allowing a request for amendment at a late stage of the examination proceedings, that is, against the background that the applicant has already had at least one opportunity to amend the application and that the examining division has already completed the substantive examination of the application, will be an exception and not the rule (**G 7/93**, point 2.3 of the Reasons).

(d) It is not the function of a board of appeal to review all the facts of the case as if it were in the place of the department of first instance, in order to decide whether or not it would have exercised the discretion in the same way as the department of first instance. Rather a board of appeal should only overrule the way in which the department of first instance exercised its discretion if it comes to the conclusion either that the department of first instance has not exercised its discretion in the right way as set out in (b) above or has exercised its discretion in an unreasonable way, and thus exceeded the proper limits of its discretion (**G 7/93**, point 2.6 of the Reasons).

In **T 1399/10** the board held that if an examining division comes to the conclusion that a request is not prima facie allowable but introduces new deficiencies, it is justified for the division to refuse the request under R. 137(3) EPC.

In **T 1326/11** the decision under appeal dealt solely with the refusal under R. 137(3) EPC by the examining division to admit into the proceedings the request received after issuance of the communication under R. 71(3) EPC. Thus, the question to be decided on this appeal was whether this refusal was an appropriate exercise of the discretion given to the examining division under R. 137(3) EPC. Guided by the principles to be found on **G 7/93** as summarised in **T 1064/04**, the board was of the view that the complexity of the case only supported the decision of the examining division not to admit a request at a very late stage of proceedings, which had already involved two communications of the examining division and oral proceedings before it. Admitting the request at that late stage would have led to re-examination and consequently unduly lengthened the proceedings.

In **T 246/08** the board held that a refusal of consent to amend made in advance of any amendment being submitted could not be a reasonable exercise of discretion pursuant to R. 137(3) EPC (R. 86(3) EPC 1973) and was ipso facto a substantial procedural violation.

A number of decisions set out below relate to earlier versions of R. 51(4) EPC 1973 which were applicable up to 1 July 2002. Nevertheless, they may also be applicable to the amended version of R. 71(3) EPC, which entered into force on 1 April 2012.

In **T 375/90** the board noted the conditions defined by the boards of appeal limiting the extent of the discretion which may be exercised when applying R. 86(3) EPC 1973, where amendments were proposed by the applicant after issue of the R. 51(4) EPC 1973 communication:

(i) There was no discretion in the obligation to admit amendments which removed deficiencies constituting violations of the EPC 1973 (see **T 171/85**, OJ 1987, 160; **T 609/88**).

(ii) In all other cases the EPO's interest in a speedy completion of the proceedings must be balanced against the applicant's interest in the grant of a patent with amended claims (see **T 166/86**, OJ 1987, 372; **T 182/88**, OJ 1990, 287; **T 76/89**).

The board noted that the Guidelines stated that the communication under R. 51(4) EPC 1973 did not constitute an opportunity for the applicant to call into question the outcome of the earlier procedure and only minor amendments would be considered within the period under R. 51(4) EPC 1973. It followed from the foregoing considerations that the examining division (or the board acting within its competence), when applying the provisions of R. 86(3) EPC 1973, was not completely free to deny any examination of the respective amended documents. See also **T 989/99**.

In **T 999/93** the decision to refuse the application under R. 51(5), first sentence, EPC 1973 for lack of any approved text of the application (Art. 113(2) EPC 1973), was incorrect since the fact that the appellant never withdrew the main and first and second auxiliary requests as well as the appellant's letter (disapproval of the text proposed for grant, but request for a decision on the main request) clearly showed that they indeed approved and proposed the text according to their higher-ranking requests (see also R. 51(5), second

sentence, EPC 1973). The decision would instead have required reasoning as to the substance of the main, first auxiliary and second auxiliary requests.

In **T 237/96** the board held that the broadening of the scope of claim 1 requested by the applicant after receipt of the examining division's communication under R. 51(4) EPC 1973 so as to encompass one originally disclosed embodiment was not consistent with their previous submission that said embodiment was not part of the invention, raised new issues as to clarity and inventive step and was not supported by any argumentation in favour of the allowability of the amended claim. The board found that the examining division, in refusing to consent to the amendment under R. 86(3) EPC 1973, did not exercise its discretion in a wrong or unreasonable manner. Had it given its consent to the amended version of the claim, it would have been necessary to restart examination from the beginning, which, given the prima facie lack of clarity of the claim, would have led to a considerable delay.

In **T 1066/96** it was clear that further amendments could not be excluded wholesale in advance, but the discretion under R. 86(3) EPC 1973 had to be exercised on a case-bycase basis balancing the interests of the EPO and the applicant against one another (see **G 7/93**, OJ 1994, 775). Therefore, in exercising its discretion under R. 86(3) EPC 1973 in a negative way, an examining division could only refuse an application if, before issuing a decision, it had informed the applicant of the fact that the further amendments requested would not be admitted and of the reasons for not admitting said amendments, thereby taking due account of the applicant's reasons for such late filing of further amendments (see also **T 2536/17**). If the applicant maintained their request and their counterarguments were not considered convincing by the examining division, the application had to be refused under Art. 97(1) EPC 1973, since it contained no claims to which the applicant had agreed.

3.3.4 Claims fees due in response to Rule 71(3) EPC communication

According to R. 71(4) EPC (in force since 1 April 2012) if the European patent application in the text intended for grant comprises more than fifteen claims, the examining division shall invite the applicant to pay claims fees in respect of the sixteenth and each subsequent claim within the period under paragraph 3 unless the said fees have already been paid under R. 45 or 162 EPC.

The appeal in **J 6/12** was lodged against the decision by the formalities officer acting for the examining division to refuse a request for a refund under R. 71(5) EPC of ten claims fees following amendments which had resulted in a smaller number of claims. R. 71(6) EPC (now R. 71(4) EPC), which entered into force in December 2007, was the legal basis for the invitation to pay claims fees. According to this provision, the "text [of the application] intended for grant" was the basis for charging additional claims fees. However, the Legal Board held that this text had only become final after the examining division had approved the filed amendments, and not already on the date of issue of the communication under R. 71(3) EPC. Fees which the appellant had been invited to pay at that earlier stage had not yet become payable and decreased in the measure that the appellant had reduced the number of claims in response to the communication under R. 71(3) EPC. The Legal

Board stressed that the EPO could not retain fees of more than insignificant amounts which had been paid for no legal reason.

3.4. Amendment after approval of the text for grant

Rule 71a(2) EPC (Conclusion of the grant procedure) makes it clear that, until the decision to grant the European patent is issued, the examining division may resume the examination proceedings at any time.

An examining division has discretion to allow amendments until issue of a decision to grant (**T 690/09**, referring to **G 7/93**, order 1, OJ 1994, 775; **G 12/91**, OJ 1994, 285).

Once the applicant has approved the text communicated to them pursuant to R. 71(3) EPC, by paying the fees and filing the translation of the claims, further requests for amendment will only exceptionally be admitted under the discretionary power of the examining division given by R. 137(3) EPC. A clear example of an admissible request is where the applicant files separate sets of claims for designated states for which prior national rights exist. Similarly, it is appropriate to admit minor amendments which do not require re-opening of the substantive examination and which do not appreciably delay the issue of the decision to grant (see **G 7/93**).

A refusal of amendments must be reasoned, and both Art. 113(1) and 116(1) EPC must be observed. It must be shown that the conditions defined in **G 7/93** are not met. This means that arguments must be given as to why the amendments are not minor in nature but in fact necessitate resuming substantive examination while considerably delaying the issue of a decision to grant the patent (Guidelines H-II, 2.6 – April 2025 version).

In decision **G 7/93** the Enlarged Board stated that the wording in R. 86(3) EPC 1973 (now R. 137(3) EPC) "No further amendment may be made without the consent of the examining division" simply meant that the examining division might or might not give its consent to a request for amendment by the applicant. The approval of a notified text submitted by an applicant pursuant to R. 51(4) EPC 1973 was not rendered binding by virtue of a communication being issued in accordance with R. 51(6) EPC 1973. Even following the issue of such a communication and until the issue of a decision to grant the patent, it was left to the discretion of the examining division under R. 86(3), second sentence, EPC 1973 whether or not to allow amendment of the application. However, since the underlying object of a R. 51(6) EPC 1973 communication was to conclude the granting procedure on the basis of the approved text, a request for amendment which was received by an examining division after such a communication has been issued should be considered in a different way from a similar request for amendment received at a much earlier stage in the overall examination procedure, and in particular before approval by the applicant of a notified text. Such a request should be considered in the context of the very late stage in the pre-grant procedure at which it had been made, and against the background that the examining division had already completed its substantive examination of the application, and that the applicant had already had at least one opportunity to amend the application. Against such a background, allowing a requested amendment after the issue of a R. 51(6) EPC 1973 communication would be the exception rather than the rule.

The question remained in what kind of circumstances it would be appropriate to make an exception to the normal rule. In the Enlarged Board's view, the discretion to allow amendment should be exercised according to the same principles. Of course, an objection should only be raised by an examining division at that stage of the proceedings if it was prepared to allow amendments to meet the objection. When exercising its discretion following the issue of a R. 51(6) EPC 1973 communication, an examining division had to consider all relevant factors. In particular it had to consider and balance the applicant's interest in obtaining a patent which would be legally valid in all of the designated states, and the EPO's interest in bringing the examination procedure to a close by the issue of a decision to grant the patent.

In **G 10/92** (OJ 1994, 633) the Enlarged Board stated that if examination proceedings were re-opened by the examining division after approval in accordance with R. 51(4) EPC 1973, because – for whatever reason – the proposed text for grant was to be amended, R. 51(4) EPC 1973 required that the applicant once again be informed of the text in which the examining division intended to grant the European patent. The same was true in appeal proceedings. The approval in accordance with R. 51(4) EPC 1973 given before the department of first instance was equally binding on an appeal. If the board of appeal then concluded that the patent had to be amended prior to grant, the applicant again had to approve the amended text, approval being stated before the board if the board was ruling on the issue, or to the examining division if the matter had been remitted.

In **G 10/93** (OJ 1995, 172) the Enlarged Board held that the examining division was not bound by the view – whether positive or negative – expressed in the examination pursuant to Art. 96(2) EPC 1973; examination proceedings could be re-opened "for whatever reason" after the approval in accordance with R. 51(4) EPC 1973.

In **T 171/85** (OJ 1987, 160) the board decided that if discrepancies or inconsistencies were found in the text communicated under R. 51(4) EPC 1973 to the applicant for a European patent, they may be removed in agreement between examining division and applicant even if the latter had already given their approval under R. 51(4) EPC 1973 to the (faulty) text.

3.5. Examination after remittal for further prosecution

If a case is remitted from the boards of appeal for further prosecution, the examining division must check whether requests from examination proceedings prior to the appeal are still outstanding and must give the party an opportunity to comment (see **T 1494/05**; see also Guidelines E-X, 2.1 – April 2025 version).

If a department has to give a decision in a case which has already been remitted by the board of appeal for further prosecution to that department, it is bound by the ratio decidendi of the board of appeal, insofar as the facts, e.g. the subject-matter of the patent and the relevant state of the art, are the same (Guidelines E-X, 4 – April 2025 version).

In **T 79/89** (OJ 1992, 283) the board rejected the appellant's main request, and remitted the case to the department of first instance for further prosecution on the basis of the

auxiliary request. In this case, Art. 111(2) EPC 1973 was applicable, according to which the department of first instance shall be bound by the ratio decidendi of the board of appeal, insofar as the facts are the same. The ratio decidendi of the board of appeal's previous decision was that the subject-matter of the main request was not allowable, but that the grant of a patent in accordance with the auxiliary request was subject to a consideration of its patentability by the examining division. In this case, in the board's judgment, following the issue of the board's previous decision, the examining division clearly had no power to re-open examination on the basis of the claims which the appellant requested (with subject-matter corresponding to the previously rejected main request). Having examined the subject-matter of the auxiliary request for patentability and found no objection to it, the examining division was bound to issue a communication under R. 51(4) EPC 1973 with a text based on the auxiliary request. Furthermore, in the absence of approval of such text, in the board's judgment the examining division was bound to refuse the application, for the reasons set out in its decision. Since the examining division had no power to re-open examination in respect of the claims as requested by the appellant, in the context of the appeal in question the board necessarily had no power to re-open examination in respect of such claims, because it could only exercise power which was within the competence of the examining division (Art. 111(1) EPC 1973). Thus, the main request of the appellant had to be refused.

3.6. Amendments after the decision to grant

In **T 798/95** the decision to grant the European patent was handed over by the formalities section of the examining division to the EPO postal service for notification. The request for amendment of the application under R. 86(3) EPC 1973 was filed on the same day at 6.47 pm, thus after completion of the proceedings. Referring to **G 12/91** (OJ 1994, 285), the board held that a request for amendment under R. 86(3) EPC 1973 filed after completion of the proceedings up to grant before an examining division was to be disregarded, even if the filing of the request and the completion of the proceedings occurred on the same date. See also Guidelines H-II, 2.6 – April 2025 version.

In **T 646/20** the board noted in its Catchword that further member states could not be designated after grant. With reference to decision **G 1/10** (OJ 2013, 194), the board concluded that in the interest of legal certainty, the patent in the version as granted should no longer be open to amendments and that the applicant had had "adequate means at his disposal" to remedy beforehand. In the board's view, it was incumbent on the applicant to verify the complete file in order to spot any inconsistencies it may wish to draw attention to. Inconsistencies related to text and the designated member states in the communication under R. 71(3) EPC and not raised in response thereto must be considered as approved by applicant.

3.7. Withdrawal of amendments and abandonment of subject-matter

3.7.1 General issues

A request to withdraw an amendment is itself a request for further amendment; thus, if this request occurs after reply to the first communication from the examining division, the corresponding amendment will be admitted only if the examining division consents.

In deleting subject-matter from an application, the applicant should avoid any statement which could be interpreted as abandonment of that subject-matter. Otherwise the subject-matter cannot be reinstated (see **J 15/85** (OJ 1986, 395); **G 1/05**, OJ 2008, 271; **G 1/06**, OJ 2008, 307; see also Guidelines H-III, 2.4 – April 2025 version).

In **J 15/85** it was held that if an applicant cancels claims in a patent application but fails to state at the time that their deletion is without prejudice to the filing of a divisional application, the examining division is obliged to withhold its consent to the subsequent filing of a divisional application. However, a declaration of abandonment can be interpreted to the effect that there was no intention to abandon definitively the subject-matter of the application or patent. In **T 910/92** the applicants had expressly abandoned several claims in their application, but later retracted their declaration and requested that the claims deleted from the application be reinstated in a divisional application. The board considered under what circumstances it was possible to retract a declaration of abandonment. It referred to the case law, which required that the real intention of the party making the declaration be established, taking into account all the circumstances of the case, and concluded that in this case the appellants' real intention was not to abandon part of the original disclosure altogether, but to avoid the lack of unity that had arisen as a result of the change in the protection sought. In contrast to the case in **J 15/85** the board did not see any need in this case to protect the public interest by generally prohibiting the retraction of a declaration of abandonment. It could be expected that any third parties interested in the proceedings relating to the application in question would have asked to inspect the files at suitable intervals up until the conclusion of the proceedings (**G 1/06**; **G 1/05**; **J 2/01**, OJ 2005, 88; **J 29/97**).

In **J 13/84** (OJ 1985, 34) the Legal Board applied the same criteria to the interpretation of a declaration of abandonment as the case law had developed for declarations of withdrawal of an application. In particular, all the circumstances had to be taken into consideration and not just the preceding declarations. In the case in question the applicants had deleted their claim 21 in response to a communication from the examining division, adding that "in accordance with the examiner's suggestion, we are filing a divisional application for the intermediate products ... and for their method of preparation". The Receiving Section took the view that the divisional application, with the former claim 21 as its subject-matter, was not filed within the period of two months prescribed in R. 25(1)(b) EPC 1973 (in the version which entered into force on 7 October 1977; the provision was deleted with effect from 1 October 1988). It argued that claim 21, which had already been divided out from the application on 6 June 1983 and therefore no longer formed part of the parent application on 31 August 1983 (the date of filing of the divisional application), could no longer be converted into a divisional application. The Legal Board

did not share this view and called for the declaration of abandonment to be interpreted in the same way as a declaration of withdrawal of an application, i.e. taking into account all the circumstances. It added that, generally speaking, and as stated in the Headnote of **J 11/80** (OJ 1981, 141), a request for withdrawal should only be accepted without question if it was completely unqualified and unambiguous. The Legal Board also referred to decisions **J 24/82**, **J 25/82** and **J 26/82** (OJ 1984, 467), in which it was found that, where claims were withdrawn specifically under R. 25(1) EPC 1973 (in the version which entered into force on 7 October 1977), the applicant's restrictive intention was not to be interpreted in isolation on the strength of particular statements but in the context of the entire procedure. The Legal Board took the view that in this case no express intention to drop the claim ensued from the circumstances. The divisional application was therefore admissible.

In **T 118/91** the board ruled that the inclusion of a particular claim in a divisional application did not mean that claim had been dropped from the parent application.

3.7.2 Effects of non-payment of claims fees

If an applicant fails to pay claims fees, the applicant is considered under R. 45(3) EPC (R. 31 EPC 1973) to have abandoned the claims. Apart from resolving the specific question whether certain parts of the application were part of the description or were claims, decision **J 15/88** (OJ 1990, 445) made clear that such abandonment of certain claims could only cause a substantive loss of subject-matter if the subject-matter involved was contained only in the claims and not also in the description or drawings. The Legal Board held that an applicant who declined to pay claims fees when they were demanded ran the risk that features of a claim deemed to have been abandoned pursuant to R. 31(2) EPC 1973, which were not otherwise to be found in the description or drawings, could not subsequently be reintroduced into the application and, in particular, into the claims. The idea that there could be forced abandonment of subject-matter, in reliance on R. 31(2) EPC 1973, appeared rather to be in conflict with the principles of higher law to be deduced from Art. 52(1) EPC 1973 in conjunction with Art. 123(2) EPC 1973. An applicant normally had the right to derive subject-matter from any part of the description, claims or drawings as originally filed. See also **T 490/90**.

3.8. Withdrawal of the patent application

3.8.1 General issues

A valid notice of withdrawal which has been received at the EPO is binding on the applicant, although, in the case of withdrawal by mistake, R. 139 EPC (R. 88 EPC 1973) may be applicable (see e.g. **J 10/87**, OJ 1989, 323; **J 4/97**; **T 1673/07**; **J 6/13**; **J 11/16**). However, a withdrawal cannot be retracted once the public has been officially informed of it (**J 1/11**, **J 2/15**). A publication in the European Patent Register has the same legal effect as a publication in the European Patent Bulletin, unless otherwise specified (**J 1/11**, **J 2/15**).

3.8.2 Unambiguous and unconditional withdrawal

A request for withdrawal of a European application should only be accepted without question if it is completely unambiguous and unconditional (compare **J 11/87**, OJ 1988, 367; **J 27/94**, OJ 1995, 831; **J 19/03**; see also **J 11/80**, OJ 1981, 141; **T 60/00**; **J 38/03**; **T 1673/07**). In **J 11/87** (OJ 1988, 367) the Legal Board added that where there was even the slightest doubt as to the applicant's actual intent such a declaration should be construed as a declaration of withdrawal only if the subsequent facts confirmed that such had been their true intent.

In **J 15/86** (OJ 1988, 417) the Legal Board stated that there was a recognised difference between passive abandonment and active withdrawal of a European patent application. Each case in which there was a dispute as to the applicant's intention had to be considered on its own facts. A written statement by the applicant or their representative had to be interpreted in the context of the document as a whole and the surrounding circumstances. Similarly, **J 7/87** (OJ 1988, 422) ruled that the language used had to be interpreted in the light of the surrounding circumstances, from which it had to be clear that the applicant really wanted immediate and unconditional withdrawal rather than passive abandonment leading in the course of time to deemed withdrawal. Actual withdrawal did not depend on whether the applicant had used the term "withdrawal".

In **J 6/86** (OJ 1988, 124) the Legal Board considered the statement "the applicant wishes to abandon this application" as an unambiguous withdrawal of a European patent application, since nothing in the circumstances under which the statement had been made could be taken as qualifying such an interpretation. It was too late to ask for retraction of a notice of withdrawal once the withdrawal had been notified to the public in the European Patent Bulletin (see **J 15/86**).

3.8.3 Correction of the withdrawal of the application

In **J 19/03** the Legal Board noted that it was obvious that corrections of procedural acts having an ab initio effect could have a potentially serious impact on an application, in particular if they related to its territorial extent or to whether the application was pending at all, and raised serious concerns as to legal certainty not only for the applicants vis-à-vis the EPO but also for the public. Therefore, the case law of the boards of appeal took as a starting point that, as a general rule, an applicant was bound by its procedural acts notified to the EPO provided that the procedural statement was unambiguous and unconditional (compare **J 11/87**, OJ 1988, 367; **J 27/94**, OJ 1995, 831) and was not allowed to reverse these acts so that they could be considered as never filed (**J 10/87**, OJ 1989, 323; **J 4/97**; see also **J 2/15**). On the other hand, the boards of appeal considered that R. 88 EPC 1973 (R. 139 EPC) acknowledged as a further legal value the desirability of having regard to true, as opposed to ostensible, party intentions in legal proceedings (**T 824/00**, OJ 2004, 5) in appropriate circumstances. As a result of the conflict between these two legal principles, the boards regarded R. 88, first sentence, EPC 1973 as conferring a discretion on the competent instance to allow or not to allow a correction of an error since it was only stated in this rule that a respective error "may be corrected".

Rule 139 EPC (R. 88 EPC 1973) states that linguistic errors, errors of transcription and mistakes in any document filed with the EPO may be corrected on request. However, if the request for such correction concerns the description, claims or drawings, the correction must be obvious in the sense that it is immediately evident that nothing else would have been intended than what is offered as the correction.

a) Conditions for the correction

In **J 4/97** the applicants informed the EPO three days after withdrawal that their request had been made erroneously and should be cancelled. The EPO informed the applicants that the withdrawal had come into force and was binding, and notification of the withdrawal was later published in the European Patent Bulletin. However, the Legal Board held that the withdrawal of the application could be corrected under R. 88 EPC 1973 (which corresponds to R. 139 EPC). The legal considerations contained in **J 10/87** concerning the retraction of a withdrawal of a designation of a contracting state applied equally to the withdrawal of a patent application as a whole. In particular, it had to be ascertained that the withdrawal had been due to an excusable error, that there was no undue delay in seeking retraction, and that the retraction of the withdrawal had not adversely affected the public interest or the interests of third parties. In the circumstances of the case, the Legal Board held that the mere fact that the withdrawal was retracted after only three days was a strong indication that it had indeed been made in error. The error resulted from confusion between two similar reference numbers assigned by the appellants to their patent applications. In the Legal Board's opinion this mistake could be considered as an excusable oversight. The public interest was not affected because the withdrawal was retracted before the corresponding entry was made in the Register and more than six weeks before the withdrawal was officially notified to the public in the European Patent Bulletin. Thus, at the time the general public was informed of the withdrawal, the public part of the file clearly showed that a request for cancellation of the withdrawal had been filed thereby warning third parties relying on the information published by the EPO. The board also considered that the interests of third parties who might have inspected the file could be protected if a national court applied Art. 122(6) EPC 1973 mutatis mutandis. See however **J 5/19** in which the Legal Board did not adhere to e.g. **J 10/87** and **J 4/03** insofar as these decisions required, as a condition to be met for corrections under R. 139 EPC, that the error was due to an excusable oversight.

b) Public interest

In **J 4/03** the Legal Board noted that the request for retraction of the withdrawal of the application had been made after notification of the withdrawal in the European Patent Bulletin, the means of official publication of the EPO. That meant that the public had already received the information that the application no longer existed so that the principal precondition for allowing a correction was not met. See also **J 7/06**.

In **J 14/04** the Legal Board rejected the request for correction of the withdrawal of the application. It agreed with **J 10/87** that the public interest lay in being able to rely on information officially published by the EPO. The Legal Board took the view that the Register constituted an official publication (see also **J 37/03**, **J 38/03**), and as, at the time

of the request for withdrawal, access to the Register was freely offered to the public on the internet, the request for withdrawal was available to the public on the date the Register indicated the request for withdrawal was recorded. It was of no relevance whether the file was actually consulted on this date. Nor did the Legal Board consider that Art. 122(6) EPC 1973 could apply mutatis mutandis to cases of correction under R. 88 EPC 1973.

The Legal Board held in **J 25/03** (OJ 2006, 395) that entries in the Register also amounted to notification to the public from the day of their publication as well as publication in the European Patent Bulletin. The Legal Board rejected the request for correction of the withdrawal of the patent application and added that it was of no relevance that only four days had elapsed between mention of the withdrawal in the Register and mention of the request for retraction of the withdrawal. Legal certainty would suffer unacceptably if further delay were permitted for retraction of the withdrawal in such circumstances where even after inspection of the complete file there would not have been any reason for a third party to suspect, at the time of its official notification to the public, that the withdrawal could be erroneous and later retracted.

In **J 1/11** the Legal Board noted that both the European Patent Register according to Art. 127 EPC and the European Patent Bulletin according to Art. 129(a) EPC were official sources of information to the public. There was nothing that would allow a distinction as to which of the two was more official, reliable or decisive. Contrary to what the appellant alleged, entries into the Bulletin were no more "cast in stone" than those of the Register, and could be corrected either under R. 140 EPC, or by way of a decision. As far as the function of providing information to the public was concerned, the Legal Board was unable to deduce a fundamental difference between the Register and the Bulletin. The Legal Board decided that the appellant's requests for retraction of the withdrawal of its application as a correction of an error under R. 139 EPC had to be refused. The Legal Board pointed out that explicitly withdrawing a pending patent application was a declaration of the highest importance for the applicant, since all the legal effects of the application, such as establishing a preliminary right, were finally abandoned. In the light of these consequences, utmost caution was therefore required when declaring the withdrawal of an application. A correction of errors in documents filed with the EPO under R. 139 EPC was only possible under strictly defined conditions. In the case in hand, the request for retraction of the withdrawal reached the EPO more than a month after the withdrawal was made and after it was recorded in the Register. However, a withdrawal cannot be retracted once the public has been officially informed of it. In a broader sense, this was also reflected in the principle that a declaration of intent could only be retracted if the retraction reached the addressee (the public) either before said declaration or at the same time, a rule that could be found in the civil law systems of many contracting states of the EPC. See also **J 2/15** and **J 3/22**.

In **J 6/13** the Legal Board pointed out that an applicant was bound by its procedural acts notified to the EPO provided that the procedural statement was unambiguous and unconditional (**J 19/03**). The Legal Board held that there could be no retraction of a withdrawal if there was no reason for third parties to assume that the withdrawal was erroneous. Referring to **J 12/03** (citing with approval **J 25/03**), the Legal Board pointed out

that in the interest of legal certainty for third parties, and taking into account the public function of the Register, a third party upon file inspection must have had good reason to suspect that the withdrawal was made in error in order to allow its retraction. The Legal Board had to determine whether, in the case in hand, such good reason was present. It took the view that, based on decisions **J 12/03** and **J 18/10**, the prospects of the application, however promising, were insufficient to infer an obvious or even potential contradiction with a subsequent withdrawal. Patent applications may be withdrawn due to considerations of business strategy, investor preference, shift in portfolios, agreements with competitors, etc. Due to financial considerations, most granted European patents were validated only in a limited number of countries. These considerations may come into play at any time, even after the recent payment of annuities, or after the communication of a positive search report. The favourable prospects of the application in this case would thus not lead a third party to the conclusion that the withdrawal was possibly made in error. Nor did they lead the representative who handled the case to this conclusion, either.

In **J 2/15** the applicant had pointed to a "fundamental inconsistency" between the decisions in cases **J 10/87** and **J 4/97** on the one hand, and **J 25/03** and **J 1/11** on the other, concerning the question whether the publication of a withdrawal in the Register amounted to an official publication thereof. The Legal Board acknowledged that the reasoning of the more recent decisions had led a change in the case law due to the evolution of technical means. However, this could not be seen as an inconsistency in the case law where cases on the same subject-matter arrive at different results and have a different reasoning whilst being decided at the same time. The Legal Board was of the opinion that this inconsistency had been comprehensively addressed in **J 1/11**, and saw no need to elaborate on this further.

In **J 10/08** the Legal Board concluded that the public would not have been misinformed or misled by the information published in the Register, since in the case in hand the public would have been informed about the withdrawal and the request for its retraction at the same time and would therefore have been sufficiently warned that there was possibly something wrong with it. Hence, the withdrawal of the application could be retracted by correction under R. 139 EPC.

In **J 6/19** the Legal Board noted that the request for withdrawal, which the applicant had sought to retract, was unqualified, unambiguous and unconditional, and therefore valid. The Legal Board applied the reasoning of **J 25/03**, where four days elapsed from the mention of the withdrawal in the Register to the addition to the file of the request for retraction of the withdrawal. The Legal Board concluded that it was therefore of no relevance to the case in hand that the request for retraction was received on the same day the withdrawal was published. The time requirement of R. 139 EPC had not been met.

c) Intention of the party

In **J 7/19** the board concluded, with reference the case law of the boards of appeal (**J 8/80**, OJ 1980, 293; **J 4/82**, OJ 1982, 385) to R. 139 EPC, that mistakes which resulted in a divergence between the party's actual and declared intent were eligible for correction under R. 139 EPC. In the case in hand the applicant decided to abandon the application

on the basis of an erroneous assumption. The board found there to be no divergence between the applicant's declaration and its true intention and dismissed the appeal. In the case law of the boards, only errors relating to the declaration, its content or its transmission fell under the notion of a mistake within the meaning of R. 139 EPC. The board explained there were good policy reasons for having this limitation. If the notion of a mistake were extended to also cover a scenario where the declaration correctly reflected a party's intentions, but was based on wrong assumptions, any mistaken assessment of the disclosure of the application, the patentability of the invention, the entitlement to priority, the legal provisions or the related case law would make any withdrawal potentially eligible for correction. This would be detrimental to legal certainty. Where the applicant has made a decision on withdrawal without considering all the relevant circumstances, it must bear the consequences.

In **J 19/03** the Legal Board found that under R. 88, first sentence, EPC 1973 (R. 139, first sentence, EPC), it was not sufficient to prove that a divergence had occurred between the true intention of the applicant and the declaration filed by their representative; rather it was additionally required that this divergence was caused by an error of the person who was competent to make the decision on the procedural act before the EPO. Therefore, as a rule, in cases where the party was represented by a professional representative, the error pursuant to R. 88 EPC 1973 had to be an error of the representative in expressing their own intentions.

In **J 5/19**, however, the Legal Board held that in assessing whether the withdrawal was due to a mistake in the case in hand, only the intention of the applicant and not that of the European representative was relevant. The decision to withdraw the application indeed lay with the former and not the latter.

3.9. Refusal of a European patent application under Article 97(2) EPC

Under Art. 97(2) EPC (Art. 97(1) EPC 1973) if the examining division is of the opinion that the European patent application or the invention to which it relates does not meet the requirements of the EPC, it shall refuse the application unless the EPC provides for a different legal consequence.

In **R 14/10** the Enlarged Board held that there was no obligation under the EPC to carry out the examination of a European patent application or patent in its entirety, i.e. in respect of all pending claims if a claim considered unallowable has been maintained and no auxiliary request relating to a set of claims not comprising this unallowable claim had been submitted. In such a case the application or patent failed to meet a requirement of the EPC and was open to refusal or revocation (see **T 228/89**, referring to **T 5/81**, OJ 1982, 249; see also **T 293/86**, **T 398/86**, **T 98/88**).

In **T 162/88** it was stated that if the European patent application in the version submitted or approved by the applicant contained a claim which the examining division considered unallowable, the examining division had to refuse the European patent application in its entirety under Art. 97(1) EPC 1973 and not just the claim concerned (see also **T 117/88**, **T 253/89**, **T 228/89**).

In **T 11/82** (OJ 1983, 479) the board held that a European patent application had to satisfy the conditions laid down in the Implementing Regulations (see Art. 78(3) EPC 1973). If, in the opinion of the examining division, the application did not do so, the examining division was obliged by Art. 97(1) EPC 1973 to refuse it.

In several decisions the boards pointed out that it was highly desirable that the examining division should give an appealable decision with sufficient reasoning on all the issues that had been properly raised by the EPO during the examination proceedings and dealt with substantively in the applicant's reply. Such "complete" decisions streamlined the procedure, rendering remittal to the department of first instance unnecessary; the board could decide all issues already raised in the department of first instance without depriving the appellant of the opportunity to have them considered at two instances (see **T 153/89**, **T 33/93**, **T 311/94**).

In **T 839/95** the examining division did not take a final decision as provided for in Art. 97 EPC 1973. Instead, it issued a decision indicated as an interlocutory decision under Art. 106(3) EPC 1973 rejecting the main and two auxiliary requests and stating that the invention claimed according to the third auxiliary request was found to meet the requirements of the EPC. The board noted that an interlocutory decision in the case of an allowable auxiliary request was foreseen in the instructions to examiners only for auxiliary requests in opposition proceedings. It did not consider it appropriate for the department of the first instance to proceed in the same way in grant proceedings. In the board's judgment, the purpose of the interlocutory decision in opposition proceedings was intended to save the proprietor the further cost of fulfilling the formal requirements under R. 58(5) EPC 1973 before there was a final decision on the version in which the patent could be maintained (**T 89/90**, OJ 1992, 456). A corresponding situation did not exist in grant proceedings because there was no adverse party who might object to the version to which the applicant had agreed. The appeal was admissible, since the appellant was adversely affected by the rejection of their preceding requests.

In **T 856/05** the appellant had argued that since the decision of the examining division did not give any reasons for refusing claim 6, it was not reasoned, thereby contravening R. 68(2) EPC 1973. The board held that it was sufficient for the examining division, when deciding to refuse a European patent application under Art. 97(1) EPC 1973, to state one ground only which in their opinion would prejudice the grant of a European patent, since the EPC did not contain any provision which would allow a European patent to be partially granted. In the case in hand, the examining division was unable to grant a patent because it was of the opinion that the subject-matter of claim 1 did not involve an inventive step. Consequently, the examining division was under no obligation to comment on the other claims.

A European patent application can also be refused under Art. 97(2) and 125 EPC if it claims the same subject-matter as a European patent which has been granted to the same applicant and does not form part of the state of the art pursuant to Art. 54(2) and (3) EPC (**G 4/19**, OJ 2022, A24). For more on the topic of double patenting, see chapter II.G "Prohibition of double patenting".

3.10. Date on which a decision to grant a European patent takes effect

Under Art. 97(3) EPC the decision to grant a European patent shall take effect on the date on which the mention of the grant is published in the European Patent Bulletin. Art. 97(3) EPC is essentially identical to Art. 97(4), first sentence, EPC 1973. The provisions concerning the minimum period that must lapse before the grant can take effect have been deleted from the article. With the other grant formalities being transferred to the Implementing Regulations (see R. 71 EPC), this matter too was more appropriately regulated at a lower legislative level. Consequently, Art. 97(6) EPC 1973 was deleted as unnecessary.

Article 98 EPC stipulates that the EPO shall publish the specification of the European patent as soon as possible after the mention of the grant of the European patent has been published in the European Patent Bulletin. The contents of the specification have been transferred to the Implementing Regulations (see R. 73(1) EPC). Art. 98 EPC contains the words "as soon as possible" in order to indicate that it is not always technically possible to publish the specification on the same day as the mention of the grant.

In **T 84/16** the board referred to **T 1644/10** and held that no legal effects were provided by the EPC with respect to the patent specification. The board endorsed the finding in Legal Advice No. 17/90 (OJ 1990, 260) that "the text of the patent specification (...) has no binding character. Its function is confined to facilitating public access to the content of the granted patent, particularly the nature and scope of the industrial property right".

In **J 7/96** (OJ 1999, 443) the Legal Board did not share the view of the department of first instance and the applicant that the proceedings for grant were concluded on the date the examining division reaches its decision to grant a European patent under Art. 97(2) EPC 1973. The Legal Board noted that it was true that this date represented the date on which the process of reaching a decision on the application within the examining division was concluded; both the EPO and the applicant were bound by the decision as far as the text of the patent to be granted, the claims, description and drawings were concerned, and the subject-matter of the text of the patent became res judicata at that date. Thereafter, the EPO could no longer amend its decision and had to disregard any fresh matter the parties might submit (see **G 12/91**, OJ 1994, 285). Only linguistic errors, errors of transcription and obvious mistakes could be corrected later under R. 89 EPC 1973. The date on which the decision to grant the European patent was reached was thus clearly decisive as regards the EPO and the applicant. The Legal Board noted that under Art. 97(4) EPC 1973, the decision to grant a European patent referred to in Art. 97(2) EPC 1973 did not take effect until the date on which the European Patent Bulletin mentions the grant. It was from this date of mention that, in accordance with Art. 64(1) EPC 1973, a European patent conferred on its proprietor the same rights in respect of each contracting state in respect of which it is granted as would be conferred by a national patent granted in that state. The mention also marked the time when the responsibility of the EPO came to an end and the national patent systems took over, the granted patent becoming a bundle of national patents. It also marked the start of the period during which a notice of opposition may be filed (Art. 99(1) EPC 1973). Thus, the date of publication of the mention of the grant of the patent was the date on which the grant of the

patent took legal effect with respect to third parties, and on which the extent of protection conferred on the applicant was determined once and for all by means of the accompanying publication of the specification of the patent pursuant to Art. 98 EPC 1973. During the period between the decision to grant the patent (Art. 97(2) EPC 1973) and the publication of the mention of the grant (Art. 97(4) EPC 1973), the application was deemed to be still pending before the EPO. As the department of first instance itself admitted in its decision, and as was also not disputed by the applicant, according to established EPO practice it was still possible during this interim period to take some limited action in respect of the application, which may, for example, be withdrawn or transferred. Applicants may even withdraw individual designations if they so wish. For its part, the EPO continued to have certain rights or obligations concerning the patent during this period; for example, the annual fees fell due and transfers of rights in the patent must be registered by the EPO.

In **J 23/03** the appellant requested that the designation country GR incorrectly marked with a cross be corrected to GB. After a considerable exchange of correspondence, the examining division refused the request for correction on the ground that, from the date of publication of the patent, public interest in the reliability of the published information overrode the patent proprietor's interest in a correction, especially as the applicant had had several opportunities to check the designation information in the course of the proceedings, namely after the notification of forms 2004 and 2005. The Legal Board stated that R. 88 EPC 1973 did not contain an explicit reference to a time limit and that a request for correction could therefore be submitted at any stage of the patent grant procedure (see also **J 6/02**). This also applied to the correction of incorrect designation information in the application documents as requested by the appellant. The Legal Board nevertheless found that the appellant's request for correction of the designation information in the application documents had been submitted to the EPO only on 29 April 2002. Mention of the grant of the patent had appeared in the Patent Bulletin over a month before that date. Under Art. 97(4) EPC 1973, mention of the patent grant led to the grant of the patent taking effect and to the patent grant proceedings being concluded. At the time that the appellant submitted their request for correction, therefore, the proceedings were no longer pending (see **J 7/96**, OJ 1999, 433; **J 42/92**). The Legal Board held that the pendency of patent grant proceedings was, however, a requirement for the submission of an admissible request for correction because after that date the bundle of European patents granted under a single system divides into national patents which are then no longer administered by the EPO but by the appropriate national offices.

3.11. Errors in the European Patent Bulletin

In decision **J 14/87** (OJ 1988, 295) the question arose to what extent a deficiency in the publication of the mention of grant of a European patent, i.e. the omission of important particulars relating to the grant, might render the patent ineffective. The Legal Board held that in principle deficiencies in the publication of the mention of grant in the European Patent Bulletin did not necessarily render the decision to grant within the meaning of Art. 97(4) EPC 1973 ineffective. Nevertheless, this matter could be decided only in the light of the case in question and the fact that the purpose of the publication was to draw the attention of interested parties to the grant of the patent, and also that any decision to file an opposition had, under normal circumstances, to be based on a careful examination

of the extent of the protection conferred by the patent and not solely on the particulars given in the European Patent Bulletin. Such an examination could be carried out satisfactorily only if the patent specification was published at the same time as the mention of grant of the patent.

4. Additional searches during examination

An additional search will sometimes be required either at the first stage of amendment or subsequently. This may arise for a number of reasons (for more details, see Guidelines C-IV, 7.3 – April 2025 version).

4.1. Rule 63 EPC governing incomplete search

4.1.1 Introduction

Rule 63 EPC (R. 45 EPC 1973) governs the procedure followed by the search division when it is not possible to carry out a meaningful search. For more details see Guidelines B-VIII, 3 – April 2025 version.

Rule 63 EPC was amended by decision of the Administrative Council CA/D 3/09 of 25 March 2009 (OJ 2009, 299), which entered into force on 1 April 2010. It introduced among other things the invitation to the applicant to file a statement indicating the subject-matter to be searched. In particular, R. 63(1) EPC states that if the EPO considers that the European patent application fails to such an extent to comply with the EPC that it is impossible to carry out a meaningful search regarding the state of the art on the basis of all or some of the subject-matter claimed, it shall invite the applicant to file, within a period of two months, a statement indicating the subject-matter to be searched.

According to R. 63(2) EPC if the statement under paragraph 1 is not filed in due time, or if it is not sufficient to overcome the deficiency noted under paragraph 1, the EPO shall either issue a reasoned declaration stating that the European patent application fails to such an extent to comply with the EPC that it is impossible to carry out a meaningful search regarding the state of the art on the basis of all or some of the subject-matter claimed or, as far as is practicable, draw up a partial search report. The reasoned declaration or the partial search report shall be considered, for the purposes of subsequent proceedings, as the European search report.

In **T 1242/04** (OJ 2007, 421) the board held that R. 45 EPC 1973 applied to cases which did not comply with the provisions of the EPC to such an extent that it was not "possible" to carry out a "meaningful search" into the state of the art on the basis of all or some of the claims. Thus a R. 45 EPC 1973 declaration was allowed only where a search was not possible. In other cases the search division had to draw up a partial search report, so far as was practicable. The board explained that R. 45 EPC 1973 related only to the practicability of a search and not to the potential relevance of its results in subsequent substantive examination.

In **T 1653/12** the appellant cited **T 1242/04** to support its position that a search in the case in hand would not have been impossible. The board noted that **T 1242/04** dealt with R. 45 EPC 1973, which had a different wording from current R. 63 EPC. Since **T 1242/04** dealt with a case, in which no invitation of the search division under R. 63(1) EPC and no response thereto was present, the reasons of that decision were not directly applicable to the case in hand. However, both decisions stated that fundamental clarity problems might make it impossible to carry out a meaningful search. The discrepancy between the claims and description in the case in hand was such a fundamental clarity problem.

Pursuant to R. 63(3) EPC when a partial search report has been drawn up, the examining division shall invite the applicant to restrict the claims to the subject-matter searched unless it finds that the objection under paragraph 1 was not justified.

4.1.2 Additional search necessary: limited discretion of the examining division

In **T 1515/07** the board stated that in normal circumstances an additional search had to be carried out if a search under R. 63 EPC was missing. The case law allowed discretion in this respect, but this discretion was limited to the special cases of notoriously known features or those explicitly accepted by the applicant as known. In all other cases, an additional search had to be performed. In particular, as long as no search had been performed an examining division should normally not refuse an application for lack of inventive step if the invention as claimed contained at least one technical feature which was not notorious. The examining division considered that it was not "necessary" to carry out a search because a decision could be reached anyway. The examining division was held to have committed a substantial procedural violation within the meaning of R. 103(1)(a) EPC by not performing an additional search that was manifestly necessary. It was therefore equitable to reimburse the appeal fee.

In **T 1242/04** (OJ 2007, 421) it was held that only when a search was not at all possible could it be denied under R. 45 EPC 1973. Whether or not the search division believed that the result of a search would be of use for the substantive examination was irrelevant. If nevertheless the situation occurred that no search had been performed although it could (and should) have been, an examining division was not obliged to perform an additional search for purely formal reasons if it considered a refusal of the application to be justified on the basis of prior art which was either so well known that it clearly did not require written proof or was accepted by the applicant as known. In all other cases an additional search should be performed.

In **T 690/06** regarding the procedure before the examining division the board was of the opinion that the examining division should have performed an additional search since the database partitioning and access control features were neither non-technical nor notorious. Following the principles set out in **T 1242/04**, the board considered that, as long as no search has been performed, an examining division should normally not refuse an application for lack of inventive step if the invention as claimed contained at least one technical feature which was not notorious. The term "notorious" had to be interpreted narrowly. See also **T 918/14**.

In **T 1411/08** the board understood "notorious" as implying that technical detail was not significant. The board stated that where a search division had decided that no search was to be performed, it was not always necessary for the examining division to carry out an "additional search" before raising an inventive-step objection. According to the established case law of the boards of appeal it was possible to raise an objection of lack of inventive step without documented prior art. That should be allowable where the objection was based on "notorious knowledge" or indisputably forms part of the common general knowledge (**T 1242/04**). Such cases, however, were exceptional, and a search was otherwise essential. In the case in hand, the examining division could and should have ensured that a search was performed before refusing the application for lack of inventive step. The board considered that the failure to carry out an "additional search" constituted a substantial procedural violation.

In **T 929/18** the board, referring to decision **T 1411/08**, held that a mobile user device of a peer-to-peer data sharing group was a technical feature of the infrastructure of the system, which went beyond a notorious data processing system. Therefore, the board remitted the case to the examining division for an additional search to be carried out (Guidelines C-IV, 7.2 – March 2022 version). The board noted that the Guidelines did not define what such an additional search should cover. In the board's view, in a case like this, where no search had been carried out, the additional search should be just as complete as a normal prior art search under Art. 92 EPC. Furthermore, the results of the search ought to be presented in the public file, either in a separate document or in a communication of the examining division. At a minimum, the field of search and the relevant documents should be indicated. Should the search not reveal any relevant documents, a statement to that effect would allow the applicant, a board of appeal and third parties to conclude that the search had been completed.

In **T 1924/07** the board held that the applicant's acknowledgement in the original application that certain prior art was known was, in general, not a sufficient reason for not carrying out an additional search. The only condition under which an additional search can be dispensed with was where all the technical features of a claim correspond to "notorious" prior art.

In **T 2299/10** the decision under appeal was, inter alia, based on the objection that the subject-matter of claim 1 lacked an inventive step. The EPO acting as International Searching Authority issued a declaration of non-establishment of the international search report under Art. 17(2)(a) PCT. No supplementary European search report was established either. The examining division examined the application despite the fact that no search had been carried out. However, this was only possible in exceptional cases and, according to the case law of the boards of appeal, an additional search for pertinent prior art may be dispensed with only if the technical features of the claims were considered to be "notorious", i.e. generic and so well known that they could not reasonably be refuted (see **T 1411/08**). In the board's judgment, the technical features went beyond the mere common general knowledge and could not be considered "notorious". An applicant's acknowledgement in the original application that certain prior art was known is in general not a sufficient reason for not carrying out an additional search since such statements may be – and indeed frequently are – withdrawn or qualified. Moreover, this could only apply in

cases where all the technical features in the claim would be acknowledged as known (see **T 1924/07**). In the case in hand, however, the appellant did not acknowledge the relevant features of claim 1 mentioned as being known. Thus, claim 1 could not be definitively assessed with respect to novelty and inventive step without knowledge of the relevant documented prior art. Thus the request required a search for relevant prior art. Hence the matter had to be remitted for an additional search and further examination.

In **T 359/11** the board held that where the relevant search authority had stated, either in a search report or in a declaration that no search report would be established, that it was not necessary to cite any documentary evidence of the prior art on the grounds that all of the technical features of the claimed invention were notorious, it was always incumbent upon the examining division to consider whether an additional search was necessary. The criterion to be applied was that if the invention as claimed contained at least one technical feature which was not notorious, the application should normally not be refused for lack of inventive step without performing an additional search (see **T 690/06**). In the case in hand, the choice of the examining division to decide on the issue of inventive step without performing an additional search could only be considered justifiable if the claimed subject-matter comprised no technical features which were non-notorious.

In **T 2249/13** the appellant doubted the legitimacy of the notice from the EPO dated 1 October 2007 concerning business methods (OJ 2007, 592), which announced a no-search policy for claims pertaining to business methods. It claimed such discrimination was not justified. It considered that the EPO had enriched itself unfairly by receiving the search fee without performing a search. Furthermore, the no-search declaration of the search division could not be deemed to be a European search report under R. 63(2) EPC as the search division had ignored R. 63(1) EPC by failing to invite the appellant to file a statement indicating the subject-matter to be searched. The board pointed out that the board was applying the EPC and associated provisions as they stood. The Rules Relating to Fees did not provide for a refund of the search fee in case of a no-search declaration under R. 63 EPC. R. 63(2) EPC states that such a no-search declaration shall be considered as the European search report. Further, the fact that the search division did not comply with R. 63(1) EPC (failure to communicate with the appellant) did not alter the legal situation. The search division's actions were not open for review by the board (Art. 106(1) EPC) and, for the same reason, neither was the search division's reliance on the notice from the EPO dated 1 October 2007 concerning business methods. Therefore, the board considered that the request for a (partial) refund of the search fee was inadmissible.

In **T 1895/13** the board concurred with in **T 2249/13**; it could only apply the EPC and associated provisions as they were. Art. 9(1) RFees provided for a refund of the search fee only in the case that the European patent application was withdrawn at a time when the EPO had not yet begun to draw up the search report, but not in the case of a no-search declaration under R. 63 EPC. Furthermore, the search division could be assumed to have analysed the set of claims before taking the decision to issue a no-search declaration, and, hence, it could not be argued that the EPO had been unjustly enriched. The board explained that it was also not competent to decide on claims for compensation in respect

of a loss or damage allegedly caused by the EPO in the course of patent grant proceedings (see **J 14/87**, OJ 1988, 295).

4.1.3 Declaration under Rule 63(2) EPC

a) Notoriously well-known technical features

According to the case law of the boards of appeal an examining division need not carry out an additional search if the technical features of the claims are notoriously well known. In particular, it is possible to raise an objection of lack of inventive step without documented prior art (see e.g. **T 939/92**, OJ 1996, 309; **T 1242/04**, OJ 2007, 421; **T 1411/08**, **T 1895/13**). That should be allowable where the objection was based on "notorious knowledge" or indisputably forms part of the common general knowledge. In such cases it would be inappropriate to carry out an additional search for documented prior art on purely formal grounds (**T 1242/04**; see also **T 690/06**, **T 698/11**, **T 779/11**).

In **T 2467/09** the examining division refused the application for lack of inventive step without making reference to documentary evidence. In fact, no prior art search was carried out in either the international phase or the European phase. The board noted that according to the established case law of the boards of appeal, an application should normally not be refused for lack of inventive step as long as no search had been performed. An exception may however be made in cases where the objection was based on knowledge that was "notorious" or indisputably formed part of the common general knowledge. The board pointed out that while it could not be reasonably disputed that server systems providing web pages were known at the priority date of the application, in its view this was less evident for "technologies for the dynamic building of web pages". While such technologies were probably well known in 2008, which was when the examining division for the first time explicitly relied on their existence, it had to be kept in mind that the field of web technology had evolved considerably in the eight years following the filing of the priority application in April 2000. The board noted that the argument that certain knowledge was notorious was only a sufficiently cogent reason if it satisfied any reasonable addressee, i.e. if, at the time the argument was to be assessed by the applicant and, in case of an appeal, by a board of appeal, it could not be reasonably disputed that knowledge formed part of the common general knowledge of the skilled person at the effective filing date. In the case in hand, the board held that without documentary evidence, the examining division's reasoning failed to convince in this respect. The board remitted the case to the department of first instance for further prosecution. The examining division was to carry out an additional search on the basis of the claims, including the dependent claims. See also **T 283/12**.

b) Subject-matter not having technical character

In **T 1242/04** (OJ 2007, 421) the board noted that R. 45 EPC 1973 applied to cases which did not comply with the provisions of the EPC to such an extent that it was not "possible" to carry out a "meaningful search" into the state of the art on the basis of all or some of the claims. Thus a R. 45 EPC 1973 declaration was allowed only where a search was not possible. In other cases the search division would draw up a partial search report, "so far

as is practicable". In the board's view, R. 45 EPC 1973 related only to the practicability of a search and not to the potential relevance of its results in subsequent substantive examination. The board noted that it was not evident that claims directed only to technical features that the search division deemed "trivial" could prevent a meaningful search into the state of the art, which in fact ought to be particularly simple in such a case. The board held that where the application's subject-matter had non-technical aspects, a declaration under R. 45 EPC 1973 could be issued only in exceptional cases in which the claimed subject-matter clearly had no technical character. In the board's view, however, it was not always necessary in such circumstances to carry out an additional search in the documented prior art.

The board in **T 779/11**, referring to **T 1242/04**, pointed out that although R. 45 EPC 1973 was not identical to Art. 17(2)(a) PCT (in conjunction with R. 39.1 PCT), there appeared to be no good reason why the same findings should not apply to the issuing of a declaration under Art. 17(2)(a) PCT. See also **T 2948/18** and **T 918/14**.

c) Statement indicating the subject-matter to be searched not sufficient to overcome the deficiency noted under Rule 63(1) EPC

In **T 1653/12** the board pointed out that the applicant's statement did not provide a basis for the search examiner to perform a meaningful search. The particular wording used therein ("and/or") left it entirely open which of the two alternatives claimed should be searched. Hence, it was plausible that a meaningful search could not be made.

In **T 736/14** the board noted that the EPC contained no explicit provisions on how to proceed if an applicant whose application was non-unitary responded unclearly or in a misleading way to an invitation from the examining division to specify which searched invention it wished to prosecute further. The board held that in such a situation it could not automatically be assumed that the applicant selected the invention covered by the main request for examination. Rather, the examining division had to clarify, e.g. via a further communication, which of the searched inventions the applicant actually wanted it to examine.

4.2. Non-payment of further search fees under Rule 64 EPC

Rule 64(1) EPC (R. 46 EPC 1973) was amended by decision of the Administrative Council (OJ 2009, 299), and entered into force on 1 April 2010.

Under R. 64(1) EPC if the EPO considers that the European patent application does not comply with the requirement of unity of invention, it shall draw up a partial search report on those parts of the application which relate to the invention, or the group of inventions within the meaning of Art. 82 EPC, first mentioned in the claims. It shall inform the applicant that, for the European search report to cover the other inventions, a further search fee must be paid, in respect of each invention involved, within a period of two months. The European search report shall be drawn up for the parts of the application relating to inventions in respect of which search fees have been paid.

In **G 2/92** (OJ 1993, 591) the Enlarged Board stated that an applicant who failed to pay the further search fees for a non-unitary application when requested to do so by the search division could not pursue that application for the subject-matter in respect of which no search fees had been paid. Such an applicant must file a divisional application in respect of such subject-matter if they wished to seek protection for it. The Enlarged Board also stated that if the applicant had not availed himself of the opportunity to have the search results on the other inventions included in the search report because they had paid no additional search fees in response to the invitation under R. 46(1) EPC 1973, they would be taken to have elected that the application should proceed on the basis of the invention which had been searched. However, non-payment was not to be equated with the abandonment of parts of the application.

In **T 998/14**, however, the board noted that decision **G 2/92** did not necessarily apply for features which were disclosed in the original application documents in connection with an invention or group of inventions in respect of which a search had been made.

5. Amendments relating to unsearched subject-matter – Rule 137(5) EPC

5.1. General issues

Rule 137(5) EPC as in force from 1 April 2010 (OJ 2009, 299) (R. 137(4) EPC and R. 86(4) EPC 1973) relates to amendments made during the grant procedure which are under the control of the examining division. It stipulates that amended claims may not relate to unsearched subject-matter which does not combine with the originally claimed invention or group of inventions to form a single general inventive concept. Nor may they relate to subject-matter not searched in accordance with R. 62a or 63 EPC.

In **T 2459/12** what was at issue was whether the invention was "unsearched" within the meaning of R. 137(5) EPC, which limits the choice of subject-matter which may be put forward by way of amendment for examination in the European procedure. The board stated that it was clear that the only interpretation of R. 137(5) EPC was that, within the meaning of R. 137(5) EPC, "unsearched" means "unsearched by the EPO". It was consequently the view of the board that where, following the drawing up of a supplementary European search report by the EPO, an applicant files amended claims seeking protection for subject-matter not covered by the supplementary European search as a result of the application of R. 164(1) EPC as then in force, an objection under R. 137(5) EPC should be raised (see also **T 1871/14**).

5.2. The purpose of Rule 137(5) EPC

The wording of R. 137(5), first sentence, EPC is the same as that of R. 86(4) EPC 1973. R. 86(4) EPC 1973 (with effect from 1 June 1995) was intended to prevent amendments of the application which circumvent the principle that a search fee must always be paid for an invention presented for examination. The board in **T 274/03** explained that R. 86(4) EPC 1973 stopped applicants switching to unsearched subject-matter in the reply to a communication from the examining division and made means available for the EPO to react when different subject-matter was claimed not simultaneously but in sequence as

was the case when the applicant drops the existing claims and replaces them with originally non-unitary subject-matter extracted from the description. See also **T 442/11**, **T 509/11**, **T 1285/11**, **T 2334/11**, **T 145/13**, **T 1485/13**, **T 820/15**.

In **T 443/97** the board stated that R. 86(4) EPC 1973 concerned examination proceedings, and particularly those cases in which no further search fees requested by the search division for non-unitary subject-matter had been paid by the applicant. The purpose of R. 86(4) EPC 1973 was to exclude any amendment which circumvented the principle according to which a search fee must always be paid for an invention presented for examination. The board noted that unity of invention was a requirement of an administrative nature and that the administrative purposes of this requirement were fulfilled when the examination procedure had been concluded, i.e. when the patent had been granted (see **G 1/91**, OJ 1992, 253). Therefore, R. 86(4) EPC 1973 was not relevant for the opposition case in hand.

5.3. Applicability of Rule 137(5) EPC

5.3.1 General issues

Rule 137(5) EPC states: "Amended claims may not relate to unsearched subject-matter which does not combine with the originally claimed invention or group of inventions to form a single general inventive concept. Nor may they relate to subject-matter not searched in accordance with Rule 62a or Rule 63".

According to well-established case law, R. 137(5) EPC does not apply when the applicant has not paid the search fee in respect of a non-unitary invention relating to the originally filed claims (see **T 708/00**, OJ 2004, 160; **T 1285/11**).

In **T 613/99** the board stated that R. 86(4) EPC 1973 (now R. 137(5) EPC) referred to a particular situation, i.e. where subject-matter was described but not claimed in the original application and was therefore not searched; where that subject-matter failed to meet the requirement for unity of invention with the matter claimed in the application; and where, following the search report, the applicants had filed fresh claims relating only to this unsearched matter. In this situation, the patentability of these fresh claims could not be examined in the context of the original application, since this would have amounted to a derogation from the principle endorsed in **G 2/92** (OJ 1993, 591), according to which the invention to be examined had to be an invention for which a search fee had been paid. In the case in hand, the situation was entirely different. The claimed subject-matter in the application at issue had been claimed in the original application and had therefore been searched, even if it had not been possible to carry out a meaningful search. Moreover, the invention forming the subject of claims 1 and 2 of the application at issue was substantially the same as that which formed the subject of claims 1 and 2 of the original application. In such a situation, if the examining division rejected a finding of the search division regarding matter excluded from the search, a so-called additional European search could be carried out at the request of the examining division.

5.3.2 Extent of the European search report

The extent of the search for prior art to be conducted for the purposes of the European search report is defined in Art. 92 EPC, which states that the European search report shall be drawn up by the EPO "on the basis of the claims, with due regard to the description and any drawings". In principle, and in so far as possible and reasonable, the search should cover the entire subject-matter to which the claims are directed or to which they might reasonably be expected to be directed after they have been amended (Guidelines B-III, 3.5 – April 2025 version).

In **T 708/00** (OJ 2004, 160) the application was refused by the examining division, principally on the grounds that the new claims were not allowable under R. 86(4) EPC 1973. The board stated that the provisions of Art. 92(1) EPC 1973 must not have the effect of limiting the search solely to the subject-matter of the claims, even if this would simplify matters for the search division. Nor did this imply that the sole purpose of the description and drawings was to help interpret the claims. It did, however, mean that the search division had to be discerning in the use of its discretionary power so as to ensure that the search was in complete accordance with the subject-matter of the patent application (see R. 44(1) EPC 1973), i.e. the invention, even if the essential features were not all defined in the claims at the time of search but were disclosed for example in the description or drawings. In the case in hand, the applicants were never informed of exactly what subject-matter was searched, which meant that the examining division and board of appeal were also without any information in this regard. It was therefore impossible – since negative proof is out of the question – to establish what subject-matter went "unsearched" under R. 86(4) EPC 1973. This rule therefore had to be interpreted using alternative means such as the preparatory documents or the documents published regarding the adoption of the rule. The board came to the conclusion that amended claims may only be refused on the basis of R. 86(4) EPC 1973 if the subject-matter of the claims filed originally and that of the amended claims was such that, had all claims originally been filed together, a further search fee would have been payable – on top of the search fee payable in respect of the claims actually filed at the outset – in respect of the amended claims, relating to a different invention within the meaning of R. 46(1) EPC 1973. The board noted that R. 86(4) EPC 1973 must be interpreted so as to fairly balance the objective of this rule, namely the EPO's interest in collecting, in return for services rendered, search and examination fees, and the fundamental right conferred by the EPC on the applicant to make amendments at least once to the description, claims and drawings that prove necessary during the grant procedure. The board pointed out that the intention and purpose of R. 86(4) EPC 1973 and the interference with the applicant's fundamental right to amend the application at least once called for a strict interpretation of R. 86(4) EPC 1973 (see also **T 141/04**). It held that R. 86(4) EPC 1973 did not apply when the applicant had not paid the search fee in respect of a non-unitary invention relating to the originally filed claims in spite of being invited to do so under R. 46(1) EPC 1973. In that case, the application could not be examined further, and a divisional application would have to be filed if protection were sought (see **G 2/92**, OJ 1993, 591). The boards in **T 319/96** and **T 631/97** (OJ 2001, 13) made a clear distinction between applying the provisions of R. 86(4) EPC 1973 and a situation where search fees were not paid in spite of an invitation to do so under R. 46(1) EPC 1973.

In **T 789/07** the board held that in order to search a claimed feature completely – as required by Art. 92 EPC and in line with the Guidelines – the search division must as a rule ascertain how the feature is to be interpreted in the light of the description and drawings. Only then can it arrive at a reasoned assessment about the amendments likely to be made to the claims during examination proceedings and within the framework of the original disclosure. This interpretation also forms the basis for comparison, with a view to R. 86(4) EPC 1973, with the originally claimed invention or group of inventions. The board also took the view that a claimed feature falling within the scope of the search must be regarded for R. 86(4) EPC 1973 purposes as searched, even if it was not in fact searched in a specific case (see also **T 2334/11**, **T 1679/10**, **T 345/13**, **T 1503/13**). In **T 1679/10** the board added that it would go too far to construe the Guidelines as meaning that it would be sufficient to have one broad independent claim in the application as filed, with no dependent claims, in order to be entitled to a search extending to all the features of a large number of embodiments covered by the wording of that claim.

In **T 264/09** the board stated that if a feature which had not been searched, and which further defined an element which was already part of a claim which had been searched, was taken from the description and added to this claim in order to overcome an objection under the EPC, e.g. lack of inventive step, this did not result in a claim which had been amended such that it related to unsearched subject-matter which did not combine with the originally claimed invention to form a single general inventive concept (see also **T 2334/11**, **T 1503/13**). The board thereby followed the well-established case law on the interpretation of R. 86(4) EPC 1973 (see e.g. **T 708/00**, OJ 2004, 160; **T 274/03**; **T 141/04**), it being noted that R. 86(4) EPC 1973 had the same wording as R. 137(4) EPC (as in force at the date the examining division took its decision), which, as from 1 April 2010, is included in R. 137(5) EPC. The board noted that the Guidelines were drafted accordingly; these explicitly mentioned the possibility of carrying out an additional search in connection with the examination of amended claims.

In **T 2029/13** the board was of the view that amended claims 1 to 13 did not lack unity of invention, and that consequently the search division should also have searched claims 7 to 13 (second group of inventions) of the supplementary European search report, and the examining division should not have raised an objection under R. 137(5) EPC (version that entered into force on 1 April 2010) against the second and third auxiliary requests underlying the decision under appeal on the grounds that claim 1 of those requests comprised unsearched features. Since the claims of the present main request and first auxiliary request comprised features relating to claims 7 to 13 of the supplementary European search report , which should have been searched but were not, the board considered it appropriate to remit the case to the examining division for further prosecution under Art. 111(1) EPC to perform an additional search for the combination of features of claims 7 to 13 and continue substantive examination on that basis.

In **T 1520/14** the board accepted that there was no obligation on the search division to extend the search to a feature mentioned in the description where there was no objective reason to expect that future amendments might be directed to precisely this feature. However, where the description repeatedly stresses the utility of the invention for a particular purpose or in a particular technical area, it was clearly foreseeable that the

invention may ultimately be claimed in relation to this purpose or technical area. The board found that the position of the search division that claim 1 was fully searched, but that the search did not extend to what was repeatedly presented in the description as the principal area of application, was not reasonable and not in conformity with the requirements of Art. 92 EPC. It was equally unreasonable for the examining division to confirm the correctness of this position.

5.3.3 Subject-matter of amendment not combining with the originally claimed invention

In **T 442/95** the appellants submitted new claims, based on subject-matter which did not appear in the claims as filed. They submitted that the description of this newly claimed subject-matter was to be found in the description. In the board's judgment, the subject-matter claimed had not been searched and did not combine with the originally claimed and searched groups of inventions to form a single general inventive concept. There was no need at this stage to investigate whether the application as filed provided support for such a claim, because under R. 86(4) EPC 1973 the claim was not admissible. The only path open to the appellants was to pursue the subject-matter of said claim in the form of a divisional application.

In **T 353/03** the examining division had stated in its decision of refusal that the new feature in claim 1 had not been searched and that, for that reason, the application was refused according to Art. 97(1) EPC 1973 in conjunction with R. 86(4) EPC 1973. The board found that in its decision the examining division did not take into account the fact that R. 86(4) EPC 1973 mentioned another condition which also had to be fulfilled for amended claims to be rejected, namely that the unsearched subject-matter did not combine with the originally claimed invention to form a single general inventive concept (lack of unity). There was no discussion in the appealed decision as to why the subject-matter of new claim 1 was not in unity with original claim 1. The board came to the conclusion that the appealed decision was not reasoned within the meaning of R. 68(2) EPC 1973.

In **T 333/10** the board found that the subject-matter of amended claim 1 could not be considered to have been searched and it did not combine with any of the originally claimed inventions to form a single general inventive concept. The appellant referred to **T 2334/11** and argued that, in a case like the one before it, no "a posteriori" unity judgment was to be made; rather, it was to be generally examined if the added feature taken from the description combined with the originally claimed invention to form a single general inventive concept focused on in the claims and description as originally filed. The board noted that the claims as originally filed had been found to lack unity by the search division. It also stated that the case in hand concerned the replacement of some of the features from the combination of features on which the search was based by features which might not be considered as corresponding special technical features within the meaning of R. 44(1) EPC and which could not be expected to constitute a pure limitation of one of the searched inventions. In contrast, **T 2334/11** concerned a factual situation in which added features restricted the scope of the searched subject-matter. This difference had also been addressed in **T 2334/11**, which essentially stated that the case law concerning R. 137(5) EPC distinguished between cases in which the claimed subject-matter was substantially changed, in particular by replacement or omission of a feature in a claim, and

which could give rise to an objection under R. 137(5) EPC, and cases which concerned the pure limitation or concretisation of a claim by adding a feature disclosed in the application as originally filed, and which did not normally cause lack of unity with the originally claimed invention within the meaning of R. 137(5) EPC. In the case in hand, the board did not see a limitation or concretisation of any of the four inventions which had initially been searched and which could have been pursued by the appellant. The board noted that **T 2334/11** could not be understood to the effect that the amendment of an independent claim by a feature extracted from the description was generally admissible under R. 137(4) EPC if the subject-matter of the independent claim had been searched and lacked novelty with respect to a prior art document. Instead, the board in **T 2334/11** emphasised that – in such cases – it always had to be examined whether the added feature was linked to the general inventive idea that can be deduced from the claims and description as originally filed. Hence, the amended set of claims was not admissible.

5.4. Criteria for amendments to be allowable under Rule 137(5) EPC

The question concerning the criteria to be used for the proper application of R. 137(5) EPC has been dealt with in various decisions of the boards of appeal.

5.4.1 Amendment not affecting the notion of unity of invention

A claim may be limited by inclusion of additional features, provided the resulting combination was directly and unambiguously disclosed in the application as originally filed in an explicit or implicit manner and does not relate to an invention which was not searched (Guidelines H-V, 3.2 – April 2025 version).

In **T 708/00** (OJ 2004, 160) the board held that under R. 86(4) EPC 1973, amended claims could only be refused if the subject-matter of the claims filed originally and that of the amended claims was such that, had all the claims originally been filed together, a further search fee would have been payable – on top of the search fees payable in respect of the claims actually filed at the outset – in respect of the amended claims, relating to a different invention within the meaning of R. 46(1) EPC 1973 (see also **T 319/96**; **T 631/97**, OJ 2001, 13, **T 1473/13**). It noted that a subsequent amendment to limit the subject-matter of the main claim by additional features disclosed in the application as filed did not generally affect the notion of unity of invention under either R. 86(4) or 46(1) EPC 1973 and that it was normal for an applicant to make such an amendment in respect of an objection to the patentability of the subject-matter in unlimited form. See also **T 2334/11**.

In **T 274/03** it was however made clear that certain conditions had to be satisfied for an amendment not to generally affect the notion of unity of invention. Thus, this notion was not affected, and therefore no post-search switching of subject-matter was involved by the amendment, if for instance features were added from the description to further define an element that was already a feature of the original main claim. See also **T 1394/04**.

In **T 2334/11** the board held that what generally had to be ascertained for the purposes of applying R. 137(5) EPC where an original claim was amended by adding a feature was whether the added feature could be regarded as falling under the original general inventive

concept as established in the light of the claims and description as filed (see **T 1640/07**), and not whether the originally claimed subject-matter and the subject-matter defined in the amended claim withstood an assessment of unity a posteriori. It found that one of the ideas underlying the case law on application of R. 137(5) EPC was that, while amendments to claimed subject-matter which considerably altered the essence or nature of the invention – especially through replacement or omission of features in a claim (see **T 442/95**, **T 274/07**) – might occasion an objection under R. 137(5) EPC, the mere limitation or the more specific drafting or supplementing of a claim by inclusion of a feature disclosed in the application as filed, in order, for example, to overcome an objection of lack of clarity, novelty or inventive step, generally did not result in a lack of unity for the purposes of R. 137(5) EPC. See also **T 1503/13**, **T 820/15**.

In **T 1394/04** the board noted that careful consideration of the very nature of the added feature was necessary in order to determine whether the amendment lead to a situation where lack of unity of inventive concept between the original main claim and the later claimed subject-matter arose. Such a situation in the context at issue would necessarily entail an implicit finding of lack of unity "a posteriori" (with reference to **T 274/03**) and according to the Guidelines this form of objection to lack of unity should be the exception. The board also noted that it could not be excluded that such a situation could arise as a consequence of later amendments supported solely by the description. In fact, it may occur that the description of the application contains a further general inventive concept, distinct from that underlying the main claim and its dependent claims, if any, but not clearly identified or declared as such in the description. In such a case, if the subject-matter of the main claim based on the first inventive concept had to be amended, on account of a lack of novelty resulting from too broad terms used in the wording, any amendment of the claim pertaining exclusively to said further inventive concept could justify an objection of lack of unity "a posteriori". This example elucidates that situations may actually occur where the amendment of the main claim, whose subject-matter lacks novelty, based on features supported exclusively by the description, may affect the notion of unity of the invention. Although such situations occur very rarely in practice, as already noted above, in such cases R. 86(4) EPC 1973 would have to be applied in order to avoid a possible circumvention of Art. 82 EPC 1973. In the case in hand however it was clear that, much the same way as in **T 274/03**, the introduced amendment feature merely constituted a further specification of original features of the claim which were essential to the invention. This constituted an essential aspect of the invention. Therefore, no lack of unity pursuant to R. 86(4) EPC 1973 in conjunction with Art. 82 EPC 1973 could be found.

In **T 2021/15** the board held, following **T 708/00**, that when rejecting amended claims as inadmissible under R. 137(5) EPC, it was not enough to show that an objection of lack of unity would have arisen if the amended claims had been part of the original claim set. It must be shown that the amended claim lacked unity with all claims in the original claim set, because each claim was part of the originally claimed "group of inventions". In other words, if there was unity with at least one of the original claims, R. 137(5), first sentence, EPC did not apply.

In **T 1866/15** the board agreed with the general statement that, in order to assess whether or not amended claims fulfilled the requirements of R. 137(5), first sentence, EPC it

needed to be established whether or not an objection of lack of unity would have been raised if the amended claims had been present in the set of claims on file at the time of the search. The board also agreed with the statement from the Guidelines that "an objection under Rule 137(5), first sentence, EPC would [...] arise if a technical feature taken from the description which has an effect unrelated to the effect(s) of the features of the originally claimed invention(s) were added to a claim" (see Guidelines, H-II, 6.2 – March 2021 version) insofar that the effect of an originally claimed invention could be that of a feature of a dependent claim. However, it stated that if an amendment introduced a feature with an effect entirely unrelated to the effects of the original claims, this might well be a sound basis for the examining division to deny its consent under R. 137(3) EPC. Confirmed in **T 416/19**.

5.4.2 No legal basis for exercise of discretion

In **T 2431/19** the board held that R. 137(5) EPC provided for a mandatory requirement that amended claims must fulfil to be allowable. R. 137(5) EPC did not refer to the act of making an amendment, but rather to the amended claims themselves. More specifically, the phrase "amended claims may not" or "nor may they" in R. 137(5) EPC expressed – in the form of a prohibition – a substantive and mandatory requirement for amended claims to be allowable. This requirement did not leave any room for discretion on the part of the deciding body. Accordingly, and contrary to R. 137(3) EPC, there is no reference to consent by the examining division in R. 137(5) EPC. The board found that R. 137(5) EPC hence relates to a matter of substantive law rather than to a matter of procedural law. It lays down substantive requirements, non-compliance with which leads to the refusal of a European patent application under Art. 97(2) EPC (see also **T 1126/11**). R. 137(5) EPC does not, however, provide a separate legal basis for taking a discretionary decision on the admittance of amended claims which could be relied upon independently from R. 137(3) EPC. In the case in hand the non-admittance of an amended set of claims on the basis of that rule alone therefore constituted a substantial procedural violation under R. 103(1)(a) EPC.

In **T 1866/15** the board endorsed the findings of **T 2431/19**, finding that if an amendment did not comply with R. 137(5) EPC, it was not allowable on that ground alone and the examining division no longer had discretion whether or not to admit it under R. 137(3) EPC. See also **T 416/19.**

5.4.3 Amendments filed to meet an objection

In **T 141/04** the board held that R. 86(4) EPC 1973 does not apply if a feature originally disclosed in the description is added to an originally-filed claim in order to meet an objection raised. It noted that the Guidelines were in line with the case law of the boards of appeal. The board noted that, notwithstanding the applicant's right to introduce subject-matter from the description into the claims, the exercise of such a right was not without restrictions, as indicated by Art. 123(1) EPC 1973 and R. 86(3) EPC 1973. Therefore, the examining division could possibly have exercised its discretion under R. 86(3), last sentence, EPC 1973 to refuse to admit this request, as it was filed for the first time during the oral proceedings before the examining division and apparently comprised unsearched

subject-matter. As such, the request could not reasonably be considered as clearly allowable, this latter being a usually applied requirement for admissibility of a request at such a late stage of the proceedings. On the contrary, the potential requirement for an additional search would have represented an unreasonable protraction of the examination procedure.

In **T 274/03** the board noted that it was clear that post-search "switching" of subject-matter clearly implied a significant change in the nature of the subject-matter being claimed which was not normally comparable to the addition of features taken from the description to further define an element that was already a feature of the original main claim. The board was of the opinion that an amendment amounting to the restriction of an original main claim by including complementary features from the original description into the claim represented an admissible reaction of an applicant vis-à-vis an objection against the patentability of the unamended claim and did not constitute an abuse of the system of the nature which R. 86(4) EPC 1973 was introduced to prevent (**T 377/01**, **T 708/00**). This type of amendment should not therefore in general be judged as contravening the requirements of the rule, even though an additional search could be required**.** In this context it was to be observed that the implicit finding of lack of unity between the originally claimed and later claimed subject-matter, which was a prerequisite for an objection under R. 86(4) EPC 1973, had to, with amendments of the type under consideration here, be a posteriori. The Guidelines made it clear however that this form of objection to lack of unity should be the exception, with benefit of the doubt being given to the applicant. See also **T 2334/11**.

5.5. Non-compliance with Rule 137(5) EPC: a ground for refusing an application

In **T 2459/12** the board noted that in **T 1981/12** doubt was also expressed whether R. 137(5) EPC could be an appropriate basis for refusing an application. The board in **T 1981/12** concluded that, by reference to **T 708/00** and **T 442/95**, an amendment not complying with this rule was inadmissible. According to Art. 97(2) EPC, a European patent application which does not meet the requirements of the EPC is refused unless "this Convention provides for a different legal consequence". R. 137(5) EPC sets out a requirement to be met by amended claims of a European patent application, and neither in the rule itself nor elsewhere in the EPC is any "different legal consequence" provided for the case where this requirement is not met. The board therefore judged that a failure to meet the requirements of R. 137(5) EPC was a ground for refusal of the application under Art. 97(2) EPC (see also **T 2431/19**, **T 1126/11**). The board stated that this was also entirely consistent with the view taken in **T 708/00** according to which R. 86(4) EPC 1973 was regarded as having "the status of an administrative provision in the context of the search and grant procedures", as is "the case for the unity of invention requirement in general".

C. Opposition procedure

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1. Legal character of opposition proceedings and applicable principles

Opposition proceedings (see Art. 99 to 105 EPC and R. 75 to 89 EPC) constitute an exception to the general rule under the EPC that after grant a European patent is no longer within the competence of the EPO but becomes a bundle of patents within the jurisdiction of the designated contracting states (**T 9/87**, OJ 1989, 438). They allow, during a limited period of time, a centralised action for revocation of a European patent to be brought before and decided by the EPO.

Opposition is an **independent procedure** following the grant procedure (**T 198/88**, OJ 1991, 254). It is not designed to be an extension of the examination procedure (**G 1/84**, OJ 1985, 299). As explained in **G 9/91** and **G 10/91** (OJ 1993, 408 and 420), it takes place at a point in time when the proprietor is enjoying in each designated contracting state the same rights as would be conferred by a national patent granted in that state (Art. 64 EPC). The relief sought by the opponent is not, as in traditional pre-grant opposition, refusal of the patent application but revocation of the patent as granted (in its entirety or in part) with effect ex tunc in all designated contracting states (Art. 68 EPC). Furthermore, the limited grounds for opposition (Art. 100 EPC) are essentially the same as the grounds for revocation under national law (Art. 138 EPC), the concept of post-grant opposition under the EPC differs considerably from that of pre-grant opposition. The opposition procedure before the EPO thus has several important features more in common with the concept of the traditional revocation procedure and its effect is more similar to that of such a procedure. This characteristic is further emphasised by the addition at a late stage in the preparation of the EPC of the possibility to oppose a European patent even if it has been surrendered or has lapsed for all contracting states (Art. 99(3) EPC 1973; see R. 75 EPC and also **T 606/10**). As opposition is an independent procedure which takes place after the grant procedure, a document considered in examination proceedings is not automatically scrutinised in opposition or opposition appeal proceedings, even if quoted and acknowledged in the contested European patent (**T 198/88**, OJ 1991, 254).

The opposition procedure is a purely administrative procedure. It differs fundamentally from the appeal procedure, which must be regarded as a judicial procedure and is, by its very nature, less investigative (see **G 7/91** and **G 8/91**, OJ 1993, 356 and 346; **G 9/91**, OJ 1993, 408). Unlike an appeal, opposition has neither suspensive effect nor the effect of transferring the case to a superior instance (see **T 695/89**, OJ 1993, 152).

Post-grant opposition proceedings under the EPC are in principle to be considered as **contentious** proceedings between parties who normally represent opposing interests and

who should be treated equally fairly (**G 9/91** and **G 10/91**, OJ 1993, 408 and 420). As soon as the notice of opposition has been filed, the procedure automatically becomes bilateral, no matter whether the opposition is valid, admissible or allowable. The Convention does not provide for a decision by an opposition division "to end the ex parte proceedings" (**T 263/00**). R. 79(1) EPC (R. 57(1) EPC 1973) requires the opposition division to communicate the opposition to the proprietor of the patent, and the Guidelines D-IV, 1.5 (April 2025 version) provide that communications and decisions about whether the opposition is deemed to have been filed and is admissible are also to be notified to the patent proprietor. Concerning the contentious nature of opposition proceedings, see also parallel cases **T 1553/06** and **T 2/09** in this chapter IV.C.2.1.4.

According to the principle of party disposition (cf. **G 9/92** and **G 4/93**, OJ 1994, 875), the request of the opponent determines the extent to which the patented subject-matter may be examined in opposition. In **T 364/18**, for instance, the board saw itself limited to examining the patent with regard to the claims opposed, in accordance with the principle of ne ultra petita (on the extent of opposition, see also chapters IV.C.2.2.6 and IV.C.3.2).

Opposition proceedings are characterised by the interplay between its nature as contentious proceedings between parties (**G 9/91** and **G 10/91**, OJ 1993, 408 and 420) and the principle of ex officio examination which applies to proceedings before the EPO (Art. 114(1) EPC) and thus also in opposition proceedings (**G 9/92** and **G 4/93**, OJ 1994, 875). Accordingly, in opposition proceedings, the EPO must investigate the facts of its own motion (Art. 114(1) EPC). However, certain restrictions have been placed on this principle in order to make opposition proceedings clearer, to shorten and accelerate cases, and to limit the risks to the parties (**G 9/92** and **G 4/93**, OJ 1994, 875). In particular, ex officio examination has a restricted application with respect to the grounds for opposition: grounds extending beyond those properly covered by the opponent's statement pursuant to R. 76(2)(c) EPC are only exceptionally considered (**G 9/91** and **G 10/91**; for details, see chapter IV.C.3.3 and 3.4).

Under the EPC, there is no legal obligation for the patent proprietor to take an active part in opposition proceedings (e.g. in reply to the communications under R. 81(3) EPC or R. 116(2) EPC). However, the patent proprietor is not free to present or complete their case at any time they wish during the opposition or opposition appeal proceedings (see e.g. **T 936/09** and **T 167/11**; see also the case law in chapters IV.C.5.1.4 "Timeframe for filing amendments", V.A.4.3.4 "Discretion under Article 12(4) RPBA", V.A.4.3.7 "Submissions that should have been submitted at first instance – Article 12(6), second sentence, RPBA".

Certain topics relating to opposition proceedings are dealt with in Part III: See chapters III.O. "Transfer of party status", III.P. "Intervention", III.Q. "Continuation of the opposition proceedings by the EPO" and III.R. "Apportionment of costs".

2. Filing and admissibility requirements

2.1. Entitlement to file an opposition

2.1.1 General principles

The legislator explicitly designed the opposition procedure as a legal remedy in the public interest which, according to Art. 99(1) EPC, is open to "any person" (**G 3/97** and **G 4/97** (OJ 1999, 245 and 270). "Any person" is to be interpreted in line with Art. 58 EPC as "any natural or legal person, or any body equivalent to a legal person by virtue of the law governing it". Thus, any legal entity recognised as such under any system of law anywhere in the world may give such notice, and not just those recognised under the laws of the contracting states to the EPC (**G 3/99**, OJ 2002,347; **G 1/13**, OJ 2015,42; see also **T 635/88**, OJ 1993,608). It is a generally recognised principle of national law and also under the EPC that legal entities which do not exist cannot bring or take part in proceedings (**G 1/13**, **T 353/95**). "Any person" does not include the patent proprietor (**G 9/93**, reversing **G 1/84**). See chapters IV.C.2.1.2. and IV.C.2.1.4.

According to the Enlarged Board in **G 3/97** and **G 4/97**, but also more recently **G 1/13**, an opponent's status is a procedural status, and the basis on which it is obtained is a matter of procedural law. This is addressed in Art. 99(1) EPC in conjunction with Art. 100 EPC, R. 76 and R. 77(1) EPC (R. 55 and R. 56(1) EPC 1973). The opponent is the person who fulfils the requirements set out therein for filing an opposition; in particular the person must be identifiable (R. 76(2)(a) EPC, R. 41(2)(c) EPC; R. 55(a) EPC 1973; see also in this chapter IV.C.2.2.4). The EPC does not specify any further formal conditions to be met by the opponent. A person who fulfils the said requirements becomes a party to the opposition proceedings (Art. 99(3) EPC; Art. 99(4) EPC 1973).

Thus, the EPC does not require that the opponent have an interest in the outcome of the opposition proceedings. As early as in **G 1/84** (OJ 1985, 299) the Enlarged Board held that the motives of the opponent were in principle irrelevant (otherwise, the phrase "any person" would have been rendered as "any person interested"), whilst their identity was primarily of procedural importance (similarly in **T 635/88**, OJ 1993, 608; **T 590/93**, OJ 1995, 337). Following that case law, the board in **T 798/93** (OJ 1997, 363) found that the EPC and its attendant provisions contained no requirements as to the opponent's personal circumstances or motives for acting. Requests for the opposition to be declared inadmissible therefore had to be refused if, as in the case under consideration, they were based on either an objection regarding a particular aspect of the opponent's status, such as their profession (professional representative before the EPO), field of technical expertise (different from that of the opposed patent), or on a lack of motivation for acting (statement by the opponent saying that their only reason for acting was to complete their training). See also **T 1839/18**, in which the board held that the current system of allowing any person to have a patent reviewed by way of opposition proceedings regardless of any specific interest was in line with the function of patents and with the public's interest in legal certainty and clearing the register of undeserved or undeservedly broad monopolies. The board noted that the case law of the Enlarged Board was consistent in this regard.

2.1.2 A natural or legal person, or equivalent thereto

The legal personality of a named entity under the EPC is decided on the same basis as before national courts, namely the capacity to sue or to be sued in its own name and on its own account. Thus "any person" according to Art. 99(1) EPC) is to be interpreted in line with Art. 58 EPC as "any natural or legal person, or any body equivalent to a legal person by virtue of the law governing it" There is no procedural difference with respect to an opposition filed by a single natural person, by a single legal person or by a single body equivalent to a legal person by virtue of the law governing it; they have to fulfil the same requirements and to pay a single opposition fee (**G 3/99**).

Where it is doubtful whether the opposition is filed on behalf of a body which enjoys legal personality in its own right, or on behalf of several natural persons acting in common, the opposition division shall invite the opponents to establish that the body is a legal person or an equivalent thereto. If this is not established, the opposition is to be considered as having been filed on behalf of the several natural persons as common opponents (**G 3/99**; see also chapter IV.C.2.1.8 "Filing a joint opposition").

In **G 1/13** (OJ 2015, A42) the Enlarged Board considered that the starting point should be the clearly established principle under the EPC that national law should be referred to in order to determine whether a legal entity exists or has ceased to exist, and has capacity to act (subject to limits where national law provisions were contrary to the EPC). The case in hand concerned a UK company which had ceased to exist as a legal entity but which had later been restored to existence using a particular procedure available under UK law, the effect of which was that the company was deemed to have continued in existence as if it had not ceased to exist. The Enlarged Board noted the position under French law differed from English law, whereby striking a company off the register of companies (the "RCS") did not, by itself, have any effect in terms of loss of that company's legal personality or, therefore, any bearing on its capacity to act in judicial proceedings. The dissolution of a company was only the first step towards its loss of legal personality. See also the summary of further aspects of this decision in chapter IV.C.2.1.3 "Examination at any stage in the proceedings of entitlement to oppose".

In **T 846/22** the respondent had submitted that as a "dormant company" under UK law at the time of filing the opposition, the appellant was not entitled to conduct any business and could not be equated to a legal person. The board referred to Section 1169 of the (UK) Companies Act 2006, according to which a company is dormant during any period in which it has no significant accounting transactions. Although inactive, a dormant company was not struck off, but remained on the Companies House register and thus maintained the status of a legal person. The board thus agreed with the conclusion drawn to this effect in **T 184/11**. Whether the appellant had engaged in transactions which could have led to the loss of its dormant status went beyond the assessment of its status as a legal person.

In **T 1893/22** the admissibility of the opposition was contested on the basis that the opponent's professional representative could not represent the company since he was simultaneously managing the legal entity he represented, and also because the entity had changed legal form. On the former aspect see chapter III.V. "Representation". On the latter

aspect the board agreed with the reasoning of the opposition division that the change of legal form from SASU to SARL under French law seemed to indicate a change of name, but not a transfer of assets to a different company, as supported by D12 stating that no new legal entity had been created. The board thus agreed with the decision under appeal that the opposition was admissible (R. 76(2)(a) and (d) EPC).

2.1.3 Examination at any stage in the proceedings of entitlement to oppose

An objection that an opposition is inadmissible because the opponent was not entitled to file it may be raised at any stage of the proceedings, i.e. even at a late stage before the board of appeal.The admissibility of the opposition is an indispensable procedural requirement for any substantive examination of the opposition submissions and is therefore to be examined ex officio (see **T 289/91**, OJ 1994, 649; **T 590/94**, **T 522/94**, OJ 1998, 421; **T 1178/04**, **T 384/08**, **T 2596/19**). If the board has good reasons for examining the admissibility of an opposition (**T 199/92**), it may and is obliged to do so, even if the patent proprietor has not challenged admissibility during either opposition or appeal proceedings (**T 541/92**). In **G 3/97** and **G 4/97** (OJ 1999, 245 and 270), the Enlarged Board reaffirmed that the admissibility of an opposition could be challenged during the appeal proceedings on grounds relating to the identity of an opponent, even if no such objection had been raised before the opposition division.

During the appeal underlying **G 1/13** (OJ 2015, A42), the proprietor had challenged the admissibility of the opposition because the opponent company had ceased to exist during the opposition proceedings. By court order, the company was then restored with retrospective effect. The Enlarged Board held that where an opposition is filed by a company which subsequently, under the relevant national law, ceases to exist, but is subsequently restored to existence under a provision of that national law, by virtue of which the company is deemed to have continued in existence as if it had not ceased to exist, all these events taking place before a decision of the opposition division maintaining the opposed patent in amended form becomes final, the EPO must recognise the retroactive effect of that provision of national law and allow the opposition proceedings to be continued by the restored company (see also chapter V.A.2.4.3d) "Existence of a company").

In **T 1121/21** the board considered that the question of admissibility could be assessed at any stage of the proceedings. Thus it found in the case in hand that the appellant's argument that, in application of the principle of protection of good faith, admissibility of an opposition cannot be questioned at a late stage in the proceedings, did not stand.

For decisions concerning **transfer of opponent status**, see chapter III.O.2.

The status of opponent can also be acquired by an **assumed infringer** who has **intervened** in pending opposition proceedings (see chapter III.P. "Intervention").

2.1.4 Filing of opposition by patent proprietor or inventor

Patent proprietors may not oppose their own patents. In **G 9/93** (OJ 1994, 891), the Enlarged Board departed from the view taken in **G 1/84** (OJ 1985, 299) and held that

patent proprietors were not covered by the expression "any person" used in Art. 99(1) EPC 1973, thereby endorsing the concept of opposition proceedings applied in **G 9/91** and **G 10/91** (OJ 1993, 408 and 420) as contentious proceedings between parties normally representing opposing interests. The provisions of Part V of the EPC and the corresponding Implementing Regulations were clearly based on the assumption that the opponent was a person other than the patent proprietor and that the opposition proceedings were always inter partes. The case law established in **G 1/84** on this point is thus obsolete.

In **T 3/06** the patentee argued, with reference to **G 9/93** (OJ 1994, 891), that opponent 2 as the **inventor** of the patent in suit, being a **shareholder** of the patent proprietor, could not validly file an opposition even if the plain language definition of "any person" in Art. 99(1) EPC did not prevent inventors from filing an opposition. The board held the patent proprietor and the opposing inventor to be different persons. The inventor, although a shareholder in the patent proprietor, was not an executive of the company, nor did he have any substantial influence on commercial and judicial decisions concerning the business of the patent proprietor.

A procedure for limitation or revocation of a European patent at the request of the patent proprietor is now provided for under Art. 105a to 105c EPC (see also chapter IV.D.1.).

2.1.5 Filing of opposition on behalf of a third party – straw man

With regard to the question whether an opposition is inadmissible if the opponent is a "straw man" acting for some other person, the Enlarged Board clarified in **G 3/97** and **G 4/97** (OJ 1999, 245 and 270) that the opponent is the person who fulfils the requirements of Art. 99(1) in conjunction with Art. 100 EPC, R. 55 and 56(1) EPC 1973 (R. 76 and 77(1) EPC). The EPC does not specify any further formal requirements to be met by the opponent. Filing the opposition renders this person formally the legitimate opponent. The fact that the opponent is acting on behalf of a third party does not render the opposition inadmissible. It is however inadmissible if the opponent's involvement is to be regarded as **circumventing the law by abuse of due process**. Such circumvention of the law arises, in particular, if:

- the opponent is acting on behalf of the patent proprietor. According to **G 9/93** (OJ 1994, 891), a proprietor cannot oppose their own patent; opposition is an inter partes procedure, so the patentee and opponent must be different persons.

- if the opponent is acting on behalf of a client in the context of activities which, taken as a whole, are typically associated with professional representatives, without possessing the necessary qualifications (Art. 134 EPC 1973). This would be the case if a person not entitled to act as a professional representative were acting on a client's behalf and carrying out all the activities typically carried out by professional representatives, while they themselves assumed the role of a party in order to circumvent the prohibition on their acting as a professional representative.

However, circumvention of the law by abuse of process does not arise merely because a professional representative files an opposition in their own name on behalf of a client. In any case, the principle of the free evaluation of evidence applies. The **burden of proof lies with the person alleging that the opposition is inadmissible**. The deciding body has to be satisfied, on the basis of clear and convincing evidence, that such abuse is occurring.

Previously relevant case law (see e.g. **T 10/82**, OJ 1983, 407; **T 635/88**, OJ 1993, 608; **T 25/85**, OJ 1996, 81; **T 289/91**, OJ 1994, 649; **T 590/93**, OJ 1995, 337; **T 798/93**, OJ 1997, 363) has been superseded by **G 3/97** and **G 4/97**.

The fact that the existence of a "hypothetical client" is openly confirmed in the course of opposition proceedings does not affect the opponent's identity and cannot create any confusion in this regard. The question whether the actual existence of a client is confirmed has no bearing on the admissibility of the opposition. The situation is not different from the case in which no such open confirmation is given: both when a professional representative acts as opponent and when an opposition is filed by a legal entity named "straw man", everybody is aware that the entity which has assumed the procedural status of an opponent is acting on behalf of a third party (**T 2095/21**, see also **T 2365/11**). In **T 1839/18** the board noted that labelling an opponent as a "straw man" was misguided, as no interest in raising an opposition was necessary or needed to be proven, and consequently any argument based on an opponent's alleged lack of "real interest" had to fail.

In parallel cases **T 1553/06** and **T 2/09**, involving the same parties but different patents, the board examined whether the parties and their representatives had worked together on a **test case** in order to obtain answers from the EPO to specific legal questions regarding prior art. Following the principles set out in **G 9/93** and **G 3/97**, the board emphasised the contentious nature of opposition proceedings as a necessary condition for the admissibility of the opposition and examined whether an abuse of procedure, i.e. because the opponent acted on behalf of the patent proprietor ("straw man"), rendered the opposition inadmissible. The board could not find a circumvention of the law by abuse of process as it saw no reason to doubt the parties' submissions that the opponent was not bound by any instructions from the patentee or the study committee. An opposition filed within the framework of a test case was not inadmissible for that sole reason, provided that the prosecution of the proceedings thereby instituted was contentious because the parties defended mainly opposing positions.

In **T 2365/11** the notice of opposition was filed by a natural person; however, in a submission (to indicate the language which would be used during the oral proceedings) the opponent's attorney had referred to a certain company as the opponent. The board held that the opponent was clearly identified in the notice of opposition. Whether or not the correctly identified opponent was acting on behalf of a third person did not affect the admissibility of the opposition. The situations described in **G 3/97** (Order 1(b) and (c)) as circumvention of the law by abuse of process could be excluded in the present case.

In **T 84/19** the issue at stake was whether the filing of the opposition/appeal by a straw man (the patent attorney firm) constituted a circumvention of the eligibility criteria to pay a

reduced appeal fee. The board had no doubts as to the veracity of the appellant's original SME declaration and found the filing of the opposition and the appeal by the patent attorney firm constituted no circumvention of the law regarding the entitlement to pay a reduced appeal fee. The board further disagreed that decision **T 1839/18** availed the argument that companies employing "straw men" to file their oppositions/appeals could abuse the provisions relating to entitlement to pay a reduced appeal fee. See also chapter V.A.2.5.4c) "Reduced fee for appeal filed by a natural person or a particular entity". The Rules relating to Fees are discussed further under chapter III.U.

In **T 846/22** the respondent contended the appellant had been acting on behalf of a third party with the intention of avoiding any liability for possible costs apportioned to the appellant under Art. 104 EPC. The board noted that acting on behalf of a third party could not be seen as a circumvention of the law unless further circumstances were involved (**G 3/97**) and found there was no requirement under the EPC that a party be equipped with sufficient financial means to comply with a merely hypothetical costs order. Moreover, the EPC did not offer the patent proprietor any kind of guarantee that an opponent would be able in fact to reimburse costs awarded against them (**G 3/97**, point 3.2.6 of the Reasons). On the apportionment of costs, see chapter III.R.

2.1.6 Repeated filing of opposition documents by the same person

According to **T 9/00** (OJ 2002, 275), the repeated filing of an opposition by the same person could be objected to for lack of legitimate interest. A (legal) person who filed two different notices of opposition against the same patent acquired party status as an opponent only once, even if both notices complied with the requirements of Art. 99(1) EPC and R. 55 EPC 1973 (R. 76 EPC). Both oppositions in question gave lack of novelty and lack of inventive step as grounds. Since the later opposition did not entail any change in the legal situation in the opposition proceedings compared to the earlier one, the board dismissed it as inadmissible for lack of a general legitimate interest. Nor could such an interest be inferred from the fact that the later opposition was assigned to a different part of the company and only that part of the company had been transferred to a third party. The status of opponent could pass to a third party only if both parts or the entire company were transferred to it.

In **T 774/05** a notice of opposition was filed on one day, enclosing a cheque for the opposition fee but no reasoned statement. On the following day further documents were filed which included patent documents and a reasoned statement referring to a notice of opposition. The board found the opponent had intended to maintain a single opposition, as evidenced by the statement in the faxes that the cheque for the opposition fee presented the day before should be used for the opposition. That both the document filed initially and the faxes of the following day each stated that they were an opposition was not an indication, of an intention to file two oppositions but rather an indication of their content. Taking all these documents together, the board considered that the opponent had filed only one opposition, for which the requirements for a valid filing had been completed within the opposition period. The opposition was therefore admissible.

In **T 966/02**, the same opponent had filed two oppositions, the second of which cited document D1, on which the opposition division based its decision. The main issue was whether the opposition division had been competent to use the document cited in the second opposition. The board stated that the first opposition had been filed in due form and time and was therefore admissible. Hence there was no need to decide whether the second opposition was admissible, since the department of first instance was, in any event, competent to take account of both document D1 and any other relevant material of its own motion (Art. 114 (1) EPC).

2.1.7 Filing of multiple oppositions by different persons – single opposition proceedings

According to Art. 99(3) EPC, opponents are parties to the opposition proceedings as well as the patent proprietor. It is clear from this provision that multiple admissible oppositions do not initiate a corresponding number of parallel opposition proceedings but only a single one. Each opponent can rely on an opposition ground duly submitted by other opponents and communicated to all parties in accordance with R. 79(2) EPC, both in the opposition proceedings and in any subsequent appeal proceedings (**T 270/94**, **T 620/99**, **T 774/05**, **T 1657/14**, **T 891/16**).

2.1.8 Filing a joint opposition – multiple opponents

a) Payment of a single opposition fee

In **G 3/99** (OJ 2002, 347), the Enlarged Board held that an opposition filed in common by two or more persons, which otherwise met the requirements of Art. 99 EPC 1973, R. 1 EPC 1973 (R. 3 EPC) and R. 55 EPC 1973 (R. 76 EPC), was admissible on payment of a single opposition fee. The payment of the opposition fee was linked to the filing of an opposition and not to the number of persons who filed the opposition. There was no procedural difference with respect to an opposition filed by a single natural person, by a single legal person or by a single body equivalent to a legal person by virtue of the law governing it. With respect to the wording "any person" in Art. 99(1) EPC 1973 and its interpretation in line with Art. 58 EPC 1973 see chapter IV.C.2.1. above.

b) Representation, legal status and composition of a multiple opponent

In **G 3/99** (OJ 2002, 347), the Enlarged Board also held that, in an opposition filed in common, there had to be in all cases a **common representative** (Art. 133(4) EPC 1973 and R. 100 EPC 1973). Only that common representative is entitled to act in the opposition proceedings on behalf of all the common opponents taken as a whole and to sign the filed documents. Since the EPO treats a procedural act performed by a non-entitled person in the same way as a missing signature (see **T 665/89**), each common opponent or any other person acting on their behalf could perform such an act to avoid missing a deadline, provided the deficiency is remedied within an additional period set by the board in the communication under R. 36(3) EPC 1973 (R. 50(3) EPC), notified to the common representative and sent for information to the non-entitled person who performed the act. The deficiency is remedied once the procedural act is signed by the common representative.

According to the Enlarged Board, in order to safeguard the rights of the patent proprietor and in the interests of procedural efficiency, it had to be **clear throughout the proceedings** who belonged to the group of common opponents or common appellants. If either a common opponent or appellant (including the common representative) intended to withdraw from the proceedings, the EPO had to be notified accordingly by the common representative or by a new common representative determined under R. 100(1) EPC 1973 in order for the withdrawal to take effect.

Referring to this case law in its interlocutory decision in **T 482/02** of 9 February 2005, the board stated that, where it was doubtful whether an opposition had been filed on behalf of a body which enjoyed legal personality in its own right or on behalf of several natural persons acting in common, the opponents (here a UK partnership) should be invited to establish that the body was a legal person or an equivalent thereto. If this was not established, the opposition was to be considered as having been filed on behalf of the several natural persons as common opponents (see also **T 866/01**). In that case the opponents still had to furnish the names and addresses of the partners in order to comply with R. 55(a) EPC 1973 (R. 76(2)(a) EPC). If this information was not received within a period specified by the board, the opposition had to be rejected as inadmissible under R. 56(2) EPC 1973 (R. 77(2) EPC), irrespective of whether or not such information would have been sufficient to prevent rejection under R. 56(1) EPC 1973 (R. 77(1) EPC).

Similarly, in **T 315/03** (OJ 2005, 246), the board followed **G 3/99**, adding that, while the admissibility of an opposition by multiple opponents had to be kept under review throughout the proceedings, parties could not expect the opposition division or board to do this alone. It was clear that the board had neither the resources nor the knowledge of the relevant laws of all the contracting states necessary to police the composition of, and the legal status of all members of, multiple opponents. Once prima facie admissibility was acknowledged, it had to be up to the party or parties seeking to challenge admissibility to make a case of inadmissibility.

With regard to changes over time in the **composition** of a multiple opponent, the board agreed with the respondent that the absence over eleven and a half years of any notification concerning the 1200 members of opponent 6 ("opposition club") could in itself be considered an indication that the "clear throughout" condition established in **G 3/99** had not been complied with. On the other hand, the fact that certain opponents only came into being for the purpose of filing opposition to one patent could not in itself be an objection to admissibility; an opponent's motive or lack of motive was irrelevant (see **G 3/97**, OJ 1999, 245). Similarly, it appeared to the board to be wholly irrelevant that an opponent, whether individual or multiple, might be supported by others (e.g. employees or shareholders of a company which was a party). Such supporters clearly could not take any part in the proceedings and could not affect its outcome. Moreover, the support for a party could not per se be a reason to challenge admissibility.

2.2. Formal requirements for opposition and filing in due time

2.2.1 Introduction

According to Art. 99(1) EPC notice of opposition must be **filed within nine months** of the publication of the mention of the grant of the European patent in the European Patent Bulletin. Notice of opposition is not deemed to have been filed until the opposition fee has been paid. In the interests of legal certainty, the Convention lays down certain further requirements that must be met before the opposition period expires, in particular that the notice of opposition is filed in a written reasoned statement (R. 76(1) EPC), that it sufficiently identifies the opponent (R. 76(2)(a) EPC) and the patent opposed (R. 76(2)(b) EPC), that it states the extent to which the patent is opposed and the specific grounds, and that it indicates the facts and evidence presented in support of these grounds (R. 76(2)(c) EPC). Fulfilment of the requirements of R. 76(2)(c) EPC (R. 55(c) EPC 1973) is not only essential for the admissibility of the opposition. They also establish the legal and factual framework of the opposition (see **G 9/91** and **G 10/91**, OJ 1993, 408 and 420).

In **T 1408/19** an erroneous citation of the publication number of document E2 had been provided in the notice of opposition filed on the last day of the nine-month period according to Art. 99(1) EPC. The board rejected the respondant's interpretation of **T 344/88** that the opposition division should have been able to identify the correct publication number within the nine-month period according to Art. 99(1) EPC. It would be completely unrealistic to expect the opposition division to immediately check such errors. It followed from the normal daily operation of the EPO that the division would be assigned to the file only later, and in all likelihood would not even see the file within the opposition period. The board took the view that in the case at hand it was decisive that all material and information necessary for (possibly later on) establishing the correct publication number of E2 was submitted prior to expiry of the nine-month period according to Art. 99(1) EPC.

In **T 571/22** the board endorsed the approach according to which the end of the opposition period under Art. 99(1) EPC was a fixed point in time as of which an opposition division had discretion not to admit facts and evidence submitted by an opponent (see **T 1776/18**, summarised below in this chapter IV.C.5.1.6). Accordingly, an opposition division had discretion not to admit facts and evidence which were not filed within the nine-month opposition period.

2.2.2 Opposition period

a) Period triggered by the publication of the mention of the grant of the patent

In **T 438/87** the question addressed was whether a **delay in publication** of the European patent specification could affect the calculation of the nine-month period for filing an opposition. The board concluded that, since the mention of the grant of the patent in suit had been brought to the public's attention in the normal way, it was from this date that the opposition period had begun, irrespective of what problems may have affected publication of the patent specification and what consequences such an untoward event might have for certain third parties owing to their geographical location.

According to **T 1644/10**, the opposition period is triggered solely by the grant of a European patent and publication of the mention of its grant in the European Patent Bulletin. The mention in the European Patent Bulletin that a correction of the patent specification has been issued does not trigger either a first or any "further" opposition period, even if the corrected specification confers a broader scope of protection than that conferred by the one originally published.

In **T 956/19** the board found that the legally effective filing of oppositions by opponents 1 and 2 on the last day of the opposition period under Art. 99(1) EPC was the prerequisite for the opposition proceedings to be pending and so also for interrupting this opposition procedure. That an opposition period was running did not in itself mean proceedings were pending before the EPO, but simply imposed a time limit for initiating such proceedings. An interruption could therefore only apply from the date of the effective filing of the oppositions at the earliest; it could not preclude their filing. R 142(4) EPC was not applicable to periods such as the opposition period under Art. 99(1) EPC which the applicant or patent proprietor were not required to observe. See also chapter III.D.4.8. "Consequences of interruption of proceedings (Rule 142(4) EPC)".

b) Observance of the time limit

(i) Filing using the EPO's Online Filing software

In **T 480/21** the board stated that the EPO's Online Filing system was intended to be installed on users' electronic systems. If the software supplied by the EPO contained some bug which meant that any attempted filing would inevitably fail, that fault would be attributable to the EPO, even though the software was not running on an EPO machine or on EPO premises. In the case in hand, following a malfunction of the Online Filing system on the last day of the opposition period, the opponent successfully filed the notice of opposition by fax the same day. The request therein that the EPO debit a deposit account for the payment of the opposition fee was however not carried out. The opponent then successfully paid the opposition fee the following day using the Online Filing system, thus outside the regular opposition period. However, the payment period was extended under point 5.5 ADA to at least the next day, due to the malfunction of the Online Filing system, and as the payment was made on this day, the opposition was deemed to have been filed in time.

(ii) Filing by fax

From 1 July 2024, the EPO no longer accepts filings by fax (see decision of the President of the EPO dated 22 April 2024 concerning the abolition of facsimile (fax) as a means of filing patent applications and other documents, OJ 2024, A41). The decisions below therefore relate to filings prior to the applicability of this decision.

In **T 2061/12**, the board noted that the case law of the boards of appeal distinguished between fax parts received before and after midnight, according the different filing dates (**T 683/06**, **T 2133/10**; decision of the President of the EPO dated 12 July 2007, OJ SE 3/2007, 7, in force at the relevant time,). In this case, only the last page and possibly

part of the penultimate one had arrived after midnight, while Form 2300 signed by the representative, the payment form and at least the first two pages of the notice of opposition – which at a minimum substantiated a novelty objection – had all certainly reached the EPO before midnight. The opposition had therefore been filed in due time under Art. 99(1) EPC; it also complied with R. 76(1) and (2) EPC. It was therefore admissible (R. 77(1) and (2) EPC). See also **T 2317/13**.

However, in **T 858/18** the board held that if a facsimile transmission of a document within the meaning of R. 50(3) EPC begins on an earlier date and extends beyond midnight to a later date, the entire document is accorded the later date as the single date of receipt. The board found that the decision of the President of the EPO dated 12 July 2007 concerning the filing of patent applications and other documents by facsimile (OJ SE 3/2007, 7) provided no legal basis for according the earlier date as the date of receipt for the part of the document arriving at the EPO before midnight. The term "document" referred to the record of a complete unit of information.

The board in **T 2307/15** (regarding a statement setting out the grounds of appeal received by fax) did not follow this approach, but confirmed the approach taken in **T 2061/12** and **T 2317/13** (for a more detailed summary of **T 2307/15**, see chapter V.A.2.6.).

2.2.3 Payment of opposition fee – correction of a payment form

Article 99(1), last sentence, EPC states that a notice of opposition is not deemed to have been filed until the opposition fee has been paid. According to the board in **T 152/85** (OJ 1987, 191), payment of an opposition fee is a factual requirement, which must be fulfilled within the nine-month opposition period if an opposition is to be admitted. Failure to pay an opposition fee within the required period where the filing of an opposition is intended is a factual mistake which cannot be rectified once the time limit for filing an opposition has passed. In the board's view, it could not be corrected under R. 88 EPC 1973 (R. 139 EPC). It was apparent from the wording of that rule that the clear policy of the EPO was to distinguish between a mistake in a document and other kinds of mistakes, such as failure to pay a fee in time, and only to allow correction of mistakes in a document.

In **T 1000/19**, however, the board allowed the correction of electronic form 2300E. The opponent's representatives had mentioned in their letter accompanying the notice of opposition that they had authorised the responsible EPO department to debit the opposition fee from their deposit account, but had failed to indicate the payment method in box X of the form. The opposition division's view that R. 139 EPC was not "time-barred" and could therefore not be applied to the non-extendable time limit for filing an opposition was rejected by the board as legally incorrect. There could be no doubt that the ratio of **G 1/12** (OJ 2014, A114) also applied if the admissibility of an opposition, or the question whether an opposition was deemed to have been filed, was concerned (**T 615/14**, **T 579/16**). Furthermore, the board saw no reason why the lines of reasoning set out in **G 1/12** regarding the applicability of R. 139 EPC should not equally apply to a correction of an incorrectly filled-in payment form (see **T 317/19**). Rather, the applicability of

R. 139 EPC to debit orders had been acknowledged or at least not ruled out by the boards of appeal (**T 152/82**, OJ 1984, 301, **T 17/83**, OJ 1984, 306).

2.2.4 Identity of opponent and correction of opponent's name

a) Principles

Under R. 76(2)(a) EPC and R. 41(2)(c) EPC, the notice of opposition must contain the name, address, nationality of the opponent (nationality only for natural persons, **T 978/17**) and the state where their residence or principal place of business is located. However, a notice of opposition in which a piece of information required under R. 76(2)(a) EPC in conjunction with R. 41(2)(c) EPC is missing is inadmissible only if the opponent cannot be **clearly identified** by the end of the opposition period (see **T 25/85**, OJ 1986, 81; **T 1551/10**; **T 978/17**).

T 590/94 held that this defect cannot be remedied. With reference to the rationale of **G 1/12** (relating to correction of the appellant's name) the board in **T 615/14** concluded however that a request to correct the designation of the opponent in the notice of opposition was allowable under R. 139, first sentence, EPC provided that it complies with the principles endorsed in **G 1/12** (see also **T 1121/21**). Hence, the original intention at the time of filing the opposition could also be established on the basis of evidence submitted after expiry of the opposition period. See also the summaries of **T 615/14** and **T 579/16** in chapter IV.C.2.2.4d) below.

Deficiencies such as a wrong postal code or lack of signature may be subsumed under R. 76(2)(a) and R. 50(3) EPC, respectively, and can thus be remedied within a time limit set by the opposition division in accordance with R. 77(2) EPC. The opposition division can extend this time limit or set a new time limit if deemed appropriate (**T 1632/06**, **T 244/12**). See also the cases in this chapter IV.C.2.2.9b) "Signature" below.

b) Incorrect designations and abbreviations

In **T 870/92** of 8 August 1997 the board emphasised that, when indicating a legal entity, failure to use its exact official designation (R. 26(2)(c) EPC 1973 and R. 61a EPC 1973; R. 41(2)(c) and R. 86 EPC) did not necessarily mean that the opposition was inadmissible. An incorrect designation which nevertheless sufficed to indicate the party's identity had to be distinguished from the absence of such information. Errors in a designation could be corrected at any time (R. 88, first sentence, EPC 1973; R. 139, first sentence, EPC; see also **T 828/98** and **T 719/09**).

In principle, the use of an abbreviation instead of the full name of a legal entity does not render an opposition inadmissible as long as the party's identity can be established. In **T 1034/08**, the board had no reasonable doubt that the abbreviation GSK stood for GlaxoSmithKline with regard to the identity of the Belgium-based opponent GSK Biologicals. Given that Belgian company law allows the co-existence of more than one company name and that GlaxoSmithKline Biologicals was the company's sole primary

name, the board concluded that abbreviation GSK Biologicals did not constitute an incorrect designation of the opponent.

In **T 1893/22**, the board endorsed the analysis of the opposition division in its decision that the fact that a submission was filed on a business letter indicating the old legal form (SASU) did not undermine its opinion that the change to the legal form of the then opponent from SASU to SARL indicated a change of name only, as the letter was filed close to the date of change of the legal form and thus the company stationery might not have been updated yet or the use of the old footer might have been overlooked. A letter filed 10 days later indicated SARL in the footer.

c) Evidence of identity

In **T 1165/03** the board regarded an identity card or passport as the **best evidence of identity** but with the same proviso as applies to all evidence, i.e. that its value could be offset or even negated by other evidence. In this case, two partly illegible photocopies of different identity cards and inconsistent explanations had been filed. The board therefore held that the identity card evidence was inherently unreliable and inconclusive.

Questioning the identity of an opponent is not enough to render the opposition inadmissible; cogent evidence must be put forward. In **T 4/05** no such case was made. The appellant had not filed the extract from the commercial register which, it submitted during oral proceedings before the board, showed a different company name. This could therefore not be cited as evidence that the opponent's identity was unclear. The appellant's objection that two other companies were trading at the same address as the opponent also failed.

In **T 1426/13** the opposition had been filed on behalf of "Isarpatent GbR". The board noted that the lack of public registration of a **GbR** ("Gesellschaft bürgerlichen Rechts") could contribute to uncertainty or even confusion about the name and/or identity of a GbR at specific points in time. However, the EPO had to accept that such **unregistered legal entities may be a party in proceedings** before the EPO. Any relevant evidence had to be evaluated according to the principle of free and unfettered consideration of evidence (e.g. **T 482/89**, OJ 1992, 646). From the documents submitted the board was satisfied that a name change had occurred before the opposition was filed and that no other entity than Isarpatent GbR could have been the opponent. Nor was the admissibility of the opposition affected by any changes in the composition of the GbR after the opposition had been filed. A GbR may be held liable for its obligations, including costs which may be awarded to another party in EPO opposition proceedings. Therefore it was not necessary to determine the individual members (**T 482/02** of 9 February 2005 distinguished).

In **T 2439/17** the board considered the filed register extract to be evidence of the company's existence. The appellant had failed to cast any plausible doubt on this. The board further observed that neither being well known nor demonstrable business activity were among the EPC requirements for obtaining the status of opponent.

In **T 1121/21** the board noted that the letter of opposition clearly identified one single legal person, namely Evonik Degussa GmbH. It found no concrete indication in the opposition letter that the opposition could have been filed by Evonik Industries AG, as suggested in the appealed decision. The opposition division had found a basis for its assumption in the use of a logo mentioning "Evonik Industries" on the top of numerous pages of the letter of opposition. The board held that due to its function, its generic presence on official papers and its typical symbolic representation, **a logo alone could not be a sufficient legal identification** of a company for the purposes of R. 76(2)(a) EPC. Likewise the fact alone that Evonik Industries AG was the owner of the deposit account was completely irrelevant. The fact that fees were paid by another company within the Evonik group was not sufficient to raise reasonable doubts as to the identity of the party to the proceedings. The board distinguished the present case from **T 25/85** (OJ 1986, 81), in which at expiry of the opposition period the name of the opponent was completely missing, and from **T 579/16** in which two distinct entities were mentioned in the notice of opposition, so that there were objective doubts upon expiry of the opposition period as to the identity of the opponent.

d) Availability of Rule 139 EPC to rectify errors

According to **T 1551/10**, for an opposition to be admissible, the opponent has to be **identifiable** by expiry of the opposition period (**T 25/85**, OJ 1986, 81), and provided this is the case, wrong information can be corrected (**T 219/86**, OJ 1988, 254; **T 870/92** of 8 August 1997, **T 1121/21**). Extracts from the commercial register showed that Swisscom (Schweiz) AG was the (sole) universal successor in title to Swisscom Mobile AG, which was originally named as the opponent, although it had already been removed from the register before the opposition was filed. It was not apparent that any of Swisscom Mobile AG's business assets had been taken over by any other legal entity. Therefore, Swisscom (Schweiz) AG was clearly and unambiguously identifiable as the opponent by the time the opposition period ended. Procedural statements mistakenly made in the name of a deceased party or of a legal person that no longer existed following a merger could be regarded as having been made in the name of their universal successor in title (**T 15/01**, OJ 2006, 153; see also **T 2941/18**). The mistake in the opponent's name could therefore be corrected under R. 139 EPC. See however **T 1226/13** in which the board requested additional evidence concerning the true intention of the person on whose behalf the opposition was filed.

In **T 1269/11** the board held that both R. 77 and R. 139 EPC were available in principle to rectify errors in the name of the respondent (opponent) as given in the notice of opposition (by analogy with **G 1/12**, OJ 2014, A114, concerning correction of the wrong identification of the appellant and summarised in chapter V.A.2.5.2a)). However, there was not sufficient evidence to allow a correction in this case.

The Enlarged Board summarised in **G 1/12** (OJ 2014, A114) the principles for reliance on R. 139 EPC developed in the case law of the boards of appeal, namely: a) the correction must introduce what was originally intended; b) where the original intention is not immediately apparent, the requester bears the burden of proof, which must be a heavy one; c) the error to be remedied may be an incorrect statement or an omission; d) the request for correction must be filed without delay. Furthermore, an allowable correction

under R. 139 EPC has **retrospective effect** (confirmed in **T 2941/18**, see also **G 2/21**, OJ 2023, A85). See in particular point 37 of the Reasons.

The board in **T 615/14** confirmed the availability of R. 139 EPC to correct the name of the opponent (irrespective of the question of identifiability of the opponent, which was not discussed). It stated that a request to correct the designation of the opponent in the notice of opposition was allowable under R. 139, first sentence, EPC provided that it complied with the principles endorsed in **G 1/12** (OJ 2014, A114), in particular that the correction had to introduce what was originally intended when filing the notice of opposition, that it did not give effect to a change of mind or development of plans and that it represented the opponent's actual rather than ostensible intention. The original intention at the time of filing the opposition could also be established on the basis of evidence submitted after the expiry of the opposition period. See also **T 603/15** and **T 1226/13**, which emphasises the heavy burden of proof required (with reference to **G 1/12**, OJ 2014, A114 and **J 8/80**, OJ 1980, 293).

In **T 2254/14**, the board investigated whether the opponent had been duly identifiable on expiry of the opposition period and found that the particulars provided had indeed been inconsistent in that the trading name given in the notice of opposition (EPO Form 2300) could be associated to a different legal person from the one named in the attached statement of grounds. Citing **G 1/12** (OJ 2014, A114), however, it held that this could be corrected under R. 139 EPC. The board considered that the criteria set out in that decision, in particular in point 37 of the Reasons, were met.

In **T 579/16** too, the board, having first of all found that the opponent had not been clearly identifiable from the documents submitted prior to expiry of the opposition period, confirmed that an opponent's name could be corrected under R. 139, first sentence, EPC where the conditions set out in **G 1/12** (OJ 2014, A114) were met. Drawing on the wording of Section 121(1) of the German Civil Code, it interpreted the condition that the correction request be filed "without delay" to mean that it had to be filed "without culpable delay" ("ohne schuldhaftes Zögern"), i.e. how promptly a requester could reasonably be expected to act had to be **assessed subjectively rather than objectively**. The answer therefore depended not only on any special circumstances of the specific case having to be taken into account in line with **J 16/08** but also on the knowledge and personal perspective of the person making the request. The board held that the request at issue had been made without delay.

This line was also taken in **T 1755/14**, where the entity in the name of which the opposition was filed **ceased to exist** before this filing so that no opposition status was acquired which could be transferred as requested. However, having examined the requirements established in **G 1/12** (point 37 of the Reasons), the board considered that the request for correction of the error was allowable.

In **T 1638/14** the notice of opposition was not accompanied by form 2300 and the information regarding the opponent's identity in the header and the body text of this notice was contradictory. In the board's view, by the end of the opposition period, the opponent had not been unambiguously identified. The opponent's request for correction under

R. 139, first sentence, EPC was refused as the conditions set out in **G 1/12** (OJ 2014, A114) were not fulfilled. Likewise in **T 603/15** the request for correction was rejected for the reason that condition d) ("without delay") of point 37 of the Reasons in **G 1/12** was not considered to be fulfilled, with the board holding that taking four years to make the request was not in keeping with this condition that it be filed without delay.

2.2.5 Sufficient identification of the opposed patent

Under R. 76(2)(b) EPC, the notice of opposition must contain, inter alia, the number of the patent, the name of the proprietor and the title of the invention. If the patent is not sufficiently **identified**, the opposition must be rejected as inadmissible under R. 77(1) EPC, unless the deficiency has been remedied before expiry of the opposition period.

In **T 317/86** (OJ 1989, 378) the opponent had not indicated the title of the invention within the period specified under R. 56(2) EPC 1973 (R. 77(2) EPC) for remedying deficiencies other than those falling under R. 56(1) EPC 1973 (R. 77(1) EPC). The board decided that omission from the notice of opposition of the title of the invention – merely an item of bibliographical data identifying the contested patent – did not constitute a deficiency within the meaning of R. 56(2) EPC 1973, if the other particulars available to the EPO were together sufficient to identify easily and beyond doubt the patent being contested by means of an opposition.

In **T 335/00** and **T 336/00**, the R. 55(b) EPC 1973 (R. 76(2)(b) EPC) requirements were not strictly fulfilled. Among other things, the title of the invention was missing, and the opposition was directed to the application. The board nonetheless deemed the opposition admissible because the contested patent was identifiable uniquely and fairly easily on the basis of the specified publication number.

2.2.6 Statement of extent of opposition

The Enlarged Board remarked in **G 9/91** (OJ 1993, 408) that in practice it is rather unusual that the opposition is limited to only a certain part (subject-matter) of the patent. Normally, the whole of the patent is opposed. Addressing the situation where it was clear from the statement under R. 55(c) EPC 1973 (R. 76(2)(c) EPC) that the patent was opposed only to a certain extent, the Enlarged Board held that by limiting the extent to which the patent is opposed to only certain subject-matters, the opponent deliberately refrains from making use of their right under the EPC to oppose remaining subject-matters covered by the patent. Such subject-matters are therefore, strictly speaking, not subject to any "opposition" in the sense of Art. 101 and 102 EPC, nor are there any "proceedings" in the sense of Art. 114 and 115 EPC concerning such non-opposed subject-matters. The statements in the notice of opposition relevant to the extent to which the European patent is opposed should be interpreted in such a way that an addressee would understand them, taking into account the surrounding circumstances (**T 376/90**, OJ 1994, 906; see also **T 1/88**, in which the board based its interpretation of equivocal procedural acts on the "objective value of the declaration", German: "objektiver Erklärungswert"). However, the general practice of interpreting the **absence of such statements** as an indication of the

opponent's intention to oppose the patent concerned in its entirety has been subject to scrutiny in the light of **G 9/91**. In **T 376/90** the board doubted that this "liberal" practice could be continued. In the extreme, where the extent to which a patent is opposed is in serious doubt, this reviewed approach may lead to a rejection of the opposition as inadmissible (**T 376/90**). However, in **T 764/06** the board concluded from the absence of a statement under R. 55(c) EPC 1973 (that the patent was opposed only to a certain extent) that the patent in suit was opposed in its entirety. In **T 570/14** the board considered that the question whether claims 5 to 7 were covered by the extent of the opposition was not a question of admissibility.

2.2.7 Statement of grounds for opposition

The notice of opposition must also state the grounds on which the opposition is based (R. 76(2)(c) EPC; R. 55(c) EPC 1973). The grounds for opposition which can form the legal basis of an opposition are contained in an exhaustive list in Art. 100 EPC. Accordingly, an opposition may only be filed on the grounds that (a) the subject-matter of the European patent is not patentable under Art. 52 to 57 EPC, (b) the European patent does not sufficiently disclose the invention or (c) the subject-matter of the European patent goes beyond what was originally disclosed.

The Enlarged Board set out a number of fundamental principles in **G 1/95** (OJ 1996, 615):

Whereas the grounds for opposition in Art. 100(b) and (c) EPC 1973 each relate to a single, separate and clearly delimited legal basis on which an opposition can be based, i.e. insufficient disclosure or unallowable amendment before grant, the same does not apply to Art. 100(a) EPC 1973. Art. 100(a) EPC 1973 not only refers to the general definition of patentable inventions under Art. 52(1) EPC 1973 and the exceptions to patentability under Art. 53 EPC 1973; it also refers to a number of definitions given in Art. 52(2) to (4) and 54 to 57 EPC 1973 for the terms "invention", "novelty", "inventive step" and "industrial application", which, when used in conjunction with Art. 52(1) EPC 1973, set specific requirements and therefore constitute separate grounds for opposition. Taken together, Art. 52 to 57 EPC 1973 therefore do not, for the purposes of Art. 100(a) EPC 1973, constitute a single objection to the maintenance of the patent, but a collection of different objections. Some of these are completely independent of each other (e.g. Art. 53 and 52(1) EPC 1973, Art. 54 EPC 1973) whereas others might be more closely related (e.g. Art. 52(1) and 54 EPC 1973; Art. 52(1) and 56 EPC 1973). For an opposition to be admissible under Art. 100(a) EPC 1973, it has to be based on **at least one of the grounds for opposition** set out in Art. 52 to 57 EPC 1973.

According to the reasoning of **G 1/95**, one function of R. 55 and 56 EPC 1973 (R. 76 and 77 EPC) is to establish what the notice of opposition has to contain in order to be admissible. R. 76(2)(c) EPC specifies that the notice of opposition has to contain a statement of the extent to which the European patent was opposed and of the grounds (i.e. the legal reasons mentioned above) on which the opposition is based and an indication of the facts, evidence and arguments presented in support of these grounds, i.e. the substantiation. The wording of (c) shows clearly the distinction made between the grounds, meaning the legal reasons or legal bases, such as those under Art. 100(a) EPC,

and the substantiation. Accordingly, in the context of Art. 99 and 100 EPC and of R. 76(2)(c) EPC, a "ground for opposition" has to be interpreted as meaning an individual legal basis for an objection to the maintenance of a patent. It follows in particular that Art. 100(a) EPC contained a collection of different legal objections (i.e. legal bases), or different grounds for opposition, and is not directed to a single ground for opposition.

Non-compliance with Art. 84 EPC is not a ground for opposition, but is a matter to be considered in the context of Art. 101(3) EPC (see also **G 3/14**, OJ 2015, A102 and in this chapter IV.C.5.2.2).

In **T 600/08** the board observed that the EPC did not provide for reviewing, as part of opposition proceedings, the legality of a decision by the Receiving Section to correct an applicant's name in a divisional application. The grounds for opposition were set out exhaustively in Art. 100 EPC. Objections to the text of a patent as granted could not be raised on other grounds. It made no difference that the text of the patent in suit had been amended.

2.2.8 Substantiation of grounds for opposition: indication of facts, evidence and arguments

Rule 76(2)(c) EPC requires that the notice of opposition contain a statement of the extent to which the European patent is opposed and of the grounds on which the opposition is based, as well as an indication of the facts and evidence presented in support of these grounds.

a) No "partial inadmissibility"

The third requirement of R. 76(2)(c) EPC for the admissibility of the opposition is the substantiation of the specified ground, i.e. an indication of the facts, evidence and arguments presented in support of it. The fulfilment of this latter requirement in respect of **one of the grounds for opposition** is enough to render admissible the opposition **as a whole**. Nowhere in the EPC is there any basis for the concept of partial admissibility of oppositions. The concept of "inadmissibility" is only applicable to the notice of opposition as a whole (**T 653/99**; see also **T 212/97**, **T 65/00**, **T 414/17** and **T 2659/17**).

According to **T 114/95**, if an opponent requests revocation of the patent in its entirety, it is sufficient to substantiate the ground(s) of opposition in respect of **at least one claim** of the patent for the requirements of R. 76(2)(c) EPC (R. 55(c) EPC 1973) to be met (**T 926/93**, OJ 1997, 447; **T 1180/97**, **T 1900/07**; see also in this chapter IV.C.3.3.).

b) Relevant date for compliance

The question whether the requirements in R. 76(2)(c) EPC are met must be determined on expiry of the nine-month opposition period (R. 77(1) EPC). A notice objectively complying with the requirements **on the relevant date** is not rendered inadmissible where the opponent later cites prior art not mentioned in it to support their line of argument (**T 1019/92**; see also **T 104/06**).

c) Full and concise reasoning

In accordance with R. 76(1) EPC, a notice of opposition shall be filed in a written reasoned statement. It should contain reasoning that is full but concise (**T 222/85** (OJ 1988, 128).

In **T 222/85** (OJ 1988, 128) the board held that the third requirement of R. 55(c) EPC 1973 (R. 76(2)(c) EPC) was only satisfied if the contents of the notice of opposition were sufficient for the opponent's case to be **properly understood on an objective basis**, from the point of view of a reasonably skilled person in the art to which the opposed patent relates. The board reasoned that the purpose of this third requirement, in combination with the first two requirements, was to ensure that the notice of opposition set out the opponent's case sufficiently so that both the patentee and the opposition division knew what that case was. Whereas the requirements of R. 55(a) and (b) EPC 1973 (R. 76(2)(a) and (b) EPC) and the requirements (1) and (2) of R. 55(c) EPC 1973 could be considered as **formal** in nature, requirement (3) of R. 55(c) EPC 1973, in combination with Art. 99(1) EPC, was **substantive** in nature, and called for reasoning which went to the merits of the opponent's case. A well-drafted opposition ought to contain reasoning that was full but concise. And in general, the less reasoning that a notice of opposition contained, the greater the risk that it would be rejected as inadmissible (similarly **T 925/91**, OJ 1995, 469; see also **T 2/89**, OJ 1991, 51; **T 448/89**, OJ 1992, 361; **T 545/91**, **T 204/91**). Thus, the sufficiency of the notice of opposition in this respect had to be distinguished from the strength of the opponent's case. On the one hand, an unconvincing ground of opposition might have been clearly presented and argumented. Conversely, a deficient submission may be rejected as inadmissible even though if properly drafted it would have succeeded. According to the board, the question whether a particular notice of opposition had met the minimum substantive requirements of Art. 99(1) EPC 1973 and R. 55(c) EPC 1973 could only be decided in the context of the particular case (since various relevant factors, such as the complexity of the issues raised, vary from case to case) – see also e.g. **T 534/98**, **T 1097/98**, **T 934/99**, **T 426/08**.

In **T 134/88** the board found that allegations which could not be subsumed under one of the opposition grounds had to be left out of consideration (see also e.g. **T 521/00**).

In **T 623/18** the board qualified these principles established in **T 222/85** and **T 134/88** by emphasising inter alia that there was no basis for making the admissibility of the opposition dependent on substantive questions, such as whether an objection relates merely to a lack of clarity (see the abstract in this chapter IV.C.2.2.8g).

In **T 204/91** the board stated in particular that the term "indication" in R. 55(c) EPC 1973 (R. 76(2)(c) EPC) had to be construed as requiring **more than a mere hint** at a number of possible attacks upon the patent and at the likely support for each such possible attack, which indication or hint might then be augmented by the subsequent late filing, possibly even at the appeal stage, of further evidence, arguments or other matter – even of fresh grounds of objection. Rather, the scope and depth of "indication" needed to be such as to enable the patentee and the opposition division to see clearly just what attack was being mounted against the patent, and what evidential support was being adduced for that attack. In other words, the patentee and the opposition division had to be put in a position

of understanding clearly the nature of the objection submitted as well as the evidence and arguments in its support. This required the elaboration of the relevant circumstances of the case to such an extent that the patentee and the opposition division were able to form a definitive opinion on at least one ground for opposition raised, without the need to make further investigations (see **T 453/87** and **T 279/88**; see further e.g. **T 1069/96** and **T 426/08**). But see **T 1408/19** summarised in chapter IV.C.2.2.8e) below (merely an indication of the facts and evidence required).

The fact that a patentee must be able to understand, without undue burden, the case made against their patent in the notice of opposition does not, however, exclude the possibility that they may have to undertake a **certain amount of interpretation** (**T 199/92**; see also **T 934/99**, **T 1553/07**, **T 265/16**, **T 2596/19**; see however **T 1082/00**, which highlights the limits of this principle and refers to **T 204/91**).

From decisions **T 222/85** (OJ 1988, 128), **T 2/89** (OJ 1991, 51), **T 199/92**, **T 934/99**, **T 204/91** and **T 1069/96**, the board in **T 1332/18** summarised the established requirements for an admissible opposition as follows: the reasons for the objections to the patent had to be objectively apparent without any need for investigation and they had to put the patent proprietor in a position to respond to them with arguments and amendments to the claims. An opposition could only be deemed admissible if both of these criteria were satisfied for at least one of the grounds for opposition.

d) Substantiation to be distinguished from strength of the opponent's case

In **T 934/99** the board stated that R. 55(c) EPC 1973 (R. 76(2)(c) EPC) did not imply the requirement of a logical line of reasoning in the sense that the arguments brought forward in the notice of opposition had to be cogent or convincing. Rather, the criterion was whether the arguments presented were relevant and, where necessary as the result of a reasonable interpretative effort, specific enough to allow a person skilled in the art to form a reasoned opinion of whether the line of reasoning on which the opponent apparently relies was (logically) correct ("convincing") or not (i.e. wrong).

The sufficiency of the notice of opposition has **to be distinguished** from the **strength** of the opponent's case. On the one hand, an unconvincing ground for opposition might have been clearly presented and argued. Conversely, a deficient submission may be rejected as inadmissible even though, if properly drafted, it would have succeeded (**T 222/85**, OJ 1988, 128; **T 621/91**, **T 3/95**, **T 1069/96**, **T 1856/11**).

In the same vein, in **T 65/00** the board held that it was of no importance for admissibility whether the relevance of the arguments brought forward, or their correctness, was sufficient to revoke the patent. In the case at issue it was therefore irrelevant whether the arguments brought forward by the opponent referred to Art. 84 or Art. 83 EPC 1973. For admissibility it was sufficient that the arguments were such that an **arguable case** was **established**. See also **T 623/18**.

Similarly, the board in **T 1194/07** referred to the established case law, according to which the indication of facts, evidence and arguments need not be conclusive or correct. That is

an issue of merit. However, the board also emphasised that the merits of a case can only be assessed in a meaningful manner if the case has been stated fully, by an adequate indication of the relevant facts, evidence and arguments. Key elements linking the cited prior art to the claim or relating to their validity as evidence, as well as crucial arguments informing the reader why the skilled person might have considered combining the features of such prior art with those of the accompanying evidence, should not be missing in the notice's chain of logic leading from the prior art to the invention.

e) Indication of evidence

Assessing the evidence is part of the process of ascertaining whether the opposition is well founded in substance (**T 234/86**, OJ 1989, 79). Thus, in **T 353/06** the board identified the appellants' arguments for the inadmissibility of the opposition as concerning the corroborative value of the facts and evidence, rather than a failure to indicate such facts and evidence in support of the grounds of opposition.

In **T 426/08** too, the board, citing **T 234/86** and **T 538/89**, stressed that R. 55(c) EPC 1973 did not require that the indicated evidence be put on file within the period for opposition. However, the board considered that the **content of evidence** merely referred to within the opposition period but not produced until after it could not, for the purpose of examining admissibility, be taken into account either as an indication of facts or evidence or as proof of facts. On the indication of evidence in the context of public prior use, see in this chapter IV.C.2.2.8i) below.

In **T 1408/19** the board observed that R. 76(2)(c) EPC **merely required an indication** of the facts and evidence presented in support of the argued grounds for opposition, but that not necessarily every piece of evidence need already be presented along with the notice of opposition. It should also be sufficient if the indications given in the notice of opposition permitted the substantive content of the evidence offered to be established only at a later stage, provided that this substantive content could be established without undue effort and still within a reasonable time. In the case in hand the patent proprietor argued that the opposition was insufficiently substantiated and therefore was not admissible due to the erroneous citation of the publication number of document E2 which meant it was not possible to identify it; unacceptable independent enquiries and further investigations would therefore have been necessary to enable the proprietor to understand the objections raised. According to the board, the facts and evidence submitted in accordance with R. 76(2)(c) EPC were sufficient for the ground of opposition to be correctly understood by the opposition division and the proprietor.

f) No burden of proof with regard to negative facts

In **T 2037/18**, the board observed that there was **no burden of proof** ("Darlegungs- und Beweislast") **with regard to negative facts** to be discharged in substantiating the notice of opposition. Under the rules on the burden of proof applicable in EPC proceedings, each of the parties had to present and prove only the facts in their favour – in line with the principle of "negativa non sunt probanda" (see the summary of this decision in this chapter IV.C.2.2.8j)).

g) Examples – sufficient substantiation acknowledged

In **T 1279/05**, the board held that it was not absolutely necessary to cover every single feature of the opposed patent claim so long as the notice of opposition dealt with the **essence** of the invention defined in that claim (see **T 134/88** and **T 1097/98**). See also **T 114/07**.

In **T 534/98** the board held that evidence of the **common general knowledge** was not required to substantiate an opposition. In accordance with the prevailing view in the case law, proof that something belonged to the common general knowledge was only necessary if this was called into question by another party or by the EPO.

In **T 1074/05**, the arguments in the notice of opposition were concise and made no reference to relevant sources in citation D5. The board, however, considered that such references were unnecessary in the case in hand because D5 was a short document disclosing a technically straightforward communication system in a similarly abstract fashion to the contested patent.

Similarly, in **T 1014/09** the board, considering the facts of the case in issue and the accompanying legal analysis set out in the notice of opposition, held that the **general reference** to the original disclosure in the notice of opposition could be regarded as a due indication within the meaning of R. 55(c) EPC 1973 (R. 76(2)(c) EPC).

In **T 185/88** (OJ 1990, 451) the board ruled that a formally correct statement of grounds for opposition existed if the only document cited in support of the sole assertion of lack of inventive step (here: German patent specification), while itself published **after** the date of filing or priority, nevertheless contained a reference to a document published **before** the date of filing or priority (here: German unexamined application or "Offenlegungsschrift"). See also **T 205/08**.

In **T 864/04** the board had to examine whether the express mention of document D1a in the notice of opposition in relation to D1 by the statement: "(divided out inter alia of US-PS No. 5,290,583)" was sufficiently precise to enable the patentee to find out the date of the publication of this document. In the board's view, this was indeed the case because no undue burden was involved to discover D1a's publication date.

In **T 623/18** the board guarded against a too strict approach. The board emphasised the purpose of the statement under R. 76(1) and (2)(c) EPC, as explained in **G 9/91** and **G 10/91** (OJ 1993, 408 and 420), namely to define the extent and scope of the opposition and the legal and factual framework, within which the substantive examination of the opposition is in principle conducted, as well as to give the patentee a fair chance to consider their position at an early stage of proceedings. The board saw no basis for making admissibility of the opposition dependent on the assessment of substantive questions, in particular on whether an objection merely related to a lack of clarity or could support the ground for opposition under Art. 100(b) EPC. It was also a matter of substantive examination to characterise the person skilled in the art, for whom, according to Art. 100(b) EPC, the description should be sufficiently clear and complete, and for whom

obviousness over the prior art was to be assessed according to Art. 100(a) EPC in combination with Art. 56 EPC.

In **T 470/19** the board held that whether or not the invention as defined in the patent claims could be carried out within the meaning of Art. 100(b) EPC did not depend on whether or not the claimed subject-matter solved the problem cited but not claimed by the opponent. See also chapter II.C.3.3 "Alleged effect not a feature of the claims".

h) Examples – sufficient substantiation denied

In **T 182/89** (OJ 1991, 391) the board took the view that, if a notice of opposition alleging insufficiency under Art. 100(b) EPC 1973 as the sole ground for opposition contained a mere statement that one example in the patent had been repeated once "exactly as described" without obtaining exactly the described results as claimed in the patent, the notice of opposition should be regarded as inadmissible even if the alleged facts were subsequently proved.

In **T 550/88** (OJ 1992, 117) the board of appeal considered whether **national prior rights** could as a matter of law constitute "facts or evidence" relevant to the ground of lack of novelty under Art. 54(1) and (3) EPC 1973. In the board's judgment, on the proper interpretation of Art. 54(3) EPC 1973, national prior rights were not comprised in the relevant state of the art. The board decided that the opposition was inadmissible because the only facts and evidence indicated in the notice of opposition were references to national prior rights.

According to **T 613/10**, the admissibility of the opposition has to be decided in the light of the circumstances of the case, especially if the requirements of R. 76(2)(c) EPC are not clearly and unambiguously met. Those circumstances included not just the technical complexity of the subject-matter in the opposed patent and the citations but also the number of claims and the number of citations – even if in principle an opposition could contain any number of attacks or citations. The patent proprietor should not have to try and work out the opponent's case themselves, from inadequate information given in the notice of opposition. In the case before the board, notice of opposition had been filed within the opposition period on the official form and two additional sheets. These listed 26 items of evidence, which however were filed, together with a detailed statement, only after the period expired. The notice had indicated the grounds of lack of novelty and lack of inventive step but did not say which citations related to which. None of the cited passages or drawings had been compared with the features of any of the 26 claims; nor had any technical connection been established between the citations and the claims. The board concluded that the requirements of R. 76(2)(c) EPC were not fulfilled.

In the similar case **T 296/17**, where the opponent filed nineteen pieces of evidence and a notice of opposition of one page which neither substantiated any of the grounds for opposition nor referred to any relevant paragraph of the evidence filed, the board likewise considered the opposition inadmissible. The board rejected the appellant's argument that the opposition division should have examined the opposition of its own motion.

i) Alleged public prior use

In accordance with **G 1/95** (OJ 1996, 615), alleged public prior use does not constitute a ground for opposition under Art. 100(a) EPC but is a fact cited to substantiate such a ground (**T 190/05**).

An allegation of public prior use will only meet the third requirement of R. 76(2)(c) EPC if it is sufficiently substantiated. It is established case law (e.g. **T 328/87**, OJ 1992, 701; **T 538/89**; **T 988/91**; **T 541/92**; **T 28/93**; **T 927/98**; **T 900/99**; **T 1022/99**; **T 190/05**; **T 25/08**; **T 1856/11**; **T 2037/18**, **T 105/18**) that, when an opposition ground is based on an allegation of public prior use, the requirements of R. 76(2)c) EPC are fulfilled if the notice of opposition indicates, within the opposition period, the facts which make it possible to determine

– the date of prior use ("when"), in order to ascertain its "prior" character;

– the object of the use ("what"), in order to examine its relevance, and

– the circumstances relating to the alleged use ("how") in order to confirm its availability to the public.

The notice of opposition must also indicate the arguments and evidence in support of the alleged prior use.

An **abstract indication** of the subject-matter of the prior use is generally insufficient. Instead, the opponent must compare its features with those of the contested claim and demonstrate the technical parallels between them (see e.g. **T 28/93**, **T 25/08**, **T 426/08**). This can, however, be dispensed with in straightforward cases in which the facts are immediately self-evident to the average skilled person (**T 1069/96**, **T 25/08**, **T 426/08**). In **T 1856/11** the board took the information contained in the supporting documents filed during the opposition period into account for establishing the required details.

In **T 538/89** the board stressed that the evidence offered in support of public prior use could be submitted after expiry of the period for opposition since R. 55(c) EPC 1973 (R. 76(2)(c) EPC) only required that it be indicated (see also e.g. **T 234/86**, OJ 1989, 79; **T 752/95**; **T 249/98**; **T 1022/99** and **T 25/08**). According to the board, **nomination of a witness** for subsequent examination is deemed to constitute indication of evidence (see also **T 28/93**, **T 988/93** and **T 241/99**). In **T 1553/07** the board held that the naming of a witness to be heard later was to be regarded as a sufficient indication of evidence as long as it was clear for what assertions of facts the witness was being named. There was no need also to indicate what the witness would be able to say about the alleged facts.

A distinction must be made between examining the admissibility of the opposition and its substantive merit. The information relating to the "when", the "what" and the "how" of the circumstances surrounding prior use is all that the patent proprietor and the opposition division need in order to understand the case of the opponent and for the opposition to be admissible. The rest, i.e. whether the alleged facts were or would be sufficiently proven

through additional filings in the course of the opposition proceedings, was a question of allowability in terms of substantive law. Thus, establishing that the alleged prior use was indeed public had little bearing on the **admissibility** of the opposition, but could be significant for assessing its **allowability** in terms of substantive law (see **T 786/95**, **T 1022/99**, **T 1553/07**, **T 25/08**, **T 1856/11**, **T 2037/18**, **T 105/18**).

Case law on the issue of whether sufficient details of the "when, what and how" of the prior use have been submitted can also be found in other contexts, namely when a board needs to establish whether (and, if so, at what point) a late-filed prior use had been sufficiently substantiated to be considered in the proceedings (see e.g. **T 441/91**, **T 97/92**, **T 611/97**, **T 460/13**, **T 1955/13**; on the admission of late-filed submissions, see in this chapter IV.C.4.) or whether facts had been sufficiently substantiated for evidence offered to be taken (see e.g. **T 1271/06**, citing **T 297/00**).

Addressing the substantiation requirement under R. 76(2)(c) EPC, the board in **T 2037/18** reiterated that, under the rules on the burden of proof ("Darlegungs- und Beweislast") applicable in EPC proceedings, each of the parties had to present and prove the facts in their favour (**T 219/83**, **T 270/90**). It then explained that the sale of a ready-to-use object to a third party was the typical case of something being made publicly available (**T 482/89**), since the third party usually had an interest in using the object as they saw fit. Thus, when an object was sold to a customer, it and its identifiable technical features became publicly available on its handover to that buyer (positive fact) unless the buyer was bound by a confidentiality obligation (negative fact). Accordingly, it was for the opponent to assert and prove such a handover to a buyer (**T 326/93**), whereas it was for the patent proprietor to assert and prove that this buyer had been bound by any confidentiality obligation (**T 221/91**, **T 969/90**), as was reflected in the principle "negativa non sunt probanda", i.e. a negative need not be proved, recognised in the boards' case law (**R 15/11**, **R 4/17**). The board went on to observe that the burden of proof could shift but not until the party initially bearing it had produced prima facie evidence or argued a typical course of events supporting a presumption as to the facts (**T 570/08**). A patent proprietor's submissions could therefore place a secondary burden of proof on the opponent, but only from that point on ("ex nunc") and so without any bearing on what it was required to substantiate in its notice of opposition under the third point of R. 76(2)(c) EPC.

Several decisions note that specification of the circumstances of the act of use also requires that the opponent indicates "**to whom**" the subject-matter was made available (see e.g. **T 522/94**, OJ 1998, 421; **T 339/01**; **T 1553/07**; **T 2010/08**; **T 1927/08**). In **T 241/99**, for instance, the board considered it insufficient for the purposes of R. 55(c) EPC 1973 (R. 76(2)(c) EPC) that, in the event of a purported **sale to a small**, **closed group of customers**, these were identified only by a coded indication (list of numbers). This was different from the **sale of mass-produced goods to anonymous buyers** and resembled rather the case of a single sale, for which the requirements of R. 76(2)(c) EPC were met only if the name and address of the sole buyer were indicated within the opposition period.

Citing **T 472/92** (OJ 1998, 161), the board in **T 55/01** noted that, in cases where only one party had access to information about an alleged public prior use, the case law had tended

towards expecting that the public prior use be proved beyond any reasonable doubt ("up to the hilt"), answering the typical questions "What?", "When?", "Where?", "How?" and "To whom?", since the other party was reduced to merely pointing out inconsistencies or gaps in the chain of evidence. However, the board noted with reference to **T 241/99** that case law had taken into account that cases of **mass-produced consumer goods**, which were widely advertised and offered for sale to customers who often remained anonymous, may require a different treatment. In the case at issue no allegations concerning the identity of the purchasers had been made and no proof concerning this matter produced. The sale of the mass-produced product on the market and the distribution of the corresponding service manual was nevertheless considered as proven on the balance of probabilities. See also **T 414/17**, where the board considered the indication that a product (intended for the mass market) was made available by advertisement and offer for sale to be sufficient to substantiate the circumstances.

In **T 574/17** all the available evidence stemmed from the sphere of the appellant-opponent. Hence, it was decisive whether or not the board – after having assessed all the evidence – was convinced beyond reasonable doubt that the alleged public prior use had taken place. The board was satisfied that the "Tonga" elements at issue had to be considered a mass-produced product, as evident from witness testimonies. It was also convinced that they had been sold in large numbers, evidenced by available invoices; it was further persuaded that these sales took place prior to the priority date. Under these circumstances, the board held it was not necessary to prove that a particular sale of a particular Tonga panel occurred to prove beyond reasonable doubt that 25 mm and 40 mm Tonga panels were sold before the priority date. It considered, however – contrary to the board in **T 55/01**, which relied on the balance of probabilities for its conclusion – that the aforementioned sales had been proven beyond reasonable doubt in the case in hand.

The evaluation of evidence and standard of proof in cases of alleged public prior use is dealt with in detail in chapter III.G.4.3.2.

j) Non-patent literature and oral disclosures

In **T 511/02**, concerning the opponent's duty of substantiation, it had not been indicated when and how **fitting and installation instructions** cited against the patent had been made available to the public. Since this factor was crucial to the establishment of whether they formed part of the prior art and thus whether they could actually be cited against the patent, no adequate indication had been given of the relevant facts and evidence (see also **T 1271/06** and **T 109/11** for cases where the requirements of R. 55(c) EPC 1973 (R. 76(2)(c) EPC) were found not to be met; see **T 1688/12** for a case where these requirements were considered to be fulfilled).

In **T 782/04** the board noted however that the respondent had to apply a reasonable amount of understanding by reading the notice of opposition as required by the jurisprudence. In the case in hand the **brochure** produced by a company to illustrate a product to potential customers bore the notice "printed in Japan 73", whereas the priority date of the patent in suit was ca. 18 years later. The board considered that the allegations were sufficiently substantiated. See also **T 1236/13** (concerning documentation available

on the internet) where the allegations as to which information carrier was used, the publication date and who was the public could be derived from document D6.

In **T 16/14**, the board considered an **author's copy** to be sufficient evidence of what was in the article actually published, since the publisher had at any rate been specified in such a way that a check could have been performed without undue burden. Besides, the appellant had not only already offered in its notice of opposition to produce the actually published article but also gone on to do so.

Where an **oral disclosure** is cited as prior art, the opposition division and the patent proprietor must be provided with sufficient details of the facts asserted and the supporting evidence to determine the date and content of the disclosure and the circumstances in which it was made public (**T 406/92**).

2.2.9 Other requirements for notice of opposition

a) Translation

In **T 193/87** (OJ 1993, 207) the board found that if a notice of opposition was filed in a language of a contracting state other than an official language of the EPO and the prescribed **translation** was not filed in due time (Art. 14(4) and (5) EPC 1973; Art. 14(4) EPC), the notice should be deemed not to have been received, and the opposition fee was to be refunded (following **T 323/87**, OJ 1989, 343). Since the opposition had not come into effect, there was no question of examining its admissibility under R. 56(1) EPC 1973 (R. 77(1) EPC).

b) Signature

In **T 960/95** the notice of opposition was filed without having been signed. The board stated that a notice of opposition should be duly signed (R. 36(3), first sentence, EPC 1973, R. 61a EPC 1973; R. 50(3), first sentence, EPC, R. 86 EPC). The omission of the signature was remedied within the time limit set by the opposition division, and the notice of opposition therefore retained its original date of receipt (R. 36(3), third sentence, EPC 1973; R. 50(3), third sentence, EPC). See also **T 1165/03** and **T 1850/19**, which confirmed the application of R. 50(3) EPC (former R. 36(3) EPC 1973).

c) Authorisation

In **T 1700/11**, the board observed that, where a European representative filed an opposition on a party's behalf but then failed to file a signed authorisation in due time after being asked to do so by the board, the opposition had to be deemed not filed (R. 152(6) EPC). On the topic of representation, see also chapter III.V.

2.3. Procedural aspects of examination of admissibility

2.3.1 Admissibility of opposition to be checked at every stage

The admissibility of the opposition must be checked ex officio in every phase of the opposition and ensuing appeal proceedings (**T 289/91**, OJ 1994, 649 and e.g. **T 522/94**, OJ 1998, 421; **T 646/13**, stating that this is established case law, and **T 414/17**). On the other hand, as highlighted in **T 522/94**, the requirement of admissibility must not be circumvented by overemphasising the ex officio principle and shifting the burden of establishing the case from the opponent to the opposition division.

2.3.2 Formalities officers' powers in opposition proceedings

In opinion **G 1/02** (OJ 2003, 165), the Enlarged Board examined the power of formalities officers to decide on the consequences of late payment of the opposition fee. Taking the view that **T 295/01** (OJ 2002, 251) and **T 1062/99** were divergent, the President asked the Enlarged Board to consider whether points 4 and 6 of the notice of the Vice-President of Directorate-General 2 of the EPO of 28 April 1999 (OJ 1999, 506) conflicted with provisions of a higher level (Referral by the President of the EPO, OJ 2002, 466). The Enlarged Board stated that the provisions of the notice were valid on the basis of R. 9(3) EPC 1973 (R. 11(3) EPC), under which formalities officers could be entrusted with duties falling to the examining and opposition divisions and involving **no technical or legal difficulties**. It therefore concluded that points 4 and 6 of the notice of 28 April 1999 did not conflict with provisions of a higher level.

2.3.3 Preliminary opinions on admissibility

In **T 222/85** (OJ 1988, 128) the board stated that a communication under R. 57(1) EPC 1973 (R. 79(1) EPC) indicating that an "admissible notice of opposition" had been filed within the opposition period was not a decision of the opposition division, and the sending of such a communication did not prevent the subsequent rejection of the notice of opposition as inadmissible under R. 56(1) EPC 1973 (R. 77(1) EPC), for example if the admissibility was challenged by the patent proprietor. The contents of a "communication" never constitute an appealable "decision". Thus, the communication, even though it had been sent after the notice of opposition had presumably been examined for admissibility, only represented a preliminary view, on an ex parte basis, and was not binding upon the department of the EPO which sent it (see also **T 621/91**).

2.3.4 Consequences of inadmissibility

If a notice of opposition is rejected as inadmissible, the opposition proceedings are legally terminated without a decision as to the substance of the opposition. It is inconsistent with this procedural principle for the decision rejecting the opposition as inadmissible to consider its merits (not even if the division does so ex officio under Art. 114(1) EPC, according to the board in **T 956/19**). Remarks on substantive matters in a decision rejecting the opposition as inadmissible, have no legal effect, and should in principle be avoided (**T 925/91**, OJ 1995, 469).

The inadmissibility of an opposition, when finally decided, or an appeal, has the effect of transferring the European patent to the national jurisdiction of the designated states, which then assumes sole responsibility for assessing the patent's validity with reference to their own legislation (**T 925/91**, OJ 1995, 469; see also **T 328/87**, OJ 1992, 701).

In **T 1420/21**, the board stated that, contrary to what the respondent claimed, a situation could not arise whereby the opponent would cease to be a party to the proceedings while opposition proceedings were under way. The board said that an opponent did not "lose their status as a party" because facts, evidence and arguments filed along with their notice of opposition in accordance with R. 76(2)(c) EPC failed to comply with that rule. In such a case, the opposition would be rejected as inadmissible and there were would be no further opposition proceedings to which the opponent and patent proprietor could be a party.

3. Substantive examination of opposition

3.1. Introduction

In **G 9/91** and **G 10/91** (OJ 1993, 408 and 420) the Enlarged Board held that R. 76(2)(c) EPC (R. 55(c) EPC 1973) made sense only when interpreted as having the **double function** of governing (together with other provisions) the admissibility of the opposition and of simultaneously establishing the legal and factual framework within which the substantive examination of the opposition was in principle to be conducted.

The **legal framework** of an opposition case is defined solely by (i) the extent to which the patent is actually opposed and (ii) the grounds upon which it is opposed, whilst its **factual framework** is determined by the facts, evidence and arguments adduced and set out in the notice of opposition pursuant to R. 76(2)(c) EPC (**T 737/92**; see also **T 1900/07** with regard to the legal framework). A distinction has to be made between the two main requirements of R. 76(2)(c) EPC, i.e. the indication of the **extent** to which the European patent is opposed and the **grounds** for opposition.

3.2. Extent of opposition

Rule 76(1) EPC (Art. 99(1) EPC 1973) provides, inter alia, that "notice of opposition shall be filed in a written reasoned statement". R. 76(2)(c) EPC (R. 55(c) EPC 1973) requires the notice of opposition to contain, inter alia, "a statement of the extent to which the European patent is opposed" (see also in this chapter IV.C.2.2.6).

In **G 9/91** (OJ 1993, 408) the Enlarged Board clarified that the **power** of an opposition division or a board of appeal **to examine and decide** on the maintenance of a European patent under Art. 101 and 102 EPC 1973 (now merged in Art. 101 EPC) depends on the extent to which the patent is opposed in the notice of opposition (R. 55(c) EPC 1973; R. 76(2)(c) EPC). However, this principle is subject to a restriction: even if the opposition is expressly directed only against the subject-matter of an independent claim in a European patent, claims which depend on any such independent claim can nonetheless also be examined as to their patentability if the independent claim is eliminated in

opposition or appeal proceedings, provided that the validity of these **dependent claims** is put in doubt prima facie by the information which is already available (see also **T 443/93**, **T 31/08**; the principles set out in **G 9/91** have been followed by subsequent case law, e.g. **T 1019/92**, **T 1066/92**, **T 711/04**, **T 1350/09**; see also **T 525/96** and **T 907/03** in respect of claims of an auxiliary request).

If in a request the claims against which the opposition was directed have been deleted, that request and its subject-matter are allowable, because they are not a subject of the opposition proceedings (see e.g. **T 2278/14**).

The **statements** in the notice of opposition **relevant to the extent** to which the European patent is opposed should be interpreted in such a way that an addressee would understand them, taking into account the surrounding circumstances (**T 376/90**, OJ 1994, 906; see also **T 1/88**, in which the board based its interpretation of equivocal procedural acts on the "objective value of the declaration"; for a case where the accompanying letter contradicted the indication in Form 2300, see **T 570/14**).

In the light of **G 9/91**, the board in **T 376/90** doubted that the general practice of interpreting the **absence of such statements** as an indication of the opponent's intention to oppose the patent concerned in its entirety could be continued. See however also **T 764/06**, in which the board concluded from the absence of a statement under R. 55(c) EPC 1973 that the patent was opposed only to a certain extent that the patent in suit was opposed in its entirety.

In **T 938/03** the board highlighted that the extent to which a patent was opposed did not depend on the second requirement under R. 55(c) EPC 1973 (R. 76(2)(c) EPC), namely the indication of the grounds of opposition and the facts, evidence and arguments in support of these grounds. Rather, the extent to which a European patent is opposed was exclusively determined by what has been implicitly (see **T 376/90**, OJ 1994, 906) or explicitly indicated (in the case at issue by ticking the relevant box in EPO Form 2300). See, however, the different opinion in **T 737/92**, requiring that claims are actually opposed, as distinct from being merely formally mentioned in the notice of opposition.

In **T 809/21** the board, applying the principles of **G 9/91**, noted that the opposition division's discretion to extend the opposition to unopposed claims was limited to claims which, while not explicitly opposed, were dependent upon an opposed independent claim which falls in opposition or appeal proceedings. There was no legal basis for the EPO to deprive the proprietor of a patent comprising claims 1 to 7 only, which were not opposed, nor the subject of any other ongoing proceedings before the EPO. Where the patent was not opposed in its entirety, and where the opposition division decided that all of the proprietor's requests in relation to the opposed claims must fail, only the unopposed claims, which were not part of any opposition proceedings, were left standing. Hence, provided the requirements of R. 82(1) EPC were met, the patent may be maintained on the basis of the unopposed claims, irrespective of whether the proprietor had filed an explicit request for this during the proceedings. Such a request would, in fact, be superfluous, since the unopposed claims had been granted and were not the subject of any opposition. In the case in hand the board found the decision of the opposition division to directly revoke the

only partially opposed patent in its entirety had to be considered a substantial procedural violation within the meaning of R. 103(1)(a) EPC.

3.3. Scope of examination of grounds for opposition

According to the Enlarged Board in its opinion **G 10/91** (OJ 1993, 420; see also **G 9/91**, OJ 1993, 408), an opposition division or a board of appeal is **not obliged to consider all the grounds for opposition** referred to in Art. 100 EPC, going beyond the grounds covered by the statement under R. 55(c) EPC 1973 (R. 76(2)(c) EPC), but may exceptionally do so. In opposition proceedings, the opposition division may, in application of Art. 114(1) EPC, raise a ground for opposition not covered by the opposition statement or consider such a ground raised by the opponent (or referred to by a third party under Art. 115 EPC) after the expiry of the time limit of Art. 99(1) EPC in cases where, **prima facie**, there are clear reasons to believe that it is relevant and would in whole or in part **prejudice the maintenance of the European patent**.

However, in opposition appeal proceedings a more restrictive application of Art. 114(1) EPC is generally justified. A fresh ground for opposition should only be raised by the board of appeal or admitted into the proceedings if the board considers it already prima facie highly relevant and the patentee agrees to its introduction (**G 10/91**). For details see chapter V.A.3.2.3h) "Fresh ground for opposition on appeal".

In order to avoid any misunderstanding, the Enlarged Board stated in **G 10/91** that in the case of **amendments** of the claims or other parts of the patent **in the course of opposition** or appeal proceedings, such amendments are to be fully examined as to their compatibility with the requirements of the EPC. As explained in **G 3/14** (OJ 2015, A102), the term "amendments" has to be understood in the sense that the subject-matter to be examined must have some direct nexus with the amendment. See chapter IV.C.3.5 "Grounds raised against claims amended after grant" and chapter IV.C.5.2. "Scope of examination of amendments" (which also highlights the limited extent of examination of amended claims for compliance with Art. 84 EPC).

The wording of Art. 101(1) EPC ("at least one ground for opposition", as opposed to "the grounds for opposition" in Art. 101(1) EPC 1973) now makes it clear that the opposition division is not obliged to examine all the grounds for opposition. Reference is also made to this chapter IV.C.3.4. "Fresh grounds for opposition".

Following **G 10/91**, the board in **T 274/95** (OJ 1997, 99) held that, if a ground for opposition was substantiated in the notice of opposition but was **subsequently not maintained** during the opposition proceedings (in the case in question, a statement to that effect had been made by the opponent during oral proceedings), the opposition division was under no obligation to consider this ground further or to deal with it in its decision, unless the ground was sufficiently relevant to be likely to prejudice maintenance of the patent.

In **T 223/95** the board observed that an investigative approach by which the opposition division would take steps of its own motion to establish the level of knowledge of the person skilled in the art would not be consistent with the character of the post-grant opposition

proceedings under the EPC. Opposition proceedings were in principle to be considered as **contentious proceedings** between parties normally representing opposite interests, who should be given equally fair treatment. In the board's opinion, it was unrealistic to suppose that the opposition division could seek, gather and select evidence in an entirely impartial fashion; herein lay an essential distinction between the functions of the examining divisions and the opposition divisions. It was the responsibility of the opponent itself to present to the opposition division the facts, evidence and arguments in support of the grounds on which the opposition was based. See also **T 897/19** in which the board noted that an investigative approach from the opposition division under Art. 114(1) EPC was limited in view of the character of the post-grant opposition proceedings under the EPC.

In **T 2685/19** the board held that it did not follow from the Enlarged Board's decision **G 10/91** that it was imperative to examine other criteria in addition to prima facie relevance. This meant that, in the case in hand, the fact that the opposition division had not made additional comments on whether the late filing of insufficient disclosure as a ground for opposition was excusable could not be taken as a basis for classing the admission of this ground as an error in exercising discretion.

3.4. Fresh grounds for opposition

3.4.1 Fresh grounds examined exceptionally

In **G 10/91** (OJ 1993, 420) the Enlarged Board held that in principle, the opposition division shall examine only such grounds for opposition, which have been properly submitted and substantiated in accordance with Art. 99(1) EPC 1973 in conjunction with R. 55(c) EPC 1973. Exceptionally, the opposition division may in application of Art. 114(1) EPC consider other grounds for opposition, which, prima facie, in whole or in part would seem to **prejudice the maintenance of the European patent** (see also the summary of **G 10/91** in this chapter IV.C.3.3. above).

This **exercise of discretion** by the opposition division is reviewed by the boards in accordance with the principles set out in **G 7/93**, according to which boards of appeal should only overturn discretionary decisions of first instance if it is concluded that the first instance exercised its discretion according to the wrong principles, or without taking into account the right principles or in an unreasonable way (see e.g. **T 1005/14**, **T 1965/17**, **T 3077/19**). For an example where the board found the opposition division had exercised its discretion to admit a new ground for opposition unreasonably, see **T 375/21**.

See also chapter V.A.3.4 "Review of first-instance discretionary decisions"

3.4.2 Meaning of "fresh grounds for opposition"

In **G 1/95** and **G 7/95** ("Fresh grounds for opposition", OJ 1996, 615 and 626; consolidated proceedings), the Enlarged Board first defined the meaning of "grounds for opposition" within the framework of Art. 100 EPC, and paragraph (a) in particular, as well as in the light of **G 10/91** (OJ 1993, 408 and 420, which had first used the term "a fresh ground for

opposition" in the context of considering the proper application of Art. 114(1) EPC during opposition appeal proceedings – see also summary of **G 10/91** in this chapter IV.C.3.3.).

It noted that the function of Art. 100 EPC is to provide a limited number of legal bases i.e. a limited number of objections, on which an opposition can be based, all "grounds for opposition" in Art. 100 EPC having their counterparts in other articles of the EPC which have to be met during the procedure up to grant. Whereas the grounds in Art. 100(b) EPC and 100(c) EPC each relate to a separate and clearly delimited legal basis for an opposition, the totality of the articles (Art. 52 to 57 EPC) within the meaning of Art. 100(a) EPC constitute a collection of different objections to the maintenance of the patent. The Enlarged Board further noted that the wording of R. 55(c) EPC 1973 (R. 76(2)(c) EPC) clearly showed the distinction made between the grounds, meaning as in Art. 100(a) EPC the legal reasons or legal bases, and their substantiation. Accordingly, in the context of Art. 99 and 100 EPC 1973 and R. 55(c) EPC 1973 (R. 76(2)(c) EPC), a "ground for opposition" had to be interpreted as meaning an **individual legal basis for objection to the maintenance of a patent**. It followed in particular that Art. 100(a) EPC 1973 contained a collection of different legal objections (i.e. legal bases), or different grounds for opposition, and was not directed to a single ground for opposition.

In **G 1/95** (OJ 1996, 615), the Enlarged Board went on to hold that, in a case where a patent had been opposed on the grounds set out in Art. 100(a) EPC, but the opposition had only been substantiated on the grounds of lack of novelty and lack of inventive step, the ground of unpatentable subject-matter based on Art. 52(1) and (2) EPC was a fresh ground for opposition.

In **G 7/95** (OJ 1996, 626), it was held that in a case where a patent had been opposed under Art. 100(a) EPC on the ground that the claims lacked an inventive step in view of documents cited in the notice of opposition, the ground of lack of novelty vis-à-vis the said documents based on Art. 52(1) and 54 EPC was a fresh ground for opposition. However, the allegation that the claims lacked novelty in view of the closest prior art document could be considered in the context of deciding on the ground of lack of inventive step. See also **T 2455/19**.

According to the board in **T 514/04**, the lack of novelty objection originally raised against claim 5, relating to a process for the preparation of a product, **did not extend to the products obtained from this process**, including the products of claims 1 to 4, and consequently the lack of novelty objection raised against claims 1 to 4 for the first time before the board was a fresh ground for opposition. See also **T 1244/13**.

In **T 1959/09** the patentee (respondent) had requested the board to refer to the Enlarged Board the question whether an existing ground for opposition **raised in respect of a different independent claim** amounted to a fresh ground of opposition as set out in **G 10/91**. In this respect, reference was made to **T 514/04** (see above), where the board had stated that the extent and ground for opposition mentioned in R. 55(c) EPC 1973 (R. 76(2)(c) EPC) were connected in the sense that a specific claim(s) is/are objected to under a specific ground or grounds. The board did not recognise the necessity for such a referral since the ground for opposition pursuant to Art. 100(c) EPC as well as the question

whether the requirements of Art. 123(2) EPC were met were clearly considered in the impugned decision. In addition, the board distinguished the present case, where claims 1 and 17 of the main request both belonged to the same category and virtually included the same subject-matter, from the case in **T 514/04**, where the question posed was whether a ground for opposition raised against a claim to a process applied equally to a claim to a product produced by said process. Hence, **T 514/04** had no bearing on the case at issue.

The board noted in passing that there was no basis in **G 10/91** for the general assumption that a ground for opposition raised against an independent claim may not subsequently be raised by the opponent against another independent claim, falling within the scope of the opposition. According to the board, **T 514/04** neither mentioned nor elucidated the relevant passages in **G 10/91** which supported that assumption. Actually, **G 10/91** appeared to regard a new ground for opposition as being a "ground for opposition not covered by the statement" pursuant to R. 55(c) EPC 1973, no indication being given in that decision which would justify the inference that this should be construed far more broadly as meaning any ground for opposition in respect of a specific given claim which was not covered by the statement pursuant to R. 55(c) EPC 1973 (R. 76(2)(c) EPC).

See also in this chapter IV.C.3.4.4 "Objections of lack of novelty and lack of inventive step".

For decisions dealing with the meaning of "fresh ground of opposition" in the context of appeal proceedings, see **T 520/01** and **T 620/08**. See also chapter V.A.3.2.3h) "Fresh ground for opposition on appeal".

3.4.3 Prima facie relevance

In **T 736/95** (OJ 2001, 191) the ground referred to by the appellant under Art. 100(c) EPC had not been raised in the notice of opposition. The opposition division had decided not to admit the newly submitted ground, without giving the parties any indication that it considered it to be less pertinent. Having regard to **G 10/91** (OJ 1993, 420) and **G 1/95** (OJ 1996, 615), the board held that the department of first instance at least had to examine whether a fresh ground was **relevant** and could therefore prejudice maintenance of the patent. Since it did not do so, but based its refusal to admit the ground only on the fact that it had been raised late, the opposition division deprived the appellant of the opportunity to have the relevance of this ground, and thus its admissibility, examined on appeal.

In **T 1340/15** the appellant argued that "prima facie" was to be understood as "at first glance" and that the legal question of whether or not the granted claims were covered by the original disclosure of the application (Art. 100(c) EPC) could not be solved prima facie. The board considered that following **G 10/91** the opposition division only had to determine if there were, prima facie, clear reasons for considering the issue of added matter. The "prima facie" test was not to be interpreted so narrowly as to mean that it must be possible to definitely conclude "at first glance" that Art. 123(2) EPC was actually infringed. In the case at hand, in view of the evident ambiguity of the language of the relevant passage, the opposition division had a valid reason for admitting the new ground.

In **T 1298/15**, the board observed that it was established case law that the main criterion to be considered in relation to a late-filed ground of opposition was its prima facie relevance. That the opposition division had not applied any other criteria did not amount to an improper exercise of its discretion. The board ruled out falling back on other criteria set out in Art. 13(1) and (3) RPBA 2007 – as the appellant (opponent) had argued should be done – on the basis that opposition and appeal proceedings were fundamentally and structurally different in nature. See also e.g. **T 3077/19** and **T 346/16**.

3.4.4 Objections of lack of novelty and lack of inventive step

In **T 135/01**, the board took the view that the mere observation in the course of an opposition procedure, whether by a party or the opposition division, that the subject-matter of a claim was new having regard to the prior art did not mean that **lack of novelty** was thereby introduced **as a ground for opposition**. Thus an assessment of inventive step generally began with a determination of the point of novelty, which implied a finding that the subject-matter of the claim was new. Treating such a routine affirmation of novelty as introducing the opposition ground of lack of novelty would be tantamount to including the latter ground as an invariant concomitant of the opposition ground of lack of inventive step, which would be contrary to decision **G 7/95** (OJ 1996, 626 – see in this chapter IV.C.3.4.2).

If a patent has been opposed on the grounds of lack of novelty and lack of inventive step and if only the ground of novelty has been substantiated, a specific substantiation of the ground of lack of inventive step is not necessary. Under such circumstances a specific substantiation of the ground of lack of inventive step is not even generally possible since – given that novelty, i.e. the presence of a difference between the claimed subject-matter and a prior art, is a prerequisite for determining whether an invention involves an inventive step in view of that prior art – this would contradict the reasons in support of lack of novelty. Therefore, the objection of lack of inventive step does not constitute a fresh ground for opposition and can therefore be examined in the appeal proceedings without the agreement of the patentee (**T 597/07**; see also **T 131/01**, OJ 2003, 115).

In **T 635/06** the notice of opposition specified that the patent in suit was opposed for lack of novelty and lack of inventive step as the respective boxes of the standard EPO Form had been crossed and as the notice explicitly indicated both grounds. In the circumstances of the case it was not possible for the opponent to substantiate the ground of lack of inventive step by any analysis going beyond its arguments against novelty. The opponent was thus limited to the position that a comparison of the disclosed composition and the claimed subject-matter revealed no distinguishing feature, the presence of which would, however, be necessary for a detailed objection to inventive step. Hence, the ground of lack of inventive step was considered by the board to be sufficiently addressed and, thus, properly raised in the notice of opposition.

3.4.5 Examination of fresh facts and evidence related to a fresh ground

In **T 1002/92** (OJ 1995, 605) the board stated that, when considering the admissibility of a further ground for opposition not covered by the notice of opposition after expiry of the

opposition period, both before an opposition division and before a board of appeal, the Enlarged Board (**G 10/91**, OJ 1993, 420) was necessarily implicitly considering the admissibility of such a fresh ground in combination with at least an indication of the **fresh facts and evidence** intended to support it. The mere stating of a fresh ground without any indication of the fresh facts, evidence and argument supporting it would obviously be inadmissible, either within or after expiry of the opposition period. The board then went on to conclude that it would be illogical to have one criterion for the admissibility of late-filed new facts, evidence and arguments in combination with a fresh ground, and a different criterion for judging the admissibility of late-filed new facts, evidence and arguments in support of a ground for opposition already covered by the opposition statement. Hence, in the board's view, it followed that the principles set out by the Enlarged Board in the opinion **G 10/91** as underlying the admissibility of fresh grounds for opposition, were also generally applicable to the admissibility of late-filed new facts, evidence and arguments intended to support grounds for opposition already covered by the opposition statement.

For further details on examination of fresh facts and evidence, see in this chapter IV.C.4. "Late submission of documents, lines of attack and arguments" below.

3.4.6 Opportunity to comment on new grounds for opposition

Article 113(1) EPC, in which the requirement that the parties be heard is enshrined, provides that decisions of the EPO may only be based on grounds or evidence on which the parties have had an opportunity to present their comments. The word "grounds" is interpreted as referring to the **essential reasoning, both legal and factual** (see e.g. **T 951/92**, OJ 1996, 53; **T 433/93**, OJ 1997, 509). See also in this chapter IV.C.6.5. Opportunity to present comments" below.

Thus if an opposition division wishes to introduce a new ground of opposition into the proceedings in addition to the ground(s) substantiated in the notice of opposition, either of its own motion or upon request by an opponent, the patent proprietor must be informed (normally in writing) not only of the new ground of opposition (i.e. the new legal basis for the opposition), but also of the essential legal and factual reasons which could lead to a finding of invalidity and revocation. Thereafter the patent proprietor must have a proper opportunity to present comments in reply to the new ground and its substantiation (**T 433/93**, OJ 1997, 509, see also **T 1283/11**).

In **T 656/96**, the opponent had based its opposition solely on the invention's purported lack of inventive step. However, lack of novelty was advanced as a ground for opposition for the first time in the oral proceedings and in the absence of the patent proprietor, who had previously informed the division that they would not be attending oral proceedings. The opposition division revoked the contested patent, even though it had not originally raised a novelty objection in its communication under Art. 101(2) EPC 1973 (Art. 101(1) EPC). In such circumstances, the board referred to the case law of the Enlarged Board distinguishing between the opposition ground of lack of novelty and that of lack of inventive step (**G 7/95**, OJ 1996, 626) and recognising the opposition division's competence to consider, exceptionally under Art. 114(1) EPC, fresh grounds for opposition which, prima facie, appear, either in whole or in part, to prejudice maintenance of the European patent

(**G 10/91**, OJ 1993, 420). In the case in hand, the board held that, particularly in the light of the opinion on novelty expressed in the communication from the opposition division, no prima facie case against maintenance of the patent could be gathered from the file, so that the appellant had been entitled to consider that the question of novelty would play no part before the opposition division. The appellant must therefore have been **taken by surprise** by the decision taken in its absence by the opposition division at the oral proceedings to revoke the patent on the grounds of lack of novelty, grounds on which the appellant had not been asked, nor had any reason, to express an opinion.

In **T 270/94**, the board found that the opposition division had infringed Art. 113(1) EPC by preventing opponent 1, who had based its opposition solely on lack of novelty, from commenting on an opposition ground of lack of inventive step duly submitted by opponent 2 and communicated to all the parties in accordance with R. 57(2) EPC 1973 (R. 79(2) EPC). Furthermore, the board observed that Art. 114(2) EPC, relied on by the opposition division, was not applicable to the case, because it indicated only that the EPO could disregard late-filed facts or evidence, whereas the case in hand involved arguments put forward by one of the parties to the proceedings in relation to a ground for opposition submitted in due time by another party.

In **T 1164/00** the board held that the opposition division was in principle entitled to introduce a new ground for opposition even at the late stage of oral proceedings, since, in its view, it was apparent that the patent in suit did not comply with the requirements of Art. 83 EPC. However, in this case, the annex to the summons to oral proceedings did not contain any indication of the opposition division's intention to introduce a new ground for opposition, which meant that the appellant was made aware of the factual and legal reasons supporting the introduction of this new ground for the first time during the oral proceedings. The board therefore concluded that the appellant had not been notified in writing as early as possible and, not having been informed beforehand of the factual and legal reasons, had been taken by surprise and had not had a fair opportunity during the oral proceedings to prepare a proper defence against this new objection. In those circumstances, the opposition division **ought to have adjourned the oral proceedings** in order to give the appellant sufficient time, in accordance with Art. 113 EPC, to prepare a suitable defence against the new objections (see also **T 433/93**, OJ 1997, 509; **T 817/93**; **T 1083/01**; **T 64/03** and **T 27/14**).

In **T 2362/08**, in its decision on insufficiency, the opposition division developed a completely different line of argument on a substantive issue of insufficiency which was raised for the first time at the oral proceedings. Furthermore, the patent proprietors had to face an **unexpected reversal of opinion** from the opposition division, which discharged the opponents of the burden of proof, thereby shifting it to the patent proprietors. The board could not consider the simple formal hearing of the patent proprietors on the issue at the oral proceedings to have been a proper opportunity for them to present their comments. By presenting the new legal and factual framework only at the oral proceedings and by coming to a final decision on the issue without first having given the patent proprietors a proper opportunity to respond, the opposition division did not respect their right to be heard (Art. 113(1) EPC).

3.5. Grounds raised against claims amended after grant

Amendments of the claims or other parts of a patent in the course of opposition (or opposition appeal) proceedings are to be examined as to their compatibility with the requirements of the EPC. The principle that the opposition division must examine only such grounds for opposition as have been properly submitted and substantiated in accordance with Art. 99(1) EPC 1973 in conjunction with R. 55(c) EPC 1973 (R. 76(1), (2)(c) EPC) does not apply to such amendments (see **G 9/91** and **G 10/91**, OJ 1993, 408 and 420, point 19 of the Reasons respectively). For details, see chapter IV.C.5.2 "Scope of examination of amendments" which also explains the limited extent of the power to examine amended claims for compliance with Art. 84 EPC.

4. Late submission of documents, lines of attack and arguments

4.1. Discretionary decision

Under Art. 114(1) EPC, the EPO is **obliged to examine the facts of its own motion**, and in doing so, it is not restricted to the facts, evidence and arguments provided by the parties and the relief sought. In **T 223/95**, however, the board emphasised the character of the post-grant opposition proceedings under the EPC, which were in principle to be considered as contentious proceedings between parties normally representing opposite interests, who should be given equally fair treatment. It was the **responsibility of the opponent** itself to present to the opposition division the facts, evidence and arguments in support of the grounds on which the opposition was based. See also **T 998/04** (referring to **G 9/91**, OJ 1993, 408 and **T 671/03**) and **T 223/05**.

According to Art. 114(2) EPC, the EPO may disregard facts or evidence which are not submitted in due time by the parties concerned. Interpretation of Art. 114 EPC therefore requires an analysis of the inter-relationship between its paragraphs 1 and 2. In **T 122/84** (OJ 1987, 177) the board summarised the historical development of the principle of ex officio examination with regard to late submission on the basis of the "travaux préparatoires" to the EPC 1973. A solution it found compatible with this principle was to leave it to the **discretion** of the department concerned whether or not to examine facts or evidence not submitted in due time, rather than ruling out such examination altogether.

Following the principles set out in **G 10/91** (OJ 1993, 420), the board in **T 1002/92** decided that in opposition proceedings late-filed facts, evidence and related arguments going beyond the "indication of the facts, evidence and arguments" presented in the notice of opposition pursuant to R. 55(c) EPC 1973 (R. 76(2)(c) EPC) in support of the grounds of opposition on which the opposition is based should only exceptionally be admitted into the proceedings by the opposition division if, prima facie, there are **clear reasons to suspect** that such late-filed material would prejudice the maintenance of the European patent in suit. See also **T 334/06**, referring to **T 273/84** (OJ 1986, 346) and **T 1002/92**. For details of the criteria for the exercise of discretion, see chapter IV.C.4.5.

For appeal proceedings the boards have highlighted that a rigid rule excluding all new evidence might lead to injustice and unfairness in some cases and would not be

compatible with the principles of procedural law generally recognised in the contracting states (**J 5/11**, **J 6/14**, **T 598/13**). That applies a fortiori to opposition proceedings.

For proceedings at first instance, R. 116(1) EPC provides that, when the summons to oral proceedings is issued, a final date for making written submissions in preparation for the oral proceedings must be fixed. New facts and evidence submitted after this date need not be considered, unless admitted on the grounds that the subject of the proceedings has changed. This provision does not act as an absolute bar to admitting late submissions; instead, its very wording shows that it leaves **room for discretion** (**T 798/05**; see also **T 2102/08**, **T 1253/09**, **T 1854/16**, **T 921/21**). See also chapter IV.C.3.2 below.

In **T 1485/08** the opposition division had decided not to admit the late filing (on the day of the oral proceedings) of an English translation of a Korean patent which had been filed with the grounds of opposition. The board noted that the document (Korean patent) had been filed with the notice of opposition against novelty of the patent in suit. Although not in one of the official languages of the EPO, from the use of various English terms in the description of the document it was already discernible that its subject-matter was related to the claimed subject-matter. The board was of the opinion that the opposition division in not admitting the English translation for the sole reason that it was late-filed, without having examined its relevance or considered any other criteria, did not properly exercise its discretion.

In **T 574/17** the board found that the line of attack presented by the opponent for the first time during the oral proceedings in the opposition proceedings lacked essential details, which made it impossible for the opposition division and the proprietor to prepare themselves and undertake a meaningful substantive assessment of this new line of attack at that point of time. Thus, the opposition division had applied the correct principles in the right manner when deciding not to admit the new line of attack.

4.2. Concept of "in due time"

4.2.1 Duty to facilitate due and swift conduct of proceedings

The discretionary power pursuant to Art. 114(2) EPC applies to facts and evidence filed late (see e.g. **T 502/98**, **T 986/08**, **T 66/14**; see also **T 1022/09**, according to which documents that were filed with the notice of opposition, and whose filing was substantiated, were automatically admitted to the opposition proceedings). What is meant by "in due time" for the purposes of Art. 114(2) EPC requires interpretation.

The parties in inter partes cases are subject to a particular **duty to facilitate due and swift conduct of the proceedings**, in particular by submitting all relevant facts, evidence, arguments and requests as early and completely as possible (see e.g. **T 1955/13**; see also **T 1768/17**, albeit in the context of the submission of requests). This duty is reflected in the EPC provisions governing the handling of late submissions: Art. 114(2) EPC as a general provision (which is, according to the preparatory documents, aimed at preventing the negligent conduct of proceedings, **T 122/84**); R. 137 EPC for the grant procedure; and R. 76(2)(c) and R. 80 EPC for the opposition procedure; R. 116(1) EPC concerning the

final date for making written submissions in preparation for oral proceedings. For appeal proceedings see the Rules of Procedure of the Boards of Appeal (RPBA), OJ 2024, A15; in this chapter V.A.4. "New submissions on appeal"

The boards have stressed that opponents are required to submit all their objections during the opposition period, setting each out in full (**T 117/86**, OJ 1989, 401; see also above in this chapter IV.C.2.2.6 and IV.C.3.2.). Under R. 76(2)(c) EPC, the notice of opposition must contain a statement of the extent to which the European patent is opposed and of the grounds on which the opposition is based, as well as an indication of the facts and evidence presented in support of these grounds. In **T 2165/10**, the board held that the appellant (opponent) should have included an indication of the alleged public prior use submitted later in its notice of opposition and indicated/filed all evidence in its possession at that time. It did not accept the appellant's argument that the documents in its possession at the time of filing the opposition were considered by the appellant not to be enough to constitute a complete chain of evidence.

In **T 1364/12**, the board found that documents not admitted by the opposition division had been submitted by the appellant (patent proprietor) in due time in response to the communication under R. 79(1) EPC and so should have formed the basis for the opposition proceedings. It had not been open to the opposition division to consider whether or not to admit them at its discretion on the basis of prima facie relevance, and doing so therefore amounted to an erroneous exercise of that discretion.

The filing of facts and evidence within subsequent periods of time may also be in "due time" when it occurs in accordance with the principle of procedural economy and, therefore, when the filing party has observed a **fair degree of procedural vigilance** (**T 502/98** referring to **T 201/92**, **T 238/92**, **T 532/95** and **T 389/95**; cited in **T 568/02**; see also e.g. **T 574/02**).

Accordingly, new facts, documents and/or evidence are regarded as having been filed on time if their filing was occasioned by an argument or a point raised by another party so that, under the circumstances of the case, they could not have been filed earlier. According to **T 502/98** this may occur, for instance, when certain facts or evidence became relevant only after a party has submitted an unforeseeable amendment of the claims or a new experimental test report or has challenged for the first time the existence of common general knowledge. In such cases, a diligent party normally has no obligation to retrieve and file such facts and evidence before such action of the other party (cited e.g. in **T 986/08**). See also **T 623/93**, where the board held that, where amended claims were introduced in the opposition proceedings there could be no objection to the opponent's submitting new citations and new arguments against the new claims (with reference to **G 9/91**, OJ 1993, 408, point 19 of the Reasons).

Therefore, the filing of new facts and evidence in direct response to new submissions by the other party (**T 389/95**, **T 320/08**, **T 1698/08**, **T 1949/09**), or at the earliest time possible in the proceedings (**T 468/99**, **T 2551/16**), or promptly after their relevance has become apparent (**T 201/92**, **T 502/98**, **T 568/02**, **T 574/02**, **T 986/08**, **T 998/17**), has been considered to be "in due time" (see also **T 156/84**, OJ 1988, 372, but also e.g. **T 1734/08**

and **T 733/11**, which considered submissions filed outside the period specified by Art. 99(1) EPC to be late-filed, without considering the observance of procedural vigilance).

In **T 1445/22** the board found, however, that the opposition division had not raised any new aspects in its preliminary opinion, but rather reiterated the position given by the respondent in its reply to the notice of opposition. There had been no change in the subject of the proceedings before the opposition division which would have led to new evidence being considered to be timely filed.

In **T 117/02** the board stated that in the case of a request to introduce late-filed submissions (here: a new ground of opposition and new arguments and evidence) the **right to be heard** should be granted before those late-filed submissions were rejected.

An opponent must be given an opportunity to respond in an appropriate way when the subject of the proceedings has changed, for example due to amendment. Depending on the nature of the amendment this may involve the filing of further documents (**T 366/11**).

4.2.2 Rule 116(1) EPC – not an invitation to file new submissions

According to the established case law, R. 116(1) EPC should not be construed as an invitation to file new evidence or other material departing from the legal and factual framework of issues and grounds pleaded as established with the notice of opposition (**T 39/93**, OJ 1997, 134; **T 1445/22**). Also, the fact that the opposition division expressed a preliminary opinion in its communication did not necessarily justify the filing of new evidence, unless this was in **reaction to new aspects** raised in the communication (**T 628/14**).

The board in **T 66/14** observed that, according to case law, evidence first submitted by an opponent after expiry of the nine-month period under Art. 99(1) EPC was generally to be regarded as late for the purposes of Art. 114(2) EPC, and that R. 116(1), fourth sentence, EPC was not to be understood to mean that a fresh period during which new evidence could be filed without being treated as late was triggered on issue of the summons to oral proceedings (see also **T 841/08**, **T 1445/21**, **T 531/22**). However, there may be cases in which special circumstances justify an opponent's not filing evidence until after the nine-month period under Art. 99(1) EPC and in which, therefore, that evidence is **not** to be treated as late for the purposes of Art. 114(2) EPC (**T 532/95**). In particular, new evidence submitted after the date referred to in R. 116(1) EPC is to be admitted if the **subject of the proceedings has changed**. This is typically the case where new claim requests are filed such that there was no reason to file the evidence in response thereto any earlier or where the opposition division raised a new issue (**T 1445/22**).

4.2.3 Fair response – examples

In **T 1551/14**, during the written proceedings that followed initial oral proceedings before the opposition division, at which witnesses had been heard, the patent proprietor had filed a new auxiliary request limiting the subject-matter of the independent claims by a new

feature. Having been summoned to a second round of oral proceedings, the opponent had filed, within the period fixed under R. 116 EPC, a statutory declaration made by one of the previously heard witnesses and proposed that the witness be heard again. For the board, this declaration, which dealt with matters that had become relevant only once the new auxiliary request had been filed, was a direct and timely reaction of the opponent (appellant) to that request, and therefore could not be treated as filed late. The board did not share the appellant-proprietor's misgivings that the declaration conflicted with the case made so far. That submissions filed as a legitimate reaction to an amendment to the counter-party's case contained contradictions was in any event not a proper basis for refusing to admit those submissions from the outset.

In **T 2734/16** the board held that a new line of attack on inventive step pursued in response to and using the documents submitted by the patent proprietor with its reply to the opposition should not be considered late-filed per se. For reasons of "equality of arms", the new attack could be admitted into the opposition proceedings even if the documents ultimately proved no more relevant than other documents.

In **T 1711/16** the opponent had filed further evidence within the final date set in accordance with R. 116(1) EPC in order to overcome concerns expressed by the opposition division for the first time in its communication sent out in preparation for the oral proceedings. The board pointed out that the prima facie relevance of these documents, which in the proprietor's opinion was lacking, was irrelevant to the issue of admittance. The decisive point was whether these documents and the submissions made in respect of them dealt with the concerns of the opposition division and were timely submitted, i.e. whether they represented a **fair answer** to the concerns raised by the opposition division. Accordingly, the board overturned the opposition division's discretionary decision not to admit the evidence at issue.

4.3. Sufficient reasoning

According to the consistent case law of the boards of appeal, although Art. 114(2) EPC gives an opposition division discretion not to consider facts and evidence not submitted in due time, the division is obliged to give reasons for its decision; it is not enough merely to cite their late submission (**T 705/90**, **T 214/01**, **T 1855/13**, **T 1984/19**). Even if submissions are late-filed, their admission remains a procedural aspect over which the opposition division can exercise discretion. As a consequence, the decision needs to show the reasoning why the discretion was exercised one way or the other (**T 1855/13**).

In **T 2097/10**, the board found that the brief statement of reasons given by the opposition division – to the effect that documents D18 and D19 were relevant and not especially voluminous – was sufficient. Moreover, it was not apparent from the minutes that the patentee's representative had been denied an opportunity to comment on those documents, or that they had asked for more time to prepare such comments but their request had been refused.

In **T 544/12** the board pointed out that a **bare assertion** of a lack of prima facie relevance was not by itself sufficient reasoning.

In **T 1984/19** the board found that while an opposition division must have a certain freedom in admitting or disregarding late-filed evidence, the reasoning given in the contested decision for not admitting D16 into the opposition proceedings was insufficient in view of R. 111(2) EPC. From the decision and the minutes, the board was unable to comprehend which considerations had led the opposition division to the conclusion that the content of D16 did not go beyond the content of the documents on file and why D16 was considered not relevant for the outcome of the case, whether in view of novelty or inventive step. In order to ascertain whether the opposition division had exercised its discretion properly (**G 7/93**, OJ 1994, 775), it was essential for the board to know which principles the opposition division had taken into account and which interests it had balanced.

4.4. Documents cited in the patent specification or search report

A document considered during the examination procedure is **not automatically** scrutinised in opposition or opposition appeal proceedings, even if it is quoted and acknowledged in the contested European patent (**T 155/87**, **T 198/88**, OJ 1991, 254; **T 484/89**, **T 652/99**, **T 2053/13**, **T 1522/21**). Generally, it has to be relied upon by a party to be considered by the opposition division.

According to **T 291/89** this also applied to a document cited in the search report (see also **T 387/89**, OJ 1992, 583, summarised below). In **T 111/04** the board agreed with the case law and considered that this applied also to evidence filed during the grant proceedings.

In **T 536/88** (OJ 1992, 638) the board pointed out, however, that the document cited and acknowledged in the description of the contested patent itself as the **closest prior art** and on the basis of which the technical problem in the description was formulated remains an exception. Such a document also forms part of the opposition or opposition appeal proceedings even if it is not expressly cited within the opposition period (confirmed e.g. in **T 541/98**, **T 652/99**, **T 454/02**, **T 86/03**, **T 257/14**, **T 1123/14**; distinguished e.g. in **T 1421/12** and **T 2541/17**; for the opposite view, see e.g. **T 234/90**, **T 300/90** and **T 501/94**, OJ 1997, 193).

In **T 140/00** although document (7) had been cited in the specification of the patent in suit, it had merely been acknowledged as **conventional background art**; it was not considered therein as essential or as the closest prior art and starting point of the claimed invention. Therefore, that document did not automatically form part of the appeal proceedings and, thus, was late-filed evidence subject to a discretionary decision of the board.

In the board's view in **T 387/89** (OJ 1992, 583), neither an opposition division nor a board of appeal had any duty to reconsider the relevance of documents cited in the European search report if such documents had not been relied upon by the opponents to support their grounds of opposition. Under Art. 114(1) EPC 1973, however, an opposition division or appeal board could introduce new documents into the opposition proceedings if it had good reason to suppose that the documents could affect the outcome of the decision (**T 420/93**, **T 530/00**).

4.5. Criteria for the exercise of discretion

4.5.1 Different approaches

It is at the opposition division's discretion whether to admit late-filed documents (Art. 114(2) EPC; see chapter IV.C.4.1. above). According to settled case law, it must first examine them as to their relevance. Late-filed facts, evidence and supporting arguments should only exceptionally be admitted into the proceedings if, prima facie, there are reasons to suspect that such late-filed documents prejudice the maintenance of the European patent in suit (see, in particular, **T 1002/92**, OJ 1995, 605; see also **T 1643/11**, **T 2443/12**; and in this chapter IV.C.4.5.3 "Prima facie relevance").

As to whether and, if so, to what extent opposition divisions can or must consider other criteria too, with the result that even prima facie relevant documents may not be admitted in certain cases, the boards have taken various different approaches.

According to one of those approaches, the **principle of examination** by the EPO of its own motion (Art. 114(1) EPC) **takes precedence** over the possibility of disregarding facts or evidence not submitted in due time. This follows from the EPO's duty towards the public not to grant or maintain patents which it is convinced are legally invalid (**T 156/84**, OJ 1988, 372; **T 2542/10**; **T 1272/12**). Accordingly, the **main criterion** for deciding on the admissibility of late-filed documents and evidence is their **relevance**, i.e. whether they are decisive (relevant) for the outcome of the case (see **T 258/84**, OJ 1987, 119; **T 892/98**; **T 605/99**, **T 572/14**). Some decisions assess the relevance in relation to other documents already in the case (e.g. **T 932/99**, **T 482/01**, **T 927/04**; see however **T 1652/08** and **T 66/14** rejecting this definition). If the document is relevant it must be admitted into the case and taken into account (**T 164/89**, **T 1016/93**).

In addition, in landmark decision **T 1002/92** (OJ 1995, 605) the board held that the principles set out by the Enlarged Board in **G 9/91** and **G 10/91** (OJ 1993, 408 and 420) with regard to the admissibility of fresh grounds of opposition (see chapter IV.C.3. above) are also generally applicable to late-filed new facts and evidence in support of grounds of opposition already presented in the notice of opposition. Accordingly, in proceedings before the opposition divisions, late-filed facts, evidence and related arguments which go beyond the "indication of the facts, evidence and arguments" presented in the notice of opposition pursuant to R. 55(c) EPC 1973 should only exceptionally be admitted into the proceedings if, prima facie, there are clear reasons to suspect that such late-filed material would prejudice the maintenance of the European patent in suit. The board saw the consideration of relevance as the principal factor governing the exceptional admissibility of late-filed new facts, evidence and related arguments in proceedings before the opposition division. For the more restrictive and stringent criteria in proceedings before the boards of appeal, see chapter V.A.4. and, in particular, chapters V.A.4.4.6, V.A.4.5.5m) and V.A.4.5.4e).

Many decisions have affirmed **T 1002/92** (for late submissions in opposition proceedings see e.g. **T 481/99**, **T 481/00**, **T 1643/11**, **T 1883/12**, **T 2438/13**, **T 710/15**). In **T 2049/16** the board reiterated that the need to avoid the maintenance of invalid European patents

justified, in first-instance proceedings, the admittance of documents that, in the opposition division's view, were prima facie relevant.

However, in many decisions, the relevance of late-filed documents was not viewed as being the only decisive criterion for admitting them. Other criteria, such as how late the documents were, why they had been submitted late and whether their submission constituted a procedural abuse or whether admitting the late-filed documents could lead to an excessive delay in the proceedings, were also held to be decisive (see **T 534/89**, OJ 1994, 464; **T 17/91**, **T 951/91**, OJ 1995, 202; **T 1019/92**, **T 481/99**, **T 1182/01**, **T 927/04**, **T 1029/05**, **T 1485/08**, **T 2542/10**, **T 1272/12**, **T 1883/12**, **T 1271/13**).

The board in **T 1445/22** did not consider the circumstances leading to the obtaining of the evidence by the party filing it as relevant for the issue of whether a document was filed in due time. These circumstances were external to the proceedings and it would run counter to the concept of discretionary power if that discretion were denied to a deciding body by circumstances external to the proceedings. Were such discretion to be denied, then all documents created or coming to light at any stage of the proceedings that were filed by a party would automatically be part of the proceedings. However, this would undermine the nine-month period under Art. 99(1) EPC which aims to establish the factual and legal framework within which the substantive examination of the opposition is, in principle, conducted, allowing the patent proprietor a fair chance to consider its position at an early stage of the proceedings (see **G 10/91** and **T 1002/92**).

For decisions on the exercise of discretion by opposition divisions, see in this chapter IV.C.4.5.2 to 4.5.5; for criteria for considering late-filed facts and evidence in appeal proceedings, see chapter V.A.4. and, in particular, chapters V.A.4.1.2, V.A.4.4.6, V.A.4.5.1, and V.A.4.5.4e).

4.5.2 Review of discretionary decisions by the boards

a) Limits to the discretionary power in Article 114 EPC

The discretionary power conferred by Art. 114 EPC necessarily implies that the EPO department of first instance must have a certain degree of freedom in exercising its power. A board of appeal should only overrule the way in which a department of first instance has exercised its discretion when deciding on a particular case if it concludes that it has done so according to the wrong principles, or without taking into account the right principles, or in an unreasonable way, and has thus exceeded the proper limits of its discretion (**T 640/91**, OJ 1994, 918; **G 7/93**, OJ 1994, 775; see also chapter V.A.3.4). This rule also applies with respect to opposition division decisions on the admission (**T 1209/05**, **T 1652/08**, **T 1852/11**, **T 2513/11**) or non-admission (**T 1485/08**, **T 1652/08**, **T 1253/09**, **T 1568/12**, **T 1883/12**, **T 1271/13**, **T 1690/15**, **T 1711/16**) of late-filed submissions. It is not the function of a board of appeal to review all the facts and circumstances of the case as if it were in the place of the department of first instance in order to decide whether or not it would have exercised such discretion in the same way (**T 75/11**, **T 2685/19**, **T 1522/21**; see however **T 544/12**, where the opposition division did not give sufficient reasons for its decision). In particular, the board should not interfere in such a discretionary decision

simply because, under the same circumstances, the board itself would have decided differently (**T 960/15**).

This discretionary power has to be exercised reasonably after hearing the parties, including in oral proceedings if requested (**T 281/00**).

In **T 435/20** the board found that the opposition division had decided according to the wrong principles and had disregarded the **principles of procedural fairness and of equal treatment of the parties**. Firstly, the board found inter alia that the mere fact that the opposition division's preliminary opinion was positive for one party could not in itself justify not admitting any further documents by this party which were filed by the final date set by the opposition division for making written submissions under R. 116(1) EPC. Secondly, as pointed out by the board, arguments submitted by a party's professional representative do not qualify as means of giving evidence under Art. 117(1) EPC and may therefore have a different weight depending on whether or not they are supported by further evidence. Accordingly, the opposition division was mistaken in holding that the declaration D81 with supporting documents on the one hand, and the representative's arguments on the other were equivalent and that this could justify non-admittance of documents D81 to D90. Further, D81 to D90 had been filed as direct and immediate response to new evidence submitted by the appellant on the last day for making written submissions under R. 116 EPC. In admitting this late-filed evidence into the proceedings but not admitting D81 to D90 filed by the respondents in direct response, the opposition division had not respected the principles of procedural fairness and of equal treatment of parties.

In **T 879/21** the board considered that the opposition division had exercised its discretion using the wrong criteria and in an unreasonable manner when deciding not to admit the late-filed documents. The opposition division's finding that D15 to D17 were not prima facie relevant because the allegations that the claimed composites and foams could not be obtained and the objections of lack of disclosure, novelty and inventive step "were already brought forward in the notice of opposition" was unreasonable. With this reasoning, the opposition division had de-facto not assessed the prima facie relevance of these documents. The board found that if this approach were to be implemented, a party would lose the right to have any new evidence supporting an attack raised in the notice of opposition considered, irrespective of its prima facie relevance for the outcome of the proceedings.

See also in particular chapter V.A.3.4.1 "Principles applying to the review of first-instance discretionary decisions".

b) No legal basis to overturn submissions admitted by the opposition division

In **T 1852/11** the board observed that the framework of the EPC did not provide a legal basis for excluding, at the appeal stage, a prior art document which was correctly admitted into the first-instance proceedings. The board in **T 617/16** held that this was particularly the case when the impugned decision was based on them (see e.g. **T 1549/07**, **T 1652/08**, **T 26/13**, **T 1201/14**); in view of the aim of the appeal proceedings to review the decision

under appeal in a judicial manner according to Art. 12(2) RPBA, such submissions were automatically part of the appeal proceedings (see e.g. **T 487/16**, **T 2603/18**).

Other boards have not ruled out the possibility of a review altogether, but have limited it to cases of errors in exercising discretion or procedural errors (**T 2603/18**, **T 2685/19**; see **T 1549/07**, **T 1652/08**, **T 2197/11**, **T 572/14**).

For a more substantial review of the case law concerning the board of appeal's review of first-instance discretionary decisions, see chapter V.A.3.4.

4.5.3 Prima facie relevance

a) Relationship between prima facie assessment and in-depth assessment

According to established case law of the boards of appeal, a decisive criterion for admitting late-filed documents is their prima facie relevance, see e.g. **T 1002/92**, OJ 1995, 605; **T 212/91**, **T 931/06**, **T 1883/12**, **T 1511/14** and **T 838/17**; for appeal proceedings, see in particular chapters V.A.4.1.2, V.A.4.4.6, and V.A.4.5.5.

Prima facie relevance is ascertained on the face of the facts, i.e. with **little investigative effort**, which reflects the need for procedural expediency in considering and admitting late-filed facts and evidence (**T 1883/12**).

In **T 1348/16** the board considered that the opposition division, in admitting a document which it had found to be prima facie relevant and potentially prejudicial to the maintenance of the patent in suit, had based its decision on the right principles and that there was no reason to doubt that it had exercised its discretion in a reasonable way. This was not contradicted by the fact that a detailed analysis of the document later led the opposition division to conclude that it was actually not novelty destroying and that another document represented the most relevant state of the art. Such an in-depth analysis was not part of the prima facie assessment of the relevance of a document. See also **T 1614/18**.

In **T 1525/17** the board observed that it was inherently contradictory to take late-filed documents as a basis for an in-depth examination of the patentability requirements, and so consider them as to their substance, yet at the same time declare them not admitted, as the opposition division had done in this case, having fully considered documents E5 and E6 in its thorough substantive assessment of inventive step. That assessment had not been referred to explicitly as a prima facie assessment of the documents' relevance; nor could it be regarded implicitly as a matter to be settled before dealing with their non-admission. The refusal to admit them therefore amounted to an erroneous exercise of discretion. See also **T 1185/15** (necessary thorough analysis at odds with finding that document is not prima facie relevant) and **T 346/16**. See likewise **T 847/20** in which the opposition division had not carried out a prima facie assessment but had fully considered the requests before concluding that they could not be admitted. The board took the view that the opposition division had wrongly exercised its discretion because, having implicitly admitted the requests, there was no discretion left not to admit them. **T 2324/14** and

T 2026/15 address implicitly admitted requests in examination proceedings, see chapter IV.B.2.4.1.

In **T 838/17** the board held that an assessment of whether a prior art document prejudiced inventive step, even at prima facie level, needed, necessarily, to go beyond an assessment of whether that document prejudiced novelty. An assessment of inventive step did not stop at the identification of a difference. While a lack of difference was sufficient to substantiate an inventive-step objection, the identification of a distinguishing feature was not sufficient to demonstrate that the invention would not have been obvious. Even if the opponent's argumentation did not go beyond the statement that there was actually no difference, proper exercise of discretion would require, at least, some explanation as to why the opposition division saw no reason to suspect that the difference would have been obvious.

In **T 1614/18** the board stated, with reference to the version of Guidelines applicable at the relevant time, that the competent department had to take a late-filed and "prima facie" relevant evidence into consideration no matter what stage the procedure had reached and whatever the reasons for the belated submission. The fact that after discussion at the oral proceedings the suspected relevance was not confirmed did not imply that the discretion was applied incorrectly. In the case in hand procedural expediency was not an issue since D6 was filed two months before the oral proceedings, and therefore no undue burden affecting negatively the position of the appellant could be reasonably invoked.

In **T 2716/19** the board decided the opposition division had applied the criterion of prima facie relevance in an unreasonable way because it had limited its assessment to the subject-matter of the then main request. It should have extended to the subject-matter of the auxiliary requests on file.

In **T 21/22** the opposition division had conducted a comprehensive examination of late-filed D20 in respect of novelty and inventive step prior to concluding that it should not be admitted on the basis of its late filing and the fact that it was not prima facie relevant. The opposition division had therefore not only carried out a mere prima facie assessment but had fully considered D20 and the objections based upon it. Thus, the board held that there was no discretion left for the opposition division not to admit D20 into the proceedings, since it was de facto fully considered (and therefore implicitly admitted) by the opposition division.

b) Relative or absolute concept of relevance

Regarding the examination of evidence, documents and other submissions as to their relevance, one line of case law holds that "irrelevant" means no more "weighty" or "cogent" than those already on file (see e.g. **T 611/90**, OJ 1993, 50, and also the decisions summarised below).

In **T 560/89** (OJ 1992, 725) the board explained that Art. 114(2) EPC 1973 allowed the EPO to disregard documents which contained no more information than the documents filed on time and did not disclose matter which could change the outcome of the decision. In **T 1557/05**, the appellant (opponent) filed further patent documents as prior

art. The board held that late-filed evidence was admissible only if it was prima facie more relevant than the evidence already on file. In this regard the board in **T 1883/12** added that relevance was decided in relation to facts to be proven, and if late documents (here: patent documents), on the face of it, were not more relevant to those facts than admitted evidence and thus appeared to add nothing, it was perfectly reasonable in the interest of procedural economy not to admit them.

Similarly, the board in **T 1690/15** rejected the appellant's argument that relevance had to be assessed absolutely. It pointed out that an opposition division carried out its prima facie assessment by comparing the features obvious from the disclosure at issue with the claimed subject-matter. If it concluded that those features did not provide it with any evidence beyond that already on file, it could justifiably disregard the disclosure. If it was clearly no better than the previously cited prior art, it could already be assumed that it was no more likely to result in a finding of a lack of patentability.

In another line of case law, however, the boards have held that, in establishing whether a document was prima facie relevant, the decisive factor is **not** whether it is even more relevant than a previously filed document, but rather whether it is prima facie **relevant for the outcome** of the case (see e.g. **T 1652/08**, **T 66/14**, **T 1348/16** and **T 435/20**).The board in **T 66/14** further explained that this could not be assessed in isolation from the submissions put forward by the party submitting a document late; in exercising its discretion, the opposition division had to consider what objection the late-filed document was supposed to substantiate.

In **T 2165/10**, documents E1-E10, which related to an alleged public prior use, had not been admitted into the proceedings by the opposition division. The board held that the prima facie relevance test had been exercised correctly. The opposition division had considered, with regard to novelty, that E1-E10 did not disclose a number of the claimed features and, with regard to inventive step, that they did not deal with the problem underlying the contested patent. Since there was a document (D4) that related to this problem, the board could not find fault in the division's reasoning that the prior use was less relevant as the starting point.

c) Further examples

For examples of cases where the boards were satisfied that the opposition division had considered the correct criterion, prima facie relevance, and had done so in detail and in a reasoned manner, see e.g. **T 1643/11**,**T 782/13**, **T 2513/11**, **T 572/14** and **T 2053/13**.

For an example of a case where the board did not agree with the opposition division's view that the late-filed document was not prima facie relevant, see **T 591/15**.

d) Other aspects must be considered

In **T 1984/19** the board found that determining whether late-filed documents were prima facie more relevant than those already on file was only one of several aspects that needed to be balanced when taking the discretionary decision to admit or not admit late-filed

evidence into the proceedings. Other aspects included the point in time at which the evidence was first presented and the amount of time available for the other party to deal with it and prepare a meaningful reply, or the complexity of the new submission and the expected lengthening of the proceedings that its admittance would cause.

4.5.4 Abuse of proceedings and submissions contrary to fair and expedient procedure

An abuse occurs where a party deliberately withholds documents for tactical reasons (see e.g. **T 1019/92**, **T 724/03**).

In **T 17/91** the board took the view that an assertion of public prior use based on the **opponent's own activities** which is submitted after the expiry of the opposition period and in the absence of good reasons for the delay represented an abuse of the proceedings and a breach of the principle of "good faith" which all parties are expected to observe. As soon as evidence was in the possession of the opponent and it was recognisable that it could be highly relevant to the validity of the patent it should be submitted in the proceedings.

By contrast, in **T 1019/92** the board held that the fact that an opponent submitted prior art material originating from itself after the end of the opposition period did not constitute an abuse of the proceedings in the absence of evidence that this was done **deliberately for tactical reasons**. Likewise, in **T 481/00** the board considered that the maintenance of a prima facie clearly invalid patent as the legal consequence of the late submission of a clearly novelty-destroying prior use allegation in opposition proceedings, albeit still submitted in time to guarantee the patentee's right to be heard, would in the specific circumstances of its case amount to an inappropriate sanction without a sufficient legal basis in the EPC or in the general principles of procedural law applicable under Art. 125 EPC. See, along the same lines, **T 2049/16**.

However, according to the board in **T 1955/13**, there were good reasons not to treat an opponent's late-filed allegation of its own public prior use differently for the purposes of admissibility depending on whether it admitted to having withheld the alleged prior art deliberately or claimed simply not to have looked for it earlier. If the lateness of its prior-art search could not be explained by procedural developments that would prompt a reasonable person to search in a particular direction for the first time, the opposition division would not be committing any error in law in applying the case law on abusive withholding of prior art when it came to deciding whether to admit its allegation.

In **T 1271/13** the opponent had submitted report D11, underlying a new insufficiency objection, one month before the oral proceedings and a corrected version D11a one day before the oral proceedings. The opposition division had come to the conclusion that the experiment results had not been submitted sufficiently well in advance for the proprietor to have had the opportunity to perform counter-experiments. The very late submission of D11/D11a was contrary to a fair and expedient procedure. The board found that the opposition division had based its discretionary decision not to admit D11/D11a on well-established principles and had not acted in an unreasonable way.

In **T 154/95** the board ruled that in opposition or appeal proceedings it was basically irrelevant how an opponent came across documents or other evidence made available to the public. Thus there was nothing to stop an opponent from citing a prior use invoked in the same case by another opponent whose opposition was inadmissible because it had been filed after expiry of the opposition period.

4.5.5 Legitimate expectation that the document is already in the proceedings

In **T 68/02** document D16 was discussed extensively by the respondent without objecting to its admission into the proceedings. At the start of the oral proceedings before the opposition division the respondent requested that the document not be admitted into the proceedings. The opposition division as a consequence did not admit the document. The board could not agree with the action of the opposition division in this respect. The discussion of the document by the respondent and the opposition division before the oral proceedings took place led to the normal expectation that the document was already in the proceedings. See also **T 1194/08**.

4.6. Late submissions of new arguments

4.6.1 New arguments – definition

The Enlarged Board defined "new arguments" in opinion **G 4/92** (OJ 1994, 149) as being not new grounds or evidence, but reasons based on the facts and evidence which had already been put forward (e.g. **T 131/01**, OJ 2003, 115). In **T 604/01**, the board held that facts in the legal sense were to be understood as the circumstances and incidents of a case, looked at apart from their legal bearing. In **T 926/07** the board stated (with reference to **T 92/92**) that facts are alleged circumstances/matters which must, where applicable, be substantiated by evidence. Arguments, by contrast, are the expositions generated when the law is applied to facts and evidence filed on time. Arguments based on facts filed on time were therefore to be admitted at every stage of the opposition and opposition appeal proceedings. See also chapter V.A.4.2.3l) to p). on the late submission of new arguments in appeal proceedings.

Taking a similar line in **T 861/93**, the board ruled that **decisions** referred to by a party in support of its arguments were never citations which, under Art. 114(2) EPC 1973, could be rejected as being late. Decisions to which a party referred in support of its arguments should be regarded as part of these arguments and should not be rejected as being filed late (doubted in **T 1914/12**).

In **T 131/01** (OJ 2003, 115) the board considered that the reasons why, in the opponent's view, the skilled person would obviously have arrived at the claimed subject-matter with the aid of a particular DE citation constituted a new argument. This document had been **cited and analysed in the notice of opposition** and its content therefore did not constitute new facts. The board in **T 2238/15** similarly took the view that a newly submitted objection of a lack of inventive step over two citations already on file was at best a new argument. Since the contents of those citations, in so far as they were relevant for claim 1

as granted and the additional features according to the first auxiliary request, had already been analysed in the notice of opposition, they were not new facts.

The board in **T 1448/09** observed that, while reference to **common general knowledge** could be an argument, whether that knowledge actually existed was a question of fact.

According to **T 1553/07** arguments also included statements intended to rebut facts which had already been put forward (including evidence). In oral proceedings before the opposition division, the patent proprietor explained why, in its opinion, the public prior use claimed by the opponent had not been established beyond all doubt by the evidence which had been submitted late. The board did not regard the disputing of the prior use claimed by the opponent as constituting the presentation of new facts.

In **T 710/15**, the opponent raised during oral proceedings before the opposition division a new objection under Art. 100(c) EPC. This ground for opposition had been previously validly invoked. The board held that in the case at issue the new objection did not introduce new facts or evidence, but merely a new argument.

According to the board in **T 1914/12**, a "fact" was to be understood as a piece of (allegedly) factual information or a circumstance on which a party based its case, whereas an "argument" was a contention that it based on one or more such facts and that supported the ground it was invoking (see also **T 2086/21**). The board gave the example of an opponent objecting that a claim lacked novelty over the disclosure in a particular paragraph of a prior art document: the ground invoked would then be lack of novelty (i.e. an assertion that the claimed subject-matter was part of the prior art), and that ground would be based on the argument that the claimed subject-matter was disclosed in the cited paragraph of the document; the fact on which that argument, meanwhile, was based would be the document's wording, a translation or copy of the document being filed as (a piece of) evidence. While a distinction was sometimes made in the case law between an "argument" and a "line of argument", the board it could see no legal basis in the EPC for treating an isolated argument differently from a set of arguments.

In **T 2053/13** the appellant's (opponent's) inventive step assessment starting from the teaching of document D3 was first presented on the day of the oral proceedings before the opposition division. Document D3 itself had been filed with the notice of opposition; it was however not presented as the closest prior art, but mentioned only in a footnote for a marginal issue. The board recalled that according to **G 4/92** (OJ 1994, 149), arguments are reasons based on facts and evidence which have already been put forward. The board considered that rather than merely presenting an additional argument in support of a chain of reasoning already known in an established factual context, the appellant had changed its case. The submission in question introduced a whole new chain of reasoning based on the allegation that document D3 was a promising springboard to the invention as claimed. Thus, the appellant's submission related to a new alleged fact. Filing a piece of evidence did not mean that any alleged fact or objection potentially derivable from that evidence was also introduced into the proceedings.

In **T 1875/15**, which concerned the admission of an objection under Art. 100(c) EPC raised for the first time during oral proceedings before the board, the board endorsed the finding in **T 1914/12** that a board has in principle no discretion not to admit late-filed arguments. However, it also noted that if a late-filed objection included new allegations of fact, the board had discretion under Art. 114(2) EPC not to admit it into the proceedings (see also **J 14/19**; for more details see chapter V.A.4.2.3l) to p)).

4.6.2 No legal basis for disregarding late-filed arguments in opposition proceedings

According to the case law of the boards of appeal, Art. 114(2) EPC provides no legal basis for disregarding late-filed arguments. Art. 114(2) EPC refers to late-filed facts and evidence ("Tatsachen und Beweismittel" in German; "faits et preuves" in French), but not legal submissions and arguments (**T 861/93**, **T 386/01**, **T 150/09**). Late-filed arguments cannot therefore be disregarded on the grounds that they were submitted for the first time at the oral proceedings (**T 92/92**, **T 704/06**). In **T 710/15** the board confirmed that Art. 114(2) EPC was not a basis for disregarding arguments not submitted in due time. For the admission of new arguments before the boards of appeal, see also **T 1914/12** citing and disagreeing with **T 1069/08** and **T 1621/09**, and chapter V.A.4.2.3l) to p).

In **T 92/92** the board held that the EPC in the English version made a clear distinction between "facts and evidence" on the one hand and "arguments" on the other in Art. 114(1) EPC and that Art. 114(2) EPC did not refer to arguments. Art. 114(2) EPC was to be interpreted such that the parties' right to argue their case was not unduly restricted.

Under R. 116 EPC (R. 71a EPC 1973) new facts and evidence do not need to be considered after the time stated in the summons, unless they are admitted on the grounds that the subject of the proceedings has changed. R. 116 EPC, and Art. 114(2) EPC on which it is based, refer to late-filed facts and evidence but not to new arguments, which can be made at any stage in the proceedings. In accordance with the jurisprudence, therefore, new arguments in support of facts already adduced have to be considered in accordance with R. 116 EPC, even if presented after the date specified in the summons, and equally cannot be rejected by citing Art. 114(2) EPC (see the following decisions issued in relation to R. 71a EPC 1973: **T 131/01**, OJ 2003, 115; **T 926/07**, **T 1553/07**).

In **T 2238/15** too, the board (citing **T 92/92**) endorsed the view that the EPC distinguished clearly between "facts and evidence" and "arguments" and provided no basis for refusing to admit late-filed arguments. The discretion under Art. 114(2) EPC to disregard late-filed facts and evidence therefore did not extend to arguments, and that applied equally to new arguments not submitted until after the date fixed in the summons to oral proceedings (see R. 116 EPC).

5. Amendments to claims, description and drawings in opposition proceedings

5.1. Admissibility of amendments

5.1.1 Principles

The extent to which amendments may be admissible in opposition proceedings was discussed in **T 1149/97** (OJ 2000, 259). Once a decision to grant has been issued, the European examination procedure is closed and its results become binding on the applicant and the EPO in that no further amendments may be made. However, if an opposition is filed, the patent in suit may be amended. Such amendments are not left to the general discretion of the patent proprietor, since opposition proceedings are not a continuation of the examination proceedings (**G 1/84**, OJ 1985, 299). However, the patent proprietor may, pursuant to **R. 80 EPC** (R. 57a EPC 1973) – without prejudice to R. 138 EPC (R. 87 EPC 1973) – react to the opponent's objections by amending the description, claims and drawings, provided that the amendments are **occasioned by the grounds for opposition** specified in Art. 100 EPC, even if the respective ground has not been invoked by the opponent (see also in this chapter IV.C.5.1.2). In addition, amendments occasioned by national rights of earlier date are admissible pursuant to **R. 138 EPC** (see also in this chapter IV.C.5.1.3).

According to the board in **T 1149/97**, those regulations could be seen to reflect the formal aspects of a procedural cut-off effect associated with the grant of a patent in the opposition phase. The grant of a patent did not constitute a general cut-off point in that the patent had to be defended in unamended form. However, only amendments as reactions to actual or possible grounds of opposition or to conflicting earlier national rights were admissible (R. 80 and 138 EPC). Possible substantive cut-off effects for amendments after grant could, in the board's view, only be based on Art. 123(3) EPC (see also chapter II.E.2.3.2).

Since the EPC does not provide for surrender of the patent in opposition proceedings, patent proprietors can merely request that the patent be amended. In requesting that the patent be maintained in a limited form, a patent proprietor is merely attempting to delimit it against objections raised by the EPO or the opponents, and **does not**, by virtue of such limitation, **irrevocably surrender subject-matter** not covered by the request as limited. In principle, the patent proprietor is free to withdraw such a request at any time during opposition proceedings or to amend it subsequently and, in particular, to resume a defence of the patent as granted, unless this would constitute an abuse of procedural law or the proprietor is prevented from doing so by the prohibition of reformatio in peius (see e.g. **T 123/85**, OJ 1989, 336; **T 296/87**, OJ 1990, 195; **T 445/97**; **T 473/99**; **T 699/00**; **T 880/01**; **T 794/02**; **T 934/02**; **T 1018/02**; **T 1213/05**; **T 1394/05**; **T 1150/11**; **T 385/15** and **T 43/16**, which refer to this principle as established case law).

Unlike R. 137(3) EPC (R. 86(3) EPC 1973), R. 80 EPC (R. 57a EPC 1973) does not specify the point in time up to which the proprietor may amend the description, claims and drawings under the requirements specified in this provision. The boards had from the beginning based their decisions on the principle that the proprietor has no right to have

amendments admitted at any stage of opposition proceedings and this did not change by the introduction of R. 57a EPC 1973. The discretion of the opposition division with regard to late-filed amendments was however derived from different provisions of the EPC (including R. 116(2) and Art. 114(2) EPC). In **R 6/19** the Enlarged Board held that Art. 123(1) EPC is the basis for the EPO's discretion whether or not to admit claim requests in opposition proceedings (see also **T 966/17**, which cited Art. 123(1), first sentence, EPC, read together with R. 79(1) and 81(3) EPC; **T 256/19**, which referred to **R 6/19** and **T 966/17** and cited Art. 123(1) EPC in conjunction with R. 79(1) and/or 81(3) EPC and, in the case of arranged oral proceedings, with R. 116(2) EPC). In **T 754/16** the board emphasised that for the opposition division to have discretion not to admit new requests, these had to be late-filed in the first place. For details regarding the late submission of amendments in opposition proceedings, see in this chapter IV.C.5.1.4.

In **T 966/17** the board made it clear that parties to adversarial proceedings were not entitled to "detailed guidance" from the decision-making department on how to overcome a deficiency at issue. Instead it was incumbent on each party to react adequately to the submissions of the opposing party.

In **G 1/10** (OJ 2013, 194), the Enlarged Board held that R. 140 EPC is not available for correcting patents, including during opposition or limitation proceedings. However, it is always open to a patent proprietor to seek to amend their patent during opposition or limitation proceedings and such an amendment could remove a perceived error. Such an amendment would have to satisfy all the legal requirements for amendments including those of Art. 123 EPC (see also full summary of **G 1/10** in chapter III.L.2.1.; but see also **T 657/11**, summarised in chapter II.E.4.5).

5.1.2 Amendments occasioned by a ground for opposition – Rule 80 EPC

a) General

Pursuant to R. 80 EPC (R. 57a EPC 1973) the claims of a granted patent may be amended, provided that the amendments are occasioned by a ground for opposition under Art. 100 EPC, even if that ground has not been invoked by the opponent. Prior to the introduction of R. 57a EPC 1973 (entry into force on 1 June 1995, see decision of the Administrative Council, OJ 1995, 9), it had already been clarified in the case law that the EPC did not guarantee a patent proprietor the right to have proposed amendments admitted in opposition (appeal) proceedings. Whether to allow such amendments was to be decided by the department concerned exercising due discretion. Amendments could be refused if they were neither appropriate nor necessary (see e.g. **T 406/86**, OJ 1989, 302). For later decisions referring to these criteria within the framework of R. 57a EPC 1973 (R. 80 EPC), see e.g. **T 17/97**, **T 313/98**, **T 994/03**, **T 263/05**, OJ 2008, 329, **T 323/05**, **T 340/10**, **T 2063/15**.

As underlined in **T 256/19** with reference to the notes on the introduction of R. 57a EPC 1973 (notice dated 1 June 1995, OJ 1995, 409), R. 80 EPC addresses the purely substantive aspects of the proprietor´s entitlement to amend the patent, and does not specify the point in time up to which amendment is allowed (on "Late submission of

amendments" and in particular discretion regarding their admittance, see chapter IV.C.5.1.4 below). In the board's view, the wording of R. 80 EPC (in particular "may be amended, provided that") meant that claims may be amended if the amendments are occasioned by an opposition ground; they may not be amended otherwise. The requirement of R. 80 EPC was therefore similar to that of Art. 123(2) EPC (see in particular "may not be amended in such a way that"). Accordingly, the board considered R. 80 EPC to be a **non-discretionary provision** with a substantive requirement that relates to the **allowability** of a patent as amended rather than to admissibility (see also **T 123/22**).

According to **T 323/05**, which concerned a request to adapt the description, R. 57a **EPC** 1973 (R. 80 EPC) established a limit to the amendments which can be made to the patent in suit. Art. 84 and R. 57a EPC 1973 were the two provisions which have to guide the patent proprietor when invited by the opposition division to adapt the description. In other words, the amendments have to be **appropriate and necessary**, and nothing more.

In **T 750/11** the board observed that amendments under R. 80 EPC were formally admissible so long as they could be regarded as a **serious attempt** to overcome a ground for opposition (see also **T 123/22**). So an amendment further limiting the subject-matter of an independent claim complied with R. 80 EPC in formal terms. Whether it actually overcame any ground for opposition was a separate matter to be settled as part of the ensuing substantive examination. A serious attempt was acknowledged in e.g. **T 1175/11** and **T 1797/16**. For a counter-example, see **T 1833/15** (in which the amendment did not change the claimed subject-matter and so did not amount to a serious attempt). The board in **T 276/20** interpreted R. 80 EPC as requiring at least a **bona fide attempt** to overcome a ground of opposition, i.e. where it appeared at least plausible that the amendment may well change the claim scope and thus may potentially address objections under one or more grounds for opposition.

In **T 993/07** the board recalled that R. 80 EPC is lex specialis for amendments during opposition proceedings, analogous to R. 137 EPC for amendments during examination proceedings. The board interpreted the rule to mean that in opposition proceedings the proprietor's right to amend the patent, e.g. the claims as granted, is limited to making amendments in order to overcome an objection based on a ground for opposition as specified in Art. 100 EPC, thereby possibly **avoiding revocation** of the patent (confirmed in **T 21/16** and referred to as established case law). In line with this interpretation, the board stated that opposition proceedings were not to be understood as an opportunity for the proprietor to fix any, from their perspective, shortcomings in the patent, such as an insufficient number of independent and/or dependent claims in order to define all commercially valuable embodiments. The fact that the addition of one or more independent and/or dependent claims may improve the fall-back positions in any future revocation proceedings before a national court was clearly not the scope and purpose of either R. 80 EPC or the opposition procedure (confirmed in **T 1764/17**). The board also observed that a limitation procedure pursuant to Art. 105a EPC was not subject to the same requirement as set out in R. 80 EPC. In **T 2444/18** the board held that the adaptation to the reduced number of preceding claims resulting from other amendments was however normal practice and could not infringe R. 80 EPC since this adaptation did not result in a

change of content but merely preserved the still applicable back-references. Moreover, the board noted R. 80 EPC concerns amendment(s) of a European patent, i.e. a comparison of an amended version to the granted version rather than a comparison between different amended versions.

In **T 359/13** the board stated that R. 80 EPC did not place any restriction on the form of amendments a patent proprietor could (seek to) make to address objections raised (here: reformulating the product claim as a use claim). On the contrary, a proprietor was free to draft proposed amendments to the specification in any manner considered appropriate. Even in the situation considered in **G 1/99** where the requirements of the principle of no reformatio in peius imposed restrictions on the manner in which the claims may be amended, an opponent as appellant had no right to prescribe the form of the amendments which the patent proprietor as respondent may make (see **T 23/04**). In **T 123/22** the board reaffirmed the view of the board in **T 359/13**, adding with reference to **T 750/11** that the sole basis for assessing the R. 80 EPC requirement was whether the amendment was occasioned by a ground for opposition. In assessing whether an amendment of claims within the meaning of R. 80 EPC was occasioned by a ground for opposition, it was therefore irrelevant whether the features added to an opposed claim were derived from dependent claims or from the description.

In **T 1285/15** the board underlined that the very language of R. 80 EPC ("... occasioned by a ground for opposition ...") made clear that the situation **at the time of the amendment** needed to be considered when compliance with this provision was examined. The fact that, as in the case in hand, the claims were amended again at a later stage and that, as a consequence, the deletion of the sentence was no longer required, did not lead to the conclusion that the amendment of the description retroactively contravened R. 80 EPC. The original amendment could still be said to have been occasioned by a ground for opposition.

In **T 946/16** the board found that the opponents' objection was based on a misinterpretation of R. 80 EPC. The amendments referred to in this rule were not ones made to an earlier version differing from the patent as granted. The result of interpreting R. 80 EPC that way would be incompatible with the spirit and purpose of the EPC. Among other things, it would make it impossible for the patent proprietor ever to overcome a clarity objection to an amendment which was itself in line with R. 80 EPC.

b) Correction of errors

In **T 2450/17** the patent specification contained an incorrect reference to the prior art as a result of an amendment during the grant proceedings. At the oral proceedings before the board, the appellant submitted an amended paragraph from which the inaccurate information had been deleted. As to whether the contested amendments were admissible under R. 80 EPC, the board pointed out that the case law had recognised that references to relevant prior art as defined in R. 42(1)(b) EPC could be added at a later stage without this necessarily being deemed an inadmissible extension of the subject-matter of the application. However, such references designed to delimit the relevant prior art should not be incorrect or misleading, otherwise they could indeed alter the subject-matter of the

patent. Remedying inaccuracies of this kind thus did not contravene Art. 123(2) EPC; on the contrary, doing so was appropriate and necessary for ensuring compliance with that provision. Deleting incorrect information about the prior art from which the patent specification was to be distinguished was thus appropriate for addressing the ground for opposition under Art. 100(c) EPC. The board also concluded that it was wrong to say that any amendment to an incorrect reference to the prior art permitted under R. 80 EPC (as it was occasioned by Art. 100(c) EPC) automatically constituted a breach of Art. 123(3) EPC. It noted that R. 80 EPC was satisfied if the patent documents were amended to overcome a potentially relevant ground for opposition and that, in the case in hand, the scope of protection had not been extended.

In **T 2444/18** the board held that the fact that there was an error in certain amended claim requests could not be used to prevent the patent proprietors from stating the back-references correctly in another claim request. R. 80 EPC did not apply to such a situation as it concerned amendment(s) of a European patent, i.e. a comparison of an amended version to the granted version rather than a comparison between different amended versions. A different understanding of the legal framework would create a legal asymmetry. On the one hand, any amended text would have to comply with all the requirements of the EPC. On the other hand, any subsequent amendments of that text could be allowed only if they were prompted by a ground for opposition.

c) Amendments intended to remedy a lack of clarity (Article 84 EPC)

Objections to the clarity of claims or any consequent requests for amendment are only relevant to opposition proceedings in so far as they can influence the decisions on issues under Art. 100 EPC or arise in relation to the subject-matter to be amended as a consequence of such issues (**T 127/85**, OJ 1989, 271).

According to the established case law of the boards of appeal, Art. 84 EPC is an EPC requirement that has to be taken into account in opposition proceedings whenever the patent proprietor files any amendments (within the limits set in **G 3/14**, OJ 2015, A102; see in this chapter IV.C.5.2.2). However, Art. 84 EPC is not itself a ground for opposition under Art. 100 EPC. Irrespective of how the granted claims are formulated, and be they dependent or independent, an opposition cannot be lodged on the basis that they lack clarity (**T 23/86**, OJ 1987, 316; **T 565/89**; **T 89/89**; **T 16/87**, OJ 1992, 212; **T 1835/08**; **T 1855/07**). The board in **T 89/89** followed the findings in decision **T 295/87** (OJ 1990, 470) according to which amendments during opposition proceedings should only be considered as appropriate and necessary in the sense of R. 57(1) and 58(2) EPC 1973 and therefore admissible if they can fairly be said to arise out of the grounds of opposition (confirmed in **T 792/95**)**.**Now, "occasioned by a ground for opposition" is a requirement under R. 80 EPC (see e.g. **T 2391/18**).

In **T 2122/17** the board agreed with the parties that a lack of clarity under Art. 84 EPC arose from granted claim 8 because it contained an option that conflicted with a feature in granted claim 1. However, it considered that granted claim 8 also fell foul of the requirements of Art. 83 and 100(b) EPC. Deleting claim 8 was therefore justified on the basis of Art. 83 and 100(b) EPC and so by a ground for opposition. As provided in

R. 80 EPC, the ground for opposition (here: Art. 100(b) EPC) did not have to have been invoked by the opponent.

In **T 2391/18** the reason for the alleged obligation to remove an inconsistency by adapting the description to the wording in the claim was to be seen in a possible lack of support of the claims by the description within the meaning of Art. 84 EPC. However, the board held that as Art. 84 EPC was not a ground for opposition, such a further amendment to the description would not be "occasioned by a ground for opposition" within the meaning of R. 80 EPC. For this reason alone it was questionable whether such a (hypothetical) amendment would be allowable.

d) Filing of new dependent or independent claims

(i) Filing of new dependent claims (sub-claims)

As explained in **T 829/93** and **T 317/90**, the addition of a dependent claim is not a response to an objection that the claimed subject-matter is not patentable because it neither limits nor amends the subject-matter claimed in the relevant independent claim. The fact that dependent claims can serve as an important safety net should the corresponding independent claim ultimately be refused does not render it legitimate to add them to a remaining, broader independent claim in opposition proceedings. See also **T 313/98**, which cited **T 829/93** in the context of R. 57a EPC 1973.

In **T 340/10**, the board reiterated that, in accordance with R. 80 EPC and the boards' settled case law, amendments to the text of a granted patent during opposition proceedings were considered appropriate and necessary, and so admissible, only if they were aimed at overcoming a ground for opposition under Art. 100 EPC (see e.g. **T 317/90**, **T 794/94**, **T 674/96**). In line with earlier case law, it explained that adding dependent claims was not, however, an answer to an objection that the claimed subject-matter was not patentable, because they neither limited nor amended the subject-matter of the related independent claim and so had no effect on its scope. It therefore considered the amendments to contravene R. 80 EPC.

(ii) Filing new independent claims

In **T 610/95** the board referred to **G 1/84** (OJ 1985, 299), which made it clear that the opposition procedure was not designed to be an extension of the examination procedure. It would, in the board's opinion, contravene the principles set out in **G 1/84** if it was considered admissible to amend the text of a granted patent during opposition proceedings, while maintaining the sole independent claim under opposition, by incorporating an additional new independent claim which as such had no counterpart in the granted patent. See also **T 2063/15** (summarised below).

In **T 223/97** the board confirmed that the addition during opposition proceedings of one or more independent claims while maintaining the main claim in question could not be considered to be a restriction to the main claim in order to meet the ground for opposition raised against it. However, the replacement of one independent claim as granted by

several, for example two, independent claims each directed to a respective specific embodiment covered by the independent claim as granted was admissible if the replacement was occasioned by grounds for opposition. See also **T 428/12**.

Referring to the above decisions, the board held in **T 181/02** that only **in exceptional cases** could the replacement of a granted single independent claim by two or more independent claims be occasioned by a ground for opposition, for example where a granted independent claim covered two specific embodiments. Such a situation might also arise if two granted dependent claims (e.g. claims 2 and 3) were linked in parallel to a single independent claim (claim 1). Then the filing of two independent claims (e.g. including the features of claims 1 and 2, and 1 and 3) might be possible (moreover thereby decreasing the number of claims). However, it was normally sufficient for the patentee to remain with a single independent claim solely by modifying the granted claim once, i.e. by adding one or more features to the granted single independent claim. See also **T 1689/12**; see further **T 1810/14**, where the board defined a further situation in which the replacement of a granted sole independent claim by two independent claims may be admissible. In **T 1764/17** .the board noted an exception could arise if two granted dependent claims were linked in parallel to a single independent claim. Then the filing of two independent claims including each one of the two parallel claim combinations might be possible, thus allowing separate fragments of the scope of protection afforded by the patent as granted to be retained. However, this exception did not apply to the addition of an independent claim directed at an aspect of the invention that was not included in the granted set of claims.

Citing the above case law, the board in **T 263/05** (OJ 2008, 329) added that, when examining the amendments, it did not have to decide whether the ground for opposition would occasion the replacement of a granted single independent claim by two or more independent claims only in "exceptional cases". Rather, it had to be asked in each individual case whether the proposed amendments were an **appropriate and necessary** response designed to avoid revocation of the patent and could thus be regarded as occasioned by the grounds for opposition. See also **T 428/12**, **T 2063/15** and **T 431/22** (summarised below).

In **T 937/00** the board saw **no objection in principle** to a patentee amending its claims in response to an opposition so that they comprised several independent claims directed to different subject-matters originally covered by a single generic claim of a given category, when such claim could not be maintained. However, the board noted that the filing of multiple independent claims directed to different inventions might **unduly complicate and delay** the opposition procedure, in particular when this filing was followed by a series of further amendments. An efficient and possibly complete examination of the opposition might for instance become virtually impossible if subsequent amendments were proposed in a piecemeal way rather than addressing all the objections raised by the other party as soon as these objections arose. See also **T 2290/12**, in which the board considered it legitimate to seek to cover parts of an initially granted claim later found by the opposition division to lack inventive step by including them in a series of independent claims so long as this did not amount to an abuse of procedure and the number of independent claims was not unreasonably high (see also **T 123/22**).

In **T 1/05** the board did not regard the introduction of product-by-process claims as an amendment occasioned by a ground for opposition. The submission of such claims demonstrated that these amendments were not directed to addressing a ground for opposition but were intended to compensate for the effects of an amendment that had been made to address such a ground, namely deletion of the product claims.

In **T 2063/15** the request at issue comprised two independent claims. However, whilst claim 2 was based on a combination of claims 1 and 9 as granted, claim 1 was based on a combination of claims 1 and 2 as granted and also additional features taken **from the description**. The board explained that, with the subject-matter of claim 1 as granted having been found not to be novel, one or more independent claims based on a combination of claim 1 as granted with features of granted claims dependent upon claim 1 could be understood to be occasioned by the ground for opposition under Art. 100(a) EPC. However, with reference to **G 1/84** (OJ 1985, 299), **T 610/95** and **T 223/97**, the board held that the inclusion of the additional independent claim 1 was no longer simply occasioned by a ground for opposition, since this ground was already addressed through the filing of independent claim 2; the additional independent claim 1 furthermore introduced claimed subject-matter which had no counterpart in the claims of the granted patent.

In **T 431/22** the board decided that R. 80 EPC did not set out any requirements for how amendments had to be made in order to overcome a ground for opposition. Amendments that were necessary and appropriate to overcome a ground for opposition were "occasioned" within the meaning of R. 80 EPC. It was admissible to replace one independent claim with several independent claims in so far as their subject-matter was limited or amended as compared with the granted claim (see also **T 123/22**). However, the board emphasised that a line had to be drawn in cases where the replacement of an independent claim appeared to be an attempt to prolong the procedure up to grant or some other form of procedural abuse. In the case in hand, the original independent claims 1 and 14 were replaced by independent claims 1 to 4 and additionally restricted so that they essentially constituted combinations of the granted independent claim 1 and its dependent claims. The board could not see any abuse of procedure in this.

5.1.3 Amendments occasioned by national prior rights

In **T 15/01** (OJ 2006, 153) the board made it clear that the general purpose of R. 57a EPC 1973 (R. 80 EPC) was to allow amendments only where they were made to overcome an objection against the validity of the European patent. It followed from the reference to R. 87 EPC 1973 (R. 138 EPC) that, within the framework of the centralised opposition procedure before the EPO, amendments were also to be allowed where the patentee intended to overcome a possible ground of invalidity which only existed in respect of a particular contracting state. Thus, R. 57a EPC 1973 was not infringed by the formulation of a separate set of claims for a contracting state in which, due to a reservation made under Art. 167(2)(a) EPC 1973, certain product claims as granted would be considered invalid or ineffective.

5.1.4 Timeframe for filing amendments

Unlike R. 137(3) EPC (R. 86(3) EPC 1973), according to which no amendment may be made without the consent of the examining division other than in the circumstances set out under paragraph (2) of that provision, R. 80 EPC (R. 57a EPC 1973) does not specify a point in time up to which the proprietor may amend the description, claims and drawings in accordance with the requirements of this provision.

According to the case law of the boards of appeal, however, the proprietor has no right to have amendments admitted at any stage of the opposition proceedings that it chooses, such as during oral proceedings, especially not without the need to give good reasons for such late filing. The right to file amendments in the course of proceedings is not unlimited in time and proposed amendments may be disregarded in particular if submitted late in the proceedings (**T 153/85**, OJ 1988, 1; **T 406/86**, OJ 1989, 302; **T 295/87**, OJ 1990, 470; **T 132/92**, **T 382/97**, **T 796/02**, **T 1253/09**).

The board in **T 500/15** also held that while there was no legal basis for refusing to admit a request merely because it had been filed after a point in time specified by the opposition division, the general admissibility of amendments did not mean that amendments always had to be admitted.

5.1.5 Discretion to admit or not admit amendments

The boards have derived the principle of discretion of the opposition division to admit or not admit amendments from different legal provisions. Early decisions derived the discretion of the opposition division from Art. 101(2) EPC 1973 read together with R. 57(1) and 58(2) EPC 1973 (R. 79(1) and R. 81(3) EPC), see e.g. **T 406/86**, OJ 1989, 302; **T 295/87**, OJ 1990, 470, **T 132/92**. The boards have also derived this discretion from R. 116 EPC, from Art. 123(1) EPC in conjunction with R. 79(1) and 81(3) EPC, and from Art. 114(2) EPC (sometimes in conjunction with R. 116 EPC (R. 71a EPC 1973)).

a) Rule 116 EPC as legal basis

Rule 116(1) EPC establishes that when issuing the summons, a final date for making written submissions in preparation for the oral proceedings shall be fixed. R. 132 EPC does not apply in this context, meaning the usual provisions for extending time limits are not available for these submissions. New facts and evidence presented after that date need not be considered, unless admitted on the grounds that the subject of the proceedings has changed. R. 116(2) EPC imposes the same obligations on the applicant or patent proprietor when submitting new documents that meet the requirements of the EPC as R. 116(1) EPC imposes on the parties in submitting new facts and evidence. In **T 382/97** the board explained that R. 57a EPC 1973 (R. 80 EPC) and R. 71a EPC 1973 (R. 116 EPC) together governed the procedural preconditions for amendments to a patent by its proprietor before the opposition division. R. 57a EPC 1973 created the legal basis for amendment, and R. 71a EPC 1973 governed the deadline for doing so. It noted that amendments not complying with a time limit set under R. 71a EPC 1973 might nevertheless be admissible, if there existed good reasons for their late submission.

In **T 28/10** the board agreed with the view that the principle of free party disposition was restricted by the principle of focussed proceedings ("Konzentrationsgrundsatz", or the "principle of procedural concentration"). As far as amending sets of claims during opposition proceedings was concerned, this "principle of concentration" was enshrined in R. 116(2) EPC. Although this provision did not completely exclude subsequent amendment of a party's case by imposing strict time limits for making certain submissions, it was left to the decision-making body's discretion whether to consider such amendments.

The board in **T 1067/08** also found that R. 116 EPC gave the opposition division the discretionary power to refuse new requests for amendments if amended claims were presented after the final date fixed under that provision. This applied in particular to requests which were presented for the first time during the oral proceedings (e.g. **T 484/99**, **T 64/02**). The board noted the purpose of this provision was in particular to prevent parties from seeking unjustified procedural advantages by abusive tactics in disregard of procedural economy. Therefore, any amendment had to be carried out in the most expedient manner, which had to be established by the opposition division taking into account the interests of all parties (see also **T 382/97**, **T 1253/09**), and the power to refuse late requests had to be exercised by considering all relevant factors which arose in a particular case, taking into account inter alia whether there were good reasons for the late filing, whether the other parties were taken by surprise and whether new issues were raised by the amendments made (see also chapter IV.C.5.1.7 "Principles for the exercise of discretion by the opposition division").

Likewise in **T 688/16** the board held that Art. 114(2) EPC only provided a discretion to admit or not admit facts and evidence and that the discretion not to admit late-filed requests was conferred by R. 116(2) EPC. That discretion was conditional on a communication stating that grounds prejudiced the maintenance of the patent. In the case at issue, however, the opposition division had not issued any such negative communication but only one stating its provisional opinion that none of the grounds for opposition prejudiced maintenance of the patent as granted, and thus the board concluded the (non)-admittance of auxiliary request 3 was not at all within the discretion of the opposition division in the case in hand.

The board in **T 1662/21** agreed with the position set out in **T 688/16**, adding that this did not mean that any amendment submitted must be admitted. The opposition division first needed to establish whether amendments were indeed intended to overcome the objections, and whether they did so in a way that was appropriate and proportionate to the circumstances. The division thus still had discretion, but had to exercise it differently from when deciding admission of amendments filed after the R. 116 EPC date that were not justified by a change of the subject of the proceedings.

In **T 1332/21** the board stated that the discretion of the opposition division whether to admit amended claims during oral proceedings was apparent from R. 116(2) EPC referring to the last two sentences of R. 116(1) EPC that such amendments "need not be considered". For criteria for the use of this discretion, the board referred to the Guidelines, E-III, 8.6 – March 2021 version (now in E-VI, 2. – April 2025 version). For the principles for the use of this discretion, see also below chapter IV.C.5.1.7.

b) Article 123(1) EPC in conjunction with Rules 79(1) and 81(3) EPC as legal basis

In **T 755/96** the board held that the power of the opposition division to accept or refuse late-filed new facts or evidence was governed by Art. 114(2) EPC 1973, the discretionary power to refuse new requests for amendments by Art. 123 EPC 1973 and the corresponding implementing regulations, i.e. R. 57a EPC 1973 (R. 80 EPC) (see also **T 1903/13**, which cites Art. 123(1) EPC as the legal basis for the discretion of the boards in opposition appeal proceedings). Several recent decisions have likewise considered Art. 123 EPC (albeit in conjunction with R. 79(1) and 81(3) EPC) to be the legal basis for this discretion: **T 966/17**, **R 6/19** and **T 256/19**.

In **T 966/17** the board considered that the opposition division's discretion in deciding whether to admit amended claims followed in essence from Art. 123(1) EPC (first sentence) in conjunction with R. 79(1) and 81(3) EPC for the reasons set out below: Art. 123(1) EPC provided that a European patent application or a European patent could be amended in proceedings before the EPO in accordance with the Implementing Regulations. In opposition proceedings, R. 79(1) EPC allowed the patent proprietor to amend the description, claims and drawings within a period set by the opposition division. Later amendments, by contrast, were admissible only at the opposition division's discretion, as was clear from R. 81(3) EPC for instance ("shall, where necessary, be given the opportunity"). See also **T 1081/20**.

In **R 6/19** the Enlarged Board held that the basis for an opposition division's discretion to admit or not admit claim requests was Art. 123(1) EPC. It observed that the first sentence states the general possibility to carry out amendments in patent applications and in patents, but only in accordance with the provisions of the Implementing Regulations (R. 81(3) EPC for opposition proceedings). It also noted that the second sentence of Art. 123(1) EPC explicitly provides applicants with a right to at least one opportunity to amend an application and remarked that, were the first sentence of Art. 123(1) EPC to mean that the patent proprietor or applicant always has the right to amend their patent or application, the second sentence of Art. 123(1) EPC would be redundant. The Enlarged Board pointed out that the right, found in the second sentence of Art. 123(1) EPC, to at least one opportunity to amend, does not extend to a patent proprietor in opposition proceedings, where the opposition division has the discretion, given in the first sentence of Art. 123(1) EPC, not to admit such requests. In such proceedings an opportunity to amend is to be given only where necessary (R. 81(3) EPC). The Enlarged Board saw no need to answer the question whether Art. 114(2) EPC, too, provides a basis for refusing requests.

In **T 256/19** it was the board's view that discretion to disregard an amended version of a patent in inter partes proceedings could only emanate from Art. 123(1) EPC in conjunction with R. 79(1) and/or 81(3) EPC and, in case of arranged oral proceedings, with R. 116(2) EPC.

In **J 14/19** the Legal Board stated that Art. 123(1) EPC could serve as an additional legal basis besides Art. 114(2) EPC.

c) Article 114(2) EPC as legal basis

In many decisions the boards have relied on Art. 114(2) EPC (sometimes in conjunction with R. 71a EPC 1973 or R. 116 EPC as its implementing provision) as the legal basis for the opposition division's discretion to admit or disregard late-filed requests (see in particular **T 1105/98**, which cited the preparatory documents to R. 71a EPC 1973, without however distinguishing between paragraphs 1 and 2 of R. 71a EPC 1973; see also e.g. **T 4/98**, **T 811/08**, **T 66/12**, **T 1214/12**, **T 2385/12**, , **T 2332/15**, **T 44/17**, **T 350/17** and **T 879/18**). In **T 1855/13** a submission containing a claim request was explicitly considered to be a fact within the meaning of Art.114(2) EPC (see also **T 604/01** in which the patent as granted and the claims as amended were considered facts; and **T 1776/18** in which the board held a patent claim was to be regarded as a statement of technical facts in legal terms and thus qualified as "facts or evidence" within the meaning of Art. 114(2) EPC). See also the additional case law outlined in **T 1776/18**, point 4.5 of the Reasons, and **T 364/20**.

The board in **T 1776/18** highlighted examples of case law in which the opposition division's discretion not to admit claim requests was considered to have its legal basis in Art. 114(2) EPC specifically in conjunction with R. 116(1) EPC (see e.g. **T 1270/18**, **T 85/19**). It further observed there were also decisions in which Art. 114(2) EPC in conjunction with R. 116(2) EPC was considered to be the legal basis for not admitting amended claim requests (e.g. **T 2536/12**, **T 1758/15**). The board agreed with the case law according to which Art. 114(2) EPC constituted a legal basis for not admitting claim requests, concluding that in submissions containing claim requests which were explicitly or implicitly substantiated, factual elements were present. The presence of these factual elements allowed Art. 114(2) EPC to be relied on as a legal basis for disregarding claim requests which were not filed in due time (**J 14/19**). Applying Art. 114(2) EPC to amended claim requests and hence to the submissions of both opponents and patent proprietors also ensured that the parties were treated equally and according to the same criteria, which guaranteed equality of arms. See also **T 364/20**, **T 1733/22**.

For the contrary view according to which Art. 114(2) EPC cannot serve as a basis for the opposition division's discretion to admit or refuse requests, see **T 755/96**, **T 281/99**, **T 688/16**, **T 754/16**.

In **T 281/99** the board was not aware of any article or rule under the EPC nor of any case law which would oblige the opposition division to refuse new claims submitted during the proceedings irrespective of their contents and the reasons for their late filing. It stated that Art. 114(2) EPC did not relate to the submission of amended claims, but noted that even this article did not affect the opposition division's discretion to accept new facts and evidence which were not submitted in due time.

In **T 754/16** the board stated that Art. 114(2) EPC did not provide a basis for disregarding the auxiliary requests filed during the oral proceedings before the opposition division, since, firstly, this article did not apply to late-filed requests in the form of amended claims, but only to late-filed facts and arguments. Secondly, the auxiliary requests in the case in

hand were filed in due time, as a direct and immediate response to the opposition division's changed opinion and since the proprietor had no earlier opportunity to react thereto.

5.1.6 Concept of "late-filed" and implications for discretion

In **T 487/13** the board held that, by deciding not to admit auxiliary requests 4 to 6 directly after late-filed document D10 was admitted into the proceedings, the opposition division did not respect the appellant's right to be heard, which was inextricably linked to the principle of fair and equal treatment of the parties. Since these new requests were filed in **direct response** to a change in the subject of the proceedings, they were submitted **in due time** and the opposition division had no discretion to disregard them.

Likewise, in **T 754/16** the opposition division had not admitted auxiliary requests 8 and 9, filed during oral proceedings, on a prima facie basis (referring to Art. 114(2) and R. 116 EPC). The board noted that this presupposed, in the first place, that the requests were late (confirming **T 273/04**). This was however not the case since filing the auxiliary requests was a **direct response to the opposition division's change of opinion** in the oral proceedings. Under R. 116(2) EPC, requests filed after the final date set for making written submissions can only then not be admitted if the patent proprietor had been notified of the grounds prejudicing the maintenance of the patent, which was not the case here. See also **T 586/16**.

In **T 966/17**, however, the board explained that, in opposition proceedings, R. 79(1) EPC allowed the patent proprietor to amend the description, claims and drawings within a period set by the opposition division. **Later amendments**, by contrast, were admissible only at the opposition division's discretion, as was clear from R. 81(3) EPC for instance. The board then considered that the opposition division's expression of a different opinion at the oral proceedings from the one provisionally set out in the communication accompanying the summons was not enough by itself to deprive it of that discretion and oblige it to admit whatever requests were filed at the oral proceedings. It was permissible for the decision on admitting new requests filed by the appellant in response to a new line of attack taken by the opponent on the basis of a newly filed document to take into consideration whether those requests were prima facie allowable or would anyway have to be refused owing to other objections already raised at a previous stage in the proceedings. See also **T 908/19** and **T 1523/22**, in which cases the boards considered that the respective auxiliary requests had been filed in due time in accordance with R. 79(1) EPC and that therefore the question whether they were "clearly allowable" was not relevant; no exercise of discretion was available to the opposition divisions on the issue of admissibility.

Another approach was taken in **R 6/19**. In this decision the Enlarged Board pointed out that the right, found in the second sentence of Art. 123(1) EPC, to at least one opportunity to amend, did not extend to a patent proprietor in opposition proceedings. It concluded that the opposition division had the discretion, given in the first sentence of Art. 123(1) EPC, not to admit such requests.

In **T 1776/18** the board analysed whether the concept of "not submitted in due time" in Art. 114(2) EPC relied on fixed criteria, such as a certain point in time in the proceedings,

or, alternatively, on relative criteria, such as individual procedural developments. It spoke against relying on relative criteria. It observed inter alia that, for appeal proceedings, the RPBA implemented Art. 114(2) EPC in a manner which in principle was binding (**T 1042/18**) and relied on fixed criteria in order to determine whether a board had the discretion not to admit a certain submission. In the board's view this approach was also preferable for opposition proceedings as an approach relying on relative criteria tied to individual procedural circumstances had the grave disadvantage that the opposition division's discretionary power was then not clearly and predictably delimited by the law itself. As to the interpretation of R. 116(2) EPC when applied to opposition proceedings, the board did not share the views expressed in **T 754/16** that requests filed after the final date set for making written submissions could only then not be admitted if the patent proprietor had been notified of the grounds prejudicing the maintenance of the patent (see also **T 1171/20**). The primary purpose of inviting the patent proprietor to file amended claim requests under R. 116(2) EPC was to expedite the opposition proceedings, and to prevent the patent proprietor from filing such requests after the date specified in R. 116(1) EPC. The board found that R. 116(2) EPC did not limit the opposition division's discretionary power under Art. 114(2) EPC and R. 116(1) EPC. In the board's opinion, as a rule, this discretionary power did not depend on the contents of the opposition division's communication under R. 116(1) EPC. However, if the opposition division invited the patent proprietor to file an amended claim request to address a specific objection and the patent proprietor complied with this invitation by filing the required amendments by the date set under R. 116(1) EPC, the opposition division's discretion not to admit that claim request may effectively be reduced to zero.

In **T 921/21** the board emphasised that, even if the approach taken in **T 1776/18** were followed, the opposition division had to exercise its discretion based on the correct criteria. In the case in hand, however, the opposition division had taken into account at least one improper criterion, namely that the requests had been filed so unusually late as to justify a departure from the principle usually applied of admitting requests filed in response to facts filed late by the other party. The board pointed out that the assumption that the patent proprietor had taken note of the opponent's written submission before Christmas, and thus prior to the EPO's communication of the submission on 20 January 2021, was speculative and disputed by the appellant. The division had therefore exercised its discretion in a flawed manner.

In **T 364/20** auxiliary requests were filed after expiry of the time limit set under R. 79(1) EPC and before expiry of the time limit set under R. 116(1) EPC. The board noted that under similar circumstances, the board in **T 221/20** had found the auxiliary requests to be admissibly raised. However, in the view of the board in the present case, it could not be held that any claim request submitted after the expiry of the time limit set under R. 79(1) EPC and before the expiry of the time limit set under R. 116(1) EPC was automatically filed in due time and thus was admissibly raised. It depended on whether it was submitted as a direct and timely response to a change of the subject of the proceedings introduced by the opponent or the opposition division. The board noted with reference to **T 966/17** that opposition divisions had the discretion to not admit any late-filed claim request if a decision on admittance was required. Hence, the boards had the

discretion to consider a late-filed claim request not to have been admissibly raised (see also chapter V.A.4.2.2c)).

5.1.7 Principles for the exercise of discretion by the opposition division

a) Criteria applicable at later stages of the proceedings – in general

The case law of the boards of appeal has confirmed the following criteria (as set out in the Guidelines E-VI, 2.2.3 – April 2025 version) that the opposition division should take into account when properly exercising its discretion under Art. 114(2) EPC or R. 116(1) or (2) EPC: prima facie allowability, procedural expediency, abuse of procedure, and the question as to whether the opponents could be expected to familiarise themselves with the amendment in the time available (see e.g. **T 491/09)**.

In **T 500/15** the board noted it was undisputed that such a discretionary decision had to be taken by applying the criteria recognised in the practice of the EPO. In the case in hand, the board agreed with the additional criterion identified by the opposition division of "the complexity of the amendments", and noted that the applicability of the examined procedural criteria had to always depend on their actual substantive effect.

In **T 2385/12** the board noted that instances where discretion may be exercised by a department of the EPO had not been formulated in a concrete manner since the particular way in which the discretion may be exercised was necessarily dependent on the specific circumstances of the case in hand.

In **T 1930/14** the opposition division, having considered the timing of the filing of the auxiliary request (which could have been filed earlier), its complexity and its prima facie allowability, did not admit the auxiliary request into the proceedings. The board was satisfied that the opposition division had exercised its discretion according to the right principles and in applying these principles had not exercised its discretion in an unreasonable way.

In **T 84/17** the board concluded that the opposition division had exercised its discretion in a reasonable way and had used the correct principles. The opposition division had correctly stressed that the auxiliary requests had been filed very late without appropriate justification. The underlying objections had been on file since the notice of opposition and their pertinence commented on in the annex to the summons. Moreover, the opposition division's decision not to admit the requests was not exclusively based on the unjustified lateness but also on the finding that the opponents could not be expected to deal with the specific restrictions of subject-matter introduced with these requests, i.e. the opposition division had also considered the substance of the amendments. In the board's opinion, if the arguments in the particular case showed that some criteria weighed so heavily that other criteria could not outweigh them, it was **not necessary to discuss all criteria**.

In **T 1617/20** the board held that using the criterion of prima facie allowability under Art. 123(2) EPC, to object for the first time at oral proceedings to a feature of the late-filed claim request (auxiliary requests 2) that was already present in higher-ranking claim

requests and had never been objected to before, not even when deciding on the allowability or admittance of those higher-ranking claim requests, went against the principles of fairness and good faith. The opposition division **should have used the same criteria** it had used when deciding on the admittance of auxiliary requests 1, which was also substantially identical to a previous request. Not doing so, and thus basing the decision as regards the two claim requests on different criteria, resulted in an inconsistent approach. The opposition division, had thus used the available criteria in an unreasonable way and its decision thus suffered from an error in the use of its discretion.

In **T 1081/20** the board noted that the admittance of the auxiliary request in question was at the opposition division's discretion pursuant to Art. 123(1) EPC in conjunction with R. 79(1) and/or R. 81(3) EPC. It stated that a board should overrule such a discretionary decision only if the wrong principles had been applied or if the decision had been taken in an unreasonable way. See also the settled jurisprudence in light of **G 7/93** (OJ 1994, 775), in chapter IV.C.5.1.8 and chapter V.A.3.4.1.

b) Prima facie allowability

In numerous decisions, the boards have considered that an opposition division's decision not to admit prima facie unallowable requests filed at a late stage of the proceedings was a proper exercise of its discretion (see e.g. **T 171/03**, **T 484/11**, **T 1737/12**, **T 108/14**, **T 2332/15**, **T 1710/18**, **T 1617/20**).

In **T 491/09** the division had regarded the request as prima facie overcoming the opposition grounds based on Art. 100(b) and (c) EPC, and, as was evident from the minutes of the oral proceedings, no clarity objections had been raised.

In **T 222/16** the board observed that the 3rd auxiliary request filed during oral proceedings at first instance in response to a change of the subject of the proceedings should have been admitted under R. 116(2) EPC. According to the established jurisprudence, the relevant criterion for deciding on the admissibility of late-filed requests was their prima facie allowability in view of the objection under discussion. This criterion had been fulfilled since the amendment in claim 1 was clearly suitable to overcome the objections under Art. 123(2) and (3) EPC. The convergence criterion relied upon by the division was of secondary importance in the context of objections under Art. 123(3) EPC.

In **T 586/16** the board acknowledged that prima facie allowability was normally the correct criterion to be applied; however, in the case in hand the opposition division should have admitted the auxiliary request, since it was a reaction to a change of mind by the opposition division during the oral proceedings.

In **T 2683/17** the board held that the opposition division, when admitting the 3rd auxiliary request filed at the oral proceedings, had exercised its discretion properly and according to the right criterion of prima facie allowability in considering that the amendments were prima facie suitable to overcome the Art. 123(2) EPC objection raised against the previous requests, and that further requirements, in particular compliance with Art. 84 EPC, were also prima facie met.

In **T 877/20** the board judged that the opposition division had exercised correctly its discretion to admit auxiliary request 4, taking the right principles into account. The board considered that the deletion of the method claims did not confront the opponents with new subject-matter and that auxiliary request 4 was prima facie allowable. Indeed the opposition division noted that auxiliary request 4 complied with R. 80 EPC and Art. 84, 123(2) and (3) EPC and overcame raised novelty objections.

The board in **T 849/22** stated the aim of the prima facie allowability criterion was to assess whether the admittance of late-filed amendments - which might change the subject of the proceedings with respect to the previous discussion of the case - was justified from the point of view of procedural economy. It found that assessing whether an independent claim of the request - which was unamended compared with the reply to the notices of opposition, which had been filed in a timely manner, and which was unaffected by and unrelated to the amendment made - was prima facie novel for the purpose of admittance represented an incorrect application of the prima facie criterion.

c) Procedural expediency and abuse of procedure

In general, the question whether an amendment is appropriate can only be answered on the basis of its content, i.e. after it has actually been submitted. To refuse any further amendment is only appropriate if it is evident after various unsuccessful amendments that the proprietor is not seriously trying to overcome the objections but is only delaying the proceedings (**T 132/92**; see also **T 623/12** and **T 1758/15**, which refers to **T 246/08**).

In **T 491/09** the board noted that firstly, due to the direct treatment of the third auxiliary request by the opposition division, instead of returning to written proceedings, a protraction of the proceedings was avoided and the respondent did not benefit from any further delay. Secondly, it was clearly the purpose of oral proceedings that all concerned were aware of the outstanding issues and what positions were taken on them, including those of the opposition division. Not allowing simple further amendments to resolve such issues would clearly run counter to this purpose. The board pointed out that the Guidelines in force at the time (E-III, 8.7 – 2010 version) made this clear by referring to the fact that if the opposition division found that some patentable subject-matter resulted from a limitation/amendment, it could even inform the proprietor of the fact and allow them an opportunity to submit amended claims thereon (see also in Guidelines E-III, 8.9 – April 2025 version). In view of the above, the board concluded that while the respondent needed some prompting to finally come up with this request to address the point under discussion, this did not amount to an abuse of proceedings by, nor to/an unwarranted advantage for the respondent.

In **T 28/10**, the patent proprietor had defended a limited set of claims in the written proceedings but reverted to the claims as granted at the oral proceedings. The opposition division had exercised its discretion not to admit the request on the basis that it considered its late submission to be an abuse of procedure and that the proprietor itself had conceded that it did not meet the Art. 54 EPC requirements. The board could not see any improper exercise of discretion in this.

In **T 2385/12**, too, the patent proprietor reverted back to the claims as granted during the oral proceedings before the opposition division. The opposition division admitted this request. The board held, that while there may be instances where reverting to the claims as granted at a late stage of opposition proceedings would be seen as an abuse of procedure, the present specific circumstances (Art. 123(2) EPC objection addressed, no evidence of a deliberate attempt to mislead the opponent) indicated this not to be so in this case. The board also did not accept the suggestion that there should be a point at which previous requests were surrendered prohibiting the return to this subject-matter. Providing concrete guidance on when requests could be filed was not foreseen within the EPC, particularly in view of the exercise of discretion provided in Art. 114(2) EPC. It would also be against the general principle that a surrender of a right cannot be presumed. See also **T 1770/16**.

In **T 368/16** the opposition division allowed the proprietor to file various auxiliary requests in the course of the oral proceedings. Its request IVa was however not admitted by the opposition division. The board held that by not admitting request IVa into the proceedings, the opposition division had exercised its power of discretion under R. 116(2) EPC in an unreasonable way and by not applying the proper principles. The request per se was apt to overcome all the objections discussed so far during oral proceedings. Even if inventive step had still to be discussed, its filing could not be considered as an attempt to prolong unnecessarily the proceedings; on the contrary, since request IVa was based on a convergent limitation with respect to request IIIb and on a combination of features derived from the granted claims, it clearly **restricted the issues remaining to be discussed**. See, similarly, **T 222/16**.

In **T 802/17** the opposition division had given the patent proprietor an opportunity to draft one additional request during the oral proceedings. However, as it then filed only an amended main request, its later request for permission to file amended auxiliary requests too was refused as this would not have been "fair" to the opponent. In the board's view, the presumably underlying considerations of procedural economy had been insufficient to justify this refusal in the circumstances, as the proprietor had been reacting to a new objection under Art. 123(2) EPC, which had been a surprising turn taken in the proceedings and which its amendment had overcome. See also **T 756/18** in which the board found that the opposition division had overstepped the limits of its discretion by stating that it would admit only one auxiliary request and rejecting all other auxiliary requests from the outset for no apparent reason; it did not even examine whether the amendments could have overcome all the objections validly raised up to that point without giving rise to any new ones – which might have rendered them admissible. No abuse of procedure or delaying tactic on the part of the appellant was apparent from the file.

In **T 879/18** the board held that a patent proprietor should be given an opportunity to amend, if **new facts and evidence** were admitted as the subject of the proceedings will have changed. In the case in hand, adding detail from the description was, in the board's view, an appropriate response and should have been admitted. Likewise in **T 222/16**, the board held that the patent proprietor should have been given at least one opportunity to file a new request in response to the new objection filed by the respondent-opponent for the first time on the final date set under R. 116 EPC. On the principles of the **right to be**

heard and the **fair treatment of the parties**, see also **T 487/13** (summarised under chapter IV.C.5.1.6 above) and **T 623/12**.

In **T 1219/19** the appellant asserted that the opposition division had changed its view in the oral proceedings and invoked R. 116(2) EPC to argue that the opposition division had no discretion to disregard the auxiliary request filed after the time limit prescribed in R. 116 EPC or to apply the criterion of prima facie allowability. The board found that the opposition division had exercised its discretion in accordance with the right principles. It could not have been deprived of that discretion merely because it had expressed a different opinion at the oral proceedings from that provisionally set out in the communication accompanying the summons. Moreover, the opposition division's preliminary opinion clearly indicated that those objections were to be the subject of further discussion at the oral proceedings. The preliminary conclusion was expressed in a careful manner and could not be understood as if the opposition division thereby gave up its discretionary power to disregard submissions filed later. A different conclusion would penalise the useful practice of providing a detailed discussion of the relevant issues in preparation for oral proceedings. In the particular circumstances of the case, a different conclusion reached at the oral proceedings by the opposition division departing from its preliminary opinion in the summons could not be regarded as a change of subject of the proceedings.

On the concept of abuse of procedure, see also the decisions relating to the late submission of documents summarised in chapter IV.C.4.5.4, and in particular **T 85/18**, which held that abuse of procedure implied deliberate misconduct, not merely a lack of diligence.

d) Reasonable expectation that the opponents familiarise themselves with the proposed amendments in the time available

Whether the opponent could be expected to deal with the amendment during the oral proceedings (see above summary of **T 491/09**) was also considered an appropriate criterion in **T 2415/13**. Along similar lines, in **T 281/99** the board approved the opposition division's admission of changes, filed during oral proceedings, which were minor (in addition to being in direct response to new objections).

In **T 463/95** the board explained that consideration of a new or amended independent claim could reasonably be expected when such a new or amended claim results from a combination of features taken from granted claims which have been specifically opposed, since the opponents should already be familiar with the subject-matter (similarly **T 577/97**; distinguished in **T 960/04**).

In **T 1261/13**, the board held that the **object and purpose of R. 116 EPC** was to ensure that all parties and the division had enough time to thoroughly prepare for the oral proceedings. As a rule, therefore, requests meeting the R. 80 EPC requirements and filed before expiry of the time limit under R. 116 EPC were admissible. In the board's view, that also went for requests with claims containing features taken from the description.

In **T 43/16**, the opposition division had considered the proprietor's **reverting to the granted claims** two weeks before the oral proceedings to be inadmissible. The board, however, considered that it was not unreasonable to expect the opponent to revisit the granted claims and its own line of argument in the notice of opposition within that time frame.

In T **491/09** the third auxiliary request filed during the oral proceedings was not going in a different direction, but was prepared on the basis of the 3rd auxiliary request filed before the deadline of one month before the oral proceedings. The amendments therein exactly addressed the issues the appellant was well aware of before the oral proceedings since it had raised objections on them at the oral proceedings. The board could therefore only conclude that the appellant had had sufficient opportunity to familiarise itself with the amended subject-matter.

5.1.8 Review of first-instance discretionary decisions by the boards

According to the settled jurisprudence of the boards of appeal developed in view of decision **G 7/93** (OJ 1994, 775), a board should only overrule the way in which a department of first instance has exercised its discretion if it concludes that the department has done so according to the wrong principles, or without taking into account the right principles, or in an unreasonable way (see e.g. **T 879/18**, **T 491/09**, **T 1933/12**, **T 222/16**).

This case law has been codified in Art. 12(6) RPBA 2020, first sentence, according to which the board "shall not admit requests, facts, objections or evidence which were not admitted in the proceedings leading to the decision under appeal, unless the decision not to admit them suffered from an error in the use of discretion or unless the circumstances of the appeal case justify their admittance" (**T 1617/20**; see also **T 1191/20**).

For further details, see chapters V.A.4.1.1b) and V.A.3.4.1 below.

5.1.9 Amending a non-opposed sub-claim

In **T 711/04**, the board observed that, in accordance with the principles set out in **G 9/91** (OJ 1993, 408), the subject-matter of a non-opposed claim was not the subject of an "opposition" within the meaning of Art. 101 and Art. 102 EPC 1973 (Art. 101 EPC combines Art. 101(1) and (2) with Art. 102(1) to (3) EPC 1973; R. 82 EPC), or "proceedings" within the meaning Art. 114 and Art. 115 EPC 1973. The Enlarged Board had also found, however, that this basic principle was not directly applicable where the only subject-matter outside the specified scope of the opposition were dependent claims which had to be regarded as implicitly covered. This exception for sub-claims was, the board found, entirely justified by the fact that a sub-claim that was combined with a main claim and then requested as a new main claim had to be examined as to its form and substance in order to ascertain whether or not the combination of the claims had extended the protection sought. This also showed that the theoretical legal construct underlying the decision in **G 9/91**, i.e. that there were no proceedings within the meaning of Art. 114 and Art. 115 EPC 1973, was untenable in the case in hand. A patent proprietor wishing to limit the patent to the subject-matter of a non-opposed sub-claim had to combine that sub-claim

with the corresponding main claim. The non-opposed sub-claim was inevitably amended as a result, even if the amendment might appear to be a mere technicality. Noting that R. 57a EPC 1973 (R. 80 EPC) had entered into force after the date of the decision in **G 9/91**, the board added that amending non-opposed sub-claims remained permissible under that provision too.

5.1.10 Applicability of Rule 43(2) EPC in opposition proceedings

Rule 43(2) EPC (R. 29(2) EPC 1973) provides that a European patent application may not contain more than one independent claim in the same category unless they involve (i) a plurality of interrelated products, (ii) different uses of a product or apparatus or (iii) alternative solutions to a particular problem, where it is inappropriate to cover these alternatives by a single claim.

The scope and potential applicability of R. 43(2) EPC in opposition proceedings was addressed in **T 263/05** (OJ 2008, 329). Having considered the purpose and legislative history of the rule, the board concluded that it could not apply across the board to all amendments made during opposition proceedings. If it did, it would be impermissible to make any amendment introducing non-unitary claims, something which was not only permissible in opposition proceedings but also clearly appropriate given that the patent proprietor was no longer able to file a divisional application. To conclude that R. 43(2) EPC applied across the board in opposition proceedings would have watered down the decision in **G 1/91** (OJ 1992, 253). R. 43(2) EPC could not be applied in opposition proceedings to prohibit the amendment of a patent as granted where it would be unreasonable to demand that the amended claims comply with it. This was the case where, otherwise, R. 43(2) EPC would force the patent proprietor to abandon potentially valid subject-matter already contained in the claims as granted. The board could not envisage any circumstances in opposition proceedings in which R. 43(2) EPC would be of any application because, once it had been established that an amendment to the claims was necessary and appropriate having regard to grounds for opposition, it would inevitably be unreasonable to impose the additional requirement that the amendment complied with the purely administrative provisions of R. 43(2) EPC.

In **T 830/11** the board confirmed that the condition of conciseness of Art. 84 EPC 1973 and the provisions of R. 29(2) EPC 1973 (R. 43(2) EPC) had to be construed in opposition proceedings in the light of the finding in **G 1/91**, point 4.2 of the Reasons. R. 29(2) EPC 1973 (R. 43(2) EPC) should not constitute an obstacle to defending the patent in all its branches (cf. **T 263/05** and **T 1416/04**). The board emphasised that it was not questioning the general applicability of Art. 84 EPC 1973 as to conciseness or of R. 29(2) EPC 1973 (R. 43(2) EPC) in opposition proceedings. It merely considered that these norms did not apply to sets of claims whose subject-matter was already claimed in the granted version of the patent.

According to the board in **T 1416/04**, a request containing a plurality of independent product claims might be allowable under R. 57a EPC 1973 (R. 80 EPC) in order to provide an amendment of a granted set of claims containing only one independent product claim, if the amended independent claims arose from the deletion of previous claims. With regard

to the form of the claims, the board did not consider it relevant for the case before it to decide whether R. 43(2) EPC applied to opposition cases or not: even if R. 43(2) EPC should be considered applicable, the subject-matter in the granted claims could not appropriately be covered by one independent claim so that the requirements of this rule would have been met anyway. On the filing of new independent claims, see also chapter IV.C.5.1.2d)ii).

5.1.11 Applicability of Rule 137(5) EPC in opposition proceedings

The board in **T 735/12** held that an opponent's objection under R. 137(5) EPC that a claim included features taken only from the description and therefore unsearched was inoperative if only because R. 137 EPC governed solely amendments to a European patent application and was therefore not applicable in opposition (appeal) proceedings. See also **T 1542/14**.

5.1.12 Converging or diverging versions of claims in opposition proceedings

In **T 2254/17** the board was faced with the argument that the opposition division, when exercising its discretion, had failed to consider the criterion that claim sets filed shortly before the oral proceedings should be converging. The board noted that certain boards of appeal had applied the criterion that claim sets filed shortly before the oral proceedings should be converging in deciding whether to admit and consider a plurality of claim sets filed for the first time in appeal proceedings (e.g. **T 1685/07**). It found however that it was questionable whether converging claim sets could be regarded as an absolute requirement for allowing amendments in examination or opposition proceedings (see also **T 996/12**). In any case, it was apparent from the decision under appeal that the opposition division had considered non-converging claim sets to be justified in view of the numerous novelty objections raised by the opponents based on different documents.

See also the chapters on converging or diverging versions of claims: chapter IV.B.2.4.4 (examination procedure, with regard to amendments under R. 137(3) EPC); chapters V.A.4.2.2 and V.A.4.2.3 (convergent approach).

5.1.13 Correction or removal of error (in claim) in opposition proceedings – Rule 139 EPC

The second sentence of R. 139 EPC allows for the corrections concerning the description, claims or drawings, provided the correction is obvious in the sense that it is immediately evident that nothing else would have been intended than what is offered as the correction.

The case law in relation to this topic is set out in chapter II.E.4.5 "Correction of errors in the description, claims and drawings after grant, and in opposition proceedings".

5.2. Scope of examination of amendments

5.2.1 Scope of examination not limited to grounds raised pursuant to Rule 76(2)(c) EPC

Amendments of the claims or other parts of a patent in the course of opposition proceedings are to be examined as to their compatibility with the requirements of the EPC (Art. 101(3) EPC). When amendments are made to a patent, opposition divisions (as well as the boards of appeal) have the power to deal with grounds and issues arising from those amendments even if they were not specifically raised by an opponent pursuant to R. 76(2)(c) EPC (**T 227/88**, OJ 1990, 292; **G 9/91**, OJ 1993, 408, **G 10/91**, OJ 1993, 420, point 19 of the Reasons, respectively; **T 472/88**; **T 922/94**; **T 1437/15**; see also **T 459/09**; for the extent of the power to examine amended claims for compliance with Art. 84 EPC, see **G 3/14**, OJ 2015, A102, and chapter IV.C.5.2.2 below).

Where amended claims were introduced in the opposition proceedings there could be no objection to the opponent's submitting new citations and new arguments against the new claims that challenged inventive step for the first time (**T 623/93**). The examination by the opposition division of a new submission justified in this way was in keeping with **G 9/91** (OJ 1993, 408, point 19 of the Reasons).

In **T 1437/15** the board pointed out that the grounds for opposition specified in Art. 100 EPC concerned only the maintenance of a granted patent (Art. 101(1) and (2) EPC). By contrast, where a patent was amended during opposition proceedings, it could be maintained as so amended only if, taking into consideration the amendments made, it met the requirements of the EPC (Art. 101(3) EPC).

In **T 693/98** the board dealt with the question as to whether, on the proper interpretation of Art. 102(3) EPC 1973 (Art. 101(3)(a) EPC), the fact that an amendment to the claims has been made in opposition proceedings opens the possibility for an opponent to raise an objection under Art. 123(2) EPC to all the amendments to the claims including those made before the patent was granted, even if such objection was not originally raised and substantiated as a ground for opposition. Citing **G 10/91** (OJ 1993, 420, point 19 of the Reasons) the board concluded that only the amendments made during opposition or appeal proceedings, not those made before grant, must be examined for compliance with the requirements of the EPC (see also **T 301/87**, OJ 1990, 335). Cited in **T 2696/16**.

The introduction of a feature into an independent claim, which feature was present in the claims and in the description as granted, could not be considered as an amendment which legitimated the admittance of Art. 100(b) EPC as a fresh ground of opposition, which required that a European patent as a whole had to disclose the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art (**T 1053/05**; see also **T 739/08** and **T 565/13**).

In **T 2155/17** the board considered that the new added-matter objection in question related to the amendment and not to the combination of features in the claims as granted, and therefore did not constitute a fresh ground in the sense of **G 10/91** (OJ 1993, 420).

In **T 895/18** the board cited **G 9/91** (OJ 1993, 408, point 19 of the Reasons) and concluded that the EPC required that, in the case of amendments in opposition or appeal proceedings, a full examination had to be undertaken of the amendments and therefore in particular of the **claims resulting from the amendments**. The board rejected a "parallelism" between the treatment of unclear features and of added matter, as suggested by the appellant (proprietor), as this disregarded the fact that, in contrast to added matter, lack of clarity was not one of the grounds for opposition according to Art. 100 EPC.

In **T 571/19**, the board observed that Art. 101(3)(a) EPC required that new claim requests be examined for compliance with the EPC requirements. This did not extend to clarity where granted claims had been combined (**G 3/14** – see also chapter IV.C.5.2.2) or to the requirement of unity of invention (**G 1/91**, Headnote), but compliance with Art. 123(3) EPC always had to be established (see **G 9/91** and **G 10/91**, point 19 of the Reasons; **T 648/96**; **T 1302/06**). However, it was not apparent from the opposition division's decision why it had found the claims of the auxiliary request on which the decision was based to be in keeping with Art. 123(3) EPC, and so the decision was insufficiently reasoned for the purposes of R. 111(2) EPC. The board considered it irrelevant that Art. 100(c) EPC had not been cited as a ground for opposition and that the opponent had not raised any objection under Art. 123(2) EPC; the amended claims should nevertheless have been examined for compliance with Art. 123(3) EPC.

5.2.2 Extent of power to examine amended claims for compliance with Article 84 EPC

The extent to which the opposition division or a board of appeal may examine clarity for the purpose of Art. 101(3) EPC was the subject of questions put to the Enlarged Board in referral **G 3/14** (OJ 2015, A102). In the case underlying the referral (**T 373/12**, OJ 2014, A115) claim 1 of auxiliary request 1, submitted during opposition proceedings, consisted of a combination of the features of claim 1 as granted and of dependent claim 3 as granted.

As a preliminary point, the Enlarged Board identified the following main types of case: amendments which encompass a literal insertion of elements of dependent claims as granted into an independent claim (type A) – these include amendments in which a dependent claim contains within it alternative embodiments, one of which is then combined with its independent claim (Type A(i))– and amendments in which a feature is introduced into an independent claim from a dependent claim, being a feature which was previously connected with other features of that dependent claim from which it is now disconnected (Type A(ii)); furthermore, amendments which encompass a literal insertion of complete dependent claims as granted into an independent claim (Type B, this being the case with which the referring board was confronted).

The Enlarged Board first considered its previous jurisprudence, i.e. **G 1/91** (OJ 1992, 253), **G 9/91** (OJ 1993, 408) and **G 10/91** (OJ 1993, 420). Citing the statement in point 19 of the Reasons in **G 9/91** and **G 10/91** that "[...] in case of amendments of the claims or other parts of a patent in the course of opposition or appeal proceedings, such amendments are to be fully examined as to their compatibility with the requirements of the EPC", it noted that if the Enlarged Board had at the time considered that the opposition division and the

boards of appeal were given wide powers to examine amended claims, it would have said so. Therefore, the term "amendments" had to be understood in the sense that the subject-matter to be examined must have some direct nexus with the amendment.

The Enlarged Board identified three main lines in the jurisprudence of the technical boards: the "conventional" approach, based on the test whether the amendment introduces any contravention of Art. 84 EPC, and the principle that Art. 101(3) EPC does not allow objections to be based upon Art. 84 EPC if they do not arise out of the amendments made (see **T 301/87** and **T 227/88**, applied in many further cases, see e.g. **T 381/02**, **T 1855/07**, **T 367/96** of 3 December 1997 and **T 326/02**). Secondly, there was a wider interpretation, according to which a lack of clarity could be examined if the amendment "highlights and focuses attention" on a previously existing ambiguity (**T 472/88**; see also **T 681/00** and **T 1484/07**). The third line of jurisprudence was considered "diverging". According to **T 1459/05** (see also **T 1440/08** and **T 656/07**), clarity may be examined on a case-by-case basis as a matter of discretion when the added feature is the only feature that distinguishes the subject-matter of the claim from the prior art. **T 459/09** was the most far-reaching of these diverging cases, stating that amended claims may generally be examined for clarity on a case-by-case basis irrespective of the kind of amendment.

On the interpretation of Art. 101(3) EPC, the Enlarged Board pointed out that the requirements of Art. 84 EPC are part of the "requirements of the Convention" for the purposes of Art. 101(3) EPC. There was, however, no indication that the object and purpose of Art. 101(3) EPC was to open up the patent to a complete re-examination, whether for clarity or the other requirements of the EPC. It was rather the amendment itself which was relevant, and its effect for the ground for opposition in question. Self-evidently, the amendment must not itself give rise to new objections.

As apparent from the travaux préparatoires to the EPC 1973, the legislator had deliberately chosen not to make Art. 84 EPC a ground for opposition. It would be unsatisfactory if an opponent could cause delays whenever an amendment was made, by raising all kinds of Art. 84 EPC objections. Furthermore, when the EPC 2000 was drafted, no suggestion was made for a change to reverse the effect of the then established case law, i.e. the conventional approach based on **T 301/87**. If the deletion of an independent claim with its dependent claims permitted examination of the remaining claims for lack of clarity, Art. 84 EPC would effectively become a ground for opposition in a large number of cases, which would be contrary to the legislator's intention. To conclude otherwise for a combination of claims which actually consists of striking out the original independent claim and then writing out the previously dependent claim in full, would be arbitrary and unjustified.

In conclusion, the Enlarged Board approved the conventional line of jurisprudence as exemplified by **T 301/87**, and answered the referred questions as follows:

"In considering whether, for the purposes of Art. 101(3) EPC, a patent as amended meets the requirements of the EPC, the claims of the patent may be examined for compliance with the requirements of Art. 84 EPC only when, and then only to the extent that, the amendment introduces non-compliance with Art. 84 EPC."

Considering the different types of amendment distinguished in **G 3/14**, the board in **T 1112/12** observed that a common theme underlying the Enlarged Board's ruling appeared to be that modifying a claim by **merely deleting or excluding embodiments** from the claimed subject-matter did not result in an amendment which was open to an objection under Art. 84 EPC (see also **T 1977/13** and **T 260/13**). In **T 2437/13** the granted claims already referred to figures and tables; it was thus not the amendments which introduced non-compliance with Art. 84 EPC in combination with R. 43(6) EPC. For further cases where the lack of clarity was already present in the claims as granted and the clarity objection therefore rejected, see e.g. **T 266/15**, **T 488/13**, **T 1905/13**, **T 1287/14**, **T 2311/15**, **T 2321/15**, **T 2244/19**, **T 2391/18**.

The following decisions are examples of cases in which the claim amendment in issue involved not a simple combination of granted claims or the mere deletion or exclusion of embodiments, but rather the addition of a feature from the description, with the result that the amended claim was open to clarity objections: **T 565/11**, **T 2321/13**, **T 842/14**, **T 315/15**, **T 1976/19**, **T 2817/19**.

In **T 248/13** certain ambiguous terms were already contained in claim 15 as granted. However these terms defined the flavour of the final product, whereas the terms of claim 1 of auxiliary request 1 referred to an ingredient to be added. The board considered that by taking these terms out of the context in claim 15 as granted and placing them in the context of claim 1 of auxiliary request 1, a **new ambiguity was introduced** that was not present before. Therefore this amendment was objectionable under Art. 84 EPC.

In **T 1221/19** the board referred to **G 3/14** (OJ 2015, A102) and recalled that, in considering whether, for the purpose of Art. 101(3) EPC, a patent as amended meets the requirements of the EPC, the claims may be examined for compliance with Art. 84 EPC only when, and then only to the extent that, the amendment introduces non-compliance with Art. 84 EPC. In line with this, the board considered that the **description** of the patent may also be examined for compliance with Art. 84 EPC only when, and then only to the extent that, the amendment introduced non-compliance with Art. 84 EPC. This was in accordance with both **G 9/91** (OJ 1993, 408) and **G 3/14**. In the case in hand the reversion back to an erroneous reference as in the application as filed did not result in any lack of clarity or ambiguity of the disclosure in the paragraphs concerned.

In **T 2391/19** the allegedly required amendment to the description did not relate to any amendment to the claims during opposition proceedings. Instead, it related to an alleged inconsistency that already existed in respect of a feature present in the granted claims. The board found that such an amendment to the description was not appropriate in opposition proceedings or opposition appeal proceedings. Even without the amendment to the description, there was no reason for the board (or the opposition division) to come to the conclusion that the requirements of the Convention (in particular the requirements of Art. 84 EPC) within the meaning of Art. 101(3)(a) EPC were not fulfilled in consideration of the conclusion of the Enlarged Board in **G 3/14** set out above in this chapter.

5.2.3 Additional searches

In **T 503/96** the board considered the criteria for the need for an **additional search** in relation to restrictive amendments. It referred to the Guidelines B-III, 3.5, in the version then applicable, which stated, "In principle, and in so far as possible and reasonable, the search should cover the entire subject-matter to which the claims are directed or to which they might reasonably be expected to be directed after they have been amended..." (see also in lightly amended form, B-III, 3.5 – April 2025 version). The board stated that whether or not to commission an additional search in a particular case was a matter for the administrative discretion of the opposition division, but if an inappropriate criterion was invoked when exercising this **discretion**, doubt would inevitably be raised as to whether the discretion was reasonably exercised. Since, in the case of amendment of the claims in the course of opposition or appeal proceedings, such amendments are to be fully examined as to their compatibility with the requirements of the EPC (**G 9/91**, OJ 1993, 408), it was not inappropriate for an opponent to make observations on a possible need for an additional search to enable this full examination to be carried out (Guidelines D-VI, 5, then applicable). The judgment on whether an additional search was necessary and the obligation to perform this search if it was judged to be necessary were administrative matters for the EPO.

5.3. Proprietor's approval of amended text of the patent

In **T 1467/16** the board recalled that the text of the patent was at the disposition of the patent proprietor (Art. 113(2) EPC) and hence a patent could not be maintained against the patent proprietor's will. Since revocation under Art. 105a(1) EPC at the request of the patent proprietor was not possible in the framework of opposition or opposition appeal proceedings (Art. 105a(2) EPC), the board, in line with previous case law, revoked the patent under Art. 101 EPC.

In **T 861/16**, the board held that since the principle of tacit acceptance ("qui tacet consentire videtur") was not established in the EPC, it was not enough for an opposition division merely to ask the patent proprietor whether it wished to comment on amendments to the description which had been prepared by the division. It had to ensure that the patent proprietor approved them.

On the need for a text submitted or agreed by the proprietor, see also chapter III.B.3.

6. Right to be heard in opposition proceedings

6.1. Principle of equal treatment

The principle of equal treatment is enshrined in Art. 6(1) ECHR and also binding for opposition proceedings, since it relies on principles of law common to all member states of the European Patent Organisation and applicable to all its departments (**T 2274/22**; see also chapter III.H.7. and chapter III.J.1.3. and the decisions therein on the applicability of the ECHR to proceedings before the EPO).

In inter partes proceedings such as opposition proceedings the right to be heard is inextricably linked to the **principle of equal treatment**: no party should be given preferential treatment in the number of times it is allowed to present its case orally or in writing. The opposition division is therefore required to ensure that the parties can exchange their submissions in full and have equal opportunity to comment on them. If the opposition division considers a multiple exchange of submissions expedient, it must give each party equal opportunity to comment. Thus, the opposition division may invite a party to submit a **rejoinder to the reply** to the notice of opposition, but in that case it is obliged to invite the other party to **respond to that rejoinder**, after which it must decide again whether a third exchange of submissions is expedient. The fact that R. 79(3) EPC (R. 57(3) EPC 1973) leaves it to the opposition division ("if it considers it expedient") to invite the opponents to reply cannot be interpreted as an authorisation to derogate from the fundamental principle of equal treatment (see **T 190/90**, **T 682/89** and **T 439/91**).

According to **T 669/90** (OJ 1992, 739), if the opposition division misleads a party into believing that it is not necessary to defend its interests by filing observations in reply to new facts and evidence filed by an adverse party, and if such new facts and evidence then form the basis for a decision adversely affecting the misled party, the latter has not had "an opportunity to present its comments" within the meaning of Art. 113(1) EPC. Such a procedure is also not a fair procedure and is contrary to the principle of good faith governing relations between the EPO and parties to proceedings before it (cf. **T 532/91**, **T 678/06**). Such inequality of treatment constitutes a substantial procedural violation.

In **T 487/13** the board held that, by deciding not to admit auxiliary requests 4 to 6 directly after late-filed document D10 was admitted into the proceedings, the opposition division did not respect the appellant's right to be heard, which was inextricably linked to the principle of fair and equal treatment of the parties. It thus committed a substantial procedural violation. Indeed, since these new requests were filed in direct response to a change in the subject of the proceedings, they were submitted in due time and the opposition division had no discretion to disregard them.

In addition to the cases that follow, see in this chapter IV.C.3.4.6 "Opportunity to comment on new grounds for opposition".

6.2. Invitation to file observations under Article 101(1) EPC

Article 101(1) EPC (Art. 101(2) EPC 1973) reinforces the right to be heard laid down in Art. 113 EPC by requiring the opposition division, when examining an opposition, to invite the parties **"as often as necessary"** to comment, within specified periods, on its own communications or those filed by other parties. Where necessary, any communication to the proprietor of the European patent must contain a reasoned statement covering all the grounds against the maintenance of the European patent (R. 81(3) EPC; R. 58(3) EPC 1973).

Article 101(1) EPC does not require as a rule that the grounds for not maintaining the patent invariably be set out in a communication, but only if this is "necessary". Such "necessity" can arise only in efforts to establish the facts or in view of Art. 113(1) EPC. So

the opposition division **must issue a communication only if** it considers this **necessary**, e.g. to take up **new** substantive or legal arguments or draw attention to points still requiring clarification. R. 81(3) EPC, which merely contains instructions concerning the content of any communications that may have to be issued, adds nothing to the above consideration of principle. Accordingly, the provisions of Art. 101(1) EPC and R. 81(3) EPC cannot be interpreted as meaning that the opposition division is obliged in every case to issue at least one communication before giving its decision, unless it is necessary to do so on the basis of Art. 113(1) EPC (see e.g. **T 275/89**, OJ 1992, 126; **T 538/89**, **T 682/89**, **T 532/91** and **T 2120/18**).

Not issuing at least one communication under Art. 101(1) EPC cannot in itself substantiate an allegation of infringement of the right to be heard under Art. 113 EPC (see e.g. **T 774/97**, **T 781/08** and **T 802/12**). In **T 165/93**, for example, the board saw no need under Art. 113(1) EPC for the opposition division, before revoking the patent, to announce its opinion in a communication or to give a further opportunity to the patentee to declare whether they were interested in a limited patent if, despite having been informed of an additional objection of the opponent, they did not react but maintained their sole request for maintenance of the patent with the amended claims. Nor is it necessary under Art. 113(1) EPC to give a party a repeated opportunity to comment on the argumentation of the EPO body, so long as the decisive objection against the contested procedural action remains the same (see e.g. **T 161/82**, OJ 1984, 551; **T 621/91**).

According to **T 295/87** (OJ 1990, 470), in opposition proceedings, under Art. 101(2) and R. 57(1) EPC 1973 (Art. 101(1) and R. 79(1) EPC) the proprietor has a right to file observations upon a notice of opposition. Thereafter, observations from the parties are only admissible in the exercise of the discretion of the opposition division or a board of appeal, if such observations are necessary and expedient in the sense of Art. 101(2) and R. 57(3) EPC 1973 (Art. 101(1), R. 79(3) EPC). The board specified that following communication of the patentee's observations (and any amendments), other parties are only to be invited by the opposition division to reply to such observations "if it considers it expedient". It was clearly desirable in the interest of the smooth and efficient conduct of opposition proceedings, and in the public interest, that observations by parties should be properly limited to what is necessary and expedient. This in turn required the exercise of a proper control by the opposition division over the admissibility of observations by parties as well as of documents filed in support of such observations. Of course, the extent to which further observations are necessary or expedient depended upon various factors, including the complexity of the issues, and could only be decided in the context of each case.

In **T 2120/18** the opposition division had used its discretion to reject the patent proprietor's request for extension of the time limit to file observations. The board found that the consequence of a possible error in the exercise of the discretion not to extend the time limit would (merely) be that late submissions by the proprietor could not be disregarded. In the absence of any submissions by the proprietor during the opposition proceedings, however, the opposition division's possible lack of proper reasoning had no effect. The board noted that the opposition division's rejection of a request for extension of the time limit indicated in its communication under R. 79(1) EPC had not

terminated the opposition proceedings. Therefore, as the non-compliance with the four-month time limit did not lead to a direct legal consequence to the detriment of the proprietor, and as the opposition division did not decide on the opposition until eleven months after the refusal of the extension request, the proprietor was still in a position to respond to the notice of opposition well beyond the time limit. The opposition division's refusal of the extension request therefore did not violate the proprietor's right to be heard. The proprietor could have anticipated that the opposition division would issue its decision after expiration of the four-month time limit indicated in the communication under R. 79(1) EPC (see Guidelines E-VII, 1.6 – November 2016 version; now in E-VIII, 1.6 – April 2025 version).

For cases where a communication was considered necessary, see in this chapter IV.C.6.5. below (**T 293/88**, **T 120/96** and **T 1056/98**).

6.3. Invitation to file observations under Rule 82(1) EPC

Rule 82(1) EPC (R. 58(4) EPC 1973) provides that the opposition division is to inform the parties of the text in which it intends to maintain the patent and invite them to state their observations within two months if they disapprove of that text. The boards of appeal have frequently addressed the issue of when it is necessary to send the parties such a communication.

In **T 219/83** (OJ 1986, 211) and **T 185/84** (OJ 1986, 373) the board stated that, after oral proceedings in an appeal from opposition proceedings, the parties had to be sent a communication pursuant to R. 58(4) EPC 1973 (R. 82(1) EPC) only if they could not reasonably be expected to state their observations concerning the maintenance of the European patent in the amended form definitively during the oral proceedings (confirmed in e.g. **T 75/90**, **T 895/90** and **T 570/91**).

In **T 446/92** it was stated that, in a case where a duly summoned opponent was not represented at oral proceedings, the decision of the board to maintain the contested patent in amended form in accordance with a request of the patentee submitted during those proceedings could nevertheless be given orally (R. 68(1) EPC 1973; R. 111(1) EPC) at the end of the proceedings, if no new facts or evidence were dealt with during the proceedings. Under these circumstances, the application of R. 58(4) EPC 1973 (R. 82(1) EPC) could be dispensed with because the patent in suit was maintained with an amended text emanating from and approved by the patentee (see, in this respect, **G 1/88**, OJ 1989, 189) and, furthermore, because the opponent's **deliberate decision to refrain from being represented at oral proceedings** before the board was to be regarded as being tantamount to a tacit abandoning of their right to present comments pursuant to Art. 113(1) and R. 58(4) EPC 1973 (R. 82(1) EPC).

In **T 29/16** the board held that a substantial procedural violation had occurred when the opposition division did not comply with R. 82(1) EPC, which, it stated, defined the right to be heard more particularly in the case in hand. The opponent had not been invited to comment on the text, on the basis of which the opposition division intended to maintain the patent in amended form. Therein lay a violation of the right to be heard.

6.4. EPO communication concerning submissions by the other party – adequate opportunity to reply

Communications signed by the formalities officer and inviting the appellants to "take note" of the opponents' submissions are not communications of the opposition division within the meaning of Art. 101(1) EPC (Art. 101(2) EPC 1973), which require a period to be fixed for reply. It is at the discretion of the recipient to reply to this communication if they find it necessary. If they intend to reply but for any reason are prevented from doing so within a reasonable period of time, then the appropriate action is to inform the opposition division of their difficulties (see **T 582/95**).

The boards of appeal have dealt in a series of decisions with the issue of determining what is a reasonable period which provides the recipient of an EPO communication with an adequate opportunity to reply:

In **T 275/89** (OJ 1992, 126) the board noted that the opposition division had waited for somewhat longer than a month before taking its decision. In the board's view, in the case of a communication which was issued for information purposes only and which did not set a time limit for response, a period of **one month** (which in the present case was exceeded) sufficed as a rule to comply with the requirements of Art. 113 EPC. Moreover, the documents on which the decision under appeal was based had already been mentioned in the notice of opposition together with an assessment of their substantive and legal significance.

In **T 263/93** the board held that the right to be heard enshrined in Art. 113(1) EPC requires that the party concerned be given **sufficient time** to submit an adequate response if the EPO decides to communicate to a party to proceedings before it an objection raised by another party without an express invitation to reply within a specified time limit. The question regarding what period of time is sufficient for this purpose is a **question of fact** which has to be answered on the basis of the merits of each individual case. The board further noted that, as a rule, a time limit set by the EPO should not be shorter than **two months** (see R. 132 EPC, former R. 84 EPC 1973). In the circumstances of **T 263/93**, where **difficult technical questions** had to be considered, the board came to the conclusion that the appellant's right to a fair procedure would have required the opposition division to have waited at least two months before issuing a decision based on the objections raised for the first time in this counterstatement. This was confirmed in **T 1152/14**.

In **T 494/95**, the board took the view that the interval of more than one month between the notification of the patent proprietor's reply to the opposition and the date of issuing the decision was sufficient to allow the appellant (opponent) a reasonable opportunity to present their comments, or **at least to indicate an intention** of so doing, or to request oral proceedings. In the board's view, it was clear from R. 57(3) EPC 1973 (R. 79(3) EPC), from the EPO information "Opposition Procedure in the EPO" (OJ 1989, 417) and from previous decisions that, if oral proceedings did not take place and the decision was based solely on grounds on which the parties concerned had had an opportunity to present their

comments, a decision could be taken without further notice upon expiry of the period allowed to the patent proprietor for submitting observations.

In **T 914/98** the board stated that the **seventeen-day** period which elapsed between the appellants receiving the reply of the respondents and the handing over of the decision to the EPO internal postal service was manifestly **too short** to give the appellants an adequate opportunity for comment. According to the board, in view of the case law highlighted in the decision and summarised above, the appellants could not reasonably have expected a decision to be issued so quickly.

However, the board in **T 2243/18** held that there was no requirement in the EPC for the opposition division to wait for further submissions of the parties after the notice of opposition and the reply of the proprietor have been received. On the contrary, parties should expect the opposition division to prepare the next action (in most cases summons to oral proceedings) at any time after receiving the reply of the proprietor (see notice from the EPO concerning the opposition procedure as from 1 July 2016, OJ 2016, A42, point 3).

6.5. Opportunity to present comments

Article 113(1) EPC, in which the right to be heard is enshrined, provides that decisions of the EPO may only be based on grounds or evidence on which the parties have had an opportunity to present their comments. The term "grounds or evidence" in Art. 113(1) EPC should not be narrowly interpreted. The word "grounds" does not refer merely to a ground of objection to the application or patent in the narrow sense of a requirement of the Convention which is considered not to be met. The word "grounds" should rather be interpreted as referring to the **essential reasoning, both legal and factual**, which leads to the findings of the decision (see e.g. **T 951/92**, OJ 1996, 53, with regard to a refusal of the application, **T 433/93**, with regard to the finding of invalidity and revocation, and **T 1056/98** with regard to inadmissibility; on the right to be heard, see also chapter III.B.).

In **T 293/88** (OJ 1992, 220) the board found that the decision of the opposition division to revoke the patent without issuing any communication in advance disregarded the fact that the validity of the **uncontested claims** 7, 9 and 10 had not been challenged at all, and a further opportunity to fall back at least to such position was reasonably to be expected in such circumstances. The onus of raising such related additional matter with the parties was on the opposition division under Art. 113(1) EPC – which it had not done in this case (distinguished in **T 463/93**; see also **T 2094/12**).

In **T 558/95** the opposition division had issued two written communications before the oral proceedings stating that, "in the provisional opinion of the opposition division", the subject-matter described in the public prior use did not prejudice the contested patent within the terms of Art. 100(a) EPC. The patent proprietor therefore found it surprising that detailed consideration was given to the public prior use during the oral proceedings. However, the board held that **provisional opinions** of this kind were not binding on the further proceedings.

If the opposition division rejects an opposition as **inadmissible** without providing a reasoning prior to its decision prevents the opponent from responding with comments, it violates the opponent's right to be heard (**T 1056/98**).

Normally, where a document has been sent to one of the parties, that party is given sufficient time to respond thereto before a department of the EPO takes a decision (**T 263/93**; see above in this chapter IV.C.6.4). If the case is to be **remitted to the department of first instance** for further prosecution, the recipient of a document still has, in view of the remittal, the opportunity to contest the arguments put forward by the other party (see **T 832/92**).

Under Art. 113(1) EPC, decisions of the EPO may only be based on grounds or evidence on which the parties concerned have had an opportunity to present their comments. This also applies **after remittal** to the opposition division of a case by a board of appeal for further prosecution on the basis of new evidence, even if submissions with respect to this new evidence have already been made during the preceding appeal proceedings. In such circumstances an express opportunity to present observations must be given to the parties by the opposition division (see **T 892/92**, OJ 1994, 664; see also **T 769/91**). In **T 120/96** another board shared this view and added that the term "opportunity" in Art. 113(1) EPC could only be given effective meaning by applying the principles of good faith and the right to a fair hearing. For such an opportunity to exist, it is necessary that the parties be expressly asked whether or not they wish to present, within a fixed period of time, their comments, or if, as in the case at issue, the parties have already made detailed submissions during the previous appeal proceedings, whether or not these submissions should be regarded as complete. On these grounds alone, the board found that the immediate termination of the opposition proceedings following the remittal, without any intervening communication announcing the resumption of proceedings, was inconsistent with Art. 113(1) EPC.

In **T 1027/13**, the board held that the categorical refusal of the opposition division to allow the accompanying person to make oral submissions or even communicate with the opponent's representative had in effect been keeping the opponent from taking a position in an "efficient and effective manner" on the contentious issues of the case. It was thus not in line with the principles stated in **G 4/95** (OJ 1996, 412; on these principles see also chapter III.V.5.2).

6.6. Communications allegedly not received

Although the patent proprietor may decide not to react to the notice of opposition, the communication under R. 79(1) EPC does not constitute a mere formality, rather it allows the patent proprietor to both contribute to the opposition division's appreciation of the facts and to defend its interests. The communication forms the basis for the preparation of the factual examination of the opposition. In **T 1529/20** the appellant (proprietor) submitted that they had never received the decision of the opposition division revoking their patent, only becoming aware of it and, more generally, of the opposition proceedings through an email from a formalities officer of the EPO. The board acknowledged that a party submitting that a communication had not been received would have difficulty trying to

prove a negative (negativa non sunt probanda). Proving that a letter was not received was hardly ever possible. Under the circumstances of the case in hand, legal certainty and the protection of the right to be heard would have required the opposition division to establish, by any available means, the fact and date of delivery of the communication of the notice of opposition. There was nothing in the file that suggested the EPO had discharged its burden of proving delivery. Since the initial act of (non-)notification of the notice of opposition was flawed, the entire opposition proceedings including the decision of the opposition division was flawed.

6.7. Change in composition of opposition division during opposition proceedings

For the implications of a change in the composition of the opposition division for the party's right to be heard, see chapter III.K.1.3.2.

7. Acceleration of opposition proceedings

7.1. Following remittal back to the opposition division

In **T 1108/21** the board, having accelerated the proceedings under Art. 10(3) RPBA in response to the legitimate and reasoned interest of opponent 1 to bring the proceedings to an end as soon as possible, remitted the case to the opposition division for further prosecution. To partially mitigate the negative impact of this course of action on opponent 1, the board explicitly ordered an acceleration of the opposition proceedings.

In **T 2916/19**, however, the board rejected the respondent's request for the board to instruct the opposition division to accelerate the proceedings, since the board was not empowered to impose time constraints to the department of first instance in charge of the case. The question of when or at which pace the case was to be dealt with by the opposition division was a managerial decision to be taken by the department of first instance.

7.2. In the case of pending infringement proceedings

In cases where an infringement action in respect of a European patent is pending before the Unified Patent Court or a national court of a contracting state, a party to the opposition proceedings may request accelerated processing. The request may be filed at any time. It must be filed in written reasoned form. In addition, the EPO will also accelerate the processing of the opposition if it is informed by the Unified Patent Court, the national court or competent authority of a contracting state that infringement actions are pending (notice of the EPO dated 7 November 2023, OJ 2023, A99; Guidelines E-VIII, 5 – April 2025 version).

The case underlying **T 290/90** (OJ 1992, 368) involved seven oppositions. One of these was deemed not filed, and the opponent appealed against the decision issued in respect of it under R. 69(2) EPC 1973 (R. 112(2) EPC). The patent proprietor requested accelerated processing of the appeal because an infringement action was pending and, in view of the probable number of infringing products on the market, the longer the opposition

proceedings took, the more difficult it would be to enforce the patent if maintained. According to the board, a "raison d'être" for obtaining and maintaining a patent was to enforce it where appropriate. The timing of enforcement proceedings could be of real importance and delays could be prejudicial to the proprietor's interests and those of their competitors. In the case of infringement proceedings the speedy processing of opposition proceedings in respect of the relevant European patent became especially important. It was therefore important to decide quickly not only on the appeal but also on the complete substantive opposition. In the case of multiple oppositions, as here, the board considered, in view of the suspensive effect of the appeal, that the opponent (appellant) should be treated as having duly filed an opposition unless and until the board decided otherwise. With an appeal concerning the existence or admissibility of one of the oppositions, the examination stage of the opposition proceedings should be prepared and processed in parallel, with the participation of all the opponents, up to the point when it was ready to be decided: as soon as the appeal was decided, the opposition could also be decided.

See also chapter V.A.1.5. "Accelerated processing before the boards of appeal".

8. Decisions of opposition division

8.1. Revocation of a European patent for failure to fulfil formal requirements – by way of decision

It had been held in **T 26/88** (OJ 1991, 30) that the revocation of the patent for failure to fulfil the formal requirements of paying the printing fee and filing the translations of the amended claims (Art. 102(4) and (5) EPC 1973; R. 82(3), second sentence, EPC) had occurred by operation of law ("automatically").

However, according to **G 1/90** (OJ 1991, 275), the revocation of a patent under Art. 102(4) and (5) EPC 1973 **required a decision**. The Enlarged Board compared the ways of terminating proceedings provided for at various stages under the EPC and concluded that the wording of the regulations clearly indicated in each case whether a decision or a communication had to be issued concerning the loss of rights under R. 69(1) EPC 1973 (R. 112(1) EPC). It also considered the issue of legal certainty and, in the light of the "travaux préparatoires", discussed the question of when a loss of rights noted in accordance with that provision became non-appealable. It found that the procedure of pronouncing revocation by way of a decision led neither to legal uncertainty nor to misunderstandings. See also **T 1403/16** for a more recent decision emphasising (in the context of the applicability of Art. 122 EPC), for all three possibilities pursuant to Art. 101 EPC to terminate opposition proceedings (revocation of the patent, rejection of the opposition and maintenance of the patent as amended), that the opposition division had to deliver a decision within the meaning of Art. 106(1) EPC. This also applied to R. 84(1) EPC.

8.2. Interlocutory decisions

8.2.1 General

In case **T 376/90** (OJ 1994, 906) the opposition division had held that the opposition was admissible in an interlocutory decision within the meaning of Art. 106(3) EPC 1973 (Art. 106(2) EPC), i.e. a decision which did not terminate the proceedings as regards one of the parties, without, however, **allowing separate appeal**. In the board's view, according to the clear language of the provision, such an interlocutory decision could only be appealed together with the final decision, unless the decision allowed separate appeal. Whether to allow a separate appeal was within the **discretion** of the opposition division. This discretion had been properly exercised by the opposition division with a view to enabling a decision on the substantive issues to be reached as soon as possible.

8.2.2 Maintenance of European patent as amended

The long-established practice of the EPO of delivering interlocutory decisions subject to appeal when the opposition division intends to maintain a patent as amended was acknowledged by the Enlarged Board in **G 1/88** (OJ 1989, 189).

According to Art. 101(2) and (3)(a) EPC (Art. 102(1) to (3) EPC 1973) a decision on an opposition to a European patent can involve revocation of the patent, rejection of the opposition or maintenance of the patent as amended, the latter requiring the publication of a new European patent specification. Previously a publishing fee was required under R. 82(2) EPC (R. 58(5) EPC 1973) for maintenance of the patent as amended; this fee was abolished as of 1 April 2024 (see decision of the Administrative Council CA/D 16/23 of 14 December 2023, OJ 2024, A3). With these regulations in mind, the EPO very early on adopted the device of an interlocutory decision, for which there is no express provision, in order to establish in the first place the text of the amended specification. Only after this interlocutory decision has become final (or the case has been decided on appeal) is a translation of the claims in the other official languages requested pursuant to R. 82(2) EPC (R. 58(5) EPC 1973), the publishing fee being no longer required. Where an appealable decision has been based on documents not complying with the applicable requirements prescribed by the President of the EPO under R. 49(2) EPC (i.e. in handwritten form), the patent proprietor shall be invited to file the amended text in a form compliant with those requirements (i.e. typed or printed) within the three-month period (R. 82(2) EPC in its amended form as of 1 April 2024; Art. 2(7), decision of the President of the EPO dated 25 November 2022 on the presentation of application and other documents, OJ 2022, A113). Once these requirements have been fulfilled what is then a non-appealable final decision on maintenance of the patent as amended is given and the new patent specification is published.

An interlocutory decision which determines the text of the patent to be maintained as amended can of course only be given if there is a text "submitted or agreed" by the patent proprietor pursuant to Art. 113(2) EPC.

In **T 390/86** (OJ 1989, 30) the board held that neither Art. 102(3) EPC 1973 (which partly became Art. 101(3)(a) EPC and partly was incorporated in R. 82 EPC) nor R. 58(4) EPC 1973 (R. 82(1) EPC) precluded an opposition division from giving decisions on substantive issues in the opposition before sending a communication under R. 58(4) EPC 1973, and before "deciding to maintain the patent in amended form". For example, an opposition division could during the course of an opposition make a (final) interlocutory decision (either orally or in writing) that a particular proposed amendment contravened Art. 123 EPC. Similarly, an opposition division could make a (final) interlocutory decision during an opposition that the main claim, for example, of the opposed patent could not be maintained. Such a **substantive interlocutory decision** was not a decision actually to maintain the patent in amended form, but was preliminary to such a decision. The taking of such substantive interlocutory decisions during the course of opposition proceedings was desirable both in order to move the proceedings forward towards a conclusion, and, in appropriate cases as envisaged in Art. 106(3) EPC 1973 (Art. 106(2) EPC), to allow a party to appeal such an interlocutory decision before the opposition proceedings were terminated. It was further held that where a final substantive decision had been given, an opposition division had no power thereafter to continue examination of the opposition in relation to the issues which were the subject of that decision. Further submissions from the parties relating to such issues were inadmissible.

In **T 89/90** (OJ 1992, 456) the opponents had lodged objections to an interlocutory decision finding that the patent as amended and the invention to which it related met the requirements of the EPC. The legal basis for interlocutory decisions was provided by Art. 106(3) EPC 1973. The board observed that the EPC contained no general rules as to when an interlocutory decision could or should be delivered. The relevant department therefore had to use its discretion in judging whether an interlocutory decision was appropriate in an individual case. This involved weighing up various considerations such as whether an interlocutory decision would accelerate or simplify the proceedings as a whole (clarifying a disputed question of priority, for example, could be of key importance for the form and length of the subsequent proceedings) and clearly also included the issue of costs. In the board's view, it was clear that the established practice of delivering appealable interlocutory decisions under Art. 106(3) EPC 1973) (Art. 106(2) EPC) where a patent was maintained as amended was based on the weighing up of such cost aspects. The board concluded that this practice was both formally and substantively acceptable.

In **G 9/92** (OJ 1994, 875), the Enlarged Board set out the implications of an admissible appeal against an interlocutory decision of the opposition division concerning maintenance of the patent in amended form, first, where the sole appellant is the patent proprietor and, secondly, where the sole appellant is the opponent. In the first case, neither the board nor the non-appealing opponent as a party as of right may challenge the maintenance of the patent as amended in accordance with the interlocutory decision. In the second case, the patent proprietor is primarily restricted to defending the patent in the form in which it was maintained by the opposition division. The board may reject as inadmissible any amendments proposed by the patent proprietor as a party as of right if they are neither appropriate nor necessary. For further details of the prohibition on reformatio in peius and its application in board decisions, see chapter V.A.3.1.

D. Limitation/revocation

1. Limitation/revocation – Article 105a-105c EPC 1502
2. Requests for revocation during opposition and opposition appeal proceedings 1502

1. Limitation/revocation – Article 105a-105c EPC

With the entry into force of the EPC 2000, Art. 105a EPC was introduced, pursuant to which a European patent may be revoked or limited at the request of the proprietor. Limitation can be achieved by an amendment of the claims. The effect of a successful limitation or revocation is that the patent is limited or revoked ab initio (Art. 68 EPC) and in respect of all the contracting states in which it has been granted. It takes effect on the date on which the mention of the decision to limit or revoke is published in the European Patent Bulletin (Art. 105b(3) EPC, **T 646/08**; **T 2177/12**). The nature of this procedure, which is ex parte, lies somewhere between the examination and opposition proceedings (**G 3/14**, point 61 of the Reasons, OJ 2015, A102).

There is no time limit as to when the request for limitation/revocation can be made. However, it is a precondition that no opposition proceedings (including opposition appeal proceedings) in respect of the patent are pending (Art. 105a(2) EPC). If they are, then the request is deemed not to have been filed (R. 93(1) EPC). If limitation proceedings are pending at the time of the filing of an opposition, the limitation proceedings are terminated (R. 93(2) EPC). If a patentee wishes to to have its patent revoked whilst opposition proceedings are ongoing, it may request it, but not by using the procedure set out in Art. 105a to 105c EPC (see in this chapter IV.D.2.). If the patentee wishes to limit its patent, it may be able to do so by amending it in the course of the opposition and opposition appeal procedure.

The examining division decides on requests for limitation or revocation under Art. 105a EPC (R. 91 EPC). If it finds the request admissible, the examining division examines whether the amended claims constitute a limitation of the claims of the European patent as granted or amended, and whether they comply with Art. 84, 123(2) and 123(3) EPC (R. 95(2) EPC; see **T 2830/18**). No examination of the claims with regard to Art. 52 to 57 EPC is foreseen. The decision of the examining division is appealable before the technical boards of appeal.

In **T 2830/18** the only claims that had been amended as compared with the patent as granted were claims 8 and 9, so these were the only claims that needed examining under Art. 105b(1) EPC.

2. Requests for revocation during opposition and opposition appeal proceedings

The procedure for limitation/revocation pursuant to Art. 105a-105c EPC is not available during opposition and opposition appeal proceedings. However, a patent may still be

revoked during such proceedings at the request of the patent proprietor. Art. 105a(2) EPC does not prevent the proprietor from filing a request for revocation during opposition proceedings, nor does it prevent the opposition division from dealing with such requests (**T 2177/12**), but these procedural courses of action are **not covered by Art. 105a-105c EPC**. As explained in **T 1651/14**, legal certainty demands clarity about the situation as regards intellectual property rights ("die Schutzrechtssituation"). Proceedings must therefore be brought to an end as quickly as possible (**T 1651/14**; see also **T 1960/12**; **T 1832/16**; **T 757/17**).

According to the board in **T 1467/16**, in view of there being no text of the patent on the basis of which the board could consider the appeal, the only possibility was for the board to revoke the patent as envisaged, albeit for other reasons, in Art. 101 EPC (see also **T 1960/12**; **T 1832/16**; **T 757/17**).

If the patent proprietor states in opposition or opposition appeal proceedings that it no longer approves the text in which the patent was granted and will not be submitting an amended text, the patent is to be revoked (see e.g. **T 1651/14**). This is supported by Art. 113(2) EPC, which provides that a patent may be maintained only in a version approved by the patent proprietor. If there is no such version, one of the requirements for maintaining the patent is lacking (**T 73/84**, OJ 1985, 241, followed by numerous decisions, see e.g. **T 307/13** and **T 1536/14**, **T 796/15**). On the requirement of a text agreed by the patent proprietor, see chapter III.B.3.3.

If the patent proprietor itself requests that the patent be revoked, the decision to revoke the patent is given **without substantive examination as to patentability**. The examination as to whether the grounds for opposition laid down in Art. 100 EPC prejudice the maintenance of the patent becomes impossible since the absence of a valid text of the patent precludes any substantive examination of the alleged impediments to patentability (**T 186/84**, OJ 1986, 79; see also **T 157/85**; **T 1659/07**; **T 124/08**; **T 1287/08**; **T 1111/10**; **T 796/15**; **T 1651/14**).

In **T 237/86** (OJ 1988, 261) the board stated that a direct request for revocation sufficed, whatever the form of the words, when it was made clear to the boards that appellant and respondent agreed that the patent should be revoked. In **T 459/88** (OJ 1990, 425) the board stated that if, in proceedings before the EPO, the patent proprietor itself requested that its patent be revoked, there could scarcely be a more cogent reason for revoking it since it could not be in the public interest to maintain a patent against its proprietor's will. The patent was thus revoked by the board under Art. 111(1) EPC 1973 (see also **T 655/01**; **T 1187/05**; **T 1526/06**; **T 1610/07**; **T 1541/09**; **T 1089/23**).

There must be no doubt that the proprietor applying to have the patent revoked is requesting revocation with the consequences specified in Art. 68 EPC (Art. 68 EPC 1973), namely the cancelling of the effects of the European patent application and the resulting patent as **from the outset** (**T 186/84**; **T 347/90**; **T 386/01**; dealing with a declaration to surrender, **T 393/15**). Where the respondent (patent proprietor) states that the patent has been abandoned 'since' a particular date, this cannot be considered to be a request for revocation, as it does not indicate that the patent has been abandoned ab initio. The case

law on requests for revocation therefore does not apply and the appeal must be examined as to its merits (**T 973/92**).

In **T 237/86** (OJ 1988, 261) the statement "we herewith abandon the above patent" was held to be equivalent to a request for revocation to which the board could accede under Art. 111(1) EPC 1973 (see also **T 347/90**). In **T 92/88** the words "the patent has been allowed to lapse in all designated states" were held to amount to a request for revocation.

In a number of cases the boards decided that a request by a patent proprietor to withdraw "the application" amounted to a request to revoke the patent (**T 264/84**; **T 415/87**; **T 68/90**; **T 322/91**). The board in **T 393/15** pointed out that the basic rule nevertheless applied that any statement intended as such a request had to be clear and leave no room for doubt. In the specific case before it, a letter stating "the patent application is withdrawn" could not be considered clear, because (among other things) the numbers of the patent and the appeal case were missing.

In **T 646/08** the appellant, in a letter, withdrew its appeal and at the same time withdrew its approval of the text of the patent as maintained by the opposition division in its interlocutory decision. The board held that the letter did not contain an **unequivocal** statement by the proprietor that it accepted the revocation of the patent with all the consequences specified in Art. 68 EPC. The appeal proceedings were terminated.

In **T 2573/12** the proprietor had stated during proceedings before the opposition division that it wished to abandon the patent. The board held that the **wish** to abandon the patent did not constitute **a clear and unambiguous** request for abandonment that could be construed as equivalent to a request for revocation (see **T 237/86**, OJ 1988, 261).

A number of cases concerned the situation in which the opposition division revoked the patent, and the patent proprietor appealed, and then, in the course of the appeal proceedings, requested the revocation of the patent. In **T 347/90** the board dismissed the appeal without going into the substantive issues, so that the revocation of the patent by the opposition divisionwas confirmed. In **T 18/92**, by contrast, the request by the patent proprietor (appellant) for revocation of the patent was interpreted by the board as a withdrawal of the appeal. Withdrawal of the appeal meant that the opposition division's decision revoking the patent took effect. In **T 481/96** the board examined the two solutions and endorsed **T 18/92**. In **T 1244/08** the board confirmed that according to established case law (see also **T 1003/01** and **T 53/03**), if an appellant (patent proprietor) whose patent has been revoked by an opposition division states clearly and unambiguously that it is no longer interested in pursuing the appeal proceedings, that is tantamount to a statement withdrawing the appeal. The withdrawal had the effect of immediately terminating the appeal proceedings, such that the opposition division's revocation decision became final. Any later request to retract the withdrawal and continue appeal proceedings was inadmissible. The board in **T 436/20** also followed this approach.

These two lines, which also may have an impact on partial reimbursement of the appeal fee, were summarised in **T 2684/18** as follows:

One line of the boards' case law views it equivalent to a withdrawal of appeal if the patent proprietor, as sole appellant against the opposition division's decision to revoke the patent, declares that it no longer approves the text of the patent as granted and withdraws all further claim requests on file (see e.g. **T 53/03**; **T 1244/08**; **T 547/11**; **T 1868/11**; **T 436/20**). According to another line of case law, a declaration by the patent proprietor that they no longer approve the text of the patent as granted means that the appeal is to be rejected as there is no longer any text of the patent in the proceedings on the basis of which the board could consider the appeal (Art. 113(2) EPC), with the result that the decision of the opposition division to revoke the patent becomes final (see, e.g. **T 163/99**, **T 1637/06**; **T 2524/12**; **T 784/14**; **T 454/15**; **T 1021/15**; **T 1653/18**). The board in **T 2684/18** concluded that, if the patent proprietor, instead of withdrawing the appeal (which would involve a partial refund of the appeal fee), does not choose this path but declares a non-approval of the text of the patent in any form, this is a deliberate choice and can thus not be interpreted as an unambiguous withdrawal of the appeal. However, the board found it unambiguous that the patent proprietor wished the decision of the opposition division to revoke the patent to become final. Thus, a dismissal of the appeal was in line with this wish.

For details on the requirement for a text submitted or agreed by the patent proprietor, see chapter III.B.3.

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1. Legal character of appeal procedure

1.1. General

The provisions governing the appeal procedure are set out in Art. 106 EPC to Art. 111 EPC and R. 99 EPC to R. 103 EPC and in the RPBA. R. 100(1) EPC plays an important role since it stipulates that, unless otherwise provided, the provisions relating to proceedings before the department which had taken the decision impugned shall apply to appeal proceedings. This application by analogy is, however, not automatically permissible in every case and for every provision (**G 1/94**, OJ 1994, 787). Criteria therefore had to be established for when such an analogy was permissible and when not. To this end it was necessary to analyse the legal nature of the appeal procedure.

Appeal proceedings are wholly separate and independent from the proceedings at first instance. Their function is to give a judicial decision upon the correctness of a separate earlier decision taken by a department (**T 34/90**, OJ 1992, 454; **G 9/91**, OJ 1993, 408; **G 10/91**, OJ 1993, 420; **T 534/89**, OJ 1994, 464; **T 506/91**). Appeal proceedings are not and were never intended to be the mere continuation of first-instance proceedings (**T 34/90**, OJ 1992, 454; **T 501/92**, OJ 1996, 261; **T 1251/07**; **T 719/09**; **T 177/18**). Article 12(2) RPBA now expressly states that the primary object of the appeal proceedings is the review of the decision under appeal in a judicial manner.

In **T 501/92** (OJ 1996, 261) the board deduced from this principle that any procedural request or statement made by a party during proceedings in the first instance was not applicable in any subsequent appeal proceedings, and had to be repeated during the latter if it was to remain procedurally effective.

The fact that the boards of appeal are courts was established in **G 1/86** (OJ 1987, 447, point 14 of the Reasons). In decision **G 1/99** (OJ 2001, 381) the Enlarged Board held that the appeal procedure is to be considered as a judicial procedure (see **G 9/91**, OJ 1993, 408, point 18 of the Reasons) proper to an administrative court (see **G 8/91**, OJ 1993, 346, point 7 of the Reasons; likewise **G 7/91**, OJ 1993, 356). In **G 9/92** and **G 4/93** (both OJ 1994, 875) it was decided that the extent of appeal proceedings is determined by the appeal.

These characteristics of the appeals procedure not only serve as criteria when assessing whether a provision may be applied analogously in individual cases; they also have general legal consequences in many respects. It follows from the characteristics set out by the Enlarged Board that the general principles of court procedure, such as the entitlement of parties to direct the course of the proceedings themselves ("principle of party disposition"), also apply to appeals (see **G 2/91**, OJ 1992, 206; **G 8/91**, **G 8/93**, OJ 1994, 887; **G 9/92** and **G 4/93**), that a review of the decision taken by the department of first instance can, in principle, only be based on the reasons already submitted before that department (**G 9/91**, **G 10/91**), and that the proceedings are determined by the petition initiating them (ne ultra petita) (see **G 9/92** and **G 4/93**). The Enlarged Board has also made it clear that the decision-making powers of opposition divisions, and of the boards in opposition appeal proceedings, are circumscribed by the statement under

R. 55(c) EPC 1973 (R. 76(2)(c) EPC) of the extent to which the European patent is opposed. They have no powers to decide and thus investigate anything extending beyond that statement (see **G 9/91**). This defined the sphere of application of Art. 114(1) EPC 1973, and clarified the distinction between the power to initiate and determine the object of proceedings, on the one hand, and the power to examine the facts then relevant, on the other. The individual procedural consequences and the Enlarged Board's decisions are discussed in greater detail below.

It is established jurisprudence that the boards of appeal and the Enlarged Board respectively act as judicial bodies, which were established by law, and apply general principles of procedural law (see **G 3/08**, OJ 2011, 10 and **G 2/08**, OJ 2010, 456).

In **T 1676/08** the board went on to say that one of these principles is laid down in Art. 6(1) ECHR, relying on principles of law common to the member states of the European Patent Organisation and applying to all EPO departments of the said organisation, which requires inter alia in "… the determination of his civil rights and obligations … everyone is entitled to **a fair and public hearing** within a reasonable time by an independent and impartial tribunal established by law". It is also established jurisprudence that, for **inter partes** proceedings before a board of appeal to be fair, the board must be neutral (see e. g. **R 12/09** of 15 January 2010 and **T 253/95**).

1.2. Rules of Procedure of the Boards of Appeal

The RPBA have their legal basis in Art. 23(4) EPC in conjunction with R. 12c(2) EPC (on this, see also **T 700/15**). They were comprehensively revised in 2019 and the new version came into force on 1 January 2020 (for details on this, see Supplementary publication 2, OJ 2020; for subsequent amendments see OJ 2021, A35 and OJ 2024, A15). The aims of the revision of the RPBA were: (i) to increase efficiency by reducing the number of issues (questions) to be dealt with, (ii) to improve predictability for the parties and (iii) to promote harmonisation.

The amendments to the RPBA can be divided into two categories. Firstly, improvements have been made as regards the management of the boards' overall caseload and of individual cases. Secondly, changes have been made to clarify that the primary object of appeal proceedings is to review the decision under appeal in a judicial manner (Art. 12(2) RPBA).

The boards of appeal are the first and final judicial instance in the procedures before the EPO. In this capacity, they review appealed decisions on points of law and fact. One of the consequences of their function being above all to review appealed decisions is that, as the appeal proceedings progress, the possibilities for parties to amend their case become increasingly limited.

The last time major changes had been made to the RPBA was in 2003. These related to the "core" of the appeal procedure, i.e. written and oral proceedings and various related aspects, such as late filing and costs (for details, see CA/133/02). In 2007 they were

revised again, to reflect the EPC 2000 (OJ 2007, 536); the provisions on written and oral proceedings were largely left unchanged, but renumbered.

Under Art. 23 RPBA, which was left unchanged from the previous version, the RPBA are binding on the boards unless they lead to a situation which would be incompatible with the spirit and purpose of the EPC (on this, see **T 2227/12**).

In **T 2154/15** the board stated that the RPBA constitute second-degree subsidiary law and thus could not remove powers attributed to the boards by an article of the EPC.

Further details on the RPBA can be found in particular in chapters V.A.9. "Remittal to the department of first instance", V.A.4. "New submissions on appeal", and III.C. "Oral proceedings".

1.3. Suspensive effect of the appeal

Under Art. 106(1), second sentence, EPC, an appeal has suspensive effect.

In **G 2/19** (OJ 2020, A87) the Enlarged Board observed that this provision has basic character. It is tailored to the standard case of an appeal filed by a party to the preceding proceedings who was adversely affected by a decision issued in them and who is seeking redress for a grievance which is appealable as such. There is, however, no legitimate interest in also lending suspensive effect to a means of redress which has no basis in the EPC and which is therefore clearly inadmissible, such as an appeal filed by a third party within the meaning of Art. 115 EPC to remove allegedly unclear claims (Art. 84 EPC). The Enlarged Board held that it logically follows that the initiation of a means of redress which, owing to such circumstances, is clearly inadmissible can have no suspensive effect.

The Legal Board defined this effect in **J 28/94** (OJ 1995, 742), in which a third party claimed entitlement to the grant of the patent and requested suspension of the proceedings for grant under R. 13(1) EPC 1973 (R. 14 EPC). The board took the view that the appeal's suspensive effect meant the contested decision had no legal effect until the appeal was resolved. Otherwise the appeal would be nugatory. Thus, if a decision refusing to suspend the publication of the mention of grant of a patent were appealed, publication should be deferred until the appeal was decided. If (as here) this was not possible for technical reasons, the EPO should take all necessary steps to advise the public that the mention of grant was no longer valid (see also **T 1/92**, OJ 1993, 685).

According to **J 28/03** (OJ 2005, 597), suspensive effect means that the consequences following from an appealed decision (here: grant of a patent on the parent application) do not immediately occur after the decision has been taken. Actions normally taking place after a decision are "frozen". Suspensive effect does not have the meaning of cancellation of the appealed decision. Even after an appeal the decision as such remains and can only be set aside or confirmed by the board of appeal.

In **J 12/16** the examining division had had the mention of the grant of the patent published while the period for appealing against the Legal Division's rejection of a request for the application's transfer was still running. The board held that doing so could cause serious problems because publishing the mention of the grant triggered the start of the period for opposing the patent; that, in turn, could make the appeal redundant while the appeal proceedings were still pending, even though the appeal itself had suspensive effect. Since, as long as the appeal period had not expired, in theory the filing of an appeal, and so the suspensive effect under Art. 106(1) EPC, had to be expected at any moment (see also **J 28/94**), publishing the mention of the grant should be avoided in such circumstances so as not to deprive the appeal of its suspensive effect in practice.

In **T 591/05**, the suspensive effect of an appeal was said to be a direct consequence of, and was subordinate to the appeal itself and, consequently, no circumstance directly arising from the suspensive effect of the appeal could be invoked in support of the admissibility of the appeal itself.

J 18/08 and **T 1674/12** likewise concerned the meaning of suspensive effect.

In view of the suspensive effect of an appeal, a request for conversion under Art. 135 and R. 155 EPC cannot be considered during appeal proceedings, since such a request is conditional on the application being deemed withdrawn, withdrawn or rejected (**T 1283/19**).

1.4. Devolutive effect of the appeal

When appeal proceedings start, responsibility for the case passes from the department of first instance to the boards of appeal (known as the devolutive effect; see **T 473/91**, OJ 1993, 630; **T 830/03**, **T 555/08**).

According to **T 1382/08**, the devolutive effect of an appeal before a board extends only to that part of the impugned decision which is indicated in the statement of grounds for appeal and actually challenged by the appeal. For the board, therefore, the extent to which the impugned decision is to be amended, as defined under R. 99(2) EPC, is simultaneously the limit of the devolutive effect. This in turn implies that the impugned decision's part not covered by the statement of grounds of appeal also cannot be part of the appeal proceedings and consequently becomes final on expiry of the time limit for appeal. This approach was also adopted by the same board in **T 448/09**. Only those issues that were considered and decided upon in the decision can later be challenged in appeal proceedings (**T 2117/11**). However, the board in **T 689/09** noted that, whilst it was aware of case law according to which the distinction between different

legal effects of a decision also fell under the "extent to which the impugned decision is to be amended" pursuant to R. 99(2) EPC, (**T 1382/08**), this approach left the notion of the "subject of the appeal" even more diffuse and elusive. See also in this chapter V.A.3.2. "Subject-matter under examination".

On appeal, the department of first instance loses its competence for the further prosecution of the application for all contracting states – the appeal does not leave a part of the application pending in the first instance. Thus, deemed withdrawal of the application pursuant to Art. 110(3) EPC 1973 applied in the case of a failure to reply to a communication pursuant to Art. 110(2) EPC 1973 in ex parte appeal proceedings, even where the decision under appeal did not refuse the application, but only a particular request. The board reasoned that even if the appealed decision concerned only the designation of a state and not the application as a whole, according to the principle of unity of the application and of the patent in the proceedings the suspensive effect of the appeal affected the application as a whole (**J 29/94**, OJ 1998, 147).

The devolutive effect of the appeal does not affect the competence of the department of first instance to decide on a request concerning the contents of the minutes of the oral proceedings held before it. What is devolved is the subject-matter decided by the appealed decision (**T 1198/97**).

1.5. Accelerated processing before the boards of appeal

New rules on accelerating appeal proceedings have been introduced in Art. 10(3) to (6) RPBA. Paragraphs 3 to 6 replace the notice from the Vice-President DG 3 dated 17 March 2008 concerning accelerated processing before the boards of appeal (OJ 2008, 220). See also the notice from the Boards of Appeal on accelerated proceedings of 19 January 2024.

The possibility of accelerating proceedings allows the boards to give an appeal priority over other pending appeals. Parties with a legitimate interest may ask the boards of appeal to deal with their appeals rapidly. Under Art. 10(3) RPBA, the boards have discretion in deciding on a party's request for acceleration (for details on this, see the explanatory remarks on Art. 10 RPBA, published in Supplementary publication 2, OJ 2020).

The appellant (patentee) in **T 734/12** requested acceleration of the appeal proceedings on the basis of three arguments: the possibility of remittal; the suggestion that the decision under appeal related to an important point of law the resolution of which might take additional time; and the commercial and medical importance of the patented and approved treatment. In the board's opinion these reasons did not in themselves justify acceleration. Whilst acceleration had been acknowledged as appropriate when infringement proceedings were threatened or pending, which was not the case here. However, it was clear there was a substantial measure of agreement between the parties and the public had an interest in the early resolution of disputes. The interests of the parties and of the public would therefore best be served by an expedited procedure.

In **T 895/13** of 28 March 2014 the board confirmed that acceleration is always a matter for the exercise of the board's discretion. While trivial reasons would clearly not warrant acceleration, there was no fixed standard of proof. It was clear in the case at issue that the board could have accelerated the procedure ex officio under the notice of 17 March 2008 concerning accelerated processing before the boards of appeal (OJ 2008, 220), in view of the disadvantage which could ensue before the Belgian courts

from the suspensive effect of the appeal in question. If the board could allow acceleration on that basis of its own motion, it could clearly do so on the request of a party. The board ordered the appeal proceedings to be accelerated. It added that its views related only to the particular facts of this case and the co-pending appeal in **T 1125/13** of 28 March 2014 between the same parties and were not intended to set any precedent for application beyond those facts.

In **T 239/16** the board allowed acceleration. The board stated that according to the notice of 17 March 2008 concerning accelerated processing before the boards of appeal (OJ 2008, 220) trivial reasons would clearly not justify acceleration. It followed from the scenarios in the notice that the term "legitimate interest" was not to be construed as requiring compelling reasons. Rather, objective reasons had to be put forth that warranted giving the appeal priority. Of course, the reasons invoked must be weighed against any disadvantage which might possibly ensue from granting accelerated proceedings. In the case in hand, in support of their requests for accelerated processing, the appellants (opponents) argued that infringement proceedings had been brought against their affiliates in France. The board was satisfied that the appeal proceedings at issue had a bearing on the infringement proceedings in France even if the appellants were not party to the infringement proceedings in France. See also **T 1868/16** where the board allowed acceleration on the grounds that arbitration proceedings had been brought against an affiliate company in Portugal.

In **T 872/13** the board did not accede to the request for accelerated processing of the appeal because the reason provided by the appellant (opponent) that the patent was "causing uncertainty and hampering investment and development decisions by interested parties" was a general statement and not specifically related to a party to the proceedings.

In **T 1213/17** the proprietor requested that the case be remitted to the opposition division if the new objection was admitted into the proceedings. The board noted that the impugned decision dealt with all the grounds for opposition raised by the opponent. Moreover, national proceedings on issues of infringement and revocation were pending before the Stockholm District Court/Patent and Market Court in Sweden, on the basis of which the opponent requested accelerated processing before the board. The board decided not to remit the case.

See also chapter IV.C.7. "Acceleration of opposition proceedings".

2. Filing and admissibility of the appeal

According to Art. 108 EPC a notice of appeal shall be filed, in accordance with the Implementing Regulations, at the EPO within two months of the date of notification of the decision. Notice of appeal shall not be deemed to have been filed until the fee for appeal has been paid. A statement setting out the grounds of appeal must be filed in accordance with the Implementing Regulations within four months of notification of the decision. R. 99 EPC sets out what the notice of appeal and the statement of grounds must contain.

The admissibility of an appeal can only be assessed as a whole (**T 382/96**, **T 1763/06**, **T 509/07**, **T 23/10**, **T 2001/14**). There is no support in the EPC for a notion of 'partial admissibility' of an appeal (**T 774/97**, **T 509/07**).

See also chapter V.A.11.3. "Appeal deemed not to have been filed".

2.1. Transitional provisions for the EPC 2000

If notice of appeal was filed before the revised EPC entered into force, the appeal's admissibility must be assessed under the provisions of the EPC 1973, in line with the principle (tempus regit actum) that entitlement to perform a procedural act is governed by the law in force when the act took place (**T 1366/04**).

In **J 10/07** (OJ 2008, 567) the board had to decide whether the EPC 1973 or the EPC 2000 applied. The decision whether an appeal is admissible according to the relevant provisions, geared to the fulfilment of the requirements for admissibility within a certain legally defined period, depends entirely on the substantive and legal position at the time of expiry of the time limits. Since the belated fulfilment of admissibility requirements after the expiry of the time limit cannot be taken into account in the examination of admissibility, so too a change in the legal position occurring after the expiry of the time limit for fulfilling the admissibility requirements can have no impact, either to the appellant's advantage or to his detriment, on the assessment of admissibility. In **T 2052/08**, the board, citing the finding in **J 10/07** that R. 103 EPC should not be applied to appeal cases concerning patent applications filed before the entry into force of the EPC 2000, found that, as **J 10/07** concerned the reimbursement of the appeal fee in situations where a substantial procedural violation had occurred at first instance, its conclusions should not be taken as implying a statement on the applicability of R. 103 EPC (see also **T 49/11**).

In **T 616/08**, the board found that, to the extent that it was relevant whether an aligned or the original version of a rule applied, there was a gap in the law which needed to be closed by case law as long as – like in the case of Art. 107, 109 and 111 EPC – the legislator was not active.

2.2. Appealable decisions

Under Art. 106(1), first sentence, EPC appeals lie from decisions of the Receiving Section, examining divisions, opposition divisions and the Legal Division. It is such decisions themselves rather than their grounds that are open to appeal (see **T 611/90**, OJ 1993, 50).

2.2.1 Departments

The boards can hear appeals only against the decisions taken by other EPO departments (**J 12/85**, OJ 1986, 155). There is thus no right of recourse to the boards of appeal in respect of extensions of patent applications and patents to the extension states. Instead, it is the respective national jurisdiction which is responsible (**J 14/00**, OJ 2002, 432; **J 19/00**, **J 9/04**, **J 2/05**, **J 4/05**, **J 22/10** and **J 9/11**). The board in **T 506/08** considered

that it was not competent to hear a request for a (partial) refund of the international search fee where no search had been performed. See also **T 2948/18**.

2.2.2 Whether there has been a decision

Whether a document constitutes a 'decision' or not depends on the substance of its content and not on its form (**J 8/81**, OJ 1982, 10; see also **J 26/87**, OJ 1989, 329; **J 13/92**, **T 263/00**). The criterion of substance has to be assessed in its procedural context (**T 713/02**, OJ 2006, 267, **R 4/18**). A "decision" needs to involve a reasoned choice between legally viable alternatives (**T 934/91**, OJ 1994, 184). According to **T 165/07**, the decisive question was whether the document (communication by a formalities officer), when objectively interpreted in its context, could have been understood by its addressees as a final, i.e. not merely preliminary, and binding determination of substantive or procedural issues by the department ("organ") of the EPO which had jurisdiction ("is competent"). In **J 12/19** the board shared this view, with the proviso that even a document issued by a department of the EPO that does not have jurisdiction may constitute a decision.

On this point, see also chapter III.K.3.1. "When is there a decision within the meaning of Rule 111 EPC?"

a) Examples of appealable decisions

(i) A formalities officer's letter rejecting the opposition as inadmissible was held to be an appealable decision in **T 1062/99**. (See also **G 1/02**, OJ 2003, 165, a referral occasioned by diverging decisions **T 1062/99** and **T 295/01**, OJ 2002, 251) on a formalities officer's competence to decide on the admissibility of an opposition).

(ii) A document (EPO Form 2901) concerned with the applicant's request for re-establishment in respect of the period for payment of the third renewal fee plus additional fee was deemed to be a decision in **J 7/08**.

(iii) A communication from the Legal Division to deny the opponent party status in the proceedings pursuant to R. 142 EPC and its resulting refusal to consider the observations and requests submitted by the opponent constituted a decision within the meaning of Art. 106 EPC (**J 12/19**).

b) Examples where the communication was not an appealable decision

The case law of the boards of appeal has established that the following are **not** regarded as appealable decisions:

(i) A request under R. 89 EPC 1973 (R. 140 EPC) for correction of a contested decision. Not until the request has been decided at first instance can the matter be referred to the board (**J 12/85**, OJ 1986, 155).

(ii) The preparatory steps referred to in Art. 96(2) EPC 1973 and R. 51(3) EPC 1973 (R. 71(3) EPC, **T 5/81**, OJ 1982, 249).

(iii) A communication under R. 57(1) EPC 1973 (R. 79 EPC, **T 222/85**, OJ 1988, 128), or R. 69(1) EPC 1973 (R. 112 EPC, **J 13/83**).

(iv) A communication from the opposition division finding that an opposition has been validly filed, and stating that the decision will be taken on that point at the oral proceedings (**T 263/00**).

(v) An order by a director of a department of first instance (such as an opposition division) rejecting an objection to a member of the division on the ground of suspected partiality. The composition of the division could, however, be challenged on such a ground in an appeal against its final decision or against a separately appealable interlocutory decision under Art. 106(3) EPC 1973 (**G 5/91**, OJ 1992, 617).

(vi) A "decision" by a director on a request for inspection of file (**J 38/97**).

(vii) A letter bearing the letterhead of an EPO DG and signed by an EPO Vice-President, if it is evident from its content that it does not constitute a decision and from its form that it does not emanate from any of the departments listed in Art. 21(1) EPC 1973 (**J 2/93**, OJ 1995, 675).

(viii) The consistent case law of the boards of appeal has been that the minutes of oral proceedings, and the correction thereof, are not decisions within the meaning of Art. 106 EPC (**R 4/18**, see **T 838/92**, **T 212/97**, **T 231/99**).

(ix) A communication from a formalities officer primarily dealing with the patentee's request to stay the opposition proceedings and to remit the case to the examination division for a decision on the request for correction under R. 89 EPC 1973 (**T 165/07**).

(x) A communication under R. 71(3) EPC. This is not intended to terminate the examination procedure but is rather a preparatory action and is therefore as such not appealable (**T 1181/04**, OJ 2005, 312; **T 1226/07**; **T 1377/15**).

(xi) When not acceding to a request to hold oral proceedings in Munich instead of The Hague, the examining division does not take a decision but only expresses the way the EPO is managed (**T 1142/12**, see also **R 13/14**).

(xii) A communication of information by which the appellant was informed that, as the decision to grant had been rectified under Art. 109 EPC, the examination procedure was resumed, and it was not possible to file an opposition during this part of the procedure (**J 22/12**).

(xiii) An order to take evidence is neither an appealable decision under Art. 106(1) EPC nor an interlocutory decision allowing a separate appeal within the meaning of

Art. 106(2) EPC. Instead, it is a case-management measure that precedes a substantive decision and cannot be reviewed as long as the proceedings are still pending (**T 1954/14**).

(xiv) A communication to change in a board's composition with regard either to the number of its members under Art. 21(4)(b) EPC 1973 or to the replacement of a member under Art. 4 of the BDS of the Technical Boards of Appeal is not a decision (**T 1676/08**).

(xv) Notification of the case number and the responsible board of appeal by the Registry did not constitute a decision under R. 69(2) EPC 1973 (R. 112 EPC) recognising that an appeal was pending (**T 371/92**, OJ 1995, 324; see also **T 1100/97** and **T 266/97**).

(xvi) A communication from the opposition division refusing a request for postponement of oral proceedings is not open to appeal and not an interlocutory decision against which a separate appeal must be allowed (**T 1967/20**).

T 26/88 (OJ 1991, 30), which held that a document stating that the patent was revoked under Art. 102(4) and (5) EPC 1973 did not constitute a decision, was overruled by **G 1/90** (OJ 1991, 275).

2.2.3 Interlocutory decisions

Under Art. 106(2) EPC (formerly Art. 106(3) EPC 1973) a decision which does not terminate proceedings as regards one of the parties (interlocutory decision) can only be appealed together with the final decision, unless the decision allows a **separate appeal**. The EPC does not explicitly set out the cases in which interlocutory decisions have to allow a separate appeal. Instead, the legislator has expressly left it to the department making the decision to decide whether to allow an appeal; see the "travaux préparatoires" for the EPC 1973 (**T 1954/14**). It is settled practice to allow a separate appeal against interlocutory decisions on admissibility of an opposition (see e.g. proceedings in **T 10/82**, OJ 1983, 407) or a finding that a patent as amended meets the requirements of the EPC (see e.g. **T 247/85** and **T 89/90**, OJ 1992, 456).

It is a requirement for admissibility of an appeal against an interlocutory decision within the meaning of Art. 106(2) EPC that the department of first instance allowed a separate appeal (**J 8/11**).

In **T 857/06** the board stated that a first interlocutory decision which does not allow a separate appeal can be appealed together with a second interlocutory decision which does not leave any substantive issues outstanding and which allows a separate appeal.

The board in **T 756/14** observed that allowing a separate appeal against an interlocutory decision under Art. 106(2) EPC is a constitutive decision by the examining decision without which the former decision cannot be challenged by way of an appeal and so this aspect must be included in the order too. See also **T 1967/20**.

2.2.4 Appeals against decisions of the boards of appeal

Art. 106(1) EPC does not provide for appeals against decisions of the boards of appeal. Appeals under Art. 106(1) EPC against final board decisions are therefore not possible and have to be rejected as inadmissible. A limited judicial review of decisions of the boards of appeal was introduced into the EPC 2000, in Art. 112a EPC. See chapter V.B.3."Petition for review under Article 112a EPC".

In **J 3/95** (OJ 1997, 493), the Legal Board referred a number of questions, including: In the context of the EPC, what administrative or jurisdictional measures should be taken in response to requests based on the alleged violation of a fundamental procedural principle and aimed at the revision of a decision taken by a board of appeal with the force of res judicata?

In **G 1/97** (OJ 2000, 322), the Enlarged Board answered the question as follows:

1. In the context of the EPC 1973, the jurisdictional measure to be taken in response to requests based on the alleged violation of a fundamental procedural principle and aimed at the revision of a final decision of a board of appeal having the force of res judicata should be the refusal of the requests as inadmissible.

2. The decision on inadmissibility is to be issued by the board of appeal which took the decision forming the subject of the request for revision. The decision may be issued immediately and without further procedural formalities.

3. This jurisdictional measure applies only to requests directed against a decision of a board of appeal bearing a date after that of the present decision.

4. If the Legal Division of the EPO is asked to decide on the entry in the Register of a request directed against a decision of a board of appeal, it must refrain from ordering that the entry be made if the request, in whatever form, is based on the alleged violation of a fundamental procedural principle and aimed at the revision of a final decision of a board of appeal.

This situation has not been changed by the introduction of a petition for review in Art. 112a EPC (**T 365/09**). According to the board, a first difference between appeal and petition evidently lay in the fact that, unlike Art. 106(1) EPC, Art. 112a(3) EPC clearly excludes a suspensive effect of the petition. Moreover, a petition for review can, according to Art. 112a EPC, only be based on fundamental procedural violations or defects during the appeal proceedings, which do not include questions relating to patentability. This can be derived from the exhaustive list of fundamental procedural violations and defects in Art. 112a(2) EPC and R. 104 and 105 EPC. This view has, in the meantime, been confirmed in **G 3/08** (OJ 2011, 10).

In **T 846/01** it was clear that the appellants were not contesting the substance of the opposition division's interlocutory decision, which dealt with the renumbering of the claims and the adaptation of the description, but were actually trying to reopen the issue of validity

which had already been decided in an earlier decision of a board of appeal. Under Art. 106 EPC 1973 and in view of the binding effect of board decisions, this finding in the decision was not open to challenge, even though the opposition division decision was accompanied by a form stating the decision was appealable. See also **T 2047/14** on this topic.

2.3. Board competent to hear a case

2.3.1 Technical or Legal Board of Appeal

a) General

The responsibilities and composition of boards are laid down in Art. 21 EPC. In **G 2/90** (OJ 1992, 10) the Enlarged Board made it clear that under Art. 21(3)(c) EPC 1973, the Legal Board was competent only for appeals against decisions taken by an examining division consisting of fewer than four members and which did not concern refusal of the application or grant. In all other cases, i.e. those covered by Art. 21(3)(a), 21(3)(b) and 21(4) EPC 1973, the technical boards were competent. The provisions of Art. 21(3) and (4) EPC 1973 governing responsibilities and composition were not affected by R. 9(3) EPC 1973 (R. 11(3) EPC).

b) Technical board of appeal competent

Article 21(3)(a) EPC expressly states that appeals against decisions concerning refusal of a European patent application or the grant, limitation or revocation of European patents are to be heard by the technical boards of appeal.

An appeal against a decision of an examining division refusing a request under R. 89 EPC 1973 (R. 140 EPC) for correction of the decision to grant was to be decided by a technical board of appeal (**G 8/95**, OJ 1996, 481, overruling **J 30/94**). (A board, however, has no appellate competence, in inter partes opposition appeal proceedings, to review the decision on correction of the grant decision taken in ex parte examination proceedings under R. 89 EPC 1973, since that decision does not form the subject of the appeal roceedings before it; see **T 79/07**, deviating from **T 268/02**; see also e.g. **T 1495/09**).

According to **T 1382/08**, for the purpose of determining competence under Art. 21(3) EPC 1973, a contradictory or unclear impugned decision is to be considered in the light of its legal consequences vis-à-vis the applicant or the impression given to the public as to its legal nature. In the case at issue, it was unclear whether the contested decision of the examining division was actually a refusal of the application or, instead, merely a refusal of a request for a refund of the search fee or confirmation of the loss of rights established in the R. 69(1) EPC 1973 (R. 112 EPC) communication. In the latter two cases, the Legal Board would have been competent to hear the appeal under Art. 21(3)(c) EPC 1973. The board found that the decision had the effect of a refusal, which meant that the technical board of appeal was competent.

However, in **J 16/13**, the board held that, where the formal order of an appealed decision is obviously erroneous to such an extent that it is essentially incomprehensible when compared with the reasons in the body of the decision, in particular when it plainly does not correspond to any of the foreseen possible legal effects flowing from the substantive issue underlying the appealed decision, and if the competence pursuant to Art. 21(3) EPC is supposed to change from one board to another only because of such an "impossible" order, the formal order can be disregarded for the purposes of Art. 21(3)(a) and (c) EPC, and rather the substantive request underlying the decision must be guiding in determining the board competent to decide the case (**T 1382/08** not followed).

c) Legal Board of Appeal competent

An appeal against the decision of the examining division refusing a request for corrections under R. 88 EPC 1973 (R. 139 EPC) filed after grant of the patent, on the other hand, is to be decided by the Legal Board. The appeal concerned the preliminary question of whether a request under R. 88 EPC 1973 could be made after grant. This was purely a question of law, and did not concern the refusal of a European patent application or the grant of a European patent. It was also consistent with **G 8/95**, as answering the preliminary question did not involve any consideration of the text with which the patent should be granted (**J 42/92**).

2.3.2 Specific cases

a) Interruption of proceedings

The question for the board in **T 854/12** was whether it was competent to decide itself whether proceedings had been interrupted under R. 142 EPC, or had to arrange for the Legal Division to take a decision in this regard. It found that a decision-making board had to ascertain for itself whether, based on the facts submitted and any additional facts it had had to investigate of its own motion, the conditions for an interruption had been met, if its decision depended on this point (see also **T 54/17**).

b) Request for a search-fee refund

In **G 1/11** (OJ 2014, A122) the Enlarged Board held that a technical board of appeal was competent to hear an appeal against an EPO examining division's decision – taken separately from its decision granting a patent or refusing the application – not to refund search fees under R. 64(2) EPC.

Where a request under R. 64(2) EPC for a refund of a further search fee paid under R. 64(1) EPC is first filed on appeal against an examining division decision, the board has no competence to decide on it and it must therefore be refused as inadmissible (**T 2076/15**).

c) Interlocutory revision and reimbursement of appeal fee

In **G 3/03** (OJ 2005, 344), the Enlarged Board held that in the event of interlocutory revision under Art. 109(1) EPC 1973, the department of first instance whose decision had been appealed was not competent to refuse a request of the appellant for reimbursement of the appeal fee. It was the board of appeal which would have been competent under Art. 21 EPC 1973 to deal with the substantive issues of the appeal if no interlocutory revision had been granted which was competent to decide on the request.

2.4. Entitlement to appeal

2.4.1 Formal aspects under Article 107 EPC

Under Art. 107, first sentence, EPC, an EPO decision can be appealed only by a party to the proceedings which gave rise to it. Concerning the entitlement to appeal of a transferee of a patent, see chapter III.O.1. "Party status as patent proprietor".

a) Appeal filed by wrong company

In **T 340/92** the appellant was a company which had obviously been named in the notice of appeal by mistake, instead of a subsidiary, which was the real opponent. The actual appellant was the only party adversely affected by refusal of the opposition, and was readily identifiable through its representative, who was named in the appeal dossier. The board held that this deficiency could be remedied under R. 65(2) EPC 1973 (R. 101(2) EPC). See also **T 875/06**.

However, if the notice of appeal was filed by an adversely affected party, but the grounds of appeal were filed by a different company which was not a party to the opposition proceedings, let alone a party adversely affected by the outcome of those proceedings, the appeal could not be held admissible. No provision having been made in the Implementing Regulations pursuant to Art. 133(3), last sentence, EPC 1973 the EPC 1973 did not allow the representation of one legal person by the employee of another economically related legal person, who could not therefore file the grounds of appeal on the other's behalf (**T 298/97**, OJ 2002, 83).

According to **G 1/12** (OJ 2014, A114), the identity of the appellant, i.e. the person entitled to appeal, has to be established by expiry of the two-month period prescribed in Art. 108, first sentence, EPC at the latest (see R. 101(1) EPC). In certain circumstances, errors in the information identifying the appellant can be corrected under R. 101(2) EPC (for more details on this, see chapter V.A.2.5.2).

b) Appeal filed in name of representative

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

In the absence of any clear indication to the contrary, a professional representative who was authorised to act for a party adversely affected by a decision and then filed an appeal against this decision had to be presumed to be acting on behalf of the very same party that he acted for in the first-instance proceedings, and not on behalf of someone else not entitled to appeal (**T 920/97**). Although the notice of appeal did not indicate the name and address of the appellant as required by R. 64(a) EPC 1973, the appellant corrected the notice of appeal in time and the appeal was thus admissible. See also **T 1911/09** and **T 2244/14**.

c) Party consisting of plurality of persons

If a party consists of a plurality of persons, an appeal against a decision which adversely affects this party has to be filed on behalf of all these persons through their duly determined common representative (see **G 3/99**, OJ 2002, 347, where multiple opponents file a joint opposition; **T 1154/06**, with respect to joint proprietors of a European patent; see also **R 18/09**, with respect to joint proprietors and a petition for review) (**T 755/09**).

In **G 3/99** (OJ 2002, 347), the Enlarged Board held that where the opposing party consisted of a plurality of persons, an appeal had to be filed by the common representative under R. 100 EPC 1973. Where the appeal was filed by a non-entitled person, the board of appeal was to consider it not to be duly signed and consequently invite the common representative to sign it within a given time limit. The non-entitled person who filed the appeal should be informed of this invitation. If the previous common representative was no longer participating in the proceedings, a new common representative should be determined pursuant to R. 100 EPC 1973 (R. 151 EPC). See also **R 18/09**. In order to safeguard the rights of the patent proprietor and in the interests of procedural efficiency, it had to be clear throughout the procedure who belonged to the group of common opponents or common appellants. If either a common opponent or appellant (including the common representative) intended to withdraw from the proceedings, the EPO had to be notified accordingly by the common representative or by a new common representative determined under R. 100(1) EPC 1973 in order for the withdrawal to take effect (see e. g. **T 562/13**).

Where an appeal is filed by **only one of several joint members** of a party and where this member is not the common representative, the board of appeal should send the common representative a communication giving him the opportunity to fulfil the necessary requirements of the EPC (see **G 3/99**, **T 1154/06**). If the common representative does not do so, the notice of appeal is deemed not to have been filed. Such an appeal is thus treated in the same way as an appeal filed but not signed by an authorised person (**R 18/09**; see also **T 755/09**).

In **T 755/09** the appeal was filed only on behalf of one of several persons who, at the time of filing the appeal, were the joint applicants of the application in suit (see Art. 59 EPC). In principle the appeal had therefore to be held inadmissible in accordance with R. 101(1) EPC. The board pointed out that the case did not come under the category calling for a communication under R. 101(2) EPC inviting the appellant to remedy deficiencies under R. 99(1)(a) EPC within a specified period (see **G 1/12**, OJ 2014, A114).

The notice of appeal was unambiguous nor did the appellant ever claim that the notice of appeal contained a deficiency under R. 101(2) EPC. The legal remedy foreseen in R. 101(2) EPC therefore could not apply (see also **T 656/98**, OJ 2003, 385).

An appeal filed by a party to the proceedings who is adversely affected by the contested decision is admissible even if it was jointly filed with a different company that was not a party to the proceedings (**T 158/19**).

d) Company in receivership

A company that has gone into receivership can no longer validly file an appeal; only the insolvency administrator can do so on its behalf. In **T 693/05**, the insolvency administrator had authorised the representative to file an appeal, which was held admissible. In **T 1324/06**, the authorised representative of a company which had previously been declared bankrupt filed an appeal on behalf of the company. Relying on R. 101(6) EPC 1973 and R. 152(8) EPC, under which the authorised representative shall be deemed to be authorised until the termination of his authorisation has been communicated to the EPO, the board held the appeal admissible, no such notification having been received from the insolvency administrator or representative.

e) Death of the appellant (opponent)

In **T 1213/13**, the board noted that the appellant, the only party to the proceedings adversely affected by the appealed decision, had died. The deadline set in the board's communication aiming to establish if there were any heirs had passed and the communication gone unanswered. It had therefore not been possible to identify any heirs (or legal representatives). Since the status of opponent could pass to any heirs, where an opponent was an appellant too, the heirs could pursue the appeal. However, they had to make themselves known and prove their status as such. The board declared the proceedings closed for want of an appellant to pursue them (see also **T 74/00**).

2.4.2 Party adversely affected (Article 107 EPC)

a) General

Under Art. 107 EPC, any party to proceedings adversely affected by a decision may appeal. A party is adversely affected within the meaning of Art. 107 EPC if the decision fails to meet that party's wishes. This had to be assessed by comparing the request at first instance with the substance of the decision (see **T 244/85**, OJ 1988, 216; **T 1682/13**). According to **T 234/86** (OJ 1989, 79) a party is adversely affected if the decision does not accede to his main requests or to auxiliary requests preceding the allowed auxiliary request (see also **T 392/91**). This is not the case if the patent proprietor withdraws his main request or preceding auxiliary requests and agrees with the allowed auxiliary request (**T 506/91**, **T 528/93**, **T 613/97**, **T 54/00**, **T 434/00**).

The question of whether or not a party is adversely affected by a decision taken by an authority as defined in Art. 106 EPC arises in connection with Art. 107 EPC in order to establish who may appeal.

An appeal is inadmissible where the appellant is seeking to amend not the decision itself but the reasons for it (**T 84/02**) or the sole aim is to settle a point of law not relevant to the case (**J 7/00**, see also **T 1790/08**). Abandoning claims to have a prompt decision in order to be in a position to appeal results in the appeal being inadmissible where the patentee's requests were actually granted by the opposition division (**T 848/00**).

In **T 735/13**, the board held that appellants who had agreed with a decision at the time but later changed their minds could not be regarded as adversely affected; an adverse effect required a discrepancy between the decision and what they had been requesting when it was issued (see also **T 1558/21**).

b) Patent applicant

(i) Decision to grant the patent

In **J 12/83** (OJ 1985, 6) the board found that an applicant for a European patent might be "adversely affected" within the meaning of Art. 107 EPC 1973 by a decision to grant the patent, if the patent was granted with a text not approved by him under Art. 97(2)(a) EPC 1973 and R. 51(4) EPC 1973 (R. 71(3) EPC) (see also **J 12/85**, OJ 1986, 155; **T 114/82** and **T 115/82**, both OJ 1983, 323 and **T 1/92**, OJ 1993, 685).

In **T 1003/19** the appellant was adversely affected despite the decision to grant a patent. The granted version of the patent corresponded neither to a text submitted by the applicant nor to a text agreed by it, nor to a text deemed to have been approved by it. There was, therefore, a discrepancy between the applicant's request and the decision of the examining division. R. 71(5) EPC only applied where the text intended for grant had been communicated to the applicant according to R. 71(3) EPC. In the board's view, this was not the case, where there was sufficient evidence to conclude that the text referred to in the communication under R. 71(3) EPC did not reflect the true will of the examining division. See also **T 2081/16**.

Following **T 1003/19** and **T 2081/16**, the board in **T 408/21** stated that R. 71(5) EPC did not apply in this case either, as in the step preceding the deemed approval the applicant had to be informed of the text in which the examining division intended to grant the patent according to R. 71(3) EPC. Although the (then) applicant received a R. 71(3) EPC communication, the documents indicated were not those which the examining division intended to grant.

In **T 2277/19** the board stated that the appellant was not adversely affected by the decision to grant a patent. The board did not follow the approach taken in **T 1003/19** and **T 2081/16**. In the board's judgement, R. 71(3) EPC imposed on the applicant a duty to check and verify the text. The fact that an applicant did not exercise its right to request amendments

under R. 71(6) EPC could only be interpreted as approval of the communicated text, i.e. the text intended for grant.

In **T 265/20** the board found that the appellant was adversely affected by the decision to grant a patent, as all the drawing sheets as requested were missing from the text of the granted patent. The board referred to **T 2277/19** (see above), in which the facts were different from the outset. In that case, the original application contained the description pages, the claims and drawing sheets 1/18 to 18/18. During the examination proceedings, the applicant filed amended drawing sheets 1/7 to 7/7 to replace drawing sheets 1/18 to 18/18 of the application as filed. Drawing sheets 1/7 to 7/7 were included in the text communicated to the applicant under R. 71(3) EPC, but drawing sheets 8/18 to 18/18, were also included. The applicant then approved the text intended for grant subject to minor amendments. The board held the appeal inadmissible on the ground that the appellant was not adversely affected. The facts of the case in hand differed in that no drawings at all, i.e. neither the requested ones nor any others, were included in the text communicated to the applicant under R. 71(3) EPC and the Druckexemplar, and in that no explicit approval was given, but approval was rather deemed to have been given.

In **T 646/20** the applicant had approved the text intended for grant and the corresponding bibliographical data. The appellant filed an appeal against the decision to grant and requested correction of the designation of member states and the addition of further states. The board held that the applicant's approval in response to the notification under R. 71(3) EPC also related to the designated member states, and the decision to grant subsequently rendered by the examining division matched the contents of the notification and the applicant's approval. The board concluded that the appellant was not adversely affected.

For more details on this, see also chapter IV.B.3.2. "Approval of the text by the applicant".

(ii) Other cases

An applicant was 'adversely affected' and thus able to file an appeal where the examining division had rectified its decision but refused to grant reimbursement of the appeal fee (**J 32/95**, OJ 1999, 733).

The grounds forming the basis of a decision on rectification should not be interpreted to mean only the legal basis of the decision, but also the factual reasons supporting the legal basis. An applicant adversely affected by the **factual basis** was thus considered adversely affected in **T 142/96**.

In **J 17/04** the board found that although the notice of appeal only referred to a correction of the decision under appeal under R. 88 and 89 EPC 1973, the appellant made therewith (implicitly) the allegation that the decision under appeal incorrectly limited the regional scope of the patent and that this decision should be set aside. The board was therefore satisfied that the appellant had sufficiently claimed to be adversely affected and the appeal was admissible.

In **J 5/79** (OJ 1980, 71) the board ruled that an applicant whose priority right was found to have lapsed because he failed to file the priority documents was no longer adversely affected if re-established in his rights before the application was published.

c) Patent proprietor

In **T 457/89**, by analogy with **G 1/88** (OJ 1989, 189), the board took the view that the appellant (patentee) was adversely affected by the decision revoking his patent, despite failing to comment on a communication within the time specified in an opposition division's invitation under Art. 101(2) EPC 1973. For, according to **G 1/88**, wherever non-compliance could lead to loss of rights, the EPC 1973 always expressly indicated this and Art. 101(2) EPC 1973 made no provision for any loss of rights. See also **T 1103/21**.

In **T 73/88** (OJ 1992, 557) the board ruled that if a patentee's request that his patent be maintained was upheld by a decision of the opposition division, he could not appeal against adverse reasoning in the decision (here, regarding his claim to priority) because he was not adversely affected by it within the meaning of Art. 107 EPC 1973.

One of the principles representing the fundamental value of legal procedural certainty was that a party was not to be regarded as adversely affected within the meaning of Art. 107 EPC 1973 by a decision which granted his final request. A request under R. 88 EPC 1973 for correction of a document as the sole reason for the appeal was inadmissible (**T 824/00**, OJ 2004, 5). In this case the proprietor had requested correction under R. 88 EPC 1973 (R. 139 EPC) of his letter withdrawing all requests (see also **T 961/00** and **J 17/04**).

In **T 528/93** a request was withdrawn during opposition proceedings and was thus not the subject of the contested decision. The board decided that a virtually identical request filed during appeal proceedings was not the subject of the appeal, because the appellant was not adversely affected by the decision of the opposition division as far as this request was concerned.

In **T 327/13** the board found that, to establish whether a party has been adversely affected by a decision, it is not enough to consider the end result in isolation, but to consider the party's complete case, as is defined in Art. 12(2) RPBA 2007, in conjunction with the substance of the decision. Although the board noted that it was clear that the appellants were adversely affected by the opposition division's decision not to accede to the then main request, the decision had not been contested with the appeal. The board therefore concluded that they could not be regarded as "adversely affected" under Art. 107 EPC.

The argument that the discovery of a prior art disclosure in national proceedings meant that the patent proprietor had subsequently become adversely affected was rejected in **T 591/05** – by granting the patent the department of first instance had acceded to the then valid request of the appellant.

In **T 332/06** the patent proprietor's appeal was admissible at the time it was filed but became inadmissible when the statement of grounds was received, as the patent

proprietor only contested that portion of the decision relating to the claims for the contracting state DE. However, these claims for DE had been allowed by the opposition division and were identical to the claims for DE in the patent proprietor's initial main request, which had been rejected only as regards the other contracting states. The patent proprietor was therefore not adversely affected with respect to DE.

In **T 1783/12** the opposition division had refused the main request that the opposition be rejected as inadmissible. The appellant (patent proprietor) had therefore been adversely affected by this procedural aspect of the decision under appeal. However its statement of grounds of appeal had not set out why this aspect should be set aside, instead explicitly addressing only why the patent should be maintained as granted. Moreover, at first instance it had requested the maintenance of the patent in amended form, and this request had been granted. Summing up, the board held that at the relevant point in time under Art. 108 EPC – the filing of the statement of grounds of appeal – (a) no reasons had been given why the decision not to reject the opposition as inadmissible should be set aside; and (b) the substantive request for the maintenance of the patent as granted did not result from an adverse effect within the meaning of Art. 107 EPC. The appeal was therefore inadmissible.

In **T 611/15** the opposition division maintained the patent in amended form based on auxiliary request VIII. The proprietor had argued that it had withdrawn only the auxiliary requests filed in writing before the oral proceedings, not the main request. However, the minutes stated that the representative of the proprietor announced that he would withdraw all other requests so that auxiliary request VIII as filed during the oral proceedings represented the main and sole request of the proprietor. In the absence of any request for correction of the minutes, the board assumed that these statements accurately reflected the state of the proprietor's requests. Given that the decision on this request was in favour of the proprietor it followed that the proprietor was not adversely affected by the decision.

d) Opponent

(i) Rule 82(1) EPC

Under R. 82(1) EPC (previously R. 58(4) EPC 1973), before the opposition division decides to maintain the patent as amended, it shall inform the parties of the text in which it intends to maintain the patent and shall invite them to file their observations within two months if they disapprove of that text.

The Enlarged Board found in **G 1/88** (OJ 1989, 189) that the fact that an opponent had failed, within the time allowed, to make any observations on the text despite an invitation to do so under R. 58(4) EPC 1973 did not render his appeal inadmissible. To regard silence as betokening consent would be tantamount to withdrawal of the opposition with consequent surrender of the right to appeal. Surrender of a right could not be simply presumed. Deeming silence to be equivalent to surrender would also be inconsistent with the logic of how the EPC operated, since it would be at odds with the way in which it dealt with the loss of rights. Where the legal consequence of an omission was to be a loss of rights, this was expressly stated. Furthermore, under Art. 164(2) EPC 1973 the

Implementing Regulations had always to be interpreted in the light of the EPC. The interpretation of the Implementing Regulations which corresponded most closely to the principles of the EPC thus prevailed. It was a principle of the EPC, however, that parties' rights were safeguarded by the possibility of appeal to at least one higher-ranking tribunal. The Implementing Regulations should therefore be construed in such a way that R. 58(4) EPC 1973 was not allowed to interfere with the right of appeal under Art. 106 and 107 EPC 1973. This interpretation in the light of the sense and purpose of the procedure under R. 58(4) EPC 1973, leads to the same goal.

In **T 156/90** the opponent had stated that he would have no objection to maintenance of the patent if the claims were amended in a specified way, which they were. His subsequent appeal was dismissed as inadmissible; his argument that the circumstances had changed and he was no longer bound by his consent failed.

In **T 266/92** of 17 October 1994 the opponent had declared in opposition proceedings that he would withdraw his request for **oral proceedings** if the patentee agreed to an amended wording of the patent, as he did. The board held that the appellant was adversely affected within the meaning of Art. 107 EPC 1973, and was entitled to appeal; withdrawal of a request for oral proceedings did not in itself imply withdrawal of any other existing request (see also **T 25/15**).

In **T 833/90** the board held that an appeal should be considered admissible if it was not clear or ascertainable whether the opponent (appellant) had agreed to maintenance of the patent. This was followed in **T 616/08**.

(ii) Opponent adversely affected

In **T 273/90** the board concluded that legal uncertainty arising from **inadequate adjustment of the description** to amended claims constituted sufficient grievance, as the commercial interests of the appellant (opponent) could be adversely affected (likewise **T 996/92**).

In **T 1178/04** (OJ 2008, 80) the board found the appeal filed by the opponent admissible even where the **validity of the opponent's status** was challenged following a disputed transfer, as a person was a party to proceedings for the purposes of Art. 107 EPC 1973 even if his entitlement to take part in such proceedings was brought into question. A decision that he was not entitled to take part in the proceedings would have the effect that he was no longer entitled to take part in the proceedings, but not that he had never been a party. See also **T 1982/09**.

It is not necessary for an opponent to have a **continuing interest**, financial or otherwise, in the prosecution of the opposition or appeal; it suffices that the decision does not accede to one of its substantive requests (**T 1421/05** following **T 234/86**, OJ 1989, 79).

(iii) Opponent not adversely affected

In **T 299/89** the board considered the extent of entitlement to appeal of an opponent who in his opposition had requested only partial revocation but in his appeal wanted the whole patent revoked. It decided that this was determined by the scope of the original request made in the opposition. The opponent was only adversely affected within the meaning of Art. 107 EPC 1973 **to the extent that this request was not granted**, and he could not on appeal file a wider request.

An opponent is not adversely affected by **obiter dicta reasons** given in a revocation decision and favourable to the patent proprietor, and which it is appropriate for the opposition division to include to obviate remittal in the event of revocation being reversed on appeal (**T 473/98**, OJ 2001, 231).

A respondent (opponent) which is not adversely affected by a decision revoking the patent is not entitled to file an appeal for the sake of **acquiring an independent appellant status** instead of the status of a respondent (party as of right) (**T 193/07**). The board considered that its conclusion was in accordance with the established jurisprudence of the boards of appeal (see e.g. **T 981/01**, **T 1147/01**, **T 854/02**, **T 1341/04**). The board also pointed out that purely hypothetical considerations put forward by the opponent in support of the admissibility of its appeal concerning potentially disadvantageous situations that might occur (in the future) in related national litigation proceedings had no legal relevance under Art. 107 EPC.

In **T 1569/11** the opponents did not seek to challenge the decision of the opposition division (i.e. revocation of the patent) but the reasons for the decision. In particular, the opponents wanted the patent to be found invalid under Art. 100(c) EPC. The board noted that, in doing so, they misunderstood the nature and purpose of opposition appeal proceedings, which are not to re-examine a patent but to decide whether or not a first instance decision is correct (cf. **T 854/02**; **T 437/98**, OJ 2001, 231; **T 193/07**).

In **T 735/13** the opponent had not raised during the oral proceedings before the opposition division any of the objections under Art. 100(a), (b) and (c) EPC to the second auxiliary request that it then had in its grounds of appeal. Since patents as granted and maintained could be opposed only for one of the reasons allowed under the EPC, the opponent had not been adversely affected by the maintenance of the patent as per the second auxiliary request, at least not for any of the reasons it had given on appeal.

2.4.3 Procedural status of the parties

a) Parties to appeal proceedings

Under Art. 107, second sentence, EPC the parties to proceedings before the department of first instance are also parties to the ensuing appeal proceedings, even if they have not personally filed an appeal. Pursuant to Art. 99(3) EPC, opponents as well as the patentee are parties to opposition proceedings. In addition, Art. 105 EPC makes provision for intervention by the assumed infringer. For further details, see chapter III.P. "Intervention".

As a matter of principle, the boards of appeal have to examine the question of party status ex officio before dealing with the substance of the case (cf. e.g. **T 384/08**, **T 540/13**).

In **T 811/90** (OJ 1993, 728) opposition proceedings had been concluded and the time limit for lodging an appeal had expired. Only the patent proprietor lodged an appeal, but against a separate decision on a point incidental to the opposition (removal of documents from the public part of the file). It was held that the other party had no right to be a party to the appeal as he had not been a party to the relevant decision.

However, in a decision concerning an appeal against a Legal Division decision refusing to suspend grant proceedings under R. 13 EPC 1973 (R. 14 EPC), the applicant was to be treated as a party to the proceedings. The request for suspension could not be separated from the grant proceedings. The applicant's legal position was directly affected by suspension, because for its duration he was denied the rights under Art. 64(1) EPC 1973 (**J 33/95** of 18 December 1995).

An applicant who was not heard when grant proceedings were suspended at a third party's request pursuant to R. 13 EPC 1973 could still challenge the justification for that suspension. He was a party as of right to any appeal proceedings initiated by the third party against rejection of the latter's request by the EPO (**J 28/94**, OJ 1997, 400).

In **T 643/91** the **appeal** of opponent 1 was rejected as inadmissible. Opponent 2 filed an admissible appeal. Opponent 1 was considered by the board to be "any other party to the proceedings" under Art. 107 EPC 1973 and, as a consequence, to be a party as of right in the appeal proceedings of opponent 2.

In **T 898/91** it was held that an opponent whose **opposition** had been rejected as inadmissible by the opposition division and who had not filed an appeal against this decision was not entitled to be a party to any appeal proceedings brought by the patent proprietor, because it ceased to be a party to the opposition proceedings once the decision on the admissibility of its opposition took full legal effect.

T 540/13 followed **T 1178/04** (OJ 2008, 80) rather than **T 898/91**. The board stated that when an opposition division decides that an opposition is inadmissible in a case where at least one other admissible opposition has been filed, it is not necessary for the opponent of the opposition held inadmissible to appeal this decision in order to preserve its party status in appeal proceedings initiated by another party.

Where two opponents lodge appeals contesting different sets of claims and one subsequently withdraws its appeal, it becomes a party as of right under Art. 107 EPC and the other opponent becomes the sole appellant (see e.g. **T 233/93**).

Where a company is dissolved and thus ceases to be a legal person, it loses its capacity to be a party to any proceedings. If it was the original appellant, the appeal consequently lapses (**T 353/95** and **T 2334/08**). However, a party's opponent or appellant status does not lapse merely as a result of bankruptcy proceedings being issued (**T 696/02**). See also

G 1/13 (OJ 2015, A42) on recognising a company's retrospective restoration under national law (see below in this chapter V.A.2.4.3 d)).

Third parties commenting under Art. 115 EPC 1973 on the patentability of the invention claimed are not parties to the proceedings before the EPO. See also chapter III.N. "Observations by third parties".

b) Rights of parties under Article 107 EPC

In appeal proceedings, the case law recognises the right of all parties to be heard (see **J 20/85**, OJ 1987, 102; **J 3/90**, OJ 1991, 550; **T 18/81**, OJ 1985, 166; **T 94/84**, OJ 1986, 337; **T 716/89**, OJ 1992, 132). The parties also have a right to oral proceedings.

Furthermore, **G 1/86** (OJ 1987, 447) recognised the validity of the principle that all parties must be treated equally in similar legal situations in proceedings before the boards of appeal.

Decision **T 73/88** (OJ 1992, 557) deduced from this that all parties to proceedings had the right to continue appeal proceedings. If there was already one valid appeal, no further appeals were needed and the fees paid for appeals filed later had to be refunded. However, in decision **G 2/91** (OJ 1992, 206) the Enlarged Board disagreed. It took the view that from the legal point of view the status of parties who had filed an appeal was not comparable with that of those who had not. It was clear from generally recognised principles of procedural law that the appellant alone could decide whether the appeal filed by him was to stand. Art. 107, second sentence, EPC 1973 only guaranteed non-appellants who were party to proceedings of the first instance that they were parties to **existing** appeal proceedings. A person who was entitled to appeal but did not do so, settling instead for being "automatically" a party to the appeal proceedings, had no independent right of his own to continue those proceedings if the appellant withdrew his appeal. He acquired that right only by filing an appeal himself and paying the associated appeal fee. By the same token, there was also no reason to refund the fee for any appeals filed after the first, unless the requirements of R. 67 EPC 1973 (R. 103 EPC) were met. The related issue of whether non-appealing parties can file substantive requests is dealt with in **G 9/92** and **G 4/93** (both OJ 1994, 875; see also chapter V.A.3.1. "Binding effect of requests – no reformatio in peius").

Also in **T 864/02** the board found that, according to some case law, a non-appealing party as of right did not have the same procedural status in all respects as did an appellant e.g., it did not have an independent right to continue appeal proceedings if the appellant withdrew its appeal (see **G 2/91**, OJ 1992, 206 and **G 9/92**, OJ 1994, 875). However, the case law also confirmed the right to be heard of all parties to pending proceedings (principle that all parties must be treated fairly and equally). The party as of right was thus entitled to raise a novelty objection where the notice of opposition had raised this ground and the submission therefore lay within the framework of the opposition procedure. In **T 591/01** and **T 475/97** the respective parties as of right were allowed to submit requests.

c) The boards' duty of impartiality in inter partes proceedings

In **T 1072/93** the board held that the freedom of the board to offer specific advice to one of the parties as to how an objection might be overcome, even when such an objection stemmed from the board itself, was severely limited, especially in inter partes proceedings where the preservation of judicial impartiality was a paramount requirement. In **T 253/95**, the same board confirmed that boards of appeal in inter partes proceedings must be strictly impartial and found that alerting a party to a possible argument against him and on a ground on which the burden of proof rested on him, in advance of the oral proceedings, would amount to a clear violation of the principle of impartiality, irrespective of the fact that the communication setting out such an argument would also be sent to the other party. In **T 394/03** the board held that, even though the opposition division's decision to reject the opposition had been annulled, it was not necessary, in the absence of a request, to give the patentee and respondent another opportunity to comment, nor, given the impartiality of the board, was there any requirement on principle to do so.

d) Existence of a company

In the case underlying **G 1/13** (OJ 2015, A42) an opposition had been filed by a company which subsequently, under the relevant national law governing the company, for all purposes had ceased to exist. However, the company was subsequently restored to existence under a provision of that governing national law, by virtue of which the company was deemed to have continued in existence as if it had not ceased to exist. The Enlarged Board held that the EPO had to recognise the retroactive effect of that provision of national law. Thus, where a valid appeal was filed in due time in the name of the non-existent opponent and the restoration of the company to existence with retroactive effect took place after the expiry of the time limit for filing the notice of appeal under Art. 108 EPC, the board of appeal had to treat the appeal as admissible. The Enlarged Board referred to the clearly established principle under the EPC that national law should be referred to in order to determine whether a legal entity existed or had ceased to exist, and had capacity to act. The Enlarged Board also considered that the EPO should follow national law as regards the deemed retrospective existence of such a legal entity. This was merely to apply the general principle that such issues are the exclusive concern of national law.

In **T 796/12** the patent proprietor raised the objection that company Z, which was registered as the appellant (opponent), had been dissolved as a result of a bankruptcy procedure before the appeal had been filed. Hence, the opponent had ceased to exist as a legal person before the filing of the appeal and could not file the appeal or be the appealing party in the opposition-appeal proceedings. The board stated that whether an opponent to an ongoing opposition appeal case can validly be regarded as a legal entity and act in these proceedings is a matter of national law of the state where the company is incorporated, see **G 1/13** (OJ 2015, A42); in the case at issue that state was Germany. Under German law, even a company removed from the company register could validly perform procedural acts, such as filing a lawsuit in cases where a dispute is related to any form of economic interest. The board thus held that the opponent could file a valid appeal even after its removal from the company register.

2.5. Form and time limit of appeal

2.5.1 Electronic filing of appeal

The EPO's online filing systems can be used to file notice of appeal and all subsequent documents (see decision of the President concerning the electronic filing of documents dated 14 May 2021, OJ 2021, A42). Art. 3 of the President's decision dated 3 March 2021, however, rules out using the **Web-Form Filing** service in appeal proceedings.

In **T 1633/18** the applicant submitted both the notice of appeal and a further letter by using the EPO Web-Form Filing service. The board stated that this service could not be used for filing documents in respect of appeal proceedings (see Art. 3 of the decision of the President of 14 May 2021, OJ 2021, A42). If documents in respect of appeal proceedings were nonetheless filed using the EPO Web-Form Filing service, they were deemed not to have been received. In such a situation the sender, if identifiable, should be notified without delay. In the case in hand, the EPO did not notify the applicant in conformity with this provision. Since both letters had been received well before the expiry of the respective time limits (for filing the appeal and for filing a statement of grounds of appeal), by not observing its duty to inform the appellant without delay, the EPO deprived it of the opportunity to resubmit its letters by a correct means of filing. As the appellant resubmitted its letters in a correct manner in reply to the board's communication pursuant to R. 100(2) EPC and as the EPO failed to notify the appellant of its incorrect use of the Web-Form Filing service, the appellant had to be treated, in accordance with the principle of the protection of legitimate expectations, as if it had submitted these letters in a correct manner before the expiry of the respective time limits. See also **T 1295/20**, in which the board held that the principle of the protection of legitimate expectations was to be applied where the deficiency – in the case in hand: the appellant's address had been filed via Web-Form Filing – could be readily identified by the EPO in the course of its normal handling of the case at the procedural stage in question and could still be corrected by the appellant in time.

The decisions reported below relate to cases settled before the previously applicable President's decision of 10 November 2015 concerning electronic filing of documents (OJ 2015, A91) entered into force (on 16 November 2015).

Under Art. 108 EPC 1973, notice of appeal was filed in **writing**. Art. 108 EPC was amended when the EPC was revised. It now requires appeals to be filed **in accordance with the Implementing Regulations** (see R. 99 EPC). Thus an appeal filed via electronic means (*epoline*®), not being "in writing" was rejected as inadmissible in **T 781/04** of 30 November 2005 and **T 991/04** of 22 November 2005, referring to the notice from the EPO dated 3 December 2003 concerning the My *epoline*® portal. Referring to **T 781/04**, **T 991/04** and **T 514/05** (OJ 2006, 526), the board in **T 765/08** stated that documents purporting to be documents filed subsequently for the purposes of R. 2(1) EPC (here the notice of appeal) must be deemed not to have been received if they are filed by technical means not approved by the President of the EPO. This applies even if the means of transmission is subsequently allowed (**T 331/08**, following **T 514/05**); the board was not entitled to exercise discretionary power to consider whether the appeal, filed via *epoline*®,

might nonetheless be deemed to have been filed, since i) to do so would be tantamount to exercising legislative power; 2) such legislative power was however clearly delegated in R. 36(5) EPC1973 to another authority within the EPO, namely the President; 3) thus pursuant to Art. 23(3) EPC1973 the board was precluded from examining whether this purported notice of appeal could be deemed to have been received, since such a procedure would be ultra vires; 4) it was immaterial that this means of communication was now permitted for the filing of appeals. It was the law and instructions in place at the time of filing which had to be applied. The board in **T 1090/08** also found the appeal inadmissible, but on the facts of the case granted re-establishment of rights.

In **T 1427/09** of 17 November 2009 the notice of appeal and statement of grounds were filed in due time but the electronic signatures were not issued to a person authorised to act in the proceedings, in contravention of Art. 8(2) of the decision of the President concerning the electronic filing of documents (OJ 2009, 182), which was silent on the legal consequences of non-compliance. The board held that the principle that the signature of an unauthorised person should be treated like a missing signature, as set out in **T 665/89**, should apply not only to handwritten signatures, but also to electronic signatures. The electronic filing of a document in appeal proceedings accompanied by the electronic signature of an unauthorised person should therefore be treated under R. 50(3) EPC like the filing of an unsigned document per mail or telefax in the same proceedings.

2.5.2 Form and content of notice of appeal (Rule 99(1) EPC)

Rule 99(1) EPC defines the content of the notice of appeal to be filed within the period specified in Art. 108 EPC. Under R. 99(1) EPC the notice of appeal shall contain, under R. 99(1)(a) EPC, the **name and address of the appellant**, under R. 99(1)(b) EPC an **indication of the decision impugned** and under R. 99(1)(c) EPC, a **request** defining the **subject** of the appeal.

A notice of appeal is a declaration directed to the EPO of the intention to challenge a particular decision by means of an appeal. The declaration of the intent to file an appeal must be clear and unambiguous (**T 551/15**).

The requirement of R. 99(1)(c) EPC takes into account the fact that the appellant's initial request, according to **G 9/92** and **G 4/93** (OJ 1994, 875) and **G 1/99** (OJ 2001, 381) defines the subject of the appeal and thereby the framework of the appeal proceedings.

a) Name and address of the appellant – Rule 99(1)(a) EPC

Under R. 99(1)(a) EPC the notice of appeal must contain the name and address of the appellant as provided in R. 41(2)(c) EPC (see also R. 64(a) EPC 1973, according to which the notice of appeal had to contain the name and address of the appellant in accordance with the provisions of R. 26(2)(c) EPC 1973).

– Appellant sufficiently identified

According to **T 624/09** it has become established case law that the provisions of R. 99(1)(a) EPC are satisfied if, as in the case in hand, the notice of appeal contains sufficient information for identification of a party (see e.g. **T 483/90**, **T 613/91** and **T 867/91**). In **T 483/90** the appellant's name was incorrectly given and its address was missing but the number of the contested patent and the name and address of the professional representative were the same as those cited in previous proceedings. In **T 613/91** the appellant's precise address was missing from the notice of appeal, but was known to the parties and the board from the opposition proceedings. In **T 350/13** there was sufficient information available to identify the appealing party (opponent); the notice of appeal indicated the number of the European patent, the decision of the opposition division and the name of the patent proprietor. Also in **T 624/09** (the notice of appeal did not contain the appellant's address), **T 1636/13** and **T 1712/10** it was possible to identify the appellant when the appeal was filed. It was alleged in **T 899/95** that the opponent was a legal entity but was not identified by its official designation; its identity was, however, clear. In **T 786/11**, the board held that "IS Limited" did not change its legal identity by being transferred to Mauritius (see also **T 1458/12** and **T 1201/14**).

An appeal filed by an appellant whose name was changed before the appeal was filed without indicating the change of name met the requirements of R. 64(a) EPC 1973 (R. 99(1)(a) EPC), provided that the appellant was identifiable (**T 157/07**). See also **T 1/97**, **T 786/00** and **T 866/01**. According to **T 866/01**, the requirement regarding sufficient identification of the appellant was to be considered to be met whenever it is possible to establish beyond reasonable doubt the identity of the appellant on the basis of all information provided by the appellant or his legal representative within the time limit under Art. 108 EPC or in the previous proceedings, including any such information contained in the decision under appeal. In **T 350/19** the appellant (patent proprietor) had indicated a different address in its notice of appeal than in the Register and only subsequently requested a change of the address in the Register. The board held that R. 99(1)(a) EPC cannot be interpreted to require that an address indicated in the notice of appeal be identical to the address in the Register. It is irrelevant for admissibility that the appellant had requested a change of its address in the European Patent Register and when this change became effective. What matters is whether the appellant can be properly identified.

In **T 2561/11** the notice of appeal was only signed by the opponent's representative without mentioning the opponent. The board was satisfied that a reader willing to understand would have understood, before the end of the time limit for filing an appeal, that the notice of appeal had been filed on behalf of the opponent.

– Missing address

In **T 314/15** the notice of appeal of the appellant (opponent) did not contain an address. This deficiency had however been remedied according to the procedure prescribed in R. 101(2) EPC. See also **T 662/09** and **T 819/15**.

In **T 1295/20**, the board considered that the principle of protection of legitimate expectations applied and that the deficiency resulting from the missing address had been remedied in time.

However, in **T 938/94**, where the appellant's name and address were not stated in the notice of appeal and it failed to give this information within the time limit set by the invitation pursuant to R. 65(2) EPC 1973 (R. 101(2) EPC), the appeal was rejected as inadmissible (see also **T 774/05**, in which the appeal was rejected as inadmissible, as the appellant's address was not given in the notice of appeal).

– Error in information identifying the appellant

Several decisions have allowed correction of the name of the appellant to substitute a natural or legal person other than the one indicated in the appeal. Where there is objectively a deficiency in the notice of appeal indicating a genuine error as regards the identity of the appellant and there is objective evidence in the file indicating with a sufficient degree of probability who the appellant should be, then the notice of appeal may be corrected under R. 101(2) EPC (**T 1961/09**, following **T 97/98**, OJ 2002, 183; see also **T 15/01**, OJ 2006, 153; **T 715/01**; **T 707/04**; **T 875/06**; **T 540/09**; **T 662/09**).

Thus, an appeal filed by mistake in the name of an opponent who no longer exists but who has a universal successor, and which was obviously intended to be filed on behalf of the person who is the actual opponent and who was prejudiced by the decision, namely the universal successor, is admissible (**T 1421/05**).

In **T 445/08** (OJ 2012, 588) it was undisputed that the notice of appeal as filed was not admissible because the appellant company had not been a party to the opposition proceedings and accordingly was not adversely affected by the appealed decision. It was no longer the patent proprietor. The questions the board referred to the Enlarged Board included whether the request for correction, which would result in the appeal being admissible, was possible pursuant to R. 101(2) or 139 EPC. The request was filed only after expiry of the relevant two-month period provided for by R. 101(1) EPC.

In **G 1/12** (OJ 2014, A114) the Enlarged Board reformulated the question originally posed in **T 445/08** (OJ 2012, 588) to ask whether, when a notice of appeal, in compliance with R. 99(1)(a) EPC, contains the name and the address of the appellant as provided in R. 41(2)(c) EPC and it is alleged that the identification is wrong due to an error, the **true intention** having been to file on behalf of the legal person which should have filed the appeal, it is possible to correct this error under R. 101(2) EPC by a request for substitution by the name of the true appellant. See later on in this chapter for the Enlarged Board's findings in **G 1/12** on whether a wrong name can be corrected under R. 139 EPC.

The Enlarged Board answered that it was possible, provided the requirements of R. 101(1) EPC had been met. Given the explicit reference in R. 101(1) EPC to Art. 107 EPC and the possibility of remedying deficiencies only within the two-month appeal period under Art. 108, first sentence, EPC, the identity of the appellant, i.e. the person entitled to appeal, had to be established by expiry of the two-month period prescribed in Art. 108, first sentence, EPC at the latest. R. 101(2) EPC concerns deficiencies concerning the indication of the appellant's name and address as prescribed by R. 99(1)(a) EPC. They may be remedied irrespective of the time limits pursuant to Art. 108 EPC, upon invitation by the board of appeal (see also **T 755/09**).

The Enlarged Board thus fully endorsed the case law (see above), in which it was considered that an incorrect indication of the appellant's identity is a deficiency which can be remedied, provided its correction does not reflect a later change of mind as to whom the appellant should be, but on the contrary only expresses what was intended when filing the appeal.

In **T 979/12** the board noted that according to **G 1/12**, the board must establish the true intention of the appellant "on the basis of the information in the appeal or otherwise on file, i.e. ascertain who must be deemed in all likelihood to have filed the appeal...".

In **T 2564/12**, too, the true appellant was identifiable from the file, even if not correctly identified in the notice of appeal.

In **T 2330/10** the board stated that there was a difference between establishing the identity of an appellant and knowing the address where the appellant could be found. The deficiencies concerning the indication of the appellant's name and address as prescribed by R. 99(1)(a) EPC did not necessarily have to be remedied within the two-month time limit pursuant to Art. 108 EPC, but could be remedied later following an invitation under R. 101(2) EPC if there was a reason to issue such invitation.

– Correction of wrong name under Rule 139 EPC

In **G 1/12** (OJ 2014, A114) the Enlarged Board also found that in cases of an error in the appellant's name, the general procedure for correcting errors under R. 139, first sentence, EPC was available under the conditions established by the case law of the boards of appeal. The following principles have been established:

(1) The correction must introduce what was originally intended. It is the party's actual rather than ostensible intention which must be considered.

(2) Where the original intention is not immediately apparent, the requester bears the burden of proof, which must be a heavy one (**J 8/80**).

(3) The error to be remedied may be an incorrect statement or an omission.

(4) The request for correction must be filed without delay.

An allowable correction under R. 139 EPC has retrospective effect (**J 4/85** as endorsed in several subsequent decisions, for example **J 2/92**, OJ 1994, 375; **J 27/96**; **J 6/02**; **J 23/03** and **J 19/03**).

In **T 603/15** the board found that this last condition had not been met because four years had passed before the request for correction of an EPO Form 2300 under R. 139 EPC had been filed, and so it had to be refused in light of **G 1/12**.

However, where the effective date of transfer of the patent to the appellant named in the notice of appeal had not actually occurred until after the period for filing a notice of appeal

and it was the appellant's **true intention** to file an appeal on behalf of the name given in the notice of appeal, there is no deficiency in the notice concerning the name of the appellant which may be remedied in accordance with R. 99(1)(a) EPC in conjunction with R. 101(2) EPC nor an error which may be corrected pursuant to R. 139, first sentence, EPC and the appeal is thus inadmissible (**T 128/10** following **T 97/98**; see also **T 2045/09**).

In **T 445/08** of 26 March 2015 the board noted that it was not immediately clear that the appeal filed on behalf of the appellant, a company fully identified with its address and nationality and different from the patent proprietor, was actually intended to be filed on behalf of the appellant and stated that, regarding the requirements listed in **G 1/12**, it could not accept that the mere fact that the appellant was the party adversely affected during the opposition proceedings was sufficient to establish the true intention. The board stated that if it was indisputable that the notice of appeal was to be considered in the context of the file history, the true intention needed to be confirmed by external facts, at least to prevent requirements such as those of Art. 107 EPC being circumvented. It found that in applying R. 139 EPC to a party's request to correct a mistake in the notice of appeal in respect of the identity of the appellant, the principle of legal certainly, according to which parties are bound by their procedural acts, needed to be taken into consideration. The board concluded that the requirements for the correction requested had been met, and thus that the correction was to be allowed.

b) Indication of the decision impugned – Rule 99(1)(b) EPC

Under R. 99(1)(b) EPC, the notice of appeal shall contain an indication of the decision impugned.

According to **J 16/94**, (OJ 1997, 331), for a notice of appeal to comply with Art. 108, first sentence, EPC 1973 and R. 64(b) EPC 1973, it had to express the definite intention to contest an appealable decision. An appeal filed as a subsidiary request, i.e. **conditional** on the main request not being allowed by the department of first instance, was therefore inadmissible. This was because there should be legal certainty as to whether or not a decision was contested. This was confirmed by **T 460/95** (OJ 1998, 588).

In **T 2716/16** the board stated that the fact that the appellant referred to the opposition division's decision in its notice of appeal erroneously as a decision on the revocation of the patent (the opposition division rejected the opposition) was immaterial to the admissibility of its appeal (see **T 1/88** in which the appellant (opponent) had also erroneously referred to the opposition division's decision to reject the opposition as a decision to reject the application).

c) Request defining the subject of the appeal – Rule 99(1)(c) EPC

The notice of appeal shall contain **a request defining the subject** of the appeal (R. 99(1)(c) EPC).

Under R. 64(b) EPC 1973, the notice of appeal had also to contain a statement identifying the decision which was impugned and the **extent** to which amendment or cancellation of the decision was requested. If the extent to which cancellation of the decision was requested was not expressly stated in the notice of appeal, the board would examine whether the relevant information could be determined from the totality of the appellant's submissions (see **T 7/81**, OJ 1983, 98 and **T 32/81**, OJ 1982, 225; see also **T 925/91**, **T 932/93** and **T 372/94**). However, this requirement now applies to the statement of grounds and no longer to the notice of appeal and can be found, reworded, in R. 99(2) EPC.

In decision **G 1/99** (OJ 2001, 381), the Enlarged Board pointed out that issues outside the subject-matter of the decision under appeal are not part of the appeal. It also noted that within the limits of what in the subject-matter of the decision under appeal adversely affects it, it is the appellant who in the notice of appeal determines the extent to which amendment or cancellation of the decision under appeal is requested.

According to the board in **T 358/08**, R. 99 EPC has not altered the previous law as to the requirements of either the notice of appeal or the statement of the grounds of appeal as regards the appellant's requests. R. 99(1)(c) EPC is satisfied if the notice of appeal contains a request, which may be implicit, to set aside the decision in whole or, (where appropriate) only as to part. Such a request has the effect of 'defining the subject of the appeal'. Nor is it necessary in the case of an appeal by an applicant or proprietor for the notice of appeal to contain a request for maintenance of the patent in any particular form. This is something which relates to 'the extent to which [the decision] is to be amended', and which is therefore a matter for the statement of grounds of appeal under R. 99(2) EPC. This has been confirmed in many decisions, e.g. **T 844/05**, **T 509/07**, **T 9/08**, **T 226/09**, **T 689/09** and **T 648/10**.

The requirement in R. 99(1)(c) EPC is duly met where the notice of appeal states that "an appeal is filed". This statement defines the subject of the appeal as a request for the legal effects of the decision being contested to be reversed. The specific wording in which the patent proprietor would like its patent to be maintained can then be requested in the grounds of appeal within the meaning of R. 99(2) EPC, which must set out the reasons why the decision should be set aside or the extent to which it should be amended (**T 1777/14**, **T 424/15**).

In **T 2561/11** the board summarised the established jurisprudence with regard to the meaning of the expression "a request defining the subject of the appeal" in R. 99(1)(c) EPC and stated that the boards had repeatedly construed the appeal of patent proprietors against a decision to revoke the patent as a request that the decision be set aside in its entirety, even though there had been auxiliary requests before the opposition division (see **T 358/08**). Similarly, in appeals against the rejection of the opposition the appeal of the opponent was construed as a request to set aside the decision under appeal and revoke the patent (see **T 9/08**, **T 183/12** and **T 256/13**).

In **T 620/13** the board pointed out that the notice of appeal must contain an unambiguous, clear and, most of all, explicit statement, which is recognisable as a legal statement,

concerning both the identification of the impugned decision and the subject of the appeal (see also **J 19/90**). It was immaterial that the registrar was able to establish which decision was appealed (see also **T 551/15**). The board conceded that the requisite request defining the subject the appeal could be implicit. However, on a correct reading of **T 358/08**, what might be "implicit" was that part of the request which indicates whether the decision is to be set aside in whole or only in part. Decision **T 358/08** lent no authority to the argument that there need not be any request at all. The appeal was rejected as inadmissible.

d) Rule 99(3) EPC

Under R. 99(3) EPC Part III of the Implementing Regulations applies mutatis mutandis to the notice of appeal, the statement of grounds and the documents filed in appeal proceedings.

Rule 99(3) and 41(2)(h) EPC together make it clear that a notice of appeal must be signed by the appellant or his representative, but not that every single document in the notice has to be signed or that the signature has to be appended at a particular place or page. In **T 783/08**, the debit order had been part of the notice of appeal, so the board held that the signature on it fulfilled the EPC requirements in question. The appeal had therefore been validly filed.

2.5.3 Appeal filed within the time limit

Article 108, first sentence, EPC requires notice of appeal to be filed at the EPO within two months of notification of the decision being contested.

a) Notification issues

In **T 389/86** (OJ 1988, 87) the board stated that an appeal which was filed after pronouncement of a decision in oral proceedings but **before notification** of the decision duly substantiated in writing complied with the time limit pursuant to Art. 108, first sentence, EPC 1973. See also **T 427/99**, **T 1125/07** and **T 1431/12**.

According to **T 1281/01** the legal fiction that the decision (under appeal) had been delivered on the tenth day following its posting (R. 78(2) EPC 1973) did not apply when it had actually been delivered to a previously authorised representative **after** she had notified the EPO that the file had been transferred to another representative. Pursuant to R. 82 EPC 1973, the decision under appeal was deemed to have been notified on the date it was received by the authorised representative and the appeal had thus been filed in due time.

b) Languages

Where the translation of the notice of appeal in an **official language** of the EPO was not filed in due time, the notice was deemed not to have been received according to Art. 14(5) EPC 1973 and the appeal not to have been filed (**T 323/87**, OJ 1989, 343; see also **T 126/04**).

Where the notice of appeal was filed in a non-official language by a company not entitled to benefit from the provisions of Art. 14(4) EPC 1973 and a translation into an official language was filed on the same day, the notice of appeal was nonetheless deemed not to have been filed. In view of **G 6/91** (OJ 1992, 491), where the translation was filed at the same time as the original, the EPO could not take it as the "official" notice of appeal and ignore the original as superfluous. As further stated in **G 6/91** "a translation cannot become the original; whatever the date on which it is filed it remains a translation, with all ensuing legal consequences, including the possibility of correction to bring it into conformity with the original" (**T 1152/05** and **T 41/09**). The residence or principal place of business of the professional representative used was irrelevant (**T 149/85**, OJ 1986, 103 and **T 41/09**).

In **T 2133/10** the board referred to **G 6/91** that a party who wanted to benefit from a fee reduction under R. 6(3) EPC must file the translation "no earlier than simultaneously" with the original. From a contextual reading of these separate parts the board inferred that the terms "at the same time" and "simultaneously" were used synonymously and were meant at least to cover the case at hand, i.e. where the original and translation were filed together in a single filing on the same date. Thus, if the original and translation are filed together a fee reduction under R. 6(3) EPC should apply.

c) Misleading decisions of the department of first instance

Where an appellant was **misled** by the EPO into thinking that the decision issued was only a draft that will be replaced by a second version, it is sufficient that the appeal was filed within the prescribed time limit as counted from notification of the second written decision (**T 830/03**).

Where the opposition division misleadingly issued two decisions, it sufficed if the statement of grounds of appeal was filed within the time limit applicable to the second decision, even if it was outside the time limit for the first decision (**T 993/06**).

In **T 124/93** the parties were misled by the re-dating of the decision by the opposition division. Following the principle of good faith governing the relationship between the EPO and the parties acting before it, their submissions received after expiration of the normal terms were considered to have been made in due time (see e.g. **T 124/93**, **T 1176/00** and **T 1694/12** in comparable cases).

2.5.4 Payment of appeal fee

a) Notice of appeal not filed

It is established case law that, if no written notice of appeal has been filed within the time limit but only the appeal fee has been paid in time, the mere payment does not constitute a valid means of lodging an appeal (**T 551/15**, **T 2609/18**). For a notice of appeal to be valid it must at least contain an explicit declaration of the wish to contest a particular decision by means of an appeal (**T 371/92**, OJ 1995, 324; **T 767/18**). It clearly follows from the wording of Art. 108 EPC that filing notice of appeal and payment of the appeal fee are

two distinct requirements, each of which has to be fulfilled separately (see **T 778/00**, OJ 2001, 554; **T 551/15**).

The legislative amendment under the EPC 2000 whereby R. 99(1) EPC lists the items making up the obligatory content of the notice of appeal removed any doubt there might have been as to the fact that the mere payment of the appeal fee cannot replace the notice of appeal (**T 1943/09**, see also **T 861/12**).

Payment of the appeal fee may at the most imply that the appellant intends to file an appeal because, once an appeal fee is paid, it remains free to decide whether or not it wishes to lodge an appeal (**T 371/92**, **T 778/00**, **T 767/18**). The party is still left the choice of whether, or at what point in time, to file notice of appeal as the necessary second act for an appeal to come into existence (**T 551/15**).

It was established very early on in the boards' case law that paying an appeal fee is not enough on its own for an appeal to be validly filed (**J 19/90**). The board stated that this applied even if the object of the payment was indicated as being a "fee for appeal" relating to an identified patent application and the form for payment of fees and costs was used. This was confirmed in **T 371/92** (OJ 1995, 324), **T 445/98**, **T 514/05** (OJ 2006, 526) and **T 778/00** (OJ 2001, 554), where the board also added that the failure to indicate the provisions of R. 65 EPC 1973 in the annex to the communication dealing with the possibility of appeal did not make this incomplete or misleading. This applies equally to inter partes proceedings (**T 1926/09**); it is in the public interest in both ex parte and inter partes proceedings to be informed with certainty about the applicant's intention of challenging a first-instance decision. See also **T 1946/15**. **T 275/86** is an exception.

In **T 595/11** the board held that fee payment is not an issue of admissibility of the appeal, but rather a precondition for the very existence of the appeal, i.e. its deemed filing. If the appeal fee is not paid, the appeal need not be examined at all for admissibility and even less on its merits.

b) Payment of only one appeal fee

The Legal Board in **J 1/16** wrote in its Catchword: "If the Legal Division has issued a single decision with rulings on the fate of more than one set of patent grant proceedings, it is legitimate to file a single appeal against that decision and to pay only one appeal fee for it."

c) Reduced fee for appeal filed by a natural person or a particular entity

Article 2(1), item 11, RFees (see decision of the Administrative Council of 13 December 2017, CA/D 17/17, OJ 2018, A4) provides that the persons and entities listed in former R. 6(4) and (5) EPC and now R. 7a(2)(a) to (d) (microenterprises, small and medium-sized enterprises, natural persons, non-profit organisations, universities or public research organisations) need only pay a reduced appeal fee rather than the full fee. The notice from the EPO dated 18 December 2017 (OJ 2018, A5) contains further details on claiming entitlement to the reduced appeal fee (note that the requirements for this

declaration are distinct from the requirements of R. 7b EPC which concerns language-related fee reductions). Its point 3 stipulates that appellants wishing to benefit from a reduced fee for appeal must expressly declare that they are a natural person or an entity covered by R. 6(4) EPC (now R. 7a(2) EPC). Under point 4, the declaration must be filed at the latest by the time of payment of the reduced fee for appeal. Point 11 states that if the reduced fee is paid but no declaration is submitted, the notice of appeal may be deemed not to have been filed or the appeal may be considered inadmissible.

In **J 8/18** the Legal Board noted that an entity within the meaning of R. 6(4) and (5) EPC (now R. 7a(2) EPC) was a small or medium-sized enterprise (SME) as defined by the European Commission Recommendation 2003/361/EC mentioned in R. 6(5) EPC (now in point 7. of the notice from the EPO dated 25 January 2024, OJ 2024, A8). The fact that the appellant was an enterprise that had its principal place of business in China did not mean that it could not benefit from the lower appeal fee.

In the cases reported below, the appellants had paid only the reduced appeal fee within the time limit for appeal, despite the criteria for a reduction not being met or being disputed. The question was thus whether the appeals were to be deemed not to have been filed for failure to pay the required amount of the appeal fee (Art. 108, second sentence, EPC; **G 1/18**, OJ 2020, A26).

In **T 84/19** a patent attorney firm was acting as a straw man opponent and subsequently appellant. The responded argued the firm was therefore not entitled to a reduced appeal fee. The board disagreed and explained that the entitlement to pay a reduced appeal fee must be assessed vis-à-vis the entity which has assumed the procedural status of an appellant, i.e. the status of appellant at the timing of filing the notice of appeal was the only relevant question In the case in hand this was vested in the patent attorney firm, regardless of whether it was acting as a straw man.

– Declaration of entitlement to reduced appeal fee

In **T 1060/19** the board noted that Council Decision CA/D 17/17 did not require a declaration according to points 3 and 4 of the corresponding notice. The board nevertheless assumed arguendo that the provisions of the notice that were pertinent to the case in hand were binding. From point 11 of the notice it followed that point 4 must be read as meaning that "it is strongly recommended that" the declaration be filed together with the payment. The board stated that the declaration of entitlement to benefit from a reduced fee for appeal mentioned in the notice from the EPO (OJ 2018, A5) could be filed until the end of the appeal period, despite the wording of point 4, last sentence, of the notice, which must be reconciled with the meaning of point 11 of the notice.

In **T 225/19**, the board followed decision **T 1060/19**, in which it was held that there was no legal basis for determining whether the fiction of non-filing applied to an appeal for which a reduced appeal fee had been paid according to whether or not a declaration complying with points 3 and 4 of the notice had been submitted. Council decision CA/D 17/17 and the resultant new version of Art. 2(1), item 11, RFees did not contain any legal foundation for the declaration required under points 3 and 4 of the notice. The notice established the

additional requirement of a declaration to be submitted with the fee payment – a requirement devoid of any basis in law. The boards were bound solely by the statutory provisions, not by EPO notices concerning the application or interpretation of those provisions (**J 8/18**, Art. 23(3) EPC). This meant at the very least that a declaration under points 3 and 4 of the notice could not already be demanded on payment of the reduced appeal fee. The boards were anyway empowered and obliged to examine whether an appeal was admissible and had been duly filed throughout the appeal proceedings, and so even after the time limit for appeal had elapsed. The boards were especially called on to examine this when other parties to the proceedings disputed that those requirements were met. The boards' general practice in this respect was to accept a declaration and supporting evidence of compliance with the requirements under R. 6(4) EPC (now R. 7a(2) EPC) even after the time limit for appeal had elapsed and the appeal proceedings were under way (see **T 3023/18**).

In **T 3023/18** notice of appeal was filed in the name of Borealis AG, and the reduced appeal fee paid, on the last day for doing so. In its first communication, the board invited the appellant to file the hitherto missing declaration necessary for the fee reduction. The appellant thereupon confirmed that it was not entitled to the reduced fee. The board pointed out that the non-filing of the required declaration was not evidence of a clear intention by the appellant to pay the full appeal fee. In the light of the above, the board did not accept that it was possible to establish that the appellant's intention was to pay the full appeal fee. The appeal was deemed not to have been filed and the board ordered reimbursement of both fee amounts (**G 1/18**, OJ 2020, A26). See also **T 1474/19** and **T 1678/21**.

– Request for correction under Rule 139 EPC

In **T 317/19** the appellant filed the notice of appeal within the two-month time limit. However, due to an error in the "Method of payment" box on Form 1038E (the box did not indicate a method but stated "not specified"), the debit order for the payment of the appeal fee was not carried out before expiry of that time limit. Following Opinion **G 1/18** (OJ 2020, A26) this resulted in the appeal being deemed not to have been filed. To change the above result, the appellant filed a request for correction under R. 139 EPC. The board referred to **G 1/12** (OJ 2014, A114) where the Enlarged Board affirmed that a correction of errors under R. 139 EPC in documents filed with the EPO is generally applied. The board was aware that the Enlarged Board had made its findings only in the context of the correction of an error in the appellant's name. However, the board failed to see why it should not equally apply to a correction of an erroneously filled payment form. In the case in hand the appellant met the requirements for a correction under R. 139 EPC as summarised in **G 1/12**. As a consequence, the appeal was retroactively deemed to have been filed. Thus, an error in a duly filed form for paying the appeal fee may be corrected under R. 139, first sentence, EPC. See also **J 8/19**, in which the Legal Board concluded that the requirements for the requested correction of the amount of the appeal fee indicated in the debit order in Form 1038E were met. As a consequence, the appeal was retroactively deemed to have been filed, the correction under R. 139 EPC having effect ex tunc.

In **T 444/20** the board held, with reference to **T 317/19**, that an error in a duly filed form for paying the appeal fee may be corrected under R. 139, first sentence, EPC. The board also referred to **T 2620/18**, which concerned very similar circumstances. In that case too the appellant had confused the then current reduced appeal fee with the former sole appeal fee and had indicated the incorrect amount of EUR 1 880 both in the notice of appeal letter and in the payment form. According to the board in that case, it was plausible that the appellant had been guided by the previously applicable, known fee amount of EUR 1 880 and had mistakenly assumed that it was paying the full fee (EUR 2 255). The present board saw no reason to deviate from that decision. Therefore, the board was satisfied that the correction sought introduced what was originally intended by the appellant and that this original intention was immediately apparent. Lastly, the appellant had filed its request under R. 139 EPC merely two weeks after the board's communication, in which it was indicated for the first time that the prescribed appeal fee had not been validly paid. The board concluded that the requirements for the requested correction were met (see **G 1/12**).

In **T 2620/18**, the appellant relied on **T 152/82** of 5 September 1983 (OJ 1984, 301) and the EPO practice of correcting underpayments in debit orders of its own motion and debiting the correct, full amount where the payer's payment intention is clear. In the board's opinion, this EPO practice was not readily applicable to a differentiated fee structure like that of appeal fees. If the debit order explicitly stated the intention to pay the reduced appeal fee, the EPO could not reasonably assume of its own accord that the payer actually wanted to pay the full fee. Moreover, not filing a declaration under R. 6(6) EPC was not an unambiguous indication of an intention to pay the full fee. The board interpreted the appellant's submissions in its statement of grounds of appeal as amounting in substance to a request for correction of the debit order and considered it credible that the appellant had indeed presumed it had paid the full appeal fee. However, it found that this request for correction had not been filed without delay (criterion (d) in the list in **G 1/12**, OJ 2014, A114, point 37 of the Reasons). The request in the statement of grounds had not been filed until six weeks after the mistake had been discovered. In the board's view, the appellant's merely having submitted another debit order at an earlier stage did not amount to an implied request for correction (R. 139 EPC).

– Difference not small

In **T 2620/18** and **T 3023/18**, the difference between the amount paid and the full appeal fee was not considered to be small. It could reasonably be assumed that, in introducing the reduced appeal fee, the legislator had not been simply looking to provide a marginal, as it were symbolic fee reduction for natural persons and small and medium-sized enterprises.

In **T 2422/18**, the appellant claimed to have paid the reduced appeal fee under R. 6(4) EPC by mistake and said that it would pay the outstanding EUR 375 later. The board rejected its arguments invoking the protection of legitimate expectations, observing that the outstanding amount was not an "amount lacking" within the meaning of Art. 8, fourth sentence, RFees.

d) Payment not from own account

In **T 186/22** the board held that the appeal fee having been debited not from the patent proprietor's account but from that of a third party could not alter the fact that the requirement of Art. 108, second sentence, EPC being fulfilled. That provision did not require the payment of the appeal fee to be made by the appellant. In fact, the question of who paid the appeal fee was irrelevant to whether the appeal was deemed to have been filed. It was sufficient that an appeal fee be paid (in the appropriate amount) before the expiry of the appeal period.

2.5.5 Appeal deemed not to have been filed

In **G 1/18** (OJ 2020, A26), the point of law referred by the President of the EPO was whether an appeal is to be treated as not filed or as inadmissible in cases of a failure to observe the two-month time limit under Art. 108 EPC owing to belated payment of the appeal fee and/or belated filing of notice of appeal.

The Enlarged Board answered the referred point of law as follows:

1. An appeal is deemed not to have been filed in the following cases: (a) where notice of appeal was filed within the two-month time limit prescribed in Art. 108, first sentence, EPC AND the appeal fee was paid after expiry of that two-month time limit; (b) where notice of appeal was filed after expiry of the two-month time limit prescribed in Art. 108, first sentence, EPC AND the appeal fee was paid after expiry of that two-month time limit; (c) where the appeal fee was paid within the two-month time limit prescribed in Art. 108, first sentence, EPC for filing notice of appeal AND notice of appeal was filed after expiry of that two-month time limit.

2. In the cases referred to in answers 1(a) to (c), reimbursement of the appeal fee is to be ordered ex officio.

3. Where the appeal fee was paid within or after the two-month time limit prescribed in Art. 108, first sentence, EPC for filing notice of appeal AND no notice of appeal was filed at all, the appeal fee is to be reimbursed.

On this in connection with reimbursement of appeal fees, see also chapter V.A.11.3. "Appeal deemed not to have been filed".

2.6. Statement of grounds of appeal

2.6.1 Legal provisions

Under Art. 108 EPC a statement setting out the grounds of appeal shall be filed within four months after the date of notification of the decision in accordance with the Implementing Regulations. Under R. 99(2) EPC, appellants have to indicate in the statement of grounds of appeal the reasons for setting aside the decision impugned, or the extent to which it is to be amended, and the facts and evidence on which the appeal is based.

Under Art. 12(3) RPBA the statement of grounds of appeal and the reply shall contain a party's complete appeal case. Accordingly, they shall set out clearly and concisely the reasons why it is requested that the decision under appeal be reversed, amended or upheld, and should specify expressly all the requests, facts, objections, arguments and evidence relied on. Art. 12(3) RPBA has the same content as Art. 12(2) RPBA 2007, apart from a few amendments (for consistency with the new paragraphs in Art. 12(2) and (6) RPBA, the terms "requests" and "objections" were added).

Under R. 64(b) EPC 1973 a statement identifying the extent to which amendment of the impugned decision was requested already had to be included in the **notice of appeal**. **T 358/08** contains a detailed analysis of the situation under R. 64(b) EPC 1973 as compared to the provisions of R. 99(1) and (2) EPC.

If the notice of appeal does not contain anything that can be regarded as a statement of grounds, the appeal is inadmissible unless a written statement of grounds is received by the EPO within the time limit set in Art. 108 EPC (R. 99(2) EPC and R. 101(1) EPC) (**T 13/82**, OJ 1983, 411).

2.6.2 Form of statement of grounds of appeal

Whether a document complies with Art. 108 EPC, third sentence, is considered to depend on its substance and not upon its heading or form. In **T 145/88** (OJ 1991, 251) the document headed "Statement of Grounds" was found not to contain even the minimum of reasoning and thus was not a statement of grounds at all. The mere existence of some argumentation and carrying the heading "Statement of the Grounds of Appeal" or "Grounds" does not automatically pass the threshold of Art. 108 EPC, even if clearly relating to the substance of the impugned decision (**T 1581/08**, referring to **T 145/88**). The board went on to point out that sufficiency is also not a question of volume. There is no minimum requirement as to the length or the fullness of detail of the argumentation which is necessary for an admissible appeal. In this context a distinction is to be drawn between insufficiency for the purposes of admissibility and insufficiency as far as the persuasiveness of the grounds is concerned which – if the arguments are not convincing – results in the dismissal of the appeal (see **T 922/05** and below). See also e.g. **T 23/03** and **T 613/07**.

The board in **T 74/12** pointed out that R. 99(2) EPC did not require a case number to be indicated in the statement of grounds of appeal. That logically implied that an appeal could not be found inadmissible simply because the case number was missing, as only the law, viz. the EPC and its implementing regulations, could define the conditions for taking certain procedural steps and the consequences to be expected if those steps were not taken. A procedural principle stated that rights or a means of redress could be lost only if such a consequence was clearly and precisely prescribed (see also **T 1638/17**).

2.6.3 Content of the statement of grounds of appeal

a) General

Under Art. 108, sentence 3, EPC, the appeal has to be substantiated in line with the Implementing Regulations (R. 99(2) EPC). As per Art. 12(3) RPBA, the statement of grounds of appeal and the reply have to contain a party's complete appeal case.

Whether a statement of grounds meets the requirements of Art. 108 EPC can only be decided on a case-by-case basis (**T 162/97**, **T 165/00**, **T 1435/11**).

The board in **T 1435/11** added that it was the boards' settled case law that the grounds for appeal had to set out an appellant's case – meaning not just its arguments but its requests too – in a way that was coherent, clear and sufficiently substantiated (see **T 760/08**, **T 446/00**). Indeed, the purpose of the statement of grounds, together with the notice of appeal, was to define the scope of the appeal. This definition was at the sole discretion of the appellant (see **T 2532/11**).

In **T 23/10** the board stated that, whether or not sufficient grounds relating to the requests submitted, was immaterial for the purposes of the admissibility of the appeal, because an appeal can only be assessed as a whole. In other words, if the admissibility requirements of Art. 108, third sentence, EPC are fulfilled in respect of at least one request, let alone of several requests, the appeal as a whole will be admissible (**T 509/07**, **T 1763/06**). The fact that the appellant, in the course of appeal proceedings, withdrew the main and auxiliary request and thereby abandoned its refutation of the reasoning of the impugned decision under Art. 100(c) EPC, had no bearing on the assessment of the admissibility of the appeal as filed. The admissibility requirements of Art. 108, third sentence, EPC concerning the appeal filed by the patentee were met within the time limit for filing the statement of grounds of appeal at least as far as the main request and auxiliary requests were concerned. As a consequence, the appeal of the patentee was admissible. See also **T 1668/14**.

If the appellant submits that the decision under appeal is incorrect, then the statement setting out the grounds of appeal must enable the board to understand immediately why the decision is alleged to be incorrect and on what facts the appellant bases its arguments, without first having to make investigations of its own (**J 10/11**, see also **T 220/83**, OJ 1986, 249, and **T 177/97**; affirmed by numerous decisions, see for example **T 573/09** and **T 918/17**).

Exceptionally, it has been acknowledged that the requirement for admissibility may also be regarded as satisfied if it is immediately apparent upon reading the decision under appeal and the written statement of grounds that the decision should be set aside (see **J 22/86**, OJ 1987, 280).

In **T 343/16** the board stated that references to the statement of grounds of other appellants were permissible. In the case in hand opponent 1 had referred to its notice of appeal and in support of its request that the patent be revoked, invoked the statement of

grounds of appeal of appellant 2, which was stated to be incorporated by reference. The board held that the appeal by opponent 1 was admissible.

b) Indication of the extent to which the decision impugned is to be amended

The decisions below concern the application of R. 64(b) EPC 1973, in particular the requirement concerning the extent to which amendment or cancellation of the decision was requested in the notice of appeal. This request, reworded, now forms part of the statement of grounds; R. 99(2) EPC.

It was sufficient to fulfil the requirements of R. 64(b) EPC 1973 if the extent of the request made on appeal could be inferred interpreting the notice of appeal in an objective way (**T 85/88**, see also e.g. **T 32/81**, OJ 1982, 225; **T 7/81**, OJ 1983, 98; **T 1/88**, **T 533/93**, **T 141/95** and **T 308/97**).

T 631/91, **T 727/91** and **T 273/92** confirmed the principle that the appeal's scope could be ascertained from the appellant's overall submissions if the request filed in the appeal proceedings did not make this clear. Since no indication was made to the contrary in the appellant's submissions, the board of appeal assumed that he wished to file a request in the appeal proceedings along the same lines as that filed in the opposition proceedings (see also **T 925/91**, OJ 1995, 469; **T 194/90** and **T 281/95**).

The wording "... we hereby file notice of appeal to the decision ..." was construed in **T 632/91** as a request to set aside entirely the decision under appeal and to grant a patent on the basis of the documents of the European patent application to which the decision under appeal referred. This was followed in **T 49/99** and **T 1785/06**. See also **T 9/08** for a corresponding application under R. 99(2) EPC.

If the only ruling in an opposition division decision was that the patent was revoked, a statement by the patent proprietor that he was appealing against the decision was invariably tantamount to his stating that he wished and hence requested that the decision be set aside in its entirety, because setting aside had to be unitary. Hence the content of the notice of appeal was what R. 64(b) EPC 1973 demanded as one of its requirements for an admissible appeal, i.e. a statement identifying the extent to which cancellation of the decision was requested (**T 407/02**). This has also been applied under R. 99 EPC; see **T 912/08**, **T 624/09**, **T 689/09** and **T 1188/09**.

However, where the decision under appeal related to more than one different legal issue, the statement identifying the extent of the appeal as prescribed by R. 64(b) EPC 1973 had to make it clear which issue(s) of the decision were also subjects of the appeal (**T 420/03**). As the notice of appeal was completely silent on the apportionment of costs and there was nothing which indicated that the decision should be set aside in its entirety, this issue was not within the extent of the appeal.

c) Direct link between the contested decision and the statement of grounds of appeal

There must be a causal relationship between the arguments in the statement of grounds of appeal and the reasons given in the decision under appeal (**T 2012/16**). The absence of any correlation of the ground of appeal to the decision under appeal is detrimental to the admissibility of the appeal (**T 349/09**). See also **T 1561/15**.

In **J 22/86** the appellant had made no submissions regarding the causal relationship between the reasons given in the statement of grounds of appeal and the asserted invalidity of the findings of the decision impugned. If no causal relationship were required, any submission, even one not connected with the reasons on which the decision impugned is based, would be acceptable. This would render the provisions of Art. 108 EPC moot. Whilst the grounds do not have to be conclusive in themselves, i.e. justify the setting aside of the decision impugned, they must enable the board to assess whether or not the decision is incorrect. The appeal was rejected as inadmissible.

In **T 223/14** the amended claims had obviously been filed with the intention of clarifying existing features and so overcoming the objection underlying the finding of a lack of novelty. They therefore did not constitute a completely new set of facts and thus there was a sufficiently direct link (see **T 2532/11**) between the decision under appeal and the statement of grounds of appeal. See also **T 1750/16**.

In **T 123/17** the board noted that the concept of a clear and direct link is not an additional requirement for the admissibility of the appeal but simply a means of expressing the requirements of Art. 108, third sentence, EPC in conjunction with R. 99(2) EPC.

d) Adequate reasoning for an appeal against a refusal of the application

Decisions **T 213/85** (OJ 1987, 482) and **T 95/10** clarify that the appeal procedure is not a mere continuation of the examination procedure (in accordance with decisions **G 10/91**, OJ 1993, 420; **G 9/92**, OJ 1994, 875 and **G 4/93**, OJ 1994, 875), but separate therefrom. Where the applicant in the grounds of appeal repeats its arguments set out during the examination phase without taking into account the decision under appeal, it mistakes the function of the boards of appeal; they are not a second go at the examination procedure, but are meant to review decisions made by the examining divisions, based on the objections raised against the decision in the grounds of appeal, which must therefore relate to the reasons on which the decision under appeal is based.

It is the boards' settled case law that this statement has to deal with all the main reasons for the contested decision in order to be considered sufficient for the purposes of admitting an appeal (**T 1904/14**). A statement of grounds failed to meet the minimum requirements if it dealt with only one of several grounds for refusal (**T 1045/02**, **T 473/09**, **T 231/14**, **T 2411/16**, **T 918/17**, **T 868/18**). Any ground that can justify a refusal when considered in isolation, independently of the other grounds stated in the decision, is considered a ground for refusal (**T 231/14**). In **T 1904/14**, the board held that this principle applied even if the grounds given in the contested decision were wrong or contradictory. A wrong, contradictory or incomplete decision did not absolve an appellant of the need to address

any such deficiencies in the statement of grounds of appeal. A sufficient statement of grounds had to be filed by the deadline in Art. 108, third sentence, EPC; a failure to so could not be remedied retroactively with a late submission.

Where there had been several independent reasons for the decision to refuse the application and at least one of those reasons was not addressed in the statement of grounds at all or only in insufficient detail, the board could not normally reverse the contested decision, even if it concurred with the appellant in relation to all the reasons for refusal addressed in the statement of grounds. The requirements of Art. 108, R. 99(2) EPC were not met (**T 899/13**).

A ground for refusal can be addressed either by amending the claims and explaining why the ground for the decision no longer applies, or by giving arguments why the objection on which the ground was based is incorrect (see **T 2022/16**, **T 305/11** and **T 899/13**).

In **T 733/98**, where an application was refused under Art. 97 EPC 1973 and R. 51(5) EPC 1973 (R. 71(4) EPC), on the grounds that the applicant neither communicated his approval of the text proposed for grant within the period according to R. 51(4) EPC 1973 nor proposed amendments within the meaning of R. 51(5) EPC 1973 within this period, the statement of the grounds of appeal was inadmissible, as it dealt only with the issues of the admissibility and allowability of new claims filed with the statement of grounds.

In the following cases, the appeal was deemed inadmissible: **T 395/12** (the applicant's only statement that directly addressed the decision under appeal was that the examining division was "wrong", with no explanation why); **T 1407/17** (the grounds of appeal gave no indication of why the ground for refusal under Art. 56 EPC was unfounded).

e) Adequate reasoning in an appeal filed by the opponent

It is established case law of the boards of appeal that appeals by opponents – as opposed to appeals by proprietors, which would need to address all objections withstanding the maintenance of the patent – are sufficiently reasoned where they make a substantiated case for the decision under appeal being wrong on one of the objections or grounds for opposition. That was because, if the decision were indeed wrong on that point, the appeal had to be allowed for this reason alone (**T 767/14**, see also **T 950/99**, **T 846/01**, **T 87/17**, **T 456/17**). For such an appeal, therefore, it is also immaterial if the case is lacking as regards other aspects dealt with in the contested decision. If an opponent's statement of grounds of appeal is insufficiently reasoned in relation to specific parts only, this does not mean the appeal is inadmissible, because admissibility can only be assessed in light of the appeal as a whole (**T 2270/17**).

In **T 950/99**, the statement setting out the grounds of appeal included the legal and factual reasons why the decision under appeal should be set aside with respect to at least one ground, namely lack of inventive step. Therefore, even if it did not contain a full reasoning with respect to each and every ground, it nevertheless met the minimum requirement of Art. 108 EPC. In **T 808/01**, the board held that, where the statement of grounds contained

several lines of argument and reasons sufficient to render the appeal admissible had been given in support of at least one of them, the appeal was admissible and it did not matter that no such reasoning had been given in support of one of others.

In **T 846/01**, the board held that, for an appeal to be admissible, at least one of the grounds in the written statement of grounds of appeal must relate to a point which could at least arguably have been decided in the appellant's favour by the instance appealed from but which point had not been so decided, and such favourable decision on this point would have produced a different outcome. Following **T 846/01**, the board in **T 1178/04** confirmed that an appeal does not lie against part of a decision of a first instance tribunal if the result would have been the same even if the point had been decided in the appellant's favour.

In **T 1187/04**, where the appellant had dealt only with the novelty objections and not addressed inventive step, the appeal was held inadmissible.

In **T 257/03**, since all the board could gather from the statement of grounds was that the appellant sought the reopening of the entire opposition proceedings, but not why it considered that the opposition division's decision should be amended, it dismissed the appeal as inadmissible.

In **T 1649/10** the board held that the mere indication by appellant II (patentee) that the subject-matter of granted claim 1 was inventive, starting from document D4 as the closest prior art, whereas the impugned decision based its analysis on a combination of D10 as the closest prior art and document D4, did not fulfil the requirements of R. 99(2) EPC. The board was not in a position to recognise in the reasoning put forward by appellant II, why the reasoning of the opposition division, which relied on document D10 as closest prior art, had to be rejected. The appeal filed by appellant II was, hence, rejected as inadmissible. Its role in the appeal proceedings was then that of a party as of right under Art. 107 EPC.

f) Statement of the legal or factual reasons

Already in **T 220/83** (OJ 1986, 249) the board ruled that the grounds for appeal should specify the legal or factual reasons on which the case for setting aside the decision was based. The arguments had to be clearly and concisely presented to enable the board and the other party or parties to understand immediately why the decision was alleged to be incorrect, and on what facts the appellant based his arguments, without first having to make investigations of their own. Whilst passages from the literature setting out the state of the art might – provided sufficiently precise reference was made to them in the grounds of appeal – be considered an integral part of the grounds, they could not by themselves form a sufficient statement of grounds. This principle was expressly confirmed in many decisions, for example **T 250/89** (OJ 1992, 355), **T 1/88**, **T 145/88** (OJ 1991, 251), **T 102/91**, **T 706/91**, **T 493/95**, **T 283/97**, **T 500/97**, **T 1045/02**, **T 809/06**, **T 2346/10**, **T 294/11**, **T 2001/14**, **T 2270/17**.

In **T 22/88** (OJ 1993, 143), the board held that a written statement announcing only that the appellant would complete an omitted act (here the filing of the translations of the

revised claims) did not comprise sufficient reasons, and therefore did not constitute a valid statement of the grounds of appeal.

Where, as a result of contradictions and inexactitudes in an anyway very brief statement of grounds, it is left to the board to make sense of it, the appeal is usually inadmissible (**T 760/08**).

In **T 2377/13** the appellant's grounds of appeal had not addressed any of the main reasons for the opposition division's decision, and in particular the finding that experiments D9 and D13 were not suitable to show that a technical effect resulted from the difference between the closest prior art and the claimed subject-matter, and so had not set out why the appealed decision should be set aside.

Precisely cited passages from the relevant literature become an integral part of the grounds but cannot by themselves form a sufficient statement of grounds (**T 1402/10**, citing **T 922/05**).

g) Addressing the reasons given in the decision in the statement of grounds of appeal

In **T 213/85** (OJ 1987, 482) the board stated that grounds sufficient for the admissibility of an appeal had to be analysed in detail vis-à-vis the main reasons given for the contested decision. If an opposition had been dismissed on the grounds of insufficient substantiation and the grounds for appeal merely disputed patentability without elaborating on the admissibility of the opposition, the appeal was inadmissible for lack of adequate substantiation (see also **T 169/89**, **T 2001/14**).

According to the board in **T 95/10**, there were three reasons for this: First, the appeal procedure is not a continuation of the opposition procedure, but a distinct procedure in which any facts, evidence or arguments considered relevant must, if need be, be resubmitted (see **G 10/91**, OJ 1993, 420; **G 9/92** and **G 4/93**, both in OJ 1994, 875). Second, the appellant's analysis of the contested decision is needed in its statement of grounds of appeal. The third reason is that, in the absence of such an analysis, neither the board of appeal nor the respondent can establish why the appellant regards the contested decision as incorrect. It is, however, only based on this knowledge that the respondent can counter the appellant's arguments and that the board is in a position to reach an objective decision (see also **T 1188/08**, **T 720/12**).

In **T 395/13**, although the statement of grounds of appeal contained no substantive arguments addressing the reasoning of the decision under appeal, it nonetheless met the requirements of Art. 108 EPC in combination with R. 99(2) EPC. This was because the main objection of the appellant in the grounds of appeal was that the decision under appeal did not contain sufficient reasoning to enable the appellant to file such arguments. R. 99(2) EPC required no more than this and in particular did not specifically require that the statement of grounds of appeal addresses the arguments in the decision under appeal. The board therefore concluded that the appeal was admissible.

h) Complete case within the meaning of Article 12(3) RPBA

Under Art. 12(3) RPBA, the statement of grounds of appeal and the reply have to contain a party's complete appeal case. See also chapter V.A.3.2.2 "Complete case on appeal".

In **T 2884/18** the appeal was rejected as inadmissible. The board considered the statement of grounds of appeal insufficient as it primarily discussed only the opposition division's finding that the asserted public prior use had not been adequately demonstrated, while failing to duly substantiate a lack of novelty in view of that public prior use. The board explained that, for a case based on chains of reasoning to be complete, as Art. 108 EPC and Art. 12 RPBA required, it was necessary to set out all the facts that led to the asserted legal outcome only when considered cumulatively. The approach had to mirror that in proceedings against a decision listing various alternative reasons why a patent could not be granted or maintained. In this respect, the case law of the boards of appeal had it that an appeal could be deemed sufficiently substantiated only if it addressed all the grounds precluding patentability. Only then had a case for setting the decision aside been made (see **T 922/05**). The same had to apply in reverse if several grounds cast doubt on the patentability of a maintained patent only when considered cumulatively, as was the case here: prior use forming part of the prior art and prior use anticipating the invention. If out of a number of facts having to be considered cumulatively in order to alter the decision just one was sufficiently substantiated, the appeal was inadmissible.

i) Mere repetition of arguments

In **T 198/15** the statement setting out the grounds of appeal consisted essentially of word-for-word repetitions of the notice of opposition, supplemented by word-for-word repetitions of the appellant's written submissions and new novelty attacks based on documents which did not form part of the proceedings before the opposition division. The arguments which were mere repetitions of the ones presented before the opposition division, did not, and could not, provide reasons why the decision under appeal was to be set aside because they were drafted before the decision of the opposition division was issued.

Furthermore, a statement of grounds of appeal that is identical or nearly identical to the notice of opposition can as a rule not be considered to contain arguments as to why the decision under appeal is incorrect (**T 2077/11**, **T 39/12**, **T 123/15** of 21 December 2016).

j) Appeal based on objection not raised nor examined at first instance

In **T 393/15** the appellant had based its statement of grounds of appeal solely on an objection under Art. 83 EPC it had not raised at first instance. During the proceedings before the opposition division, however, features from the description had been added to independent claim 1 of the request ultimately held allowable. The board observed that a request amending a patent by adding features not in the claims as granted was as a rule open in opposition proceedings to objection under Art. 83 EPC (in conjunction with Art. 101(3) EPC), even if the ground for opposition under Art. 100(b) EPC had not been cited (see also **T 66/14**). Accordingly, the Art. 83 EPC objection raised on appeal did not go beyond the legal scope of the case before the opposition division. The requirements of

Art. 108 and R. 99(2) EPC were thus met. See also chapter V.A.3.2.3h) "Fresh ground for opposition on appeal".

k) Statement of grounds of appeal not filed in full

In **T 382/16** the patent proprietor submitted with its rejoinder comparative tests (D 11). However, the rejoinder had not been signed because the last page of the rejoinder bearing the signature of the representative had not been transmitted. The whole rejoinder including the missing page 5 with the signature of the representative was submitted later. The board stated that in analogy to the provisions of R. 50(3) EPC, it was considered that the tests shall retain their original date of receipt and therefore were deemed to have been filed within four months of notification of the grounds of appeal.

In **T 2307/15** the respondent argued that the appeal was inadmissible since the statement setting out the grounds of appeal sent by facsimile was incomplete. The board found that although some paragraphs were missing in the statement setting out the grounds of appeal, the document still allowed the reader to understand the reasons according to which the appellant requested the impugned decision to be set aside and the facts and evidence on which the appeal was based. The statement setting out the grounds of appeal received was therefore to be seen as being complete. Thus, the appeal was admissible. However see also **T 858/18** regarding incomplete facsimile transmission and the observance of the time limit Art. 99(1) EPC).

l) Duty of board to be impartial

The case law of the boards of appeal was reviewed in **T 922/05** and much of it found to take a relatively lenient position in the sense that the appeals were deemed to be admissible if the competent board was able to infer from the particulars of the case the presumed intentions of the applicant and the probable reasons underlying its actions (see **T 563/91**, **T 574/91**, **T 162/97**, **T 729/90**). However, excessive leniency towards one party would rightly be perceived as an injustice towards the other. The board was of the opinion that submissions of a party which only made it possible for a board to **infer** a line of argumentation did not fulfil the requirements of either the "**clear** reasons" or the "**express** specification of facts and arguments" as prescribed by the RPBA. The statement of the grounds of appeal filed by the appellant remained silent on at least two issues, which would have been clearly relevant for deciding on the appeal, and therefore should have been addressed by the grounds of appeal in order to be complete. The appeal was rejected as inadmissible (see also e.g. **T 760/08**, **T 727/09**, **T 450/13**, **T 460/13**).

In **T 450/13** the board pointed out that the statement of grounds of appeal was not sufficiently substantiated with regard to the alleged public prior use attacks. A reference back to first-instance proceedings was not a sufficient reasoning to render a submission in the statement of grounds of appeal admissible (see **T 473/09**). The submissions in the statement of grounds of appeal had to be such as to enable the board (and any other party) to understand immediately why the decision was alleged to be incorrect, without first having to make investigations on its own. To ask the board to do this would mean that the

board had to make up the appellant's case in breach of the principle of impartiality (see also **T 1676/08**).

2.6.4 New case raised

a) Appeal based on the same ground for opposition

According to the case law of the boards of appeal (see e.g. **T 389/95**, **T 1063/98**, **T 1029/05**, **T 1915/09**, **T 1314/12**), an appeal invoking a ground for opposition already invoked in opposition proceedings, i.e. remaining within the same legal framework, albeit being based on a completely fresh factual framework does not ipso facto lead to an inadmissible appeal. However, this finding does not necessarily mean that the new items of **evidence** only filed during the appeal procedure may not be disregarded by the board.

In **T 389/95** an appeal was filed on existing grounds for opposition but based solely on new evidence introduced in the grounds of appeal. The board found the appeal to be admissible because the issue of new factual framework was one of fact to be determined objectively as part of the substantive examination of the appeal. **G 10/91** allowed even a fresh legal ground for opposition to be considered in appeal proceedings if the patentee approved and it followed from this, that an appeal based solely on such a ground was not ipso facto inadmissible; by the same token an appeal based on the same legal ground, albeit on a completely fresh factual framework, might be admissible. See also **T 932/99**.

In **T 611/90** (OJ 1993, 50) the opponent, on appealing the finding of the opposition division that the patent was novel and inventive, went on to develop what was an entirely fresh case on lack of novelty. Similarly, the appeal was found admissible in **T 938/91**, where the opponent (appellant) introduced a new alleged public prior use and citation; although a "fresh case" was presented by the appellant to the board, the fresh reasons still fell within the same ground for opposition.

Following **T 611/90**, the board in **T 252/95** held that grounds could be deemed to be sufficient if new facts were submitted which removed the legal basis from the decision. That also applied where the grounds for opposition were based on new facts and there was no discussion whatsoever of the grounds for the opposition division's decision. See also **T 801/00**.

In **T 2361/15** the appeal of the appellant was solely based on an alleged public prior use filed for the first time with its statement of grounds on the same ground for opposition. The board stated that bringing a fresh case in appeal does not automatically imply that the statement of grounds does not "indicate the reasons for setting aside the decision impugned". It is a sufficient condition that the statement of grounds of appeal enables the board to understand immediately why the decision is alleged to be incorrect and on what facts the appellant bases its arguments. The statement of grounds met this condition.

Similarly, in **T 727/09** there was an entirely new set of facts, albeit based on the same ground for opposition. The board noted that if the statement of grounds of appeal is exclusively based on these new documents, there must be a direct and clear link between

the contested decision and the grounds for appeal. In the case at issue, the factual basis was, however, entirely new. The appeal was rejected as inadmissible.

b) Taking new submissions into consideration

The extent to which new submissions filed with the statement of grounds of appeal are taken into consideration is at the board's discretion as per Art. 12(4) RPBA; for more detail on this point, see chapter V.A.3.2.2 "Complete case on appeal" and chapter V.A.4 "New submissions on appeal".

In **T 278/15**, the board held that, having found an appeal to be admissible, it could not deem it inadmissible retroactively even if it later exercised its discretion not to admit an amended request into the proceedings. The admissibility of the appeal had to be examined on the basis of all the documents filed by the appellant within the deadline, even if these documents were subsequently excluded from the proceedings (see explanatory remarks to Art. 12(4) RPBA, Supplementary publication 2, OJ 2020).

In **T 2270/17**, the board held that when deciding whether the appeal had been adequately reasoned, it was immaterial that D7 and D8 were new documents that had not been part of the opposition proceedings. Specifically, a statement of grounds of appeal could be admissible even if the facts and evidence liable to deprive the contested decision of its basis which it cited in support of an existing ground for opposition were new. The board's later, discretionary decision on whether to exclude any such new submissions from the appeal proceedings as per Art. 12(4) RPBA 2007 had no retroactive effect on the admissibility of the appeal.

In **T 501/09** the board was aware that other boards of appeal had found that an appeal based entirely on new evidence may be admissible when the grounds for opposition have remained the same (see **T 1557/05**). However, this finding does not necessarily mean that the new items of evidence only filed during the appeal procedure may not be disregarded by the board (see e.g. **T 389/95**). If this new evidence is subsequently not admitted in the appeal proceedings this has the consequence that the appellant's case on appeal is not substantiated.

c) Amended claims filed

(i) General

It is settled case law that the grounds for appeal can also be considered sufficient where they refer to new facts which deprive the decision of its legal basis (**T 252/95**, **T 760/08**), particularly where new sets of claims are filed (**T 934/02**, **T 2226/13**). An appeal is not necessarily rendered inadmissible by an appellant filing amended claims, and defending the patent solely on the basis of claims as amended in the grounds of appeal (**T 1320/19**).

In **T 655/03** an appeal by the patent proprietor was to be considered as sufficiently substantiated to satisfy the requirements of Art. 108 EPC, third sentence, even if it did not state any specific reason why the decision was contested, provided that two criteria were

met: there is a change in the subject of the proceedings due to the filing of amended claims together with the statement setting out the grounds of appeal, and the reasons for the decision are no longer relevant in view of the amended claims. See also **T 717/01**, **T 934/02** and **T 1708/08**.

The board in **T 934/02** added that it was therefore not necessary and would also be pointless for the purposes of adequately substantiating an appeal, to file grounds in support of a version of a claim that the appellant (patent proprietor) was no longer defending in the appeal proceedings. See also **T 1197/03** and **T 642/05**. However, where the application was not refused on the basis that the previous set of claims on file could not be allowed, i.e. for lack of clarity, novelty or inventive step, rather on the ground that there was no agreed set of claims, filing new claims was not an adequate response (**T 573/09**); the statement of grounds should have set out why the appellant should be given the opportunity to have the proceedings continued before the board.

In **T 2532/11** the question arose whether newly filed requests could be seen as implicit grounds of appeal. A statement of grounds of appeal supported by amended claims may define, at least implicitly, the extent to which the appellant wishes the decision under appeal to be set aside. The board of appeal has the duty to assess whether the appeal is well founded within the framework of the case as presented by the appellants but it cannot guess what the arguments are, let alone, provide arguments in lieu of the appellants. A direct link must be maintained between the decision under appeal and the statement of grounds of appeal, which had not been done in the case in hand.

Where amended claims are filed, the appeal's admissibility does not depend on whether the board later admits those claims into the proceedings or whether the appellant's case is ultimately convincing (**T 2558/16**). The extent to which amended claims filed with the statement of grounds of appeal are taken into consideration is at the board's discretion as per Art. 12(4) RPBA; for more detail on this point, see chapter V.A.4.3 "First level of the convergent approach – submissions in the grounds of appeal and the reply – Article 12(3) to (6) RPBA".

(ii) Adequate reasoning for filing amended claims

- Patent proprietor

It is not an absolute requirement for admissibility that the appellant should attack the opposition division's decision as flawed. Where amended claims have been filed, an appeal may also be admissible if sufficient reasons are given in the statement of grounds why the amendments are considered apt to remedy the deficiencies identified by the opposition division (**T 1668/14**, see also **T 278/15**, **T 1311/17** and **T 1320/19**). In **T 1610/15**, the board added that the appeal's admissibility did not depend on whether the appellant's case was ultimately convincing or whether the board later admitted the amended claims into the proceedings. See also **T 1320/19**.

However, it was not enough merely to file a new set of claims without comment. Rather, appellants had to set out why and to what extent the amended set of claims was a

response to the factual and legal assessment on which the opposition division had based its decision (**T 220/83**, OJ 1986, 249; and **T 145/88**).

The amendments should address the reasons for the decision being contested (**T 2453/09**). See also **T 1533/13**.

In **T 1276/05** the patent proprietor/appellant reverted back to a form of claim which had been effectively withdrawn during the opposition proceedings, i.e. the patent as granted, without explaining why the contested decision was wrong. The board noted that the lack of a need for explanation was based on the specific situation of the case before it, wherein – unusually – the offered amendments self-evidently overcame the grounds for the decision and the appeal was thus admissible.

- Applicant

In **T 933/09** the board considered that the mere filing of amended claims did not exonerate the appellant from the task of expressly specifying in the statement of grounds of appeal the relevance of the amendments for overcoming the objections on which the decision under appeal was based.

The mere fact of filing amended claims with the statement of grounds of appeal is not sufficient if it does not overcome the reasons for the refusal in the case at issue. The appellant in **T 1707/07** did not address the reasons given in the decision under appeal and it was thus not clear to the board why the decision under appeal was alleged to be incorrect. The appeal was rejected as inadmissible. See also **T 502/02** and **T 132/03**.

In **T 295/04**, the statement of grounds contained only a general reference to pleadings submitted during the proceedings at first instance and a set of new claims. Since such a general reference could not be regarded as setting out why the department of first instance's decision should be amended, the appeal was dismissed as inadmissible.

2.6.5 References to earlier submissions

The boards have frequently held that a statement of grounds referring generally to submissions made at first instance, as a rule, cannot be considered sufficient for the purposes of Art. 108, third sentence, EPC (see e.g. **T 254/88**, **T 432/88**, **T 534/89**, **T 90/90**, **T 154/90**, OJ 1993, 505; **T 287/90**, **T 188/92**, **T 646/92**, **T 473/09**, **T 47/12**, **T 450/13**, **T 16/14**, **T 2411/16**).

In **T 1311/13** the board stated that a mere reference to a party's earlier submissions and/or the verbatim repetition of the arguments presented in those submissions ("grounds by cut-and-paste"), including the submissions or arguments put forward at the oral proceedings before the opposition division, without actually dealing with, or entering into a discussion of the reasons given in the decision under appeal by the opposition division for arriving at its decision, was not enough to substantiate a ground of appeal.

In **T 432/88** the appeal filed only made a general reference to the appellant's submissions in the preceding opposition proceedings and thus amounted to no more than a mere assertion that the contested decision was incorrect, without stating the legal or factual reasons why that decision should be set aside. Consequently, the appellant had left it entirely to the board and the respondent to conjecture in what respect the appellant might consider the decision under appeal to be defective. This was followed in **T 534/89**, where the board pointed out that otherwise the respondent is at a loss to know how to prepare his case and the board cannot direct the appeal proceedings in an efficient way.

Merely referring to one's own first-instance submissions could not normally replace an explicit account of the legal and factual reasons for the appeal. Only exceptionally did the case law allow substantiation to take that form. References to earlier submissions, even when taken together with the contested decision, did not as a rule clearly indicate which grounds of the decision were regarded as mistaken, and why. The board and the opposing party could not then consider the merits of the appeal without making investigations of their own (**T 349/00**). See also **T 165/00**. According to the case law of the boards of appeal, the grounds of appeal should state the legal and factual reasons why the appeal should be allowed and the contested decision set aside. It is not enough merely to seek fresh examination of the patentability requirement found not to be met at the previous instance by indicating disagreement with that finding (see **T 220/83**, OJ 1986, 249; **T 213/85**, OJ 1987, 482; **T 145/88**, OJ 1991, 251; **T 1462/08**; **T 2077/11**).

In **T 2556/16** the board stated that merely referring to one's own submissions in the first-instance proceedings could not normally replace an explicit account of the legal and factual reasons for the appeal (see **T 2012/16**). This applied even more, when the absence of evidence for an alleged common general knowledge was one of the decisive reasons in the first instance decision for rejecting the opposition. The appeal had to be found inadmissible.

In a small number of isolated decisions, however, the boards have accepted a general reference to submissions at first instance as potentially constituting grounds for an admissible appeal (**T 355/86**, **T 140/88**, **T 725/89**, **T 869/91**, **T 216/10**), but these decisions were given in special cases in which those submissions already adequately addressed the grounds underlying the contested decision.

2.6.6 Arguments need not be new or relevant

Whether the appellant's arguments are convincing or likely to be successful is irrelevant for the purposes of determining the admissibility of the appeal (**T 1668/14**). See also **T 1610/15**.

In **T 644/97** the board found that the fact that the points made in the statement of grounds of appeal did not go beyond those made before the opposition division did not detract from the admissibility of an appeal. A requirement that new arguments be submitted to render an appeal admissible would have implied that the appealed decision must have been correct. Nor did the appeal need to have a strong prospect of success.

The fact that some arguments were already presented during the opposition proceedings was not detrimental to the admissibility of the appeal (**T 1074/12**).

Irrelevancy and lack of cogency might lead to an unsuccessful outcome of the appeal, but did not of themselves render it inadmissible (**T 65/96**, see also **T 922/05**).

2.6.7 Exceptional circumstances warranting admissibility of appeal

a) Immediately apparent the contested decision cannot be supported

In **J 22/86** (OJ 1987, 280) the board made it clear that where the written statement did not contain such full reasons, the requirement for admissibility might be regarded as satisfied if it was immediately apparent upon reading the decision under appeal and the written statement that the decision should be set aside. According to the board, a well-drafted statement of grounds should contain reasoning that is full but concise. And, in general, it is obvious that the less reasoning that a statement contains, the greater will be the risk that the appeal will be rejected as inadmissible for non-compliance with Art. 108 EPC. The question whether a particular statement alleged to be a statement of grounds of appeal in a particular case meets the minimum requirement of Art. 108 EPC could only be decided in the context of that particular case; and the context of a particular case will normally include the contents of the decision under appeal. In a wholly exceptional case such as the one before the board, it might be immediately apparent to the board upon reading the decision under appeal and the statement of grounds that such decision cannot properly be supported, even though the grounds contained in such statement can fairly be described as minimal. See also **J 2/87** (OJ 1988, 330), **J 6/88**, **T 195/90**, **T 729/90** and **J 1/14**.

b) Patent proprietor requests revocation

An opponent's appeal is admissible when the written statement of grounds is based solely on the fact that the patent proprietor himself filed the request for revocation of the patent after the appeal was filed (**T 459/88**, OJ 1990, 425 and **T 961/93**).

c) Substantial procedural violation

In **T 1020/13** the board held that, if a substantial procedural violation is alleged and adequately substantiated in the statement of grounds of appeal, it is irrelevant for the decision on admissibility of the appeal whether the challenge to the substantive reasons for the decision can likewise be regarded as adequately substantiated.

2.6.8 No partial admissibility of appeal

The admissibility of an appeal can only be assessed as a whole (**T 382/96**, **T 1763/06**, **T 509/07**, **T 2001/14**). There is no support in the EPC for a notion of 'partial admissibility' of an appeal (**T 774/97**, **T 509/07**, **T 2339/12**, **T 1311/13**, **T 1679/17**).

The board in **T 509/07** thus found it immaterial for the purposes of the admissibility of the appeal whether or not sufficient grounds relating to the main request had been submitted, where the first auxiliary request clearly complied with the admissibility requirements of Art. 108, third sentence, EPC. However, it is a different question whether a request in relation to which the admissibility requirements of Art. 108, third sentence, EPC are not met is admitted into the appeal proceedings. In **T 382/96** and **T 509/07**, such unsubstantiated requests were not admitted. See also **T 1763/06** and **T 2001/14**.

In **T 1679/17**, the board stated that so long as one objection to the contested decision had been raised in compliance with R. 99(2) EPC, the entire appeal was admissible. Even if other objections were not adequately substantiated as per Art. 12(2) RPBA, this did not entail any partial inadmissibility that could no longer be remedied by a later submission. Rather, it merely meant that the admission of those objections (assuming they were not substantiated until later in the proceedings) would be at the board's discretion under whichever provision was applicable at the time of their belated substantiation (Art. 13(1) or 13(2) RPBA).

2.7. Examination of the admissibility of appeal in every phase of appeal proceedings

It is established jurisprudence of the boards of appeal that the admissibility of the appeal is to be examined ex officio at every stage of the appeal proceedings (see **T 15/01**, OJ 2006, 153), and thus also at the oral proceedings (**T 501/09**, **T 2223/10**, **T 198/15**). It can and, where appropriate, must be raised by the board in appeal proceedings even if this is the first time this matter is addressed (**T 289/91**, OJ 1994, 649; **T 28/93**; **T 522/94**, OJ 1998, 421; **T 1668/07**).

In **T 670/09**, the respondent did not challenge the appeal's admissibility until two days before the oral proceedings. The board observed that, under Art. 12(2) RPBA 2007, the reply to an appeal had to contain the respondent's entire case. As a rule, respondents had to object to the appeal's admissibility or the board's competence in limine litis, i.e. before submitting their substantive defence. The respondent's objection to admissibility was therefore disregarded.

2.8. Cases where admissibility of appeal need not be considered

In appeal proceedings in which the question of allowability of an appeal can be readily decided (i.e. the appeal is clearly unallowable) but no decision on its admissibility can be taken yet, the issue of admissibility of the appeal can be left open (**T 1467/11**). Similarly, in a number of decision on petitions for review under Art. 112a EPC, the Enlarged Board did not arrive at a final conclusion as to whether the petition in question was clearly inadmissible, because it found the petition to be clearly unallowable (**T 2023/09**).

2.9. Interlocutory revision

2.9.1 General

Under Art. 109(1) EPC, in **ex parte** proceedings the department whose decision is contested must rectify its decision if it considers the appeal to be admissible and well founded. This is for reasons of procedural economy. Interlocutory revision is generally not available for decisions in **inter partes** proceedings, as the appellant should not be opposed by any other party to the proceedings. In exceptional cases, however, an opposition division may correct its decision by way of interlocutory revision if it wrongly revoked a patent for failure to comply with certain requirements despite intending to maintain that patent in amended form pursuant to a final interlocutory decision (see **T 168/03**).

On expiry of the three-month period under Art. 109(2) EPC 1973, the department of first instance whose decision is contested ceases to be responsible for the matter. Rectification of the decision is then no longer possible (**T 778/06**).

Art. 109(1) EPC provides an exception to the principle of general devolutive effect of the appeal, in order to allow an interlocutory revision. This exception has to be construed narrowly in connection with the interlocutory revision, and not as a broader entitlement for the department of first instance to decide whether an appeal is admissible (**T 1973/09**) (see also **T 473/91**, OJ 1993, 630, **T 808/03** of 12 February 2004).

In **G 3/03** (OJ 2005, 344), the Enlarged Board held that the object and purpose of interlocutory revision under Art. 109(1) EPC was to avoid, in the interest of procedural economy, any need to remit clear and straightforward cases to the boards of appeal, it being preferable for the department of first instance whose decision was contested to rectify the decision if it was immediately apparent to that department that its decision could not stand. As to reimbursement of the appeal fee in the event of an interlocutory revision, see chapter V.A.11.4.

In **T 1558/18**, the two oppositions against the patent had been withdrawn and so the appellant had not been opposed by any other party to the proceedings within the meaning of Art. 109(1) EPC. The appeal being admissible and also well founded with regard to a substantial procedural violation, the opposition division should have rectified its decision itself under Art. 109(1) EPC but had instead remitted the appeal straight to the board. In doing so, it had committed a further substantial procedural violation in relation to the appellant's right to be heard.

In **T 638/01** a form was wrongly filled in and the appeal was sent by the formalities officer acting for the opposition division directly to the boards of appeal, bypassing the consideration for interlocutory revision. The board pointed out that since the granting of interlocutory revision in an appropriate case is **mandatory**, it followed a fortiori that considering a case for interlocutory revision in circumstances where the latter is possible is itself a **mandatory procedural step**. Since, however, the legislative purpose of

Art. 109 EPC is overall procedural economy, it made no sense for the board to remit the case to the department of first instance for performance of this omitted step.

2.9.2 The department of first instance's obligation to rectify the decision

In case **T 139/87** (OJ 1990, 68) the board of appeal made it clear that an appeal by an applicant for a patent was to be considered well founded within the meaning of Art. 109(1) EPC 1973 if the main request of the appeal included amendments which clearly met the objections on which the refusal of the application had been based as indicated by the examining division. In such a case, the department that issued the contested decision **must** rectify the decision. Irregularities other than those that gave rise to the contested decision do not preclude rectification of the decision (see also **T 47/90**, OJ 1991, 486; **T 690/90**; **T 1042/92**; **T 1097/92**; **T 219/93**; **T 647/93**; OJ 1995, 132; **T 648/94**; **T 180/95**; **T 794/95**; **T 1120/11**; **T 410/14** and **T 2303/16**).

Similarly, according to **T 1060/13** it is established case law of the boards of appeal that, in the event that the appeal is objectively to be considered as admissible and well founded, the department of first instance is obliged to grant interlocutory revision (**T 139/87**, OJ 1990, 68; **T 180/95**; **T 2528/12**; **T 1362/13**); there is no room for discretion in the interests of procedural efficiency (**G 3/03**, OJ 2005, 344; **J 32/95**, OJ 1999, 713; **T 919/95**).

In **T 2445/11** the board was aware that its interpretation of Art. 109(1) EPC was not fully in line with the views expressed in **T 1060/13**, even though the outcome was the same. According to **T 1060/13**, interlocutory revision must be allowed if the main request filed with the statement of grounds of appeal clearly overcomes the grounds for refusal, it being irrelevant whether amended claims give rise to new objections or suffer from deficiencies that are themselves the subject of observations included by way of obiter dicta. In the board's view in **T 2445/11**, this approach may sometimes be too rigid, as it leaves no room for a pragmatic assessment of the situation with a view to procedural efficiency and may result in a needless repetition of the first-instance proceedings, forcing the applicant to pay a second appeal fee. In **T 682/22**, the board did not follow **T 2445/11** and followed the line of **T 1060/13**.

In **T 508/13** the board stated that the expression "considers the appeal to be ... well founded" in Art. 109(1) EPC leaves an examining division room for exercising judgment while bearing in mind that the purpose of interlocutory revision is to speed up the procedure (see **T 2445/11**). At the same time, once an examining division has decided not to rectify a refusal decision, the possible incorrectness or inappropriateness of not rectifying it is in itself insufficient reason for an immediate remittal of the case: the opportunity to cut short the appeal procedure by means of interlocutory revision has in any event passed. Rather, it has to be assessed whether an immediate remittal is appropriate in view of the overall state of the case.

2.9.3 Well-founded appeal within the meaning of Art. 109(1) EPC

An appeal is to be considered "well founded" if at least the main request submitted with the appeal includes amendments which clearly meet the objections on which the decision relies, such that the department of the first instance could reasonably be expected to recognise this and thus rectify its decision. That there are other objections which have not been removed but which were not the subject of the contested decision cannot preclude the application of Art. 109(1) EPC 1973 (**T 139/87**; **T 1060/13**; see also **T 47/90**, OJ 1991, 486; **T 219/93**; **T 919/95**). Thus, even if the amendments raise new objections not yet discussed, interlocutory revision must be allowed since an applicant should have the right to two instances (**T 1060/13**, **T 691/18**, **T 982/18**).

According to **T 1640/06** objections or remarks made in an obiter dictum of a decision under appeal cannot be taken into account (see also **T 483/20**). In **T 726/10** the board was of the opinion that the question whether or not the claims filed with the statement setting out the grounds of appeal took into account the remarks made in the obiter dictum was irrelevant for deciding whether interlocutory revision should be granted or not.

2.9.4 Competence of the department of first instance

In **T 473/91** (OJ 1993, 630) the board made it clear that the admissibility question under Art. 109 EPC 1973 fell under the jurisdiction of the department of first instance only when this question could be decided immediately on the basis of the appeal submissions themselves. Consequently, the appellate instance had exclusive jurisdiction over a request for restitutio in integrum into a time limit relating to the appeal itself.

2.9.5 "Cassatory" or "reformatory" interlocutory revision

In **T 919/95** the appellant was of the opinion that an interlocutory revision had to result in the appeal being allowed. A "cassatory" revision that merely set aside the contested decision and resumed the suspended proceedings was not compatible with the EPC. The interlocutory revision had to be a 'reformatory' revision, i.e. one that conferred on the appellant something that the contested decision deprived him of. The board stated that the requirements of Art. 109 EPC 1973 were met if the reason for the contested decision were removed as a result of an admissible appeal; once the contested decision had been set aside the requested decision could be taken, or the proceedings could be resumed, since further examination was required of new grounds or facts. The latter did not rule out a subsequent refusal. The purpose of interlocutory revision was to speed up the procedure. If an examining division rectified a decision under Art. 109 EPC 1973 merely in order to grant a patent according to an auxiliary request, even though the applicant insisted on his main request, the procedure was not thereby accelerated but slowed down and this would constitute a substantial procedural violation (see also **T 142/96**).

In **J 5/08** the Legal Board stated that according to established EPO practice, interlocutory revision under Art. 109 EPC 1973 could either be such as to annul the decision (a "rein kassatorische Abhilfe", or purely "cassatory" act) or it can be a "reformatory" revision. In both cases, and whether or not the cancellation of the appealed decision is expressly

ordered, the appealed decision is set aside by the department of first instance, in the first case by a "cassatory" procedural act, e.g. by a communication providing for the further examination of the application or, in the second case, by a revision decision immediately revising the appealed decision.

3. Substantive examination of the appeal

3.1. Binding effect of requests – no reformatio in peius

The question of law referred to the Enlarged Board in **G 9/92** and **G 4/93** (both OJ 1994, 875) asked whether and to what extent a board of appeal could depart from the request formulated in the notice of appeal when deciding opposition appeal proceedings, to the disadvantage of the appellant.

The Enlarged Board took several factors into account. The aim of the appeal was to eliminate an 'adverse effect'. As the filing of an appeal was subject to a time limit, it would not be consistent to allow non-appealing parties the unrestricted right to alter the extent of the proceedings by submitting their own requests without limitation of time. A non-appealing party as a respondent had the opportunity to make what it considered to be appropriate and necessary submissions in the appeal proceedings to defend the result obtained before the department of first instance.

The Enlarged Board thus concluded that:

1. If the **patentee** was **sole appellant** against an interlocutory decision maintaining his patent in amended form, neither the board of appeal nor the non-appealing opponent (as party to the proceedings as of right under Art. 107, second sentence, EPC 1973) could challenge maintenance of the patent as thus amended.

2. If the **opponent** was **sole appellant** against an interlocutory decision by an opposition division maintaining the patent in amended form, the patentee was primarily restricted in the appeal proceedings to defending the patent as thus maintained. Amendments proposed by the patentee (as party to the proceedings as of right under Art. 107 EPC 1973, second sentence) could be rejected by the board as inadmissible if they were neither appropriate nor necessary.

As legal uncertainty had been created by the fact that the case law of the boards of appeal had not been uniform as regards the principle of prohibition of reformatio in peius when applying or interpreting decision **G 9/92** (OJ 1994, 875), a further question was referred to the Enlarged Board, which was answered in **G 1/99** (OJ 2001, 381). See in this chapter V.A.3.1.7.

3.1.1 Reformatio in peius does not apply separately to each point

According to the established case law of the boards of appeal, the doctrine of prohibition of reformatio in peius cannot be construed to apply separately to each point or issue decided, or the reasoning leading to the impugned decision (see **T 149/02**). If an appeal

is lodged against an adverse decision of the department of first instance about the main request, then the whole request is before the board of appeal and within its jurisdiction, and the board is empowered to reopen and to decide upon matters which have been an issue before the opposition division (see **T 327/92**, **T 401/95**, **T 583/95**, **T 576/12**). The prohibition of reformatio in peius relates solely to the legal effect of an impugned decision; it does not apply to individual issues or objections (**T 1924/18**, with reference to **T 1437/15**; **T 803/17**).

3.1.2 Reformatio in peius and devolutive effect of appeal

In **T 149/02** the board stated that the two general principles of procedure – prohibition of reformatio in peius and the devolutive effect of the appeal, which conferred on the board the power to consider its subject-matter – were complementary and had to be implemented in such a way that they did not exclude each other.

3.1.3 Cases where reformatio in peius does not apply

In **T 1178/04** (OJ 2008, 80) the board held that where the issue was a person's right to be a party, the principle of no reformatio in peius was of no application, bearing in mind the fact that the principle of no reformatio in peius was taken mainly from the well-established principle in German law ("Verschlechterungsverbot"). This principle has no application in those cases where (a) there exist procedural preconditions for making relevant requests to the court ("Verfahrensvoraussetzungen") and (b) these preconditions are of a kind that cannot be waived or dispensed with ("unverzichtbare Verfahrensvoraussetzungen"), such that the court must itself be satisfied that they have been fulfilled. According to the board, in the context of patent proceedings such as these, preconditions of this kind included the admissibility of the opposition itself and the capacity of a person to be a party to the proceedings in the first place.

Referring to **T 1178/04**, the board in **T 384/08** found that the admissibility of the opposition is an indispensable procedural requirement for the substantive examination of the opposition submissions at every stage of the proceedings. The board therefore had to examine the question of the transfer of status of the opponent ex officio before dealing with the substance of the case. In **T 882/17** however, the board held that if the opponent was the sole appellant against an interlocutory decision maintaining a patent in amended form, an objection related to the inadmissibility of the opposition was subject to the principle of the prohibition of reformatio in peius. In deciding this way the board noted that it departed from **T 1178/04**.

3.1.4 Patentee as sole appellant

In **T 598/99** the board observed that the principle of reformatio in peius applied so as to prevent a sole appellant being put in a worse situation than he was in before he appealed. Where the patentee was the sole appellant, the principle could not serve to protect the opponent (respondent) from being put in a worse situation than he was in before the appeal (**G 9/92**, OJ 1994, 875 and **G 4/93**, OJ 1994, 875). Indeed, whenever a sole patentee was successful in his appeal against the revocation of his patent, the opponent would be in a

worse position than before. The fact that the opponent was not entitled to appeal against the decision to revoke the patent was immaterial in that respect.

An early decision applying the principles expounded in **G 9/92** and **G 4/93** (OJ 1994, 875) was **T 856/92**, in which the board concluded that in a case where the patentee and sole appellant appealed only in respect of some of the claims held allowable in the opposition division's interlocutory decision, neither the board nor the opponent might challenge those claims not questioned by the appellant.

When the patent proprietor is the sole appellant, the patent as maintained by the opposition division in its interlocutory decision cannot be objected to by the board, either at the request of the respondent (opponent) or ex officio (see **G 1/99**, OJ 2001, 381, **T 1689/12**, **T 822/16**).

In **T 1626/11**, the first ten claims of the main request were identical in wording to those of the second auxiliary request, which the opposition division had already found to comply with the EPC. Faced with the question whether it could examine those claims without contravening the principle of no reformatio in peius, the board cited **T 856/92** and **T 149/02**, in which the boards had concluded that, where the proprietor was the sole appellant, they could no longer review any part of a set of claims included in a new set of claims also containing additional (parallel) claims if the opposition division had already held that the first set to be EPC-compliant and the additional claims did not alter how it was to be interpreted. This conclusion, based on **G 9/92**, was similarly reached in **T 168/04**, **T 1713/08**, **T 722/10** and **T 428/12**.

The board in **T 659/07** found that where the patentee is the sole appellant, the patent as maintained by the opposition division in its interlocutory decisions, cannot be objected to by the board, either at the request of the respondent (opponent) or ex officio, even if the patent as maintained would otherwise have to be revoked on the ground that a feature present in both claim 1 as granted and as maintained introduces added subject-matter contrary to Art. 123(2) EPC 1973.

3.1.5 Opponent as sole appellant

In **T 752/93** of 16 July 1996, **T 637/96**, and **T 1002/95** the opposition division had maintained the patent in amended form and only the opponent had appealed. The non-appealing patentee proposed amendments during the appeal proceedings. In **T 752/93** and **T 1002/95** the board found that amendments proposed by a non-appealing patentee could, according to **G 9/92** (OJ 1994, 875), be rejected as inadmissible by the board of appeal if they were neither appropriate nor necessary, i.e. had not been occasioned by the appeal. According to **T 752/93** the patentee should therefore have the opportunity to correct erroneous amendments if these were detected later in the proceedings. Similarly, in **T 637/96**, the respondent (patentee) was able to request restoration of the claim as granted, as the amendment made to it in opposition proceedings did not change its subject-matter (i.e. the claim as granted and amended meant the same thing) and was therefore unnecessary. In **T 752/93** and **T 637/96** the amendments were found not to worsen the sole appellant's position and the board thus considered them appropriate and

necessary. In **T 1002/95** the board pointed out that under R. 57a EPC 1973, which came into force after decisions **G 9/92** and **G 4/93**, a patentee was entitled to make "appropriate and necessary" amendments occasioned by grounds for opposition specified in Art. 100 EPC 1973, even if the respective ground was not invoked by the opponent.

In **T 23/04** the board made it clear that the requirements of reformatio in peius do not imply any right of the appealing party (opponent) to dictate the form any proposed amendments may take, and certainly to prescribe a form of amendment which would be maximally disadvantageous to the patent proprietor.

In **T 1380/04** the board, referring to **G 1/99** (OJ 2001, 381), held that the deletion of a term by the patentee/respondent could not be allowed, as this would have worsened the legal position of the appellant, contrary to the prohibition of reformatio in peius. It was immaterial that the term had only been introduced at the suggestion of the opposition division, as this did not alter the fact that approval of this amendment was the responsibility of the proprietor. See also **T 2503/18**.

However, if the opponent and sole appellant deliberately refrains from invoking the prohibition of reformatio in peius against a claim request submitted by the respondent (patentee) which extended the scope beyond that of the claims as maintained by the department of first instance, the board need not apply the principle of the prohibition of reformatio in peius of its own motion. Following the principle of party disposition, any right protecting an appellant against an outcome that puts it in a worse position than if it had not appealed, may be waived (**T 1544/07**).

The board observed in **T 111/10** that the exceptional possibilities for amendment foreseen by **G 1/99** in application of the principle of the prohibition of reformatio in peius only applied if the patent would otherwise have to be revoked, i.e. the patent proprietor (respondent) did not have any other possibility of amendment which would allow rescue of even part of the opposed patent. In the case at issue, however, such a possibility existed. Although this would have resulted in a restriction of scope, it could not be considered unduly inequitable for a patent proprietor who, not having appealed, could not from the outset expect to get more than what was already maintained by the opposition division.

3.1.6 Revocation of patent

The principles of **G 9/92** (OJ 1994, 875) were applied in **T 169/93** to the situation where the patent had been revoked, not amended. The patentee appealed against the decision to revoke (for lack of inventive step). The opposition division had found the patent sufficiently disclosed and novel. The appellant submitted that these issues could not be reopened, as none of the opponents had appealed this finding, relying on decisions **G 9/91** (OJ 1993, 408), **G 10/91** (OJ 1993, 420) and **G 9/92**. The board disagreed, pointing out that the respondents were unable to file an appeal, not being adversely affected under Art. 107 EPC 1973, their request for revocation having been granted. Moreover, as the patent had been revoked, it was not possible for the appellant to have an even worse outcome. It was thus open to the respondents to re-argue matters which had already been at issue before the opposition division. See also **T 1341/04**, where the board further noted

that the situation arising from a decision to revoke a patent was legally different from the one in which the patent had been maintained by the opposition division in amended form, where the decision could be appealed by both patentee and opponent. It was this situation which led to the conclusion in **G 9/92** and **G 4/93** that the patent proprietor is primarily restricted during the appeal proceedings to defending the patent in the form in which it was maintained by the opposition division, in a case where the opponent is the sole appellant.

3.1.7 Exceptions to the prohibition of reformatio in peius

a) Limited exceptions to the prohibition of reformatio in peius – G 1/99

Limited exceptions to the rule against reformatio in peius exist. In **G 1/99** (OJ 2001, 381) the Enlarged Board answered the question referred to it in **T 315/97** (OJ 1999, 554), namely, "Must an amended claim which would put the opponent and sole appellant in a worse situation than if he had not appealed – e.g. by deleting a limiting feature of the claim – be rejected?".

The Enlarged Board held that **in principle** such a claim must be rejected. However, an exception to this principle might be made where the opposition division had allowed an inadmissible amendment. In the case at issue the opposition division had done just that with the agreement of the proprietor, who was thus not adversely affected by the decision and unable to appeal. The patent proprietor (respondent) had filed during the appeal proceedings a main request including the added (and unallowable) limiting feature, and an auxiliary request deleting it (and thus widening the claim). The Enlarged Board found that the main request had to be rejected because it did not meet the requirements of the EPC. Moreover, if the principle of reformatio in peius were to be applied without considering the specific circumstances of the case, the auxiliary request would also have to be rejected because it would put the opponent (appellant) in a worse situation than if it had not appealed. The only possible course the board could then take would be to revoke the patent, there being no further remedy for the proprietor. The proprietor would thus definitively lose any protection as a direct consequence of an inadmissible amendment being held allowable by the opposition division. The Enlarged Board considered it inequitable for the patent proprietor not to be given a fair opportunity to mitigate the consequences of errors of judgment made by the opposition division. The patent proprietor should thus be allowed to file requests in order to overcome this deficiency, as follows:

- in the first place, for an amendment introducing one or more originally disclosed features which limited the scope of the patent as amended;

- if such a limitation was not possible, for an amendment introducing one or more originally disclosed features which extended the scope of the patent as maintained, but within the limits of Art. 123(3) EPC 1973;

- finally, if such amendments were not possible, for deletion of the inadmissible amendment, but within the limits of Art. 123(3) EPC 1973, even if, as a result, the situation of the opponent was made worse.

See **T 594/97**, **T 994/97**, **T 590/98**, **T 76/99** and **T 724/99** for application of the principles enunciated in **G 1/99**.

b) Case law around G 1/99

According to **T 809/99** a non-appealing patent proprietor is primarily restricted on appeal to defending the claims as maintained by the opposition division. If these claims are not allowable, the principle of prohibition of reformatio in peius applies, i.e. an amended claim which would put the opponent and sole appellant in a worse situation than if it had not appealed must be rejected. The board went on to say that the only exception to this principle as set out in **G 1/99** requires consideration of a particular sequence of possibilities for overcoming the deficiency presented by the claim(s). The first solution for overcoming the deficiency to be considered (an amendment introducing one or more originally disclosed limiting features which would not put the opponent (appellant) in a worse situation than it was in before it appealed) in fact concerns a limitation of the scope of the claim. Such limitation can also be achieved by deleting the alternative embodiment in the claim, which led to the deficiency. The proprietor's argument that the limitation to only one of the two alternatives would render the scope of protection too narrow for it to be commercially interesting is not a valid reason for dismissing this solution and proceeding to the next possible solution indicated in **G 1/99**.

The respondent (patent proprietor) in **T 1194/06** conceded that a limitation according to the first route mentioned in the decision **G 1/99** (OJ 2001,381) was possible but argued that this would result in a substantial restriction of the scope of the claims. The board was aware of the fact that the respondent would lose part of the protection afforded by the patent as maintained by the opposition division. It was, however, clear from **G 1/99** that the principle of reformatio in peius had to be respected by the boards of appeal and that an exception to this principle should be construed narrowly. There was no reason to assume that the Enlarged Board in **G 1/99** considered even a substantial limitation of the scope of protection unacceptable.

The board in **T 1033/08** made it clear that **G 1/99** did not supersede **G 9/92** and **G 4/93**, but was complementary thereto in that it gave directions for allowing an exception to the principle of prohibition of reformatio in peius as defined in these decisions. Certain conditions had to be fulfilled. A limiting feature introduced during the opposition procedure had to be deleted. The necessity for its deletion had to be caused by the appeal. This meant that the deletion was necessary and appropriate because it was related to a ground of opposition and caused by new facts, evidence or arguments put forward by the appellant, or because of a different evaluation of the situation by the board of appeal. Without the deletion, the patent would have to be revoked. It was not possible to overcome the objection by introducing new features which limit the scope of the patent as maintained. Only if these preconditions were fulfilled, might an objection be overcome by introducing new features which extended the scope of the patent as maintained, but within the limits of Art. 123(3) EPC according to the second option of **G 1/99**.

In **T 2129/14** the inadmissible amendment concerned four elements of the claimed system and some relationships between them. Compared with claim 1 of the request found

allowable by the opposition division, in claim 1 of the second auxiliary request three features were deleted. As a result, the protection was extended compared to the request on the basis of which the patent would have been maintained if the opponent and sole appellant had not appealed. Under such circumstances the opponent and sole appellant was in a worse situation than if it had not appealed. The Enlarged Board laid down the conditions under which the exception may be made. The board noted that the three conditions laid down by **G 1/99** are sequential. Further, the board noted that in claim 1 of the second auxiliary request features had been added which also involved some relationships between the four elements of the system. In the board's opinion, each of the requirements lost by deleting the inadmissible amendment had to be considered together with the added features, in the light of the conditions established in **G 1/99**. The board came to the conclusion that the amendments fell within the conditions for an allowable exception under **G 1/99**, allowing the deletion of the former inadmissible amendments, and were therefore allowable.

In **T 957/22**, after having withdrawn its own appeal, the patent proprietor in its respondent's role was limited to defending the patent in the form held allowable by the opposition division, or in a more restricted form. It sought to introduce auxiliary requests which looked as though they were merely part of the proprietor's defence against the opponent's appeal; in reality, they introduced broader claim language which the opposition division had rejected ("containing" instead of "consisting of"). The board held that these requests were not to be admitted: the patent proprietor could not rely on the exception to the prohibition of reformation in peius according formulated in **G 1/99**, because **the patent proprietor had deliberately withdrawn its appeal and thus waived the possibility of defending its patent in a broader version** than that upheld by the opposition division. It had done so despite being aware that the board had endorsed in its preliminary opinion the objection under Art. 123(2) EPC against the first auxiliary request. In this situation, for reasons of equity there was no justification to grant the proprietor back the benefit of the exception to the prohibition of reformatio in peius. The patent proprietor had waived an existing right in full knowledge of the legal situation.

c) Remittal to the department of first instance

According to **T 1843/09** (OJ 2013, 502) the prohibition of reformatio in peius as far as it entails a procedural limitation of the proprietor's liberty to change by way of amendments the scope of protection sought prevails "in principle" (**G 4/93**, OJ 1994, 875) until the final settlement of the opposition case and, therefore, also in any proceedings, including further appeal proceedings, subsequent to a remittal under Art. 111 EPC. The board went on to say that it is clear from **G 1/99** that exceptions to the principle of the prohibition of reformatio in peius are a matter of equity in order to protect the non-appealing proprietor against procedural discrimination in circumstances where that prohibition would impair the legitimate defence of its patent. Therefore, exceptions are not limited to the situation specifically dealt with in **G 1/99**. Rather, the equity approach as taken by the Enlarged Board covers, beyond an error of judgment by the opposition division, any change of the factual and/or legal basis on which limitations have been made by the proprietor prior to the appeal by the opponent as the sole appellant, provided the proprietor would be

prevented by the prohibition on reformatio in peius from adequately defending its patent against new facts and objections introduced into the proceedings at the appeal stage.

In **T 24/13**, the appellant had asserted that a remittal under Art. 111 EPC would also put it at a disadvantage as the proprietor might possibly be granted a broader patent. The board disagreed because the prohibition on reformatio en peius applied equally in opposition proceedings resumed after such remittal (see **T 1843/09**, OJ 2013, 508; **T 1033/08**).

d) Lack of clarity

The three options given in **G 1/99** were set out with regard to the requirement of Art. 123(2) EPC. According to **T 648/15** these options could be applied in a similar way when dealing with the requirement of Art. 84 EPC (see also **T 1380/04**). The board further noted, that the three options given in **G 1/99** do not apply independently of one another and cannot be chosen ad libitum. Indeed, they are set out in such a way so as to indicate a particular sequence of options for overcoming the deficiency presented by a claim.

In **T 974/10** the board emphasised that the Enlarged Board had stated in **G 1/99** that, "... if the patent cannot be maintained **for reasons which were not raised at the first instance**, the non-appealing proprietor deserves protection for reasons of equity". As, in the case at issue, the clarity objection was raised by the board for the first time in the appeal, the respondent had to be allowed to file amendments as foreseen in decision **G 1/99**, which decision gave due regard to the principle of equity.

In **T 1845/16**, the board concluded that making an exception to the prohibition of reformatio in peius in line with **G 1/99** was warranted. The Enlarged Board had held there that such an exception to the otherwise binding principle of the prohibition of reformatio in peius could be allowed for reasons of equity but was to be construed narrowly, stipulating that an impermissible feature could be deleted only if there was no other option for amendment that was less detrimental to the opponent. In the case in hand, the board could not identify any such option, nor had the appellant argued anything to that effect. Consequently, there was justification for making an exception to the prohibition of reformatio in peius and permitting the patent proprietor to overcome the lack of clarity in its main request by making the amendments to claim 1 requested in its auxiliary request 1.

e) Causal link

In **T 61/10** the board pointed out that the existence of a causal link between the limiting feature to be deleted and the new situation arising on appeal was a necessary precondition for justifying an exception to the principle of prohibition of reformatio in peius for reasons of equity. In **G 1/99**, **T 1843/09** and **T 1979/11** this condition was fulfilled. However, in the case before the board, the precondition was not fulfilled, so a departure from the principle of prohibition of reformatio in peius based on analogies with the cases cited was not justified.

f) Undisclosed disclaimer

In **T 2277/18**, the respondent (patent proprietor) requested that the patent be maintained as granted or, alternatively, in the version as amended by the opposition division. Compared with the version as granted, independent claim 1 contained a disclaimer that had not been disclosed in the version as originally filed. As per **G 1/03** (OJ 2004, 413), a disclaimer should not remove more than is necessary to restore novelty. However, the board held that the disclaimer in the maintained version of the contested patent had removed more than was necessary. On the prohibition of reformatio in peius, the board stated that the requirements laid down in **G 1/99** for an admissible exception to the prohibition of reformatio in peius also applied when the inadmissible amendment was an undisclosed disclaimer. The question in this case was whether, in line with the first option from **G 1/99**, adding originally disclosed features that limited the scope of the patent as maintained could overcome the established deficiency. The board found that it could, since the application as originally filed disclosed a particular implant made of a specific Mg-Zn-Ca alloy. Adding the features from this example would further limit the scope of the patent compared with the version as maintained while simultaneously making the excessively broad and so inadmissible disclaimer superfluous and thereby overcoming the deficiency it had created.

3.1.8 Reformatio in peius and lack of cross-appeal in the EPC

According to an obiter dictum in **T 239/96**, the board took the view that, in the absence of a provision on cross-appeal (in German "Anschlussbeschwerde"), reformatio in peius could not be ruled out altogether under the EPC, as it might serve as a means of avoiding unnecessary litigation, while still satisfying the legitimate expectations of the parties for a fair hearing. The board found that this deficiency in the EPC (i.e. the lack of a cross-appeal) was of prime importance when considering the respondent's procedural position and the issue of reformatio in peius.

3.2. Subject-matter under examination

3.2.1 Primary object of the appeal proceedings – Article 12(2) RPBA

As set out in Art. 12(2) RPBA, since the primary object of the appeal proceedings is to review the decision under appeal in a judicial manner, a party's appeal case shall be directed to the requests, facts, objections, arguments and evidence on which the decision under appeal was based. In the explanatory remarks to Art. 12(2) RPBA (Supplementary publication 2, OJ 2020) it is stated that this paragraph provides a general definition of the nature and scope of the appeal proceedings in accordance with the established case law. The boards of appeal constitute the first and final judicial instance in the procedures before the EPO. In this capacity, they review appealed decisions on points of law and fact.

In **T 1604/16** the board referred to the explanatory remarks to Art. 12(2) RPBA that the boards have competence to review appealed decisions in full, including points of law and fact. This was in accordance with Art. 6 ECHR, which stipulates that there must be at least one judicial instance that can review a case in full, i.e. the law and the facts, given that the

boards of appeal are the only judicial body to review decisions by the departments of first instance of the EPO. The board was well aware that there is case law on a restriction of the boards' competence when reviewing discretionary decisions taken by the departments of first instance in certain circumstances (**G 7/93**, OJ 1994, 775, and case law based on this decision). However, it did not consider the evaluation of evidence to be a discretionary decision. See also chapter V.A.3.4 "Review of first-instance discretionary decisions" below.

3.2.2 Complete case on appeal

Under Art. 12(3) RPBA (cf. Art. 12(2) RPBA 2007), the statement of grounds of appeal and the reply must contain a party's complete appeal case. Accordingly, they must set out clearly and concisely the reasons why it is requested that the decision under appeal be reversed, amended or upheld, and should specify expressly all the requests, facts, objections, arguments and evidence relied on.

The board has a discretion not to admit any submission by a party that does not meet the requirements of Art. 12(3) RPBA, see Art. 12(5) RPBA. For further detail on this, see chapter V.A.4.3.5 "Incomplete case in grounds of appeal or reply – substantiation requirement – Article 12(3) and (5) RPBA".

In **T 2457/16**, the patent proprietor submitted a large number of auxiliary requests with the statement of grounds of appeal. The board found that the patent proprietor had not explained the amendments made in these auxiliary requests or their purpose, leaving the board and the opponent unsure as to the order in which the auxiliary requests were to be examined, precisely what amendments had been made in the requests and the reasons why they had been made. That was contrary to the requirement under Art. 12(3) RPBA that parties must submit their complete case in the statement of grounds of appeal; the patent proprietor had thereby shifted to the opponent and the board the responsibility – properly incumbent on it – to select from the numerous requests one that might ultimately be allowable (see also **R 11/08**).

In **T 412/18**, the board indicated that an appeal case in which the substantiation for a particular objection had to be pieced together from parts of the rest of the case that, when read on their own, had no readily discernible link with the issue addressed in the objection was not a complete case within the meaning of Art. 12(3) RPBA. This approach ran counter to the purpose of that provision, namely that the parties had to present a complete case at the start of the proceedings in order to provide the board (and the other parties) with an appeal file that contained every party's complete case and to prevent any tactical procedural abuse (see also **T 1488/08**, referring to the then applicable Art. 12(2) RPBA 2007). Consequently, the board did not take the inventive-step objection into consideration.

In **T 706/17**, the board held that a sweeping reference to the opposition case was insufficient for establishing why the contested decision should be reversed. Under Art. 108 EPC, R. 99(2) EPC and Art. 12(3) RPBA or Art. 12(2) RPBA 2007, the appellant (opponent) had to present a complete case in its statement of grounds of appeal that

allowed the board and the other parties to understand why the contested decision should be reversed without having to make any further investigations of their own. The appellant's inventive-step objections were therefore disregarded on appeal pursuant to Art. 12(4) RPBA 2007.

In **R 8/16** the Enlarged Board rejected the argument that the board should have known, and therefore should have considered, the petitioner's arguments from the file as presented before the opposition division. The board had no obligation to peruse the whole file of the first-instance proceedings. It is the duty of the parties to raise issues again in the appeal proceedings, to the extent necessary, as set out in Art. 12(1) and (2) RPBA 2007. In **T 16/14**, the board explained that the words "to the extent necessary" (see **R 8/16**) did not imply that a board had to consider the submissions from the first-instance proceedings. In its view, they meant that any submission not relevant for the issues to be dealt with on appeal did not have to be presented again. It concluded that a mere reference to the case made at first instance did not meet the requirements of Art. 12(2) RPBA 2007. Consequently, the appellant's (opponent's) arguments in relation to documents E1/E1a and E2/E2a were not to be considered in the appeal proceedings pursuant to Art. 12(4) RPBA 2007.

See also chapter V.A.2.6.3h) "Complete case within the meaning of Art. 12(3) RPBA ", in relation to admissibility of the appeal.

3.2.3 Opposition appeal proceedings

a) Admissibility of opposition

The admissibility of the opposition, being an indispensable procedural requirement for any substantive examination of the opposition submissions, must be checked ex officio in every phase, including any ensuing appeal proceedings (**T 240/99**).

b) The notice of appeal

In **T 226/09** the board decided that the request in the notice of appeal for the patent to be maintained on the basis of the first auxiliary request did not limit the subject of the appeal within the meaning of R. 99(1)(c) EPC for the appellant-proprietor and therefore did not rule out a broader request in the statement of grounds.

c) Unopposed subject-matter not reviewed

No part of a patent's subject-matter (e.g. individual claims) not opposed within the nine-month time limit can be reviewed in either opposition or appeal proceedings. The opponent's statement under R. 76(2)(c) EPC (R. 55(c) EPC 1973) establishes the extent to which the patent is contested and thus the formal competence of the opposition division or board of appeal. The only exception to this principle concerns an opposition explicitly directed **only** to the subject-matter of an independent claim. In such a case, subject-matter covered by claims which depend on the independent claim can also be examined as to patentability (see e.g. **G 9/91**, OJ 1993, 408; see also **T 323/94**).

According to **T 896/90**, detailed grounds for opposition for a single granted independent claim do not mean that only that part of the patent is being contested, if the opponent has indicated that he wants the whole patent revoked. However, in **T 737/92** (in which only arguments against process claims and not against composition claims were submitted) the board found that an opposition was filed only to the extent that it was substantiated (see also **T 318/01**).

Where two opponents lodge appeals contesting different sets of claims and one subsequently withdraws its appeal, it becomes a party as of right under Art. 107 EPC 1973 and the other opponent becomes the sole appellant. The scope of the appeal is defined by the latter's request, which the non-appealing party may not exceed and which binds the board (**T 233/93**).

In **T 653/02** it was held that a board has no competence to examine a newly formulated claim derived by combination of granted claim 1 with a sub-claim not being within the extent to which the patent had been opposed; this did not fall within the exception allowed by **G 9/91** (OJ 1993, 408). In **T 646/02** the board found that the case at issue differed from the facts before the board in **T 653/02**, in that the subject-matter not opposed was described in the patent and was part of the independent claim as granted but was not itself the subject-matter of a dependent claim of the patent as granted. Whether or not the board had competence to examine depended, however, only on whether the patent was clearly restricted to a subject-matter not covered by the notice of opposition. This was done in **T 646/02** by restriction to the subject-matter of the **deliberately excluded dependent claim** and, in the case at issue, by restriction to **deliberately excluded variants** of the invention. The board held that the exception in **G 9/91** was not therefore applicable in the case before it either, since it was applicable only to subject-matter implicitly covered by the notice of opposition and not to those explicitly excluded.

In **T 364/18** the appellant (opponent) expressly requested in the notice of opposition revocation of claims 1-5, 8, 9, 11, 15-17, 19 and 20. This request was repeated on appeal. The board saw in the above an express statement that the patent was opposed and the decision was appealed only in as far as the claims mentioned were concerned, which thus defined, respectively, the extent of opposition according to R. 76(2)(c) EPC, and the extent to which decision was to be amended according to R. 99(2) EPC. In accordance with the principle of ne ultra petita the board saw itself limited to examining the patent only for the claims opposed. The auxiliary request, however, was directed to the subject-matter of unopposed granted claims 6, 7, 10, 12 to 14 and 18, in the form of independent claims 1 to 7 which combined the features of respective ones of these claims with granted claim 1. As the auxiliary request was directed to those unopposed subject-matters, and the board had no power to examine such subject-matter, the patent was to be maintained in this limited form.

d) Dependent claims

In line with **G 9/91**, a patent proprietor could, in appeal proceedings, amend an uncontested **dependent** claim in accordance with R. 57a EPC 1973 (**T 711/04**).

In **T 2094/12** granted claim 5, which was dependent on granted claim 1, was not opposed. Claim 1 as upheld by the opposition division combined granted claim 1 with the (non-optional) subject-matter of granted claim 5. The subject-matter of claim 1 of the main request was therefore based on "dependent subject matters" as referred to in **G 9/91**. According to this point: "...even if the opposition is explicitly directed only to the subject-matter of an independent claim of a European patent, subject-matters covered by claims which are depending on such an independent claim may also be examined as to patentability, if the independent claim falls in opposition or appeal proceedings, provided their validity is prima facie in doubt on the basis of already available information (cf. **T 293/88**, OJ 1992, 220). Such dependent subject-matters have to be considered as being implicitly covered by the statement under R. 55(c) EPC 1973 (now R. 76(2)(c) EPC)....". Thus in the case in hand because the opposition notice was explicitly directed to granted claim 1, it was implicitly also directed to the subject-matter of granted claim 5, now claim 1 of the main request. The opposition division was thus also competent to in considering prima facie validity of the patent.

e) Appeal by patentee against revocation

Where the patentee appeals the revocation of the patent, the board is not bound by the findings of the opposition division; the whole case, including those claims considered novel by the opposition division, and objected to by the non-appealing opponent, must be considered (**T 396/89**). Furthermore, if the patent proprietor as the sole appellant in the opposition appeal proceedings makes amendments to the version of the patent adopted in accordance with an interlocutory decision of the opposition division, the board is both competent and obliged ex officio to examine those amendments from both a formal and a substantive point of view, even if the respondents expressly agree to them (**T 1098/01**). Similarly, where the patent proprietor was respondent on appeal against the decision of the opposition division as a whole, it was the board's power and duty to decide for itself on each issue addressed and it was not bound by any finding of that decision (in the respondent's favour) (**T 36/02**).

f) Removal of references in dependent claims

Claims which remain unchanged after the removal of the references in dependent claims need not be examined in opposition appeal proceedings to see if they contain grounds for opposition raised for the first time in those proceedings, unless the patentee consents (**T 968/92**).

g) Abandonment of subject-matter

Established case law of the boards of appeal has it that previous limitations of the claims cannot be treated as an express abandonment of parts of the patent but are to be regarded merely as attempts to come up with a wording delimiting the patent in such a way as to overcome objections. The patent proprietor is free at any time to revert to broader claims or to the version as granted, provided this does not amount to an abuse of procedural law (**T 43/16**; see **T 123/85**, OJ 1989, 336; **T 296/87**, OJ 1990, 195; **T 900/94**; **T 1018/02**;

T 934/02; **T 699/00**; **T 794/02**). Nonetheless, the admissibility of any such request on appeal is subject to the provisions of Art. 12(4) RPBA (see **T 28/10**, **T 1135/15**).

According to **T 123/85** (OJ 1989, 336), the EPC makes no provision for patentees to surrender their patents during opposition proceedings (referring to **T 73/84**, OJ 1985, 241; **T 186/84**, OJ 1986, 79) nor surrender part of the patent so as to limit it. Thus a request withdrawn during opposition proceedings may nonetheless be considered in any ensuing opposition appeal proceedings.

In **T 1018/02**, it was stated that amendments of a European patent had to comply with R. 57a EPC 1973 (R. 80 EPC). According to this rule, amendments were possible provided that they were occasioned by grounds for opposition. However, this did not mean that, if a patent proprietor in the first instance chose to defend a main request which was limited in scope compared with the claims as granted, then he could not during the appeal proceedings go beyond the limits of that request. In accordance with **T 407/02**, a patent proprietor who had only defended his patent in limited form before an opposition division, was in principle allowed on appeal to return to a broader version or even to the patent as granted. Following **T 407/02**, the board in **T 1188/09** pointed out that opponents must therefore always be prepared for the possibility that a patent proprietor whose patent has been revoked by the opposition division will seek its restoration as granted on appeal. According to the board in **T 1188/09**, **T 1018/02** expressly followed this approach, which was again upheld in **T 386/04**, where it was explained that supposedly contrary decisions had always been concerned with circumstances in which the amendment to the claim amounted to an abuse of the procedure.

According to **T 386/04**, an appellant (proprietor), whose patent has been revoked, is entitled to seek maintenance of the patent as granted even though its main request before the opposition division had only been the maintenance of the patent in more limited form. The exception to this is where to allow the proprietor to revert to the amended claims would amount to an abuse of procedure. According to the board, this long-standing principle is not contradicted by decisions **T 528/93** or **T 840/93** (OJ 1996, 335), which are concerned with new claims raising new issues, and is not contrary to the statement by the Enlarged Board in decision **G 9/91** (OJ 1993, 408), concerning the purpose of an appeal. In **T 727/15** the board referring to **T 386/04** admitted the main request into the proceedings (reversion to claims as granted after maintenance in more restricted form). In the case in hand such reversion did not constitute an abuse of procedure.

The board in **T 28/10** extensively discussed **T 123/85** (OJ 1989, 336) and the case law based on it (including **T 386/04**) holding that it did not follow from this case law that a patent proprietor must be able to revert to a broader version of the claims which it had not initially defended in the opposition proceedings, and thereby amend its case, without being subject to any procedural restrictions. In the case at issue, the patentee had sought to introduce into the appeal proceedings claims which had not been the basis of discussion before the opposition division. The board found that the legal situation had changed since **T 123/85** and Art. 12(4) RPBA 2007 was now the relevant legal provision rather than case law based on that decision.

In **T 2558/16**, the board held that just because a patent proprietor had dropped its request for rejection of the opposition, or replaced it with other requests, in the first-instance proceedings did not mean that it could not go back on appeal to defending the version of the patent as granted. That being said, the patent proprietor was not entitled to do so unconditionally; it had to be requested and it was at the board's discretion to grant such a request. In exercising its discretion under Art. 12(4) RPBA 2007, the board had to consider the circumstances of the individual case before it (which, in the case in hand, meant especially the events in the opposition proceedings).

h) Fresh ground for opposition on appeal

Grounds for opposition submitted for the first time on appeal may be considered only with the patent proprietor's consent. If the patentee has not consented to a fresh ground's introduction into the proceedings, the board's decision must not deal with it in substance at all and may mention only that it has been raised (see **G 10/91** and **G 9/91**, OJ 1993, 420; **G 1/95**, OJ 1996, 615). In **G 7/95** (OJ 1996, 626) the Enlarged Board held that lack of novelty and lack of inventive step, albeit both falling under Art. 100(a) EPC, were different legal grounds for opposition.

On the introduction of fresh grounds for opposition into opposition proceedings, see chapter IV.C.3.4.

In **T 1571/12** the patent proprietor consented at the oral proceedings before the board to the introduction of a fresh ground for opposition, namely that the invention could not be carried out (Art. 100(b) EPC). The board remitted the case to the department of first instance for an answer to the highly relevant question of whether the claimed subject-matter was sufficiently disclosed for it to be carried out.

In **T 350/13** the opponent's argument, that the proprietor had implicitly given its approval with respect to Art. 100(c) EPC by arguing in response to the opponent's objections, was not persuasive in admitting this ground for opposition. Irrespective of the patent proprietor at some time responding substantively to the new ground, this could not be interpreted as an implicit or binding indication that it approved the introduction of this ground into the appeal proceedings.

An appeal unconnected with the reasons given in the appealed decision (lack of inventive step) and directed only to a new ground for opposition (lack of novelty) based on a new document is contrary to the principles laid down in decisions **G 9/91** and **G 10/91** (OJ 1993, 408 and 420), according to which an appeal should be within the same legal and factual framework as the opposition proceedings. It is tantamount to a new opposition and is thus inadmissible (**T 1007/95**, OJ 1999, 733).

In **T 27/13** the board held that the objection under Art. 83 EPC in the statement of grounds constituted a fresh ground for opposition under Art. 100(b) EPC that was outside the legal framework of the opposition proceedings. The board pointed out that it could find the present appeal admissible only if the same ground for opposition was raised when the

appeal was filed. Only then could there be any discussion of the possibility of introducing a fresh, additional ground for opposition. Hence the appeal was inadmissible.

In **T 1029/14** the first time that the appellant argued that the subject-matter of claim 1 lacked an inventive step was during appeal proceedings, two working days before the oral proceedings. This objection was not admitted into the proceedings pursuant to Art. 13(3) RPBA 2007. The board further questioned whether the line of attack starting from D1 as the closest prior art could be discussed at all in the appeal proceedings without the agreement of the patent proprietor. The appellant argued that the objection concerning inventive step starting from D1 did not constitute a fresh ground of opposition and could be examined in appeal proceedings without the agreement of the patentee, since D1 had been used to attack novelty. The board referred to the similar case **T 448/03** in which inventive step was not discussed at all in the opposition proceedings, but for the first time in the appeal proceedings. In **T 448/03** it was concluded that an objection concerning inventive step was to be considered a fresh ground if it was raised for the very first time in the appeal proceedings, irrespective of the fact that the document used as the starting point for the inventive step objection was the same document as used before to attack novelty. In **T 77/18**, the opponent had raised the ground for opposition under Art. 100(c) EPC for the first time during the oral proceedings before the opposition division. Neither the minutes of the oral proceedings nor the decision under appeal indicated that the opposition division had at any later stage decided to admit the new ground for opposition. The board considered that in the absence of a positive decision on admittance by the opposition division, the ground for opposition under Art. 100(c) EPC was to be treated as a fresh ground at the appeal stage and its admittance governed by the principles set forth in **G 10/91**.

In **T 184/17** the board held that even when the ground of inventive step was neither raised and substantiated in the notice of opposition nor discussed during opposition proceedings, an objection of lack of inventive step could exceptionally be examined in the appeal proceedings without the agreement of the patent proprietor, if it stayed within the same factual and evidentiary framework of a novelty objection properly raised and substantiated in the notice of opposition. This does not mean that the ground of lack of inventive step starting from the same prior art is always implicit in a properly substantiated allegation of lack of novelty. It rather applies exclusively to a case such as the case in hand, where, after having validly raised lack of novelty in opposition on the basis of a given document and passages cited therein, the ground of lack of inventive step is subsequently invoked on appeal based only on that document and the same passages, and where therefore the factual and evidentiary framework is substantially the same.

i) No general review of the first-instance decision

In **T 1799/08** the board stated that it is not the function of the boards of appeal to carry out a general review of decisions at first instance, regardless of whether such a review has been sought by the parties. In view of the character of the inter partes appeal proceedings, it could not be expected that the board, independently of its preliminary opinion on some of the critical issues for deciding on a ground not properly substantiated by the opponent which had initially raised it, would fully investigate that ground, in breach of the principle of

equal treatment of the parties, and provide its own reasoning, substituting itself for an opponent which remained passive. The board thus accepted, in the absence of any evidence to the contrary, the patent proprietors' arguments.

j) Ambiguities in the claims

Reviewing and eliminating any ambiguities in the claims and description which are not necessary to refute substantiated grounds of opposition is not part of the review of the contested decision carried out during opposition appeal proceedings. In the event of ambiguities in the claims which are not connected to changes in the granted documents, Art. 69 EPC 1973 stipulates that the description and drawings must be used to interpret the claims, not that the claims must be changed (**T 481/95**).

k) Ex officio examination of Art. 123(2) EPC

In **T 996/18**, the board held that claims which the patent proprietor had amended by adding features from the description but which had not been examined in the opposition proceedings should be examined ex officio on appeal for compliance with Art. 123(2) EPC (Art. 114(1) EPC, R. 100(1) EPC). Otherwise, subject-matter might ultimately be allowed that had been determined solely by the parties, without ever having been examined by the EPO. In this case, the board had raised the objections under Art. 123(2) EPC for the first time during the oral proceedings. To uphold the right to be heard (Art. 113(1) EPC) and the principle of equality of arms, the appellant was given the opportunity to comment on the objections and to overcome them by filing a new auxiliary request.

3.2.4 Patentability requirements under examination in ex parte proceedings

In **G 10/93** (OJ 1995, 172) the Enlarged Board ruled that, where the examining division had refused an application, the board had the power to examine whether the application or the invention to which it related met the requirements of the EPC 1973. This also held good for requirements the division had not considered in the examination proceedings or had regarded as fulfilled. The board should then, where appropriate, decide either to rule on the case itself or send it back to the examining division.

This followed from the fact that ex parte review was not of a contentious nature. It involved examination of the patentability requirements in proceedings in which only one party (patent applicant) was involved. The departments involved at every instance had to ensure that these requirements were fulfilled. In ex parte proceedings, therefore, the boards of appeal were not restricted either to examination of the grounds for the contested decision or to the facts and evidence on which that decision was based, and could include new grounds even though in ex parte cases too the main aim of appeal proceedings was to review the contested decision.

This decision was based on case **T 933/92**, in which an examining division had refused an application for non-compliance with Art. 123(2) EPC 1973. Whilst sharing the examining division's view with respect to Art. 123(2) EPC 1973, the board felt the application should

be refused for lack of inventive step. In the board's view, the question whether grounds could be added or replaced was not resolved by **G 9/91** and **G 10/91**.

If an application for which no search had been carried out in accordance with R. 45 EPC 1973 (R. 63 EPC), inter alia for lack of clarity of the claims, had been refused for the same reason, a board of appeal need only examine whether the claims failed to comply with the clarity requirement of Art. 84 EPC 1973 to such an extent that it was not possible to carry out a meaningful search. Having found that the claims fulfilled the requirements of the EPC to such an extent that it should have been possible to carry out a search, the board in **T 1873/06** remitted the application to the examining division for an additional search to be performed and the substantive examination to be continued.

In **T 1367/09**, when preparing the communication pursuant to Art. 15(1) RPBA 2007 the board did not raise the issue of Art. 84 EPC 1973. Nevertheless, when reconsidering the case in preparation for the oral proceedings the board noted that Art. 84 EPC 1973 should indeed be addressed in the oral proceedings. The board noted that in the light of **G 10/93** (OJ 1995, 172) the board had the power, in ex parte appeal proceedings, to enforce any grounds for refusal of an application, in particular grounds which the examining division did not consider at all or held to be satisfied.

The extent of the obligation to review a case where the appeal is partially withdrawn is discussed in chapter V.A.7.3.3 "Partial withdrawal of appeal by sole appellant and opponent".

3.3. Facts under examination – applying Article 114 EPC in appeal proceedings

Art. 114(1) EPC, which also applies in appeal proceedings, requires the board to establish the facts of its own motion. See **J 4/85**, OJ 1986, 205; **T 1800/07**; **T 1574/11**. The obligation of ex officio examination as laid down in Art. 114(1) EPC is explicitly limited in particular by Art. 114(2) EPC, i.e. the possibility of disregarding facts and evidence not submitted in due time, which is further specified by Art. 12 and 13 RPBA. Although Art. 114(1) EPC formally also covers the appeal procedure, this provision generally applies in a more restrictive manner in inter partes appeal proceedings than in opposition proceedings (see **G 9/91**, OJ 1993, 408 and **G 10/91**, OJ 1993, 420). In **T 1370/15** the board noted that this meant that a board was not excluded outright from introducing new facts and evidence in inter partes proceedings. The explanatory remarks on Art. 13(1) RPBA state: "Where the Board raises an issue of its own motion under Art. 114(1) EPC, the party's right to be heard under Art. 113(1) EPC must be respected." The board stated that this sentence made it clear that, under the RPBA, a board is not prohibited from raising issues of its own motion.

As the Enlarged Board made clear in **G 8/93** (OJ 1994, 887), the board's obligation under Art. 114(1) EPC 1973 existed only once proceedings were pending (see also **T 690/98**). Earlier, **T 328/87** (OJ 1992, 701) had already ruled that the facts could be investigated only if the appeal was admissible. There were, however, limits to this obligation, for example under Art. 114(2) EPC 1973, where facts and evidence are submitted late. The same applied if an opponent (respondent) withdraws his opposition: in **T 34/94** the board

found that, "if in the event of withdrawal of the opposition the opponent is the respondent, the board may take into account evidence which was submitted by the opponent prior to withdrawal of the opposition. However, for reasons of procedural economy, the duty of the EPO to examine the facts of its own motion does not extend to its having to examine the submission of the opponent that a previous oral disclosure took place if the crucial facts were difficult to ascertain without his co-operation" (this confirmed the case law in **T 129/88**, OJ 1993, 598; **T 830/90**, OJ 1994, 713; **T 887/90**, **T 420/91** and **T 634/91**; see also **T 252/93** and **T 1047/03**).

In **T 1574/11** the board observed that it was not restricted to the facts, evidence or arguments provided by the parties. As the primary purpose of the appeal procedure was to check that the contested decision was correct, the board was in principle entitled to consider the evidence provided therein if it deemed it to be relevant to its own decision.

T 182/89 (OJ 1991, 391) sets out what the obligation to investigate involves; Art. 114(1) EPC 1973 should not be interpreted as requiring the opposition division or board of appeal to ascertain whether there was support for grounds for opposition not properly substantiated by an opponent, but as enabling the EPO to investigate fully the grounds for opposition which were both alleged and properly substantiated pursuant to R. 55(c) EPC 1973 (see also **T 441/91** and **T 327/92**).

The board in **T 2501/11** stated in its Catchword: where prior publication of a citation has been admissibly disputed and the party bearing the burden of making the case for and proving it fails to provide a substantiated response, the board cannot treat that citation as prior art because opposition appeal proceedings are adversarial and so conducted in accordance with the adversary system of procedure, in which it is for the parties to make their cases and the boards' power to examine the facts of their own motion (Art. 114(1) EPC) is limited.

In **T 862/16** the board raised, ex officio, a further objection under Art. 76(1) EPC. The appellant objected to the board's raising new issues in the appeal proceedings, arguing that new Art. 12(2) RPBA establishes the character of the appeal proceedings as a judicial review in which the parties have only very limited room for amending their case with respect to the first-instance proceedings. The board therefore should be similarly constrained from introducing new objections of its own motion. The board stated that Art. 12(2) RPBA framed the "primary object of the appeal proceedings [as being] to review the decision under appeal in a judicial manner", but mainly concerned, if at all, obligations on the parties and not the board. The board saw here no provision, or any other provision of the RPBA, which could and would restrict its power conferred by Art. 111(1) and 114(1) EPC to raise new objections of its own motion. This would, moreover, be incompatible with the spirit and purpose of the Convention (Art. 23 RPBA). Thus, provisions of the RPBA as secondary legislation according to Art. 23(4) EPC and R. 12c EPC could never take precedence over the provisions of the EPC itself. The board noted in passing that in ex parte appeal proceedings any new ground, i.e. one not examined by the first-instance department, could be invoked by a board of appeal under Art. 114(1) EPC during the appeal proceedings (cf. **G 10/93**, OJ 1995, 172). That the

board might raise new objections, such as even a new inventive-step objection, had furthermore been confirmed by the Enlarged Board (see e.g. **R 16/13**). See also **T 174/21**.

In **T 1370/15** the board stated in its Catchword that not only in ex parte, but also in inter partes appeal proceedings, a board is allowed to introduce new ex officio common general knowledge without evidence of such knowledge which prejudices maintenance of the patent, to the extent that the board is knowledgeable in the respective technical field from the experience of its members working on cases in this field.

In **T 1138/20**, the board recalled that the boards of appeal constitute the first and final judicial instance and thus the only judicial body to establish both facts and law in proceedings before the EPO. As such, the boards have the power, at any stage of the appeal proceedings, to establish the relevant facts of the case before them and thereby substitute the findings of fact of the departments of first instance. However, the boards have no obligation to establish de novo, facts already established by the departments of first instance (see also **T 42/19**). The board underlined that review of a fact-finding process should not be conflated with the review of discretionary decisions within the meaning of **G 7/93**. The review of findings of fact is distinct from the review of discretionary decisions, which can only be reviewed for a particular type of errors (see **G 7/93**, point 2.6 of the Reasons), while a review of findings of fact has no such limitation.

3.4. Review of first-instance discretionary decisions

3.4.1 Principles applying to the review of first-instance discretionary decisions

a) General

In several decisions, the boards have addressed the issue of their scope for reviewing decisions taken by departments of first instance in exercise of their discretion. Among the factors to be considered is whether or not the department of first instance exercised its discretion properly.

The issues associated with exercising discretion are addressed in a number of other chapters in the context of the various individual provisions conferring discretion: see IV.B.2.4.1 on the examining divisions' discretion under R. 137(3) EPC; IV.C.4.5. on the opposition divisions' discretion to admit late-filed submissions; V.A.9.2. on discretion to remit; and V.A.4.3.4 and following on the boards' discretion to admit late-filed submissions.

b) Proper exercise of discretion

On appeal against a decision taken by a department of first instance in exercise of its discretion, it is not for the board to review all the facts and circumstances of the case as if it were in that department's place and decide whether or not it would have exercised discretion in the same way. If the EPC requires that a department of first instance exercise discretion in certain circumstances, that department should have a certain degree of freedom to do so without interference from the boards. They should overrule the way in

which it exercised its discretion in reaching a decision in a particular case only if they conclude that it did so in accordance with the wrong principles, without taking the right principles into account or in an arbitrary or unreasonable way, thereby exceeding the proper limits of its discretion (on this point, see, in particular, **G 7/93**, OJ 1994, 775, and **T 640/91**, OJ 1994, 918, where the board found that the department of first instance had exercised its discretion unreasonably and that this amounted to a substantial procedural violation).

Although **G 7/93** was concerned with a specific situation, namely an examining division's refusal to admit amendments after issuing a communication under R. 51(6) EPC 1973, the boards have applied the criteria established there to their review of other discretionary decisions of the departments of first instance (**T 820/14**, see also **T 858/17**). For instance, the same approach has been taken to reviewing opposition division decisions on the admission of late-filed submissions (**T 1209/05**, **T 1652/08**, **T 902/09**, **T 1253/09**, **T 544/12**, **T 1882/13**, **T 960/15**).

In several decisions, e.g. **T 1614/07**, **T 849/08**, **T 1788/12**, **T 1643/11**, **T 74/14**, **T 89/15**, the boards have cited one or both of **G 7/93** and **T 640/91** when reviewing whether the department of first instance exercised its discretion properly.

In **T 820/14** the board pointed out that so long as departments of first instance had exercised their discretion properly, the boards **as a rule** should not overrule their decisions and substitute their own discretion for that exercised at first instance. That applied regardless of whether not they ultimately decided to admit the previously refused submissions, uphold the refusal to admit them on different grounds or remit the case to the department of first instance and give it an opportunity to exercise its discretion anew. By the same token, however, the case law established in **G 7/93 could not be interpreted as imposing on the boards any duty** to uphold a proper exercise of discretion at first instance.

c) Review of first-instance discretionary decisions taken on substantive grounds

In **T 1816/11**, the sole reason for the examining division's refusal to admit the main request had been that it did not meet the requirements of Art. 84 and 56 EPC. The board held that, in such cases, where the discretionary decision had been taken on substantive rather than procedural grounds, the criteria established in **G 7/93** could not apply (likewise **T 820/14**, **T 556/13** and **T 971/11**). Rather, the substantive assessment (of clarity, inventive step, etc.) underlying the decision was fully open to review, as this went to the very essence of the boards' power of review.

In **T 2342/13**, as to the examining division's reason for not admitting the auxiliary request, namely a prima facie lack of inventive step, the board considered that a question relating directly to the compliance of a request with a provision of substantive patent law was to be assessed by the board itself and that on such a point there was no latitude for deferring to the view of the department of first instance (cf. **T 1816/11**, similar **T 2343/13** and **T 1159/13**).

The board in **T 1820/13** added that, although an opposition division's exercise of discretion could, as a rule, be reviewed only to a limited extent, i.e. only for abuse or errors, that could not mean that any substantive issues underlying its resulting decision were not open to review by the boards (see also **T 307/22**). Such issues went to the very essence of the boards' power of review and so they were called on to use their own discretion under Art. 12(4) RPBA 2007 (see **T 1816/11**). Thus, their review of an exercise of discretion had to include checking any underlying prima facie examination, for example as to whether it was vitiated by manifest errors (see also **T 1332/17**).

In **T 188/16**, the opposition division had not admitted the second auxiliary request into the opposition proceedings because the amended feature did not meet the requirements of Art. 123(2) EPC. The board stated that, in such cases, it was incumbent on the boards for the purposes of applying Art. 12(4) RPBA 2007 to review the substantive assessment on which the opposition division had based its discretionary decision.

In **T 47/14** the issue was whether the opposition division had exercised its discretion improperly as a result of being mistaken as to the citation's technical relevance. The board found that it was certainly open to it to review the substantive basis for an opposition division's exercise of discretionary decision if the resulting decision was manifestly erroneous (see **T 109/08**).

3.4.2 Exercise of the boards' own discretion not to admit submissions

a) Submissions refused at first instance admitted on appeal

In the cases reported here, the boards admitted on appeal facts, evidence and requests refused at first instance, some of them pointing out that they have their own discretion to do so and are generally not bound in this by how the department of first instance exercised its discretion (see, in particular, **T 820/14** and, similarly, **T 2219/10**, **T 1811/13**, **T 795/14**, **T 1817/14**, **T 291/15**, **T 575/15**). For a summary of the development of the case law on this topic under Art. 12(4) RPBA 2007 (the corresponding passages are now in Art. 12(6) RPBA, on which see chapter V.A.4.3.), see CLB, 10th edn. 2022, V.A.3.4.2.

In **T 971/11** the opponent (appellant) filed document B1 two days before the oral proceedings before the opposition division, which did not admit it into the proceedings. The board stated that the opposition division had based its discretionary decision on the principles established by the jurisprudence and had not acted in an unreasonable way. Together with its statement of grounds of appeal, the appellant re-submitted document B1. The board considered whether it had discretion to admit a document which was not admitted in the first-instance proceedings. According to Art. 12(4) RPBA 2007 the non-admission of a document which was not admitted in the first-instance proceedings into the appeal proceedings is at the discretion of the board. The board referred to the established case law, according to which a filing made with the statement of grounds of appeal should not be considered inadmissible if it is an appropriate and immediate reaction to developments in the previous proceedings. The board has to exercise its discretion under Art. 12(4) RPBA 2007 independently, giving due consideration to the appellant's additional submissions. In the judgement of the board, a document which would have been

admitted into appeal proceedings if it had been filed for the first time at the outset of those proceedings should not, however, be held inadmissible for the sole reason that it was already filed before the department of first instance (and not admitted). To impose such a limitation on the discretion conferred by Art. 12(4) RPBA 2007 could even have the undesirable effect of encouraging a party to hold back a document during the opposition proceedings, only to present it at the appeal stage. The board admitted the document (see also **T 876/05**, **T 1403/13**, **T 1768/17**, **T 1964/17**).

In **T 2219/10** the board stated that although **T 971/11** concerned the admission of documents in opposition, similar considerations applied with respect to the question of whether sets of claims filed with the grounds of appeal which had not been admitted in the first-instance proceedings should be admitted into the appeal proceedings. This is especially the case in ex parte proceedings, in which issues of equal treatment of adverse parties do not arise. In the case in hand, there was no need to examine whether the examining division had correctly exercised its discretion in not admitting the auxiliary request filed at a late stage of the first-instance proceedings, since in the exercise of its own discretion under Art. 12(4) RPBA 2007 the board admitted all the appellant's requests, including the main request, into the proceedings. See also **T 1888/18**.

In **T 575/15** the board was of the opinion that it had the discretion to admit auxiliary requests 3 and 4, which had not been admitted by the examining division. Since at least some of the fundamental objections against the higher-ranking requests applied to these dependent claims as well, the board saw no reason not to admit them and hence took them into account.

In **T 1811/13** the board stated that the fact that the opposition division had not admitted documents HL13 and its translations did not preclude the board from admitting them if it considered them to be relevant (see **T 971/11**). This was not to be understood to mean that the opposition division had necessarily exercised its discretion incorrectly; the procedural situation simply was not the same any more. In the case in hand, the board found document HL13 to be relevant because it disclosed a feature that was critical for the assessment of inventive step.

In **T 291/15** the board stated that the fact that the opposition division did not admit a late-filed document and did not exceed the proper limits of its discretion by not admitting it did not, in principle, prevent the board from admitting the document pursuant to Art. 12(4) RPBA 2007, in particular if it considered it to be prima facie relevant and taking into account additional facts and different circumstances (**T 971/11**, **T 1811/13**).

In line with **T 971/11** and **T 2219/10** the board exercised its discretion in **T 945/12** with regard to auxiliary request I in light of the new circumstances and submissions, while taking into account the reasoning given by the opposition division for not admitting the very similar request in the first-instance proceedings. The board noted that most of the reasons invoked by the opposition division no longer applied. Since auxiliary request I was submitted with the grounds of appeal, both the board and the opponent had time to examine the request. The board therefore decided to admit the request into the appeal proceedings.

The boards in **T 490/13**, **T 1397/14**, **T 556/13** and **T 368/16** likewise admitted, on appeal, requests not admitted in the opposition proceedings.

b) Submissions not admitted by the boards

In the cases reported here, the boards decided **not to admit** facts, evidence and requests already not admitted at first instance.

In **T 584/09** of 10 June 2013, the board found that the opposition division had given sufficient reasons for its exercise of discretion and applied the correct criteria. Citing **T 640/91**, it held that it was not for it to review whether, as the appellant had argued, the opposition division might have been mistaken as to the relevance of the documents in question. In **T 1643/11** the board was not convinced that the opposition division had exercised its discretion in an unreasonable way or according to the wrong principles, nor did it consider that that exercise was based on a manifestly wrong technical assumption. For these reasons the board confirmed the division's decision not to admit D9 and D13 into the proceedings.

In **T 182/12**, the appellant had requested in its statement of grounds of appeal that its patent be maintained on the basis of a request identical to an auxiliary request that the opposition division had refused to admit. Its failure to file it earlier had been at least partly a procedural tactic and in any event not justified by an unexpected turn of events. The board therefore saw no reason to overrule the opposition division's exercise of discretion and concluded that, since it too could not admit the appellant's sole request, the appeal had to be dismissed.

In **T 1882/13**, the opposition division had refused to admit a document on the ground that it was irrelevant. Finding that to be the right criterion for deciding whether to admit late-filed documents in opposition proceedings and that the division had not applied it unreasonably or arbitrarily, the board upheld its decision.

The board in **T 1467/11** observed that Art. 12(4) RPBA 2007 left the boards room for finding in specific cases that the facts were such that requests the opposition division had rightly refused to admit could nonetheless be admitted on appeal. However, it understood the review criteria laid down by the Enlarged Board in **G 7/93** to mean that, where the opposition division had properly exercised its discretion in deciding not to admit amendments to a case, this was liable to result in their non-admission on appeal too unless facts justifying treating them differently could be established.

See also **T 902/09**, **T 2576/12**, **T 241/13**, **T 366/19**.

c) Discretion misused by the department of first instance

In **T 1872/08** the opposition division used its discretion in an unreasonable way by refusing to admit the additional comparative tests. Therefore, the board decided to overrule the decision of the opposition division in this respect and to admit into the proceedings these comparative tests, which the patentee had resubmitted in its statement of grounds.

In **T 1485/08** the board stated that the opposition division had not properly exercised its discretion in not admitting document (16T) for the sole reason that it was late-filed, without having examined its relevance or having considered any other criteria. Document (16T), which was resubmitted with the statement of grounds of appeal, was highly relevant as there were clear reasons to believe that it would prejudice the maintenance of the patent. The board decided, in the exercise of its discretion pursuant to Art. 12(4) RPBA 2007, not to hold document (16T) inadmissible.

In **T 2716/19** the opposition division, when deciding on the admittance of D24, while using the correct criterion of prima facie relevance, had used it in an unreasonable way because it limited its assessment to the subject-matter of the then main request. It should have extended to the subject-matter of the auxiliary requests on file.

3.4.3 Submissions admitted at first instance are part of the appeal proceedings

The issue in several decisions has been how far the boards can go in reviewing the admission of documents, requests or evidence in the first-instance proceedings. It is the boards' established case law that, on appeal against a decision taken by a department of first instance, it is not for the board to revisit the facts and circumstances of the case as if it were in that department's place and decide whether it would have exercised discretion in the same way (see chapter V.A.3.4.1 b) above).

In a number of decisions, it has been held that the EPC does not provide any legal basis for excluding on appeal documents, requests or evidence correctly admitted by the department of first instance, particularly if the contested decision was based on them (**T 1852/11**, **T 1201/14**, **T 1227/14**, **T 525/15**, **T 1348/16**, **T 852/17**, **T 2049/16**, **T 1525/17**, **T 110/18**, **T 1861/22**, **T 2037/22**). In view of the very aim of the appeal proceedings to review the decision under appeal in a judicial manner according to Art. 12(2) RPBA, such submissions are automatically part of the appeal proceedings (**T 617/16**, **T 487/16**, **T 2603/18**). In **T 1206/19** the board considered that only if there was a substantial procedural violation could a document admitted by the first-instance department be "unadmitted"; this would normally lead to a direct remittal of the case (contrast with **T 960/15**). In **T 1193/21** the board summarised in an obiter dictum various decisions dealing with this question.

In **T 2049/16** the opposition division admitted D20, which was filed by the opponent one month before oral proceedings, because it found it to be prima facie relevant. It was argued that the opposition division should not have admitted the document because its late filing constituted a tactical abuse of proceedings. The board, however, was not convinced that the opponent's behaviour could be deemed an abuse of proceedings. The board considered whether it was possible to reverse the admittance on appeal. The board was not aware of any explicit legal basis that would make it possible to retroactively exclude evidence that has been admitted into the proceedings and decided upon by the department of first instance.

In **T 572/14** the board noted that it can hold inadmissible and hence disregard a party's submission in the appeal proceedings only on the basis of Art. 114(2) EPC and Art. 12(4)

and 13 RPBA 2007. However, since document (21) was admitted by the opposition division and therefore became part of the opposition proceedings, it could not be excluded from the appeal proceedings pursuant to Art. 12(4) RPBA 2007 (see also **T 467/08**).

In **T 1227/14**, the board observed that the boards did not have the power to disregard on appeal submissions admitted by the opposition division in exercise of its discretion.

In **T 104/17**, the board could not immediately discern any legal basis for retroactively rejecting on appeal specific documents which had been admitted into the opposition proceedings and on which the contested decision had been based. Under Art. 12(1)(a) RPBA, any such documents, having become part of the contested decision, were basically part of the appeal proceedings too. Art. 114(2) EPC did not appear to offer any basis for retroactive rejection either. Once the examination or opposition division had admitted a document, even a possibly late-filed one, and thus taken it into account in its decision, this fact could not be excluded from the proceedings or otherwise erased without repealing the entire decision and remitting the case for a new decision.

In **T 2603/18** the board discussed the extent to which the admission of D23 into the opposition proceedings could be reviewed. The board held that, since D23 had then been cited as a basis for the contested decision at issue on appeal, it had become part of it. That alone meant it had to be considered in the appeal proceedings; otherwise, a full review of the contested decision would not be possible (see also **T 26/13**, **T 1568/12**, **T 487/16**). In the case in hand, therefore, a review of the opposition division's discretionary decision could not entail exclusion of D23, which consequently formed part of the proceedings. The board observed that some boards did nevertheless check whether the opposition division had erred in deciding to admit a document where this was alleged by a party (see **T 1652/08**, **T 572/14**, **T 2197/11**, **T 960/15**).

In **T 467/15**, the board held that the boards' discretion under Art. 12(4) RPBA 2007 explicitly covered **only** the rejection of facts, evidence or requests that could have but had not been submitted in the first-instance proceedings or that had not been admitted into those proceedings. Consequently, if the opposition division had admitted a submission into the opposition proceedings within the bounds of its discretion, the board could not disregard it on appeal. It appeared to be debatable whether, if one of the parties so requested, a decision admitting an auxiliary request should still be reviewed on appeal as to whether the discretion had been exercised appropriately (a review to this end was undertaken in relation to admitted documents in **T 572/14**, **T 1227/14**, **T 2197/11**, **T 1652/08**, **T 1209/05**, for example), or whether it was not open to such review (see **T 26/13**, referring to **T 1852/11**) because an admitted request forming the basis for the contested decision could no longer be excluded from the proceedings on appeal even if the opposition division had exceeded the proper limits of its discretion in admitting that request.

In **T 487/16** the appellant requested that D7 be excluded from the appeal proceedings. The board stated that since D7 was part of the opposition proceedings and the decision was based on D7, it was part of the appeal proceedings (see also Art. 12(2) RPBA). Furthermore, considering that the aim of the appeal proceedings was to review the

decision under appeal in a judicial manner and in view of the appellant's main request for maintenance of the patent as granted, which required a review of the decision with regard to the conclusion drawn inter alia on the basis of D7, the board saw no legal basis on which it could be excluded from the appeal proceedings. Thus, in this regard, the board confirmed the case law developed under RPBA 2007 (cf. **T 26/13**, **T 1568/12**, **T 2603/18**). For the sake of completeness, the board added that Art. 12(4) RPBA 2007 would not provide a basis for excluding D7 from the appeal proceedings either since the document was admitted into the proceedings by the opposition division.

Also in **T 858/17** the board questioned whether it had any discretion at all to exclude from the appeal proceedings a claim request that had already been admitted by the opposition division and made the subject of the appealed decision (Art. 12(2) RPBA; see also **T 1227/14**). The board held, that even assuming that it had the power to exclude something from the appeal proceedings that had been admitted by the opposition division and taking decision **G 7/93** into account, the board saw in the case in hand no reasons for excluding the main request from the appeal proceedings.

In **T 467/08**, the board refused the request to disregard on appeal comparative test results submitted in the opposition proceedings, on the basis that neither the EPC itself nor the RPBA provided for such a decision. The boards merely had competence to review a decision taken by the opposition division on whether or not to admit late-filed submissions, documents and requests filed in those earlier proceedings, or to decide themselves whether or not to admit submissions, documents and requests filed on appeal.

In **T 1525/17**, the opposition division had taken account of late-filed citations E5 and E6 throughout its entire substantive examination of inventive step, but then not admitted them into the proceedings. The board held that it was inherently contradictory to take late-filed documents as a basis for an in-depth examination of the patentability requirements, and so consider them as to their substance, yet at the same time declare them not admitted. As a rule, that documents had been examined as to their substance meant that a board could fully review their examination on appeal or at least that it was barred from holding them inadmissible under Art. 12(4) RPBA 2007 on the basis that they had not been admitted by the department of first instance, when their purported non-admission had in fact been inherently contradictory and so amounted to an improper exercise of discretion (see **T 2324/14** and **T 2026/15**).

Also in **T 346/16** the board took the view that it was necessary to take the documents into consideration when reviewing the opposition division's decision with respect to novelty and inventive step since the documents de facto formed part of the contested decision's reasoning despite the explicit decision by the opposition division to exclude them.

3.4.4 Review of an opposition division's discretionary decision (not) to admit a new ground for opposition

An opposition division has the discretionary power to introduce of its own motion a fresh ground for opposition (Art. 114(1) EPC). With regard to the opposition proceedings the Enlarged Board stated in **G 10/91** (OJ 1993, 420) that exceptionally, the opposition

division may in application of Art. 114(1) EPC consider other grounds for opposition which, prima facie, in whole or in part would seem to prejudice the maintenance of the European patent. With regard to the appeal proceedings the Enlarged Board held that fresh grounds for opposition may be considered in appeal proceedings only with the approval of the patentee. On the extent to which an opposition division should examine new grounds for opposition, see also chapter IV.C.3.3. "Scope of examination of grounds for opposition".

The board's review of the discretionary decision of the opposition division is essentially limited to ensuring that the opposition division did not use this power unreasonably (**T 1340/15**).

In **T 1119/05** the objection under Art. 100(b) EPC was already raised, although belatedly, before the opposition division which decided not to admit this late-filed ground. The board introduced the documents referred to in support of the objection in order to assess whether the opposition division had exercised its discretion properly. Having found no indication that the opposition division had exercised its discretion in an unreasonable way, the board saw no reason to reverse the decision of the first instance (see also **T 839/14**).

The board in **T 109/08** held that, when reviewing an opposition division's exercise of discretion in deciding under Art. 114(2) EPC not to admit a late-filed ground for opposition, the boards had the power to overrule its decision if they concluded that it was based on manifestly incorrect technical assumptions or on an erroneous approach to applying the ground in question, since that would amount to a misuse of the discretionary power under Art. 114(2) EPC. The case was remitted to the department of first instance for a new decision. The board may also set aside the decision of the opposition division admitting a new ground for opposition (**T 375/21**).

In **T 1286/14** the board addressed the limited scope for reviewing exercises of discretion to refuse a "fresh ground for opposition" where the proprietor objects to its admission on appeal. In the case at issue, the opposition division had considered a late-filed ground irrelevant and refused to admit it. In such circumstances, it was sufficient for the board to establish that there was evidence that the opposition division had actually examined whether the ground was prima facie relevant and given reasons for its finding on this. So, instead of reviewing whether the opposition division had examined such prima facie relevance "correctly" in substance, it merely had to check that such an examination had demonstrably been conducted. In other words, its duty to review the exercise of discretion was limited. Citing **G 10/91** (OJ 1993, 420), it thus refrained from examining the substance of the fresh ground, thereby following the approach taken in **T 736/95**, OJ 2001, 191; **T 1519/08** and **T 1592/09** and rejecting that entailing a thorough review of the earlier exercise of discretion on its merits, as taken in e.g. **T 1053/05**, **T 1142/09** and **T 620/08**.

In **T 339/18** the board followed the rationale of **T 1286/14** and concluded that the new ground for opposition could not be admitted into the appeal proceedings without the consent of the patent proprietor.

In **T 21/15**, the issue was whether to admit a newly asserted ground for opposition into the appeal proceedings. The board referred to the view taken in **T 1286/14** that, if a ground

for opposition not admitted by the opposition division was invoked again in the statement of grounds of appeal, it had to be deemed a "fresh ground for opposition" as per **G 9/91** and **G 10/91** (OJ 1993, 408 and 420) and could be admitted on appeal only with the patent proprietor's consent. In the case in hand, that would mean that the board was barred from admitting the ground for opposition asserted by the appellant into the appeal proceedings, since the respondent had not given its consent. In **T 620/08**, however, a different board had considered that the term "fresh ground for opposition" meant one relied on for the first time on appeal and did not cover a late-filed ground for opposition that had explicitly not been admitted into the proceedings after being thoroughly addressed in the contested decision. If that view were taken in the case in hand, admission on appeal of the ground for opposition not admitted by the opposition division would be at the board's discretion under Art. 12(4) RPBA 2007. The patent proprietor's consent might then be a further criterion to be factored into the board's exercise of discretion under Art. 12(4) RPBA 2007. It was decided in the case in hand not to admit the ground for opposition at issue.

In **T 178/16** the board stated that even if a board of appeal is not barred from considering a ground for opposition not considered by the opposition division, they have the power to hold inadmissible facts, evidence or requests, which were not admitted in the first-instance proceedings pursuant to Art. 12(4) RPBA 2007. The board considered this to be in line with **T 21/15**.

In **T 1969/17** the board noted that, according to **T 986/93** and **T 620/08** a board of appeal was at least not barred from considering a late-filed ground for opposition which had been disregarded by the opposition division if it was of the opinion that the opposition division exercised its discretion wrongly in this respect. See also **T 22/15**.

3.4.5 Review of discretion – stay of proceedings

In **J 1/16**, the applicant had appealed against the Legal Division's decision not to resume stayed grant proceedings until further notice. The Legal Board stated in its Catchword: where, when deciding not to resume proceedings, the Legal Division has properly identified and exhausted its scope for discretion and weighed up the situation in the light of all the relevant factors, without being influenced by anything irrelevant and without making any logical mistakes in its assessment of the facts, it is not open to the Legal Board to exercise its own discretion in the Legal Division's place. See also **J 10/21**.

4. New submissions on appeal

4.1. Introduction

4.1.1 Legal basis

a) Legal bases in the EPC

Under Art. 114(1) EPC, the EPO is obliged to examine the facts of its own motion, and in doing so, it is not restricted to the facts, evidence and arguments provided by the parties and the relief sought. According to Art. 114(2) EPC, however, the EPO may disregard facts

or evidence which are not submitted in due time by the parties concerned (on the application of these principles in opposition proceedings, see also chapter IV.C.4. "Late submission of documents, lines of attack and arguments").

Earlier case law already pointed out that the wording of Art. 114(1) EPC 1973 (Art. 114 EPC left unchanged by the EPC 2000 revision) does not mean that the boards of appeal have to conduct rehearings of the first-instance proceedings, with unfettered right, and indeed obligation, to look at all fresh matter regardless of how late it was submitted. Such an interpretation of Art. 114(1) EPC 1973 takes it out of the context not only of the remainder of the article, namely Art. 114(2) EPC 1973, but also of Art. 111(1) EPC 1973 (the EPC 2000 revision entailed only minor editorial changes to the English and French versions). When Art. 114(1) EPC 1973 is construed in its proper context, it becomes evident that there is a clear limit on the scope of any new matter that may be introduced on appeal by the parties or by the board itself, because cases on appeal must be and remain identical or closely similar to those on which the first-instance decisions were rendered (**T 97/90**, OJ 1993, 719, cited in **T 951/91**, OJ 1995, 202; see also **T 26/88**, OJ 1991, 30, where it was stated that the essential function of the appeal procedure was to determine whether the decision issued by a department of first instance was correct on its merits; **T 229/90**; **T 611/90**, OJ 1993, 50; **T 339/06** and **T 931/06**).

Facts and evidence submitted for the first time in appeal proceedings may be disregarded by the boards of appeal as a matter of discretion under Art. 114(2) EPC 1973, which limits the boards' inquisitorial duties under Art. 114(1) EPC 1973 (**T 326/87**, OJ 1992, 522).

In **T 482/18** the board dealt with whether restricting the admission of amendments as provided for in the version of the RPBA that entered into force on 1 January 2020 (in the following referred to as "RPBA") was essentially compatible with the principle of ex officio examination and concluded that it was. On this point, it cited **G 9/91** and **G 10/91** (OJ 1993, 408 and 420), according to which the main purpose of inter partes appeal proceedings was to give the losing party an opportunity to challenge the opposition division's decision on its merits and it was justified to apply Art. 114(1) EPC 1973 in a generally more restrictive manner on appeal than in opposition proceedings.

Furthermore, in **T 1767/18**, the board explained (in relation to the hierarchy of norms between the EPC and RPBA) that Art. 13(2) RBPA (in the version that entered into force in 2020) was based on Art. 114(2) EPC. There was no conflict with the provision of Art. 101(3)(a) EPC, which could not be construed as meaning that any EPC requirements needed to be examined, even less so ex officio.

In **T 1758/22**, the board considered that a purported requirement to always check claims for compliance with the requirements of Art. 123(2) EPC and/or Art. 84 EPC overstretched the principle of ex officio investigation and so was counter to the provisions of the RPBA. Likewise ruling on the principle of ex officio investigation under Art. 114(1) EPC, the board in **T 1774/21** found that it did not impose any duty on a board to examine of its own motion whether new submissions by a party were late, even if the opposing party had not (in due time) filed a request for their non-admission. Rather, Art. 114(2) EPC showed that the boards had discretion in this respect.

In **T 1042/18**, the board indicated that the filing of new submissions was restricted not only by case law on taking new grounds for opposition into account in accordance with decisions **G 10/91** (OJ 1993, 420), **G 1/95** (OJ 1996, 615) and **G 7/95** (OJ 1996, 626), but also by the possibility under Art. 114(2) EPC and the RPBA of rejecting late-filed submissions. These restrictions were independent of one another and had a cumulative effect. The board further explained that the provisions of the RPBA on late-filed submissions reflected the provision of Art. 114(2) EPC in a way that was essentially **binding** on the boards (Art. 23 RPBA).

In the same vein, the board in **T 254/20** concluded that the way in which Art. 12(6), second sentence, RPBA is worded was not at odds with Art. 114(2) EPC. It rejected the opponent's argument that the wording of Art. 12(6), second sentence, RPBA limited the use of discretion to such an extent that in essence no discretion at all could be exercised, referring among other things to the last half-sentence of the provision ("unless ...") and to the purpose of opposition-appeal proceedings (see **G 9/91**, OJ 1993, 408, and **G 10/91**, OJ 1993, 420).

It is settled case law of the boards of appeal that **new requests** containing amended claims may exceptionally be admitted in appeal proceedings (see CLB, 10th edn., 2022, V.A.5.12.1). According to R. 100(1) EPC, the provisions in R. 137(3) EPC, relating to examination, and in R. 80 EPC, relating to opposition, apply in appeal proceedings (unless otherwise provided).

In **R 6/19** the Enlarged Board held that Art. 123(1) EPC was the basis for the boards' (and the opposition divisions') discretion whether or not to admit claim requests in (opposition) appeal proceedings (see also **J 14/19** and **T 966/17**, the latter referring to Art. 123(1), first sentence, EPC, read together with R. 79(1) and 81(3) EPC). For the discussion on the legal basis for opposition divisions' discretion not to admit new requests filed during opposition proceedings, see also chapter IV.C.5.1.1.

b) Legal bases in the Rules of Procedure of the Boards of Appeal

The RPBA lay down precise provisions on later amendments to a party's case which, in particular, explicitly leave it to the board's discretion whether to admit them (regardless of whether they relate to facts, objections, evidence or requests). The RPBA were thoroughly revised in 2019, with the new version entering into force on 1 January 2020 (this thoroughly revised version is hereinafter referred to as "RPBA", first published in OJ 2019, A63, republished in OJ 2021, A35 with Art. 15a RPBA and in OJ 2023, A103 again with further amendments, in particular in Art. 13(2) and 15(1) RPBA; on the RPBA generally, see also chapter V.A.1.2.).

Under Art. 12(2) and (4) RPBA, the boards have discretion not to admit an **amendment to the case made by a party at first instance** or, more precisely, not to admit submissions on appeal which are not directed to requests, facts, objections, arguments or evidence on which the decision under appeal was based and for which the party has not demonstrated that they were admissibly raised and maintained at first instance. In addition, Art. 12(6) RPBA, in a similar way as Art. 12(4) RPBA 2007 before it, explicitly refers to the

boards' discretion not to admit requests, facts, objections or evidence which were not admitted in the first-instance proceedings (first sentence) or which should have been submitted or were not maintained in those proceedings (second sentence). Such submissions are not to be admitted unless the decision not to admit them at first instance suffered from an error in the use of discretion or the circumstances of the appeal case justify admitting them. For details on how these provisions have been interpreted in the case law, see chapter V.A.4.3. "First level of the convergent approach – submissions in the grounds of appeal and the reply – Article 12(3) to (6) RPBA".

Art. 12(3) and (5) RPBA play a role for both the admissibility of an appeal (see chapter V.A.2.6.3h)) and the admittance into appeal proceedings of incomplete or unsubstantiated requests, facts, objections, arguments or evidence (see the decisions summarised in this chapter V.A.4.3.5). Case law on the admittance aspect is included in this chapter V.A.4., although the "complete case" requirement applies not only to new submissions on appeal, but also to submissions on which the contested decision is based.

Under Art. 13(1) RPBA, the boards have discretion whether to admit amendments to a party's appeal case **after it has filed its statement of grounds of appeal or reply**. The criteria for exercising this discretion are similar to those applied under Art. 13(1) RPBA 2007 and codify the case law on that earlier provision (see e.g. **T 634/16**, **T 700/15**). The case law on Art. 13(1) RPBA is reported in chapter V.A.4.4. "Second level of the convergent approach – submissions made after filing of grounds of appeal or reply – Article 13(1) RPBA".

Article 13(2) RPBA (as amended in 2023 and entered into force on 1 January 2024) provides that amendments made to a party's case at an advanced stage of the proceedings (that is, after expiry of a **period specified** by the board **in a communication under R. 100(2) EPC** or after **notification of a communication under Art. 15(1) RPBA**) are generally to be disregarded unless there are exceptional circumstances which have been justified with cogent reasons by the party concerned. Under the previous version of Art. 13(2) RPBA the third level of the convergent approach was triggered by the notification of the summons to oral proceedings. The case law on both versions is reported in chapter V.A.4.5. "Third level of the convergent approach – submissions filed after notification of the Art. 15(1) RPBA communication or after expiry of period specified in R. 100(2) EPC communication – Article 13(2) RPBA".

The provisions mentioned above implement the "**convergent approach**", whereby the possibilities for parties to amend their case become increasingly limited as the appeal proceedings progress (see e.g. **T 1370/15**, **T 2778/17**). Parties must **identify and justify any amendments** to their case and state why they were not submitted at an earlier stage in the proceedings. Where their various individual requirements are met, the provisions are **cumulatively** applicable. See chapter V.A.4.1.2 "Primary object of appeal proceedings and the convergent approach to amendments made to party's case" below.

4.1.2 Primary object of appeal proceedings and the convergent approach to amendments made to party's case

In line with the principle set out in decisions **G 9/91** (OJ 1993, 408, point 18 of the Reasons) and **G 10/93** (OJ 1995, 172, point 4 of the Reasons; see also e.g. **T 2194/14**, **T 1102/15**, **T 343/16** and **T 632/16**), the RPBA which entered into force in 2020 highlight in their new Art. 12(2) RPBA that the **primary object** of the appeal proceedings is to review the decision under appeal in a judicial manner. Numerous decisions have referred to this principle in their reasoning when applying the provisions of the RPBA governing new submissions on appeal (see e.g. **J 3/20**, **T 2214/15**, **T 786/16**, **T 256/17**, **T 2778/17**, **T 1422/17**, **T 1456/20**, **T 1963/20**).

For ex parte proceedings, **T 913/20** recalled however that, following the principles set out in **G 10/93** (OJ 1995, 172), boards have the power to examine whether the application or the invention to which it relates meets the requirements of the EPC, including requirements, objections or evidence which the examining division did not take into consideration.

For opposition proceedings, the board in **T 1117/16**, referring to the case law on the RPBA 2007 (see CLB, 10th edn., 2022, V.A.5.2.1), reiterated that in view of the primary goal of appeal proceedings, which was now enshrined in Art. 12(2) RPBA, the factual and legal framework of the opposition proceedings was largely decisive for the subsequent appeal proceedings. Thus, parties are subject to certain restrictions during the proceedings, resulting from the **principle of fairness** to other parties in inter partes cases and from the requirements of due process more generally. In particular, parties in inter partes cases also have a duty to facilitate the **due and swift conduct of proceedings**. See also **T 2482/22**, in which the board rejected the argument that concerns over the validity of the patents issued by the EPO had to trump any other considerations.

One of the consequences of the boards' function being above all to review the appealed decision is indeed that, as the appeal proceedings progress, the possibilities for parties to amend their case become increasingly limited (see e.g. **T 1370/15**, **T 2778/17** and CA/3/19, section V.B.c), point 48). This "**convergent approach**" (referred to in numerous decisions interpreting the relevant provisions of the revised RPBA; see. e.g. **T 2214/15**, **T 2227/15**, **T 2279/16**, **T 2778/17**) consists of three levels, regulated in Art. 12(4), 13(1) and (2) RPBA. Which of these provisions apply depends on the point in the proceedings at which a party changes its case:

– at the outset of the appeal proceedings – first level of convergent approach – only Art. 12(4) RPBA;

– after the party has filed its grounds of appeal or its reply – second level of convergent approach – Art. 13(1) RPBA, which contains a reference to Art. 12(4) to (6) RPBA;

– after the period set in a communication under R. 100(2) EPC has expired or a communication under Art. 15(1) RPBA (as of 1 January 2024, previously: summons to

oral proceedings) has been notified – third level of convergent approach – Art. 13(2) RPBA (and the criteria of Art. 13(1) RPBA, see below).

Indeed, these provisions are, where their various individual requirements are met, **cumulatively applicable**.

The requirements of the first level of the convergent approach – i.e. those set out in Art. 12(4) to (6) RPBA – apply **throughout the appeal proceedings**. By way of express reference to Art. 12(4) to (6) RPBA, it is clarified in Art. 13(1) RPBA that the criteria set out in those provisions apply mutatis mutandis to any submissions made after a party has filed its grounds of appeal or its reply.

As regards Art. 13(1) RPBA, numerous decisions have confirmed that the criteria of this provision may also be applied at the third level of the convergent approach (see e.g. **T 584/17**, which gives a detailed explanation based on the travaux préparatoires in document CA/3/19, section VI, explanatory remarks on Art. 13(2) RPBA; see also **T 2227/15**, **T 172/17** and **T 574/17**). This in turn provides the possibility of relying on the criteria set out in Art. 12(4) to (6) RPBA, which are referred to in Art. 13(1) RPBA (**T 487/20**; see also **T 2486/16**, **T 2429/17** and **T 1058/20**).

All decisions pertaining to the requirements of the first level of the convergent approach set out in Art. 12(4) to (6) RPBA are reported in chapter V.A.4.3 "First level of the convergent approach – submissions in the grounds of appeal and the reply – Article 12(3) to (6) RPBA", irrespective of the stage of the proceedings at which the submissions concerned were filed.

For more details on the application of the criteria of Art. 13(1) RPBA at the third level, see chapters V.A.4.5.1a), V.A.4.5.1g) and V.A.4.5.4e)".

The provisions of Art. 12(4), 13(1) and (2) RPBA only apply to cases in which a party has **amended** its case (i.e. as compared to the one it presented at first instance as far as Art. 12(4) RPBA is concerned or its appeal case as far as Art. 13(1) RPBA and Art. 13(2) RPBA are concerned). Decisions on this preliminary issue of whether new submissions are an amendment are summarised in chapter V.A.4.2 "Amendment to a party's case".

Concerning late-filed third-party observations in appeal proceedings, see chapter III.N.3.2 and III.N.4.4.

In **R 4/22**, the Enlarged Board found that the case law of the ECtHR provides no grounds for questioning restrictive provisions such as the convergent approach in principle, or for generally denying that the application of such provisions is compatible with Art. 6 ECHR.

4.2. Amendment to a party's case

4.2.1 Discretion under Articles 12(4) and 13(1) and (2) RPBA applies only to amendments

The provisions of Art. 12(4) and 13(1) and (2) RPBA only apply to cases in which a party has amended its case (i.e. its case presented at first instance as far as Art. 12(4) RPBA is concerned or its appeal case as far as Art. 13(1) and (2) RPBA are concerned). Thus, as explained with regard to Art. 13(2) RPBA e.g. in **T 247/20**, the **test** to be applied is **two-fold**. The first question is whether the submission objected to is an amendment to a party's appeal case. If that question is answered in the negative, then the board has no discretion not to admit the submission. If, however, that question is answered in the affirmative, then the board needs to decide whether to take the submission into account (confirmed in e.g. **J 14/19**, **T 2920/18**, **T 2988/18**, **T 528/19**, **T 1361/19**, **T 2295/19**, **T 907/20**).

The point of reference for assessing whether a case had been amended within the meaning of Art. 13(1) or (2) RPBA is the statement of grounds of appeal or the reply, whereas the point of reference for assessing whether any part of the appeal case has to be regarded as an amendment within the meaning of Art. 12(4) RPBA is the decision under appeal (see **J 14/19**) and any part of the appeal case for which the party demonstrates that it has been admissibly raised and maintained in the first-instance proceedings.

According to **T 524/18** it is irrelevant whether the other party has requested non-admittance of amendments and if so when, as the board has to decide on admittance on the basis of the provisions of the RPBA, and such decision is not dependent on any request from the parties. On the related question whether procedural requests (including those for non-admittance) are amendments within the meaning of Art. 12(4) and 13 RPBA, see however chapter V.A.4.2.3j).

4.2.2 First level of the convergent approach: amendments to a party's case – Article 12(4) RPBA

a) Principles

The primary object of the appeal proceedings is to review the decision under appeal in a judicial manner (Art. 12(2) RPBA). In view of this primary object, Art. 12(2) RPBA provides that a party's appeal case has to be directed to the facts, objections, evidence and requests on which the decision under appeal was based.

At the first level of the convergent approach, the rule according to Art. 12(4), first sentence, RPBA is that any part of a party's appeal case

– that does not meet the above-mentioned requirements of Art. 12(2) RPBA, and

– for which the party has not **demonstrated** that this part was admissibly raised and maintained in the proceedings leading to the decision under appeal

is to be regarded as an amendment to the party's case.

Thus, an amendment to a party's case under Art. 12(2), (4) RPBA is a submission which is not directed to the requests, facts, objections, arguments and evidence on which the decision under appeal was based – in other words which goes beyond the framework established therein (**T 19/20**, see also **T 247/20**, **T 2988/18** and **T 907/20**) – and for which it has not been demonstrated that it was admissibly raised and maintained in the proceedings leading to the decision under appeal. Any such amendment may be admitted only at the discretion of the board (Art. 12(4), second sentence, RPBA). See chapter V.A.4.3.4.

The appeal proceedings, which are largely determined by the factual and legal scope of the proceedings that led to the appealed decision, are not intended as an opportunity to bring forward an entirely fresh case. This means that an appellant is not at liberty to shift its case as it pleases, as this would compel the board either to give a first ruling on critical issues or to remit the case to the department of first instance. Conceding such freedom to an appellant would run counter to orderly and efficient appeal proceedings, which are primarily directed to reviewing the correctness of the decision under appeal according to Art. 12(2) RPBA (**T 919/22**; see also **T 101/17** on the ratio legis of the closely related Art. 12(6), second sentence, RPBA).

In relation to the requirements of Art. 12(2) RPBA, the boards have repeatedly held that any requests not decided on in the contested decision because they were ranked lower than the request that was deemed allowable do not form part of the contested decision (see chapter V.A.4.2.2b) (iv) below).

The case law has repeatedly emphasised that, as a rule, the party making the submission bears the burden of showing that it was "admissibly raised and maintained" at first instance (see e.g. **T 246/22**, **T 3024/19** and **T 81/20**; see also chapter V.A.4.2.2c) (ii) "Party's duty to demonstrate").

Different approaches have been taken regarding how to examine whether submissions were "admissibly raised and maintained". Specifically, the boards in **T 1913/21**, **T 446/22** and **T 364/20** based their approach on whether the department of first instance would have had to admit the submission had a decision on admittance been required, whereas the boards in other decisions (in particular **T 1800/20**, **T 246/22** and **T 1659/22**) formulated certain requirements independent of those governing the first-instance proceedings (see chapter V.A.4.2.2c) (i) below).

b) Whether submissions on appeal were directed to requests, facts, objections, arguments or evidence on which the decision under appeal was based

(i) Submission decided on the merits

In several decisions, the boards have found that requests and objections on which the examining or opposition division had decided on the merits formed the basis of the contested decision as per Art. 12(2) RPBA (see e.g. **T 1186/20** and **T 1886/22** for auxiliary

requests that were admitted but not deemed allowable, and **T 920/20** for objections dealt with in the decision). Similarly, in **T 449/21** and **T 2337/16** the boards have held that a document to which the opposition division referred for the examination of a substantive issue formed the basis of the contested decision within the meaning of Art. 12(2) RPBA.

In **T 920/20** and **T 449/21**, however, the boards pointed out that only submissions that had been adequately addressed in the grounds of appeal (or the reply to the appeal) were part of the appeal proceedings from the outset in accordance with Art. 12(2) and Art. 12(4) RPBA.

The boards did not always consider that the lack of discretion under Art. 12(2) and (4) RPBA ruled out the possibility of undertaking a **limited review** of the decision to admit. In **T 1670/21**, the board reviewed the opposition division's discretionary decision on the basis of the criteria from **G 7/93** (point 2.6 of the Reasons, OJ 1994, 775), before finding that the main request on appeal, which corresponded to auxiliary request 5 admitted and allowed by the opposition division, was part of the appeal proceedings. Furthermore, the boards in **T 852/17**, **T 110/18** and **T 2603/18**, for example, could not discern any legal basis for excluding from the appeal proceedings requests or evidence that had been **duly** admitted in the first-instance proceedings. However, see also the case law referred to in **T 1193/21**.

For more detail on "Principles applying to the review of first-instance discretionary decisions", see chapter V.A.3.4.1, and for more detail on the related issue of whether submissions admitted at first instance can be excluded from appeal proceedings, see chapter V.A.3.4.4.

(ii) Submissions admitted but not decided on the merits

In **T 1520/20**, for example, the opponent filed documents D45 to D48, which the patent proprietor contended were late-filed. The opposition division admitted these documents (although the content of only two of them was actually used). The board found that these documents formed part of the contested decision. Since there had thus not been any amendment as per Art. 12(2) and (4) RPBA, the board did not have any discretion to disregard them.

However, regardless of whether there was any discretion under Art. 12(2) and (4) RPBA, the boards in some cases undertook a limited review of the decisions to admit at first instance (see e.g. **T 2886/19**, **T 1520/20**, **T 1522/21** and **T 605/22**, in which it was examined whether the opposition division had exercised its discretion to admit documents appropriately and in accordance with the right principles; for more on this approach, see point (i) above). In **T 1206/19**, related to the decision at first instance to admit a citation, the board considered that the possibility of "unadmitting" a request was limited to cases where the decision to admit involved a substantial procedural violation.

(iii) Submissions not admitted

Cases where a submission not admitted at first instance is then re-filed on appeal are governed by Art. 12(6), first sentence, RPBA. See also chapter V.A.4.3.6.

(iv) Opposition decision based on a higher-ranking request

In **T 1370/21**, the board noted that the contested decision related to the rejection of the opposition, meaning that the decision had been based solely on the main request. In the board's view, the auxiliary requests were not a subject of the decision as per Art. 12(2) RPBA. See also decisions **T 1800/20** and **T 364/20**, in which the boards additionally noted that the opposition division had not decided on the admission of the auxiliary request in question.

In **T 1135/22**, the board noted (referring to **T 42/20**, **T 221/20**, **T 1800/20** and **T 364/20**) that dealing with "carry-over requests" in this way was in line with case law that had been settled in the meantime. In its grounds, the board pointed out that the passage from Art. 12(4), first sentence, RPBA reading "[...] unless the party demonstrates that this part was admissibly raised and maintained" would be immaterial if a mere reference to the relevant auxiliary requests in the facts of the contested decision satisfied the requirements of Art. 12(2) RPBA. **T 639/20**, **T 615/22** and **T 246/22** are further examples.

(v) Deletion of claims or claim alternatives

In **T 1516/20**, the subject-matter claimed in auxiliary request 6, submitted with the grounds of appeal, had been restricted further by comparison with auxiliary request 6 on which the contested decision was based, through the deletion of a variant. The board deemed this to be an amendment but admitted the request, exercising its discretion under Art. 12(4) RPBA (see chapter V.A.4.3.4). Similarly **T 1058/20**, citing inter alia **T 2920/18** and **T 494/18**. See also **T 890/21**, in which the question was however eventually left open.

On whether the deletion of claims or claim alternatives always amounts to an amendment to the party's case or whether it does only if the deletion leads to a fresh case, see also chapter V.A.4.2.3d) dealing with this issue in the context of Art. 13 RPBA.

(vi) Reordered requests

In **T 1520/20**, with regard to the admissibility of auxiliary request 4 (which corresponded to auxiliary request 1 admitted and allowed by the opposition division), the board held that the request met the requirement of Art. 12(2) RPBA and therefore could not be regarded as an amendment as per Art. 12(4) RPBA. The opponent argued that submitting higher-ranking requests, in this case the new auxiliary requests 1 to 3, which, for their part, were divergent and inadmissible, rendered auxiliary request 4 inadmissible. The board was not convinced, noting that the facts in the cited decision **T 2112/16** were considerably different from those in the case at issue, in which the auxiliary request in dispute already formed part of the first-instance decision.

However, see also decision **T 309/21** (summarised in chapter V.A.4.2.2c)(vi)), which related to a similar situation but where the request filed at first instance did not form part of the contested decision.

(vii) Objection raised for the first time against another request

In **T 28/20** an inventive-step objection raised in the statement of grounds of appeal against auxiliary request 1 started from closest prior art (D4) which was different from the closest prior art relied upon against this request in the first-instance opposition proceedings (D9). The board held that this new objection constituted an amendment of the appellant's case within the meaning of Art. 12(4) RPBA, since it was not directed to an objection on which the decision under appeal was based (Art. 12(2) RPBA).

In **T 19/20**, however, the board took the view that the appellant's submission under Art. 123(3) EPC against the main request (auxiliary request 2 in opposition) was directed to an objection on which the decision was based, even though it was clear from the minutes of the oral proceedings before the opposition division and from the contested decision that no specific objection under Art. 123(3) EPC had been raised against what was then auxiliary request 2. The board underlined that it was undisputed between the parties that the present objection under Art. 123(3) EPC was **exactly the same** as the objection raised against the main request of the opposition proceedings. Indeed, the amendments in auxiliary request 2 were unrelated to the objection.

(viii) Objection based on document already part of the proceedings but with new reasoning

In **T 652/20** the appellant-opponent raised for the first time in its statement of grounds of appeal an objection of lack of novelty over example 12 of E3 based on the argument that chitin (not only fibroin as previously alleged) anticipated a certain feature of the subject-matter of granted claim 1. The board considered that this new reasoning based on chitin constituted an amendment to the appellant-opponent's case.

(ix) New presentation of known evidence

In the specific circumstances of **T 489/20** the board held that the tabular presentation in documents D30 (filed at the oral proceedings before the opposition division) and D31 (filed with the statement of grounds of appeal) merely highlighted experimental results already reported in the patent itself and additionally only indicated percentages calculated from these results. The content of documents D30 and D31 did there not represent new evidence and the board saw no reason for excluding them from the appeal proceedings.

(x) New arguments vs mere development of arguments

In **T 73/20** the appellant (patent proprietor) argued for the first time in the statement of grounds of appeal that there was a technical prejudice in the prior art, based on common general knowledge, against the combination of D1 and D2. The appellant submitted that this argument was just a development of the arguments put forward in opposition proceedings. The board, however, pointed out that the decision under appeal did not mention at any point the argument that there was such a technical prejudice in the prior art, merely a lack of motivation. See also **T 919/22** (defence based on a different effect and problem to be solved).

For the definition of argument in the sense of Art. 12(2) RPBA, see also **J 14/19** (summarised in chapter V.A.4.2.3p) below). See also **T 250/19**, which confirmed this approach albeit in the framework of the application of Art. 12(4) RPBA 2007.

c) Whether submissions were "admissibly raised" at first instance

(i) Approaches to the "admissibly raised" requirement

In several decisions, the boards have based their approach on whether the department of first instance would have had to admit the submissions in question in accordance with the rules governing the first-instance proceedings, had such a decision needed to be taken (explicitly e.g. in **T 1913/21**, **T 2395/22** and **T 364/20**, impliedly e.g. in **T 446/22**, **T 731/22** and **T 924/22**).

In some of these decisions, the Guidelines were taken as the basis, either the version valid at the time the new submission was filed (**T 1913/21**, **T 446/22**, **T 731/22**, **T 1178/23**, the latter with detailed explanations; cf. also **T 1659/22** and **T 823/23**), or the version valid at the time of the board's decision (**T 924/22**).

The board in **T 364/20** determined which criteria were applicable to the department of first instance not primarily on the basis of the Guidelines but on independent criteria. The board held that, in view of Art. 114(2) EPC, as a rule, claim requests should have been admitted by the opposition division if they were filed within the time limit set under R. 79(1) EPC. However, based inter alia on **R 6/19**, in truly exceptional situations auxiliary requests filed within this time limit could be considered not to have been admissibly raised. Whether or not a claim request filed after the expiry of this time limit but before expiry of the period set under R. 116(1) EPC was to be considered filed in due time depended on whether this request was submitted in direct and timely response to a change to the subject of the proceedings. Concerning the exercise of discretion, the board referred to **G 9/91** and held that a patent proprietor had in principle to be **permitted to redefine its fallback positions** in terms of auxiliary claim requests also at a late stage of opposition proceedings. The board acknowledged that **lack of clear allowability** could be a reason for the opposition division not to admit a late-filed claim request filed after the expiry of the R. 79(1) EPC time limit, as could be **insufficient time** for an opponent to deal with an amended claim request. Moreover, the criteria generally used by the boards when exercising their discretion to admit a party's submission in appeal under the RPBA could also be used, **in a more lenient way** however, in view of the administrative character of opposition proceedings. See also **T 309/21**. On the principles to be applied by the first instance, see also chapters IV.C.4. and IV.C.5.1.4 to IV.C.5.1.11.

In other decisions, the boards did not take the perspective of the first-instance department but formulated aspects or requirements to be considered in relation to the requirement of "admissibly raised" that were independent from the criteria applicable at first instance (albeit to varying degrees reminiscent of these criteria).

In **T 1800/20**, the board explained that the review of whether a part of the appeal case had been admissibly raised in the first-instance proceedings should take the following aspects,

among others, into consideration: a) the time the submission was filed; b) the suitability of the submission to overcome the objections against the higher-ranking request; c) whether the submission creates new issues; d) the suitability of the submission to contribute to a convergent development of the first-instance proceedings (see **T 1903/13**).

In **T 246/22** the board discussed the different approaches to the "admissibly raised" requirement. The approach taken in **T 364/20** (slipping at least partly into the shoes of the opposition division) did not convince the board inter alia because determining what an opposition would have decided would be a "moving target". Neither did the board subscribe to the elaborate criteria proposed in **T 1800/20**, which, in the present board's view, could lead to rather harsh situations for the parties. Nor did the board endorse the conclusions drawn in decisions **T 42/20** and **T 476/21**, where merely the timing aspect was considered. Instead, it proposed a new approach defining the following **requirements**. The party has to demonstrate:

1) that the requests had been filed in due time, typically before expiry of the time limit set by the opposition division under R. 116 EPC; and

2) that it had been made clear, explicitly or by way of unambiguous implication, for which purpose they were filed, i.e. which objections raised by the other party or the opposition division they tried to overcome and how this was actually achieved.

See also e.g. **T 1135/22**, **T 1749/22**, **T 2366/22**, **T 506/23** (by the same board); along similar lines, see also **T 445/21**.

In **T 1659/22**, the board took the term "admissibly raised" to mean "raised in the bona fide expectation that it would be admitted" and saw in this wording an expression of the principle of the protection of legitimate expectations generally applicable in proceedings before the EPO (**G 5/88**, OJ 1991, 137). As the patent proprietor had filed and substantiated its auxiliary requests in the opposition proceedings within the period under R. 116(1) EPC, the board considered that there had been such a legitimate expectation. It could not see anything that might have led the opposition division to exercise its discretion differently, for example a lack of substantiation (**T 246/22**), an excessive number of requests or diverging requests (**T 1800/20**).

And again in other decisions, without setting out a general approach for the criteria to be applied, the boards have based their conclusions regarding the "admissibly raised" requirement on the circumstances of the case, e.g. time of filing and (lack of) justification for not filing earlier (e.g. **T 2978/19**, **T 108/20**, **T 543/20**, **T 274/20**, **T 996/20**, **T 778/21**, **T 886/21**, **T 1214/21**, **T 1650/21**, **T 842/22**, **T 1464/22**, **T 2036/22**).

(ii) Party's duty to demonstrate

In several decisions the boards have emphasised the respective party's duty to demonstrate that a part of their case had been "admissibly raised" and have based their conclusions (inter alia) on the party's failure to fulfil this duty (**T 3024/19**, **T 81/20**, **T 639/20**, **T 1081/20**, **T 309/21**, **T 631/21**, **T 1224/21**, **T 246/22**, **T 389/22**, **T 1135/22**).

In **T 246/22** the board explained, with regard to Art. 12(4) RPBA, that the ordinary meaning of "demonstrates" was that, as a general rule, the party making a submission bears the burden of showing that it was "admissibly raised and maintained". The lawmakers' idea was obviously **not** to put **ex officio** responsibilities on the boards and expect them to assume an investigative role, identify and track claim requests to their source, and understand why they were filed. Furthermore, the board held that, since the statement of grounds of appeal, with which the auxiliary requests were submitted, lacked any indication that they had been "admissibly raised and maintained", it had not contained the proprietor's complete appeal case (cf. Art. 12(3) RPBA). In this sense, there were **temporal restraints** on the "demonstration" required under Art. 12(4), first sentence, RPBA.

In **T 1135/22**, the board pointed out that right up to the end of the proceedings the patent proprietor had been unable to state precisely **why** the amendments at issue had been made. The patent proprietor's observation that the auxiliary requests had been filed within the time specified in accordance with R. 116(1) EPC was irrelevant since such requests could still be deemed "late-filed" under the case law. See also **T 309/21**.

(iii) Invoking other opponents' submissions

In **T 920/20**, the board could not derive any restriction under Art. 12(4) RPBA to the effect that each party on appeal could only base its case on matter that it had itself admissibly raised in the previous proceedings. Therefore, the board deemed it legitimate for an appellant to also use lines of attack raised by other opponents in the opposition proceedings. See also **T 2036/22** (D42).

(iv) Time of filing – requests

In several decisions the boards have, according to the circumstances of the case, considered requests to be admissibly raised which were filed **within the four month time limit for reply** to the notice of opposition (see e.g. **T 2114/19** and **T 615/22**; see also **T 1214/21**, where additionally a later correction under Art. 14(2) EPC had been carried out) or before or on the **final date in accordance with R. 116(2) EPC** (see e.g. **T 42/20**, **T 221/20**, **T 476/21** and **T 1464/22**; see also **T 108/20**, where it was furthermore undisputed that the request had been admissibly raised, and **T 1650/21** where additionally redundant text was deleted shortly before the oral proceedings in a request initially filed before the final date under R. 116 EPC).

However, in **T 364/20** the board referred to exceptional situations where auxiliary requests filed within the time limit under R. 79(1) EPC could be considered not to have been admissibly raised (in line with **R 6/19**). Whether or not a claim request filed before expiry of the period set under R. 116(1) EPC was to be considered filed in due time depended on whether this request was submitted as a **direct and timely response** to a change to the subject of the proceedings. In **T 1135/22** and **T 309/21** too, the boards emphasised that the fact that the requests in question had been filed by the date fixed under R. 116(2) EPC was not decisive for the purposes of Art. 12(4) RPBA. See also **T 246/22**.

For filings after the final date set under R. 116 EPC, the boards have generally examined whether there was a justification as to why the submission in question had not been filed earlier (e.g. **T 996/20**, **T 778/21**, **T 842/22**, **T 506/23**). In the circumstances of the case before it, in **T 996/20** the board considered a request as admissibly filed which had been filed at the end of the oral proceedings before the opposition division.

(v) Time of filing – objections or evidence

In **T 1738/21** the board found that document E23 was admissibly filed **in reaction to** the opposition division's **preliminary opinion**. E23 was an extract from a handbook representing common general knowledge, which was prima facie relevant for the contested issue.

In **T 221/20** documents, which were filed two weeks after the final date specified in accordance with R. 116 EPC, constituted in the view of the board a **direct reaction to** the submission of the **amended requests** and were "admissibly raised".

(vi) Reordered requests

In **T 309/21**, auxiliary requests 18 to 20, which were filed with the grounds of appeal, were identical to requests filed and maintained in opposition proceedings. However, higher-ranking auxiliary requests had been inserted before them. Thus, the overall sequence of auxiliary requests for consideration relative to the opposition had changed. The board pointed out that this materially changed the focus of auxiliary requests 18 to 20. And this had also led to a lack of convergence because the higher-ranking requests were based on combinations with dependent claims and included newly introduced features from the description. The board observed that in the case law of the boards of appeal such a change of case resulting from the introduction of higher-ranking requests had been regarded as an amendment (citing **T 1185/17** and **T 2112/16**, with respect to Art. 13(1) RPBA, and **T 1516/20** with respect to Art. 12(4) RPBA, see also the summary of the latter decision in chapter V.A.4.2.2d) (ii)). The board also noted that the proprietor had not presented any reasoning as to why the requests were admissibly raised at that stage of the opposition proceedings. In this respect the board held that not every claim request submitted before the expiry of the time limit set under R. 116(1) EPC was automatically admissibly raised (see e.g. **T 364/20**).

(vii) Convergence

In **T 886/21**, claim 1 of auxiliary request 6 in the opposition proceedings did not further restrict the subject-matter of claim 1 of auxiliary request 5 but the subject-matter of claim 1 of the main request. As such, claim 1 of each higher-ranking request had not been developed in a convergent manner. For the board, this alternative way of restricting the subject-matter, namely in a divergent direction, was not apt to bring the proceedings to an end, even retrospectively. The board pointed out that the issue of whether a new set of claims is convergent was a valid criterion for an opposition division to consider when exercising its discretion. Moreover, the board acknowledged that a significant part of the added feature was derivable solely from the description, concluding on the basis of these

considerations that the request had "not been admissibly" raised in the opposition proceedings.

Likewise, in **T 1800/20** auxiliary request 2' was already not convergent with the next-highest-ranking request at the time the request was filed in the opposition proceedings. In the board's view, the request could not be considered to have been admissibly raised for this reason alone.

For further decisions in which the boards applied or at least acknowledged the convergence criterion as applicable criterion for the exercise of discretion of the opposition division, see **T 364/20**, **T 312/22** und **T 309/21**.

However, in **T 1464/22**, the board held that the mere fact that the request in question was not "convergent" with a previous request did not necessarily mean that it was not "admissibly raised" within the meaning of Art. 12(4), first sentence, RPBA. See also **T 2254/17**, citing **T 996/12**.

In **T 2395/22** the board considered that the requests at issue were "sufficiently convergent" given the number of objections.

d) Whether submissions were "maintained" at first instance

(i) Party's duty to demonstrate

As underlined by the board in **T 246/22**, as a general rule, the party making a submission bears the burden of showing that it was "admissibly raised and maintained". See also the further decisions cited above in chapter V.A.4.2.2c) (ii).

(ii) Whether requests were "maintained"

In **T 1214/21** a request filed two months before the oral proceedings before the opposition division and a request filed at these oral proceedings were both labelled "New Main Request". The board considered that there was no reason to suggest that the opposition division's understanding that the new main request was supposed to **replace** the previous one was erroneous. And there was no reason why the opposition division should have clarified the status of the previous request.

The board dealt with a different procedural situation in **T 1788/21**. In this case the appealed decision was to maintain the patent in amended form on the basis of the then auxiliary request 1. In the appeal proceedings, the respondent (patent proprietor) requested that the patent be maintained according to a set of claims filed as second auxiliary request during opposition proceedings. In the board's opinion, nothing suggested that this request had not been maintained in the first-instance proceedings.

In **T 1516/20**, the board regarded auxiliary requests 1, 2, 3 and 5 as an amendment to the party's case. In the board's opinion, the **requests had been reordered** in the opposition proceedings. Specifically, the aforementioned auxiliary requests had been skipped after

the opposition division expressed doubts about their allowability. Ultimately, the requests were not dealt with, and no decision was taken on them. Auxiliary request 3 was even replaced with a different auxiliary request 3. The board stressed that appeal proceedings were not conceived as a second opportunity to present a case that had **intentionally not been presented for decision** at first instance. For the board, the re-filing of auxiliary requests 1, 2, 3 and 5 in their original order, including the re-filing of withdrawn auxiliary request 3, constituted an amendment as per Art. 12(4) RPBA. See also **T 206/22**.

(iii) Whether objections were "maintained"

In **T 526/21** the board observed that the attacks based on D24 and D34 were raised in writing during the opposition proceedings in reply to the preliminary opinion of the opposition division, but not mentioned in the impugned decision. According to the minutes of the opposition oral proceedings the opponents agreed that D9 was the closest prior art and the proprietor argued that example 2 of D2 would be a better closest prior art. The choice between D2 and D9 was then discussed but no other document was considered by any opponent. None of the appellants requested a correction of the minutes. In line with **T 2730/16**, the board considered that the attacks starting from D24 and D34 were **not actively maintained**.

In **T 928/20** the board noted that the respondent admissibly filed Appendix A during the opposition proceedings within the time limit according to R. 116 EPC. This document was **not discussed** during the oral proceedings before the opposition division, nor was it mentioned in the decision under appeal. Thus, the board considered it to be an amendment pursuant to Art. 12(2) and (4) RPBA. It was, however, admitted. Similarly, see **T 2137/22**, where the opponent, even when invited by the chair of the opposition division to discuss "candidates" for closest prior art during oral proceedings, did not refer to D1 (which was not admitted in view of Art. 12(6) RPBA).

e) Documents referenced in the patent specification – not automatically part of the appeal proceedings

In **T 1522/21** the board recalled that, according to established case law (see chapter IV.C.4.4) a document is not automatically scrutinised in opposition or opposition appeal proceedings simply because it was quoted and acknowledged in the patent in suit. The opponent had not referred to these documents during opposition proceedings, but done so for the first time with its statement setting out the grounds of appeal. See also **T 2391/18** (referring to **T 140/00**).

4.2.3 Second and third levels of the convergent approach: amendments to a party's appeal case – Article 13(1) and (2) RPBA

a) Principles

An amendment to a party's appeal case under Art. 13 RPBA is in analogy with Art. 12(4) RPBA (with reference to Art. 12(2) RPBA) a submission which is not directed to the requests, facts, objections, arguments and evidence relied on by the party in its statement

of grounds of appeal or its reply. In other words, it goes beyond the framework established therein (**T 247/20** and **T 2988/18**, endorsed e.g. in **T 907/20**, **T 19/20**, **T 499/20**). Parties must however be allowed to refine their arguments, even to build on them, provided they stay within the framework of the arguments and the evidence submitted in a timely fashion in the written proceedings (**T 247/20**, confirmed in **T 2605/18**, **T 2623/18** and **T 1132/22**).

This definition was explained in **T 247/20** as follows: the RPBA contained no definition of "amendment to a party's appeal case", but they assisted in defining what was meant by an "amendment" and by "a party's complete appeal case". Under Art. 12(3) RPBA parties needed to set out why the decision under appeal should be reversed, amended or upheld, and should specify expressly "all the requests, facts, objections, arguments and evidence relied on". Art. 12(4) RPBA defined what was meant by an **amendment vis-à-vis the first-instance proceedings**, namely everything that did not comply with Art. 12(2) RPBA. In effect, an amendment was – apart from a clearly defined exception – what was not "directed to the requests, facts, objections, arguments and evidence on which the decision under appeal was based". The board then transferred this definition to **amendments to a party's appeal case**. In the case in hand, the arguments which the appellant had presented during the oral proceedings and to which respondent 2 objected were all aimed at illustrating, refining or further developing the arguments already presented with the grounds of appeal and at countering the arguments made by respondent 2 in this context and, in the board's view, did not amount to an amendment of the appellant's appeal case.

In **J 14/19**, the Legal Board also found that, on a systematic interpretation, the question whether a submission resulted in an "amendment to a party's appeal case" within the meaning of Art. 13 RPBA had to be answered using the list of possible components of an appeal case in Art. 12(2) RPBA. Art. 12(3) RPBA likewise referred to those components. See also **T 101/18** and **T 1042/18**.

In **T 100/18**, however, the board found that, while Art. 12(3) RPBA, invoked by the appellant (opponent), set out requirements to be met by the statement of grounds of appeal and the reply, it did not define what was meant by an amendment to an appeal case. The board thus looked only at whether the requirements under Art. 12(2) RPBA had been met. The content of the letter at issue in the case in hand, which had not been received until after expiry of the period for the reply, did not go beyond the requests, facts, arguments and evidence dealt with in the decision under appeal. It therefore met the requirements of Art. 12(2) RPBA and was aimed at achieving the main purpose of the appeal proceedings, namely a review of the decision under appeal in a judicial manner.

In **J 14/19** the Legal Board further held that, at the level of the EPC, the possibility of refusing to admit late-filed submissions was provided for in Art. 114(2) EPC (supplemented by Art. 123(1) EPC for amendments to a patent or patent application). Under Art. 114(2) EPC, a late-filed submission containing **factual elements** could be disregarded. See also **T 1042/18**.

The board in **T 482/18** only partly endorsed the view taken in **T 1914/12** that the boards had no discretion when it came to admitting late-filed arguments based on facts already at issue in the proceedings. Art. 114(2) EPC 1973 (left unchanged by the EPC 2000 revision)

was not a basis for rejecting **arguments**. However, the board interpreted "argument" narrowly, treating the term as equivalent to **submissions concerning interpretation of the law** (on this see, chapter V.A.4.2.3l) and V.A.4.2.3p)). It also rejected the view that facts apparent from the patent documents were part of the proceedings without having been expressly asserted (see chapter V.A.4.2.3n)).

b) Submissions at first instance not automatically part of appeal case

Several decisions have pointed out that submissions made by a party during the preceding administrative proceedings are not automatically part of any subsequent appeal proceedings where they have not been reiterated in a substantiated manner at the outset of those appeal proceedings. Raising these submissions after the initial phase of the appeal proceedings therefore constitutes an amendment to the party's appeal case (see e.g. **T 2024/16**, **T 276/17**, **T 241/18**, **T 1108/16** and **T 1577/19**, citing **G 9/92** and **G 4/93**, OJ 1994, 875).

In **T 276/17** the board explained that it followed from Art. 12(3) RPBA that facts and evidence submitted in the opposition proceedings were not automatically part of the appeal case. It was not enough for the grounds of appeal (submitted here by the patent proprietor) to make a sweeping reference, without any further explanation, to the minutes of the oral proceedings and to the arguments and facts mentioned therein.

The board in **T 1439/16** likewise pointed out that it was the appellant who defined the extent of the appeal and that, according to Art. 12(3) RPBA, the statement of grounds of appeal had to contain a party's complete case. It had been the choice of the appellant in the case in hand to make an objection of added subject-matter only to claim 1 and not to claim 8 in its statement setting out the grounds of appeal.

Regarding documents referenced in the patent specification, see chapter V.A.4.2.2e).

c) Request for dismissal of the appeal and maintenance of the patent

In **T 1309/16** the patent proprietor had not submitted any reply to the opponent's grounds of appeal and, instead, only requested, about one month before the oral proceedings, that the appeal be dismissed and the patent maintained. The board observed that the primary purpose of the appeal proceedings was to judicially review the contested decision which had rejected the opposition (Art. 12(2) RPBA) and the patent proprietor did not have to request the appeal's dismissal for that to happen. The board considered that there was no need to decide whether the patent proprietor's request was formally admissible under Art. 13(2) RPBA.

d) Deletion of claims or alternatives within claims

It is now widely accepted that even an uncomplicated amendment to a set of claims, for example deletion of an entire claim category, always constitutes an amendment to the appeal case as per Art. 13 RPBA, regardless of whether this alters the factual or legal framework of the proceedings and thus leads to a "fresh case" (see e.g. **T 1800/21** with

references to the case law; for more recent decisions, see e.g. **T 499/20**, **T 541/20**, **T 598/20**, **T 1058/20**, **T 321/21**, **T 953/21**, **T 42/22** and **T 1673/22**). However, there does appear to be a consistent line of case law developing to the effect that in cases where an uncomplicated amendment of this kind leads to a request on the basis of which the patent can clearly be maintained, any such requests can be admitted as long as the amendment does not alter the factual or legal framework of the proceedings, does not require the matter at issue to be re-evaluated, does not run counter to the principle of procedural economy and does not jeopardise the legitimate interests of any of the parties (examined in depth in **T 1800/21** with reference to the case law, following on from **T 2295/19**; for detail on the discretion to admit, see chapter V.A.4.5.4j).

After the revised RPBA came into force in 2020, the question of whether deleting claims (in particular entire claim categories) constituted an amendment to the appeal case as per Art. 13 RPBA was initially answered in different ways.

In a first line of case law, the deletion of a claim category, of dependent claims or of alternatives within claims were held not to be amendments to the appeal case if the deletion did not lead to a fresh case (see e.g. **T 1480/16**, **T 2638/16**, **T 884/18**, **T 914/18**, **T 995/18**, **T 1151/18** and **T 1857/19**). This approach was referred to in **T 494/18** and **T 2360/17** as the "non-applicability approach". Factors frequently considered by the boards applying the "non-applicability approach" when assessing whether a deletion amounted to an amendment were whether it would **alter the factual and legal framework** of the case or the subject of the discussions (e.g. **T 995/18**, **T 981/17**, **T 1569/17**, **T 1792/19**, **T 1857/19**) or entail **thoroughly re-evaluating the matters at issue** (e.g. **T 2638/16**, **T 995/18**) or whether, instead, it would merely reduce the complexity of the proceedings by eliminating one of the matters in dispute (see e.g. **T 995/18**, **T 2610/19**). Example cases where deletions were held not to be an amendment when applying these tests are **T 1480/16**, **T 2638/16**, **T 995/18** and **T 884/18**.

This view has been justified, for example, on the basis that it did not appear appropriate to make the formal fact of claims being deleted the reference point for the legal assessment and to determine on this basis alone that there had been an amendment to an appeal case that was sanctionable under Art. 13(2) RPBA and so would as a rule have to be disregarded. That is because it is not the deleted claims that are the subject of the ongoing proceedings, but rather the claims that are left in the request and thus to be decided on by the board. Not taking such requests into account would seem questionable, particularly if the remaining claims were already a subject of the appeal proceedings (Art. 12(2) and (3) RPBA) and thus had already been discussed in the context of the parties' cases (**T 2201/19**). See also **T 1361/19** which pointed out that in the case in hand all of the appellant's arguments and submissions on the remaining part remained unchanged.

By contrast, in a second line of case law, the boards have taken the view that deletions of claims or of alternative embodiments within claims always amounted to amendments and so exercised their discretion under Art. 13 RPBA (see e.g. **T 713/14**, **T 1224/15**, **T 2222/15**, **T 1597/16**, **T 1439/16**, **T 853/17**, **T 1569/17**, **T 2360/17**, **T 306/18**, **T 494/18**, **T 908/18**, **T 2091/18**, **T 2604/18**, **T 2920/18**, **T 2964/18**, **T 84/19**, **T 355/19**, **T 482/19**, **T 2295/19**, **T 541/20**, **T 1058/20**, **T 424/21**, **T 1225/21**), in most cases, however, ultimately

admitting the requests concerned, though not in e.g. **T 2222/15**, **T 1569/17**, **T 2360/17**, **T 482/19**, **T 84/19**, **T 2610/19**, **T 608/20**, **T 1058/20**.

This line of case law has been justified, for example, in that the expression "amendment to the appeal case", which is not defined any further in Art. 13 RPBA, has to be systematically construed in the context of other provisions. Referring to Art. 12(2) and (3) RPBA, it could be concluded that a submission filed by a party and not directed to requests, facts, objections, arguments or evidence contained in the statement of grounds of appeal or the reply to the appeal entails an amendment to the appeal case. In line with this systematic interpretation, therefore, filing an amended set of claims – even if the amendment merely involves claims being deleted – leads to an amendment to the status of the requests in the appeal proceedings (see e.g. **T 2295/19** with reference to **T 247/20**, **T 2091/18** and **J 14/19**). This conclusion based on a systematic interpretation of Art. 12(2), (3) and 13 RPBA was also endorsed e.g. in **T 494/18**, **T 2964/18**, **T 2920/18**, **T 355/19**, **T 1058/20**, **T 2091/18**, **T 2295/19**.

The board in **T 2091/18** held that whether an appeal case had been amended within the meaning of Art. 13(2) RPBA had to be divorced from considerations as to the impact on how the proceedings would progress (followed in **T 355/19** and **T 541/20**). Similarly, in **T 494/18** the board criticised that the "non-applicability approach" anticipated a criterion of procedural economy ("change of the factual or legal framework"). See also **T 424/21**.

In a vast majority of decisions, the boards are now of the view that this is an amendment as per Art. 13 RPBA (see in particular **T 1800/21** with further references, and the more recent decisions cited above in the first paragraph). At the same time, when deciding on whether to admit the amendment to the appeal case, most of these decisions have taken into account the aspects of whether or not the amendment leads to an altered factual situation or required the matter at issue to be re-evaluated, and of whether admitting such requests was accordingly consistent with the principles of procedural economy and fair proceedings. In this context, the board in **T 2080/18** left it open as to whether the auxiliary request in question could be deemed an amendment to the appeal case (see also **T 489/20**). However, there has not been a uniform approach as to whether the assessment of "exceptional circumstances" as per Art. 13(2) RPBA leaves any scope for taking such considerations into account. However, there appears to be a consistent line of case law developing in favour of doing so (see **T 1800/21** and chapter V.A.4.5.4j) below).

e) New request combining subject-matter of previously filed claims

In ex parte case **T 1775/18**, the appellant argued that the introduction in an independent claim of a **feature** taken **from a dependent claim** was not an amendment of its case which, under Art. 13(2) RPBA , required exceptional circumstances justified with cogent reasons. Such an amendment could not come as a surprise, since dependent claims were meant to define fallback positions. The board did not agree. While it was true that dependent claims defined fallback positions for certain purposes, in EPO proceedings they could not be equated with auxiliary requests. Art. 113(2) EPC required the EPO to decide on an application in the text submitted to it, or agreed, by the applicant. According to the board, this meant that it was the applicant's responsibility to file an (amended) set of

application documents that fully met the requirements of the EPC. For the sake of procedural efficiency, the RPBA set limits on when such amendments could still be filed in appeal proceedings.

T 312/19 concerned a new auxiliary request (6bis), filed during the oral proceedings, which combined subject-matter from two auxiliary requests. The board rejected the respondent's (patent proprietor's) arguments that the new request did not add anything new to the discussion, that the subject-matter under discussion already formed part of the respondent's appeal case, even if not included in one and the same request, and that, by not submitting all possible permutations of the independent claims, it had avoided the filing of an overwhelming number of requests. It held that the new auxiliary request was a change in the respondent's appeal case since it had never been part of the appeal proceedings until the oral proceedings. The board also pointed out that the new request **combined two independent claims** of two different requests and thus constituted a new contingency position of the respondent.

In **T 532/20** the sole claim of auxiliary request A was a **combination of granted dependent claims**. The board tended to agree with the analysis in **J 14/19** and **T 2091/18**, according to which any change from the appeal case as defined in Art. 12(2) RPBA was an amendment. The fact that auxiliary request A clearly introduced new issues to be examined into the proceedings was considered by the board in the exercise of its discretion.

f) Request previously only paraphrased and not set out in full

In **T 2154/19** the appellant (patent proprietor) argued that auxiliary requests 2 and 3 filed at the oral proceedings did not amend its appeal case because they had already been filed in a passage in its grounds of appeal. However, the claim sets had merely been paraphrased there; they had not been set out in full. A sufficiently precise particular combination of claims selected from the auxiliary requests dealt with in the contested decision could not be identified from that passage. The board therefore considered that auxiliary requests 2 and 3 amended the appeal case.

The situation was different in **T 276/17**, in which auxiliary request 2 had not been filed with either the notice of appeal or the grounds of appeal, but had been dealt with in the decision under appeal and referred to in the grounds of appeal. In the board's view, there was no doubt that the reference to "the auxiliary request" could relate only to the single auxiliary request dealt with in the decision under appeal, and so that request had been clearly identified. In addition, since that auxiliary request had already been admitted, and its merits decided by the opposition division, the board considered that the identical auxiliary request 2 filed on appeal was part of the appellant's case under Art. 12(3)(a) RPBA.

g) Resubmission of withdrawn requests or requests no longer pursued

Since a withdrawn request ceases to be at issue in the proceedings, its admission (consideration) if it is resubmitted at a later stage is subject to the same procedural requirements as apply to a brand new one (**T 2692/18**, referring to **T 1695/14** and

T 1421/20). In the case to be decided in **T 2692/18**, this meant that Art. 13(2) RPBA had to be applied because the request originally filed in response to the reply had been replaced by other requests following the communication under Art. 15(1) RPBA and had not then been resubmitted until the oral proceedings.

In **T 1421/20** auxiliary requests 1 to 5 had been considered in the decision under appeal, but the board noted that they had been replaced at the beginning of the appeal and were thus not part of the appellant's (applicant's) appeal case. The board thus regarded their reintroduction (after notification of the summons to oral proceedings) as an amendment to the appellant's case, the admission of which was subject to its discretion (Art. 13 RPBA). See also **T 798/18** and **T 1436/19**.

With regard to a similar procedural situation (namely sole request subject of the appealed decision abandoned and replaced at the outset of the appeal proceedings by two other requests, but later resubmitted), the board explained in **T 2124/21** that it was the pending requests with which the abandoned and resubmitted request had to be compared when establishing whether it was an "amendment" to the appeal case.

h) Belated substantiation of requests

In numerous decisions, boards have pointed out that the **later substantiation** of initially unsubstantiated requests is to be considered as an amendment to the party's appeal case (e.g. **T 319/18**, **T 1220/21**, **T 321/21**, summarised below, and **T 1128/21**, **T 2013/21**). There are, however, different approaches to the treatment of the initial **unsubstantiated requests**, one being that they are considered not effective (see **T 319/18**, summarised below, and e.g. **T 1732/10**, **T 2288/12**, **T 1784/14**, **T 2393/18**) and the other that they have been validly filed but are admitted to the appeal proceedings only at the board's discretion (e.g. **T 1220/21**, summarised below, and **T 1128/21**). See also chapter V.A.4.3.5b) (v).

In **T 319/18** the board recalled that Art. 12(3) RPBA, analogously to Art. 12(2) RPBA 2007, required that the parties to appeal proceedings set out their complete case in their initial submissions. The board held, with reference to **T 933/09** and **T 1533/13**, that when filing of a new set of claims, it was necessary to explicitly state why the amendments overcame the objections on which the decision under appeal was based and/or which were raised by the opponent. Unless the purpose of the amendments was self-explanatory, if reasons explaining why the new claims overcome the outstanding objections were filed after the statement of grounds of appeal or the reply, these reasons constituted an amendment to the party's appeal case. In the case in hand, the board held that the requests became effective only at the date on which they were substantiated. They were not admitted (Art. 13(2) RPBA). See also **T 750/18**. For an example where an amendment was held to be self-explanatory, see **T 2964/18**.

In **T 1220/21**, however, the board held, in view of Art. 12(3) and (5) RPBA, that a lack of or insufficient substantiation of an amended request may lead to its non-admittance, but that this did not imply that the request had not been validly filed. The board considered the late substantiation of the requests at issue as an amendment to the party's appeal case and decided not to admit it under Art. 13(2) RPBA. Moreover, it exercised its discretion

under Art. 12(5) RPBA not to admit the unsubstantiated requests. Along similar lines, in **T 1128/21** the board explained that a distinction had to be made between the filing of an amended claim request and the question of whether the request had been sufficiently substantiated. That followed systematically from Art. 12(3) and (5) RPBA, according to which a request, even if not sufficiently substantiated, had to be assessed by the board with respect to its admittance. Such an assessment of the request and the possibility of admitting it despite insufficient substantiation presupposed that the request was pending, i.e. had been validly filed.

In **T 321/21** the board discussed the two approaches to dealing with unsubstantiated requests and objections (i.e. whether unsubstantiated submissions are not validly filed or are effective but subject to the board's discretion). It pointed out that a main difference between the two approaches appeared to be whether or not a board had to take a formal admittance decision on a claim request or objection which it considered unsubstantiated. The board also explained that the principle that a party must contribute to the conduct of the proceedings by substantiating its own requests and objections in a minimum way is a general procedural principle underlying the EPC (see **T 1776/18**). In Art. 12(3), second sentence, RPBA this principle was specifically applied to the statement of grounds of appeal and the reply.

On belated substantiation of an objection or defence, see chapters V.A.4.2.3m) and V.A.4.2.3o) below.

On the substantiation requirement and especially the question whether self-explanatory requests meet the requirements of Art. 12(3) RPBA, see chapter V.A.4.3.5b) and V.A.4.4.4c) (ii).

On case law on unsubstantiated requests under Art. 12(2) RPBA 2007, see CLB, 10th edn. 2022, V.A.5.12.6.

i) Requests reordered

Opinions have differed amongst the boards as to whether it can be considered an amendment to the appeal case if a request presented in the statement of grounds of appeal or the reply to the appeal is altered as a result of new higher-ranking requests being filed or the requests being reordered. For the same issue in the context of Art. 12(4) RPBA, see chapter V.A.4.2.2c) (vi). For the exercise of discretion under Art. 13(2) RPBA, see chapter V.A.4.5.4g).

In **T 2112/16** the sequence of the auxiliary requests had been changed during the course of the appeal proceedings due to the introduction of auxiliary request 1A, which contained an additional feature, which was not present in any of the lower-ranking auxiliary requests. In the board's view this involved a material change in focus of the claimed invention and thus resulted in an amendment of the case.

In **T 716/17** the patent proprietors substantially reordered their pending requests several times during the oral proceedings. This resulted in a repeated change in the subject-matter

to be discussed, since the auxiliary requests selected by the patent proprietors related to a variety of different and diverging attempts to find allowable subject-matter. The board considered that the reordering of pending requests carried out by the patent proprietors amounted to an amendment of the case, which needed to be justified according to Art. 13(2) RPBA. This requirement was not met.

In **T 1436/19** the appellant (patent proprietor) requested a few weeks before the oral proceedings to reorder the requests filed with the statement of grounds of appeal by renumbering the former auxiliary request 4 as new main request and the former main request and auxiliary requests 1 to 3 as new auxiliary requests 1 to 4 respectively. The appellant justified the proposed reordering by referring to the need for procedural economy in view of the preliminary opinion of the board stating that auxiliary request 4 was likely to overcome all the objections raised. The board decided that the reordering of the requests constituted an amendment to the appellant's appeal case and in exercise of its discretion under Art. 13(2) RPBA did not to take the amendment into account.

In **T 218/20**, however, the board did not see how merely changing the order of requests that were all filed with the reply to the grounds of appeal as a fair and appropriate reaction to developments in the first-instance proceedings, and which the parties and the board had had ample opportunity to consider, should mean that the much stricter provisions of Art. 13 RPBA had to apply for their admission. In the board's view, in the case in hand the subject of the proceedings and the issues raised had clearly not changed.

In **T 228/22** the appellant (proprietor) changed the order of requests in response to the board's preliminary opinion by promoting the most promising request to main request. The board noted that the changed ranking order would result in the auxiliary requests not being convergent with the new main request. However, it held that even if the changed order as a whole were an amendment to the appellant's case, this would not affect the discussion of the main request.

j) Procedural requests – requests for non-admittance of the other party's submissions

In **T 755/16** the board dealt with the admittance of the patent proprietor's request not to admit a document filed with the statement of grounds of appeal into the proceedings, the request having been filed for the first time during oral proceedings. The board observed that the patent proprietor had discussed two experiments contained in the document at issue in its reply to the grounds of appeal, but had objected to its admittance neither in its reply to the grounds of appeal nor in its subsequent letters. The request not to admit the document thus represented an amendment to the patent proprietor's case.

Furthermore, in case **T 18/21**, in which the opponent likewise did not request that the patent proprietor's submission (in this case the main request) not be admitted until the oral proceedings, at which point it had already been commented on in terms of merit during the written proceedings, the board considered this late procedural request to be an amendment to the previous case.

However, in **T 1006/21** the board interpreted the term amendment in Art. 12 and 13 RPBA more narrowly. According to the board, these provisions were directed at (claim) requests or (allegations of) facts and evidence, i.e. at **substantive** issues, objections and related arguments (see Art. 12(2) and (4) and Art. 13(1) and (2) RPBA). In contrast, **procedural** requests were not amendments within the meaning of Art. 12(4) and Art. 13(1) and (2) RPBA. The board explained that this conclusion applied to procedural requests on questions that had to be taken up ex officio as well as to other procedural requests. Such procedural requests could therefore be made at any time during the appeal proceedings.

The board in **T 1774/21**, however, saw it differently. In this case the appellant raised a new objection under Art. 123(2) EPC against a feature of the main request in its statement of grounds of appeal. The respondent, after having first replied to this objection with counter-arguments, requested only in its response to the board's communication under Art. 15(1) RPBA that it not be admitted into the proceedings. The board first explained that, in the context of the RPBA, the general term "requests" included requests for non-admittance of, for example, an objection. When the RPBA sought to specifically address the issue of amended texts of patent applications or patents, it expressly referred to "an amendment to a patent application or patent" (see Art. 12(4), fourth sentence, or Art. 13(1), fourth sentence, RPBA). This understanding was also confirmed in the Explanatory remarks to Art. 12(2) RPBA (see Supplementary publication 2, OJ 2020, 55). Therefore, a request for non-admittance of an objection constituted an amendment to the party's appeal case if it was not filed in the initial stage of the appeal proceedings.

Similarly, in **T 1230/22**, the board said that it did not share the view that requests for non-admittance of late submissions always had to be considered regardless of the stage of the proceedings. Contrary to the view expressed in **T 1006/21**, the board held that the admissibility of auxiliary requests, facts or arguments was not a purely procedural question, as it was for the admissibility of an appeal or the remittal of a case to the department that issued the decision. On the contrary, whether submissions were admissible was a question relating to the subject-matter of the case and so the basis for the decision to be taken. The board therefore concluded that, regardless of the procedural aspects, this was a substantive matter. If such a request for non-admittance of late submissions was filed late in the proceedings, it was also an amendment that had to meet the requirements under Art. 12 and 13 RPBA.

k) Amendment of the description

According to the board in **T 2178/17**, the filing of a description adapted to a set of claims found by a board of appeal to meet the requirements of the EPC does not generally constitute an amendment to a party's appeal case and is therefore not subject to the board's discretion under Art. 13(2) RPBA.

A different approach was, however, taken in **T 1968/18**, in which the board, referring to the systematic interpretation set out in **J 14/19**, held that the filing of an adapted description during the oral proceedings before the board resulted in an amendment of the patent proprietor's appeal case. At the same time, it considered that this procedural

situation constituted exceptional circumstances within the meaning of Art. 13(2) RPBA. See also chapter V.A.4.5.4o) on admittance of such an amendment.

l) Further developing arguments within the framework of the appeal case as submitted so far

In **T 247/20** the board held that an amendment to a party's appeal case was a submission which was not directed to the requests, facts, objections, arguments and evidence relied on by the party in its statement of grounds of appeal or its reply. In other words, it went **beyond the framework established therein** (see also **T 2988/18**). In the case in hand, the arguments which the appellant (proprietor) had presented during the oral proceedings and to which respondent 2 objected were all aimed at illustrating, refining or further developing the arguments already presented with the grounds of appeal and at countering the arguments made by respondent 2 in this context. To the extent that additional passages or figures were referred to, this merely served that purpose. The board noted that no additional pieces of evidence had been introduced and that both the patent and D1 were very concise documents. In view of the above, the board held that the arguments at issue did not amount to an amendment of the appellant's appeal case. The board added that **oral proceedings would serve no purpose** if the parties were limited to presenting a mere repetition of the arguments put forward in writing. Instead, parties had to be allowed to **refine their arguments**, and even to build on them, provided they stayed within the framework of the arguments, and of course the evidence, submitted in a timely fashion in the written proceedings.

In the following decisions too, the boards ruled that the submission in question was merely a further development in line with the appeal case up to that point, not an amendment as per Art. 13 RPBA.

In **T 1807/19** the board considered that the appellant's (opponent's) objection of lack of inventive step submitted one month before the oral proceedings against the subject-matter of claim 1 of auxiliary request I did not constitute an amendment to the appellant's case as this objection was essentially the same as the inventive-step objection raised against claim 1 of the patent as maintained by the opposition division. Along similar lines **T 907/20** and **T 2623/18**.

In **T 684/18** the board held that the opponent's appeal case had not been amended by new arguments and even associated documents filed in support of the view already taken in the grounds of appeal that the materials disclosed in D2 had the claimed relationship in terms of mechanical strength.

See also **T 315/19** (additional argument of the patent proprietor regarding the omission of a term from claim 1 of the main request considered as refinement of the arguments in the reply to the grounds of appeal) and **T 2833/19** (argument of the opponent regarding the de facto presence of two sub-ranges in a feature of claim 1 considered as refined illustration of previous line of argument).

Moreover, see **T 450/20** which draws conclusions for the issue of whether a refinement of objections can be a reason for filing new claim requests (see chapter V.A.4.5.4f) below).

A new attack starting from a different example (relating to a different object) in the same document is neither a refinement nor further development (**T 711/21**). Moreover, further development needs to be distinguished from fleshing out previously not adequately substantiated submissions (see chapter V.A.4.2.3m)).

m) Belated substantiation of objections

Substantiating a previously unsubstantiated objection does not qualify as a mere refinement but constitutes an amendment to the appeal case (see e.g. **T 2117/18** in which the board, referring to case law on unsubstantiated requests, also held that an objection becomes effective only when sufficient substantiation is provided).

In **T 2253/16** the board found that the appellant's (opponent's) submissions in its grounds of appeal in support of its contention that D4 was novelty destroying were not adequately substantiated and therefore could not be considered (Art. 12(3) RPBA and Art. 12(4) RPBA 2007). In particular, there was no analysis of D4 showing where the appellant considered which claim features to have been disclosed. At the oral proceedings, the appellant wanted to present the case on D4 it had made in the opposition proceedings but not included in its grounds of appeal. However, the board considered that fleshing out its incomplete appeal case in this way would amount to amending it.

In **T 1217/17** the board decided to disregard several lines of argument merely mentioned but not adequately substantiated in the reply to the appeal. At the oral proceedings, the respondent (opponent) announced that it would be "expanding" on these arguments. The board however found that, for those lines of argument for which the reply merely referred to arguments put forward in the opposition proceedings, any submissions at the oral proceedings would have to be regarded as forming an entirely new appeal case. As to the other lines of argument, the board observed that the respondent's reply did not set out a logical chain of arguments as regards lack of inventive step, so any submissions on this point too would amount to a change in the substance of its appeal case. The announced submissions were not merely new arguments but also new facts, e.g. the features analysis missing from the reply and the detailing of the specific passages in the adduced evidence that the respondent regarded as destroying the novelty of claim 1.

For further cases where the boards have held that the later substantiation of an unsubstantiated objection constitutes an amendment within the meaning of Art. 13 RPBA, see **T 329/16** (no inventive step arguments raised by the opponent despite extensive novelty arguments from the patent proprietor in its statement of grounds of appeal), **T 988/17** (one attack substantiated in the reply, but attack starting from D1 substantiated only in that it "does not lead to a different assessment"), **T 1903/17** (reference to unsubstantiated arguments in the notice of opposition on the asserted lack of reproducibility of pending claims), **T 2200/17** (mere reference to notice of opposition in the grounds of appeal), **T 1436/18** (submissions of the appellant 2-opponent on inventive step too vague and general).

n) New objection based on documents already on file – new assertions of fact

(i) Requirement to make new assertions of fact in due time

The board in **T 482/18** disagreed with the finding reached in **T 1914/12** that facts apparent from the patent documents on the case file (here: disclosure of "rod-shaped" in the application as filed and clarity of that term) were automatically at issue on appeal without having been expressly asserted. That position was at odds with the nature of **judicial proceedings**, such as those before the EPO boards of appeal, which were of the kind proper to an administrative court, since such proceedings involved deciding on a factually supported case and so depended on the **assertion of facts**. On the board's interpretation of "argument", see chapter V.A.4.2.3p). See also **T 250/19** (albeit dealing with this issue in the framework of Art. 12(4) RPBA 2007).

The Legal Board in **J 14/19** shared the view taken by the board in **T 482/18**. Observing that late-filed **submissions with factual elements** could be disregarded on the basis of Art. 114(2) EPC, it held that the simple fact that a party had already submitted a particular document on appeal did not mean that its entire content formed part of its appeal case. If it later relied on parts of that document other than those it had previously cited, that could amount to amending its appeal case. It further found that both a new combination of factual aspects and a new combination of factual and legal aspects were as a rule to be treated as an amendment to the appeal case. Such an amendment had to be distinguished from a mere **fine-tuning** of an existing line of argument (as in **T 247/20**; see the abstract in chapter V.A.4.2.3l)); on the Legal Board's interpretation of "arguments" within the meaning of Art. 12(2) RPBA, see also chapter V.A.4.2.3p). Followed e.g. in **T 1161/20** (new facts asserted in relation to knowing which parts of the device of D15 disclose the features of the invention).

(ii) New lack of inventive step objection

In **T 1042/18**, the board endorsed the view in **J 14/19**, according to which both a new combination of facts (e.g. selecting a different citation or a different passage of a citation as the starting point for an objection) and a new combination of facts and law (e.g. referring to a document or passage in a different legal context) constituted an amendment to the appeal case. Therefore, in the board's opinion, an inventive step objection raised for the first time at the oral proceedings before the board starting from a **citation that had previously only been invoked in relation to a novelty objection** generally constituted an amendment to the appeal case as per Art. 13(2) RPBA. See also **T 1851/21**.

In **T 2866/18** the board explained that the question of whether newly raised inventive step objections stayed within the same overall "factual and legal framework" as previous novelty objections was not decisive for the purpose of determining what constituted an amendment of the appeal case (see **T 2360/17**).

T 2796/17 and **T 557/21** are further decisions in which new objections under Art. 56 EPC based on citations that were already part of the proceedings were regarded as an amendment to the appeal case.

(iii) New combination of documents

In **T 187/18** the board held that a new combination of documents (already cited as part of the appellant's inventive-step attack, but in different combinations) was not a mere elaboration on a previously pleaded line of argument, but a change to the party's case.

(iv) New added-matter objection

In **T 1707/16** it was only at the oral proceedings before the board that the appellant (opponent) – for the first time in either the opposition or the appeal proceedings – raised the objection that the feature at issue in claim 1 of the main request was not disclosed in figure 9, whereas it had previously argued that claim 1 contained an intermediate generalisation as the feature at issue was inextricably linked to the remaining features of the embodiment of figure 9. The board, however, considered that the question of whether or not figure 9 unambiguously disclosed the feature in question completely changed the framework of the discussion relating to Art. 123(2) EPC and therefore regarded it as an amendment to the party's case.

o) New defence and belated substantiation of a defence

(i) New defence vs elaboration on arguments already on file

In **T 1108/16** the respondent (patent proprietor) countered the inventive-step objection raised in the grounds of appeal only after receiving the communication under Art. 15(1) RPBA, by submitting arguments as to why taking the cited prior art documents together could not render the combination of features in claim 1 of its main request obvious. On the admissibility of these late-filed arguments, it contended that they had to be regarded as a natural elaboration on arguments in its reply, which already included a detailed analysis of the documents' content from which it directly followed that their teachings were essentially incompatible. The board, however, pointed out that, especially in adversarial opposition-appeal proceedings, it was essentially bound in its assessment of the factual and legal circumstances by the case made by each of the parties. Accordingly, it was not – and could not be – up to it to piece together itself from that case arguments a party had not expressly set out in defence of its patent. The new submissions in this case had to be regarded as an amendment.

(ii) Assertions containing new factual elements

In **T 2803/18** the board decided pursuant to Art. 13(2) RPBA not to take into account the respondent's (patent proprietor's) assertion of a distinguishing feature. Contesting that the feature was disclosed in D2 introduced a new factual element into the proceedings and therefore constituted an amendment to the respondent's appeal case. See also **T 791/17**.

In **T 121/20**, in order to counter the objection that claim 1 of the main request encompassed an embodiment which was not originally disclosed, the respondent (patent proprietor) invoked for the first time on appeal a different interpretation of a certain term in the claims. The board held that even if this new argument was submitted in the framework

of the same objection and the same features, it amounted to a new interpretation of the claim being based on **new facts** (different passages in the description) and thus changed the respondent's case.

In **T 203/20** auxiliary request 9 had been filed with the statement of grounds of appeal, but only during oral proceedings did the appellant (proprietor) argue that the subject-matter claimed was entitled to the priority claimed by the patent. The board held that these submissions consisted of both new allegations of fact as well as new arguments in law, and represented an amendment to the patent proprietor's case.

In **T 19/20** a new line of defence against an objection under Art. 123(3) EPC was brought forward for the first time at the oral proceedings before the board. Whereas the respondent (patent proprietor) had previously argued that the deleted part was an added undisclosed feature without any technical meaning, it argued at the oral proceedings that the deletion of a feature did not change the scope of claim 1 because it was implicitly limited by this feature in view of the description. The board held that this new line of defence raised new legal and technical issues and thus constituted a change of the legal and factual framework of the appeal.

For a further decision discussing whether a new defence comprised a new allegation of fact and thus amounted to an amendment to the party's appeal case, see e.g. **T 1303/18** (summarised above in chapter V.A.4.2.3p)).

(iii) New experimental data

In **T 2271/17** the respondent (patent proprietor) argued that the late-filed experimental data was fully in line with its position regarding inventive step set out earlier in written appeal proceedings and therefore not an amendment to its case. The board however clarified that by arguing that the experimental data demonstrated a specific effect, the respondent indicted that the data was relevant in the assessment of inventive step and the formulation of the objective technical problem. Consequently, the filing of the experimental data could only be understood as an amendment to the respondent's appeal case.

(iv) Belated substantiation of a defence

In **T 2752/19** the board considered that the new line of argument, brought forward by the appellant (applicant) during the oral proceedings before the board, went beyond a mere refinement of the arguments submitted in the statement of grounds of appeal. In these initial submissions the appellant had argued without further substantiation that D2 neither disclosed nor suggested the combined features of claim 1 of the sole request. Therefore, the new line of argument constituted an amendment to the appellant's appeal case.

p) Submissions concerning interpretation of the law

In **T 2988/18** the board observed that there was no definition of the term "argument" in the RPBA. In **G 4/92** (OJ 1994, 149) the Enlarged Board had contrasted arguments with grounds or evidence and suggested that arguments "are reasons based on the facts and

evidence which have already been put forward". In the board's view, this left open the question whether the type of argument made by the appellant, namely one which concerned the Enlarged Board's interpretation of Art. 123(2) EPC in **G 1/93** (OJ 1994, 541), also fell under the ambit of Art. 13(2) RPBA. The board explained that arguments pertaining to interpretation of the law were generally accepted **at any stage of the proceedings** (with reference being made to sources of German and English law). This had been recognised in the explanatory remarks to the RPBA (in its version which entered into force on 1 January 2020), according to which submissions of a party which concerned the interpretation of the law were not an amendment (Supplementary publication 2, OJ 2020, 56). The board concurred with this view. It further noted that the appellant's argument was essentially that the principle set out in Headnote 2 of **G 1/93** applied to the present case. This was precisely what was meant by the passage of the explanatory remarks to the RPBA referred to above, because an argument about the interpretation of the law would naturally concern how that interpretation applied to the facts of the case before the board. For an example where the appellant's submissions related to the interpretation of Art. 56 EPC, specifically to case law on the application of the problem-solution approach, see **T 325/16**.

In **T 482/18** the board endorsed the view taken in **T 1914/12** that the boards did not have any discretion when it came to admitting late-filed arguments based on facts already at issue in the proceedings, on the ground that Art. 114(2) EPC 1973 (identical to Art. 114(2) EPC) did not provide a basis for rejecting arguments. Nevertheless, it interpreted "argument" narrowly, treating the term as equivalent to submissions concerning interpretation of the law.

In **J 14/19** the Legal Board, noting that late-filed submissions with factual elements could be disregarded under Art. 114(2) EPC, held that "**arguments**" in Art. 12(2) RPBA had to be interpreted in such a way that the meaning arrived at was in line with Art. 114(2) EPC. Submissions of a party as to how the law should be interpreted did not have a factual dimension. Such **submissions concerning only interpretation of the law** were therefore not covered by the term "arguments" in Art. 12(2) RPBA, which instead referred to submissions with both factual and legal elements, of the kind as a rule made in relation to patentability issues. The Legal Board thus concluded that submissions concerning only interpretation of the law did not result in an amendment within the meaning of Art. 12(4) RPBA. Ultimately, this conclusion was confirmed by the explanatory remarks on Art. 12(4) RPBA (CA/3/19, point 54 and related part of table in section VI, explanatory notes on Art. 12(4) RPBA), and it applied by analogy to Art. 13(1) and (2) RPBA too.

In **T 1303/18** the board did not admit into the proceedings the appellant's defence (raised for the first time after the filing of the grounds of appeal and the replies) relying on entitlement to partial priority, pursuant to Art. 13(1) RPBA and Art. 12(2), (4) RPBA 2007. The board held that the new defence by which a right to partial priority was invoked was not merely a presentation of a new argument pertaining to the interpretation of law but comprised a new allegation of fact. Indeed, it would have involved a new factual assessment of the subject-matter of claim 1 as granted and of priority application D49.

In **T 116/18** (28 July 2023) the board decided at the oral proceedings not to admit the respondent's (patent proprietor's) submission that the facts underlying **T 873/21** were analogous to the facts under consideration in the case in hand, so that, based on that decision, the effect demonstrated in D21 could be relied on. In the board's view, a distinction had to be made between an interpretation of the law based on a previous decision by the boards of appeal, on the one hand, and a reference to the specific factual and legal assessments of this previous decision and the allegation that this factual situation was the same as in the case pending before the board, on the other hand. As regards the interpretation of the law, the board explained that the boards had to examine the relevant case law ex officio. If there was a contradiction between the interpretation of the EPC the board intended to follow in the case pending before it and the interpretation adopted in the earlier decision, the board had to explain the reason for its deviation. As regards the second type of submissions, the board underlined that such a submission contained both a statement of fact and its legal qualification. In order for the board to deal with such a submission, it had to examine the factual situation on which the earlier decision was based and assess whether it was similar to the one underlying the pending case. For these reasons, such a submission included a new allegation of fact and thus constituted an amendment to the respondent's appeal case.

q) Information supporting oral submissions

In **T 247/20** the appellant (patent proprietor) filed slides containing figures illustrating its interpretation of relevant processes of the patent and D1 two months before the oral proceedings. The board did not regard these figures as evidence, or a change in the appellant's appeal case, but as supporting information for the appellant's oral presentation, albeit filed in advance of the oral proceedings.

r) Translation filed later

In **T 1554/16** the appellant (opponent) had attached a translation of a Japanese patent specification to its grounds of appeal. Later, after receiving the summons to oral proceedings, it also filed a translation of the related patent application. For the board, the later translation was not an amendment to the appeal case within the meaning of Art. 13(1) RPBA, because a Japanese patent specification usually did not contain any teaching going beyond the original disclosure in the application and so the opponent's line of argument had already been clear from the translation of the specification.

In **T 1795/19**, the board held that presenting a different machine translation of a citation constituted an amendment to the opponent's case. If the translation were admitted, the patent proprietor and the board would have to deal with altered and potentially entirely new facts for which they could not prepare before the oral proceedings.

s) Late assertion of a breach of the right to be heard

In **T 545/18** the appellant argued for the first time at the oral proceedings that the fact that the inventive step was not discussed at the oral proceedings before the examining division (as noted in the statement of grounds of appeal), although Art. 56 EPC was one of the

grounds for refusing the application, amounted to a violation of its right to be heard. The board considered this to be an amendment of the appellant's case, but held that there were exceptional circumstances within the meaning of Art. 13(2) RPBA.

4.3. First level of the convergent approach – submissions in the grounds of appeal and the reply – Article 12(3) to (6) RPBA

4.3.1 Principles

According to established case law the appeal proceedings should normally be based on the facts, evidence and requests which led to the decision under appeal (see e.g. **J 12/18**, referring to CLB, 9th edn. 2019, V.A.4.11.1). This principle is reflected in Art. 12(2) RPBA, which states that, in view of the primary object of the appeal proceedings to review the decision under appeal in a judicial manner, a party's appeal case must be directed to the requests, facts, objections, arguments and evidence on which the decision under appeal was based.

Article 12(4) RPBA implements the first level of the convergent approach (see CA/3/19, section VI, explanatory remarks on Art. 12(4) RPBA, Supplementary publication 2, OJ 2020, 56). According to Art. 12(4), first sentence, RPBA, parts of a party's appeal case which do not meet the requirements in Art. 12(2) RPBA are in general regarded as an amendment. It is not an "amendment", however, if the party demonstrates that the parts not meeting those requirements were admissibly raised and maintained in the proceedings leading to the decision under appeal. For decisions on the issue of what is considered an amendment under Art. 12(4) RPBA, see chapter V.A.4.2.2 above. Any amendment may be admitted only at the discretion of the board (Art. 12(4), second sentence, RPBA).

In **T 1776/18** the board referred to Art. 114(2) EPC and explained that any submission which has not been made during the first-instance proceedings is in the appeal proceedings considered not to have been submitted in due time within the meaning of this article. Considerations such as whether a party could not have adequately reacted to a request or document filed at a late stage of the first-instance proceedings did not determine whether a submission was late-filed, but were instead relevant to the question of how a board should exercise its discretion (see also CA/3/19, pages 35 and 36, explanatory remarks on Art. 12(4) RPBA).

The requirement that the statement of grounds of appeal and the reply thereto should contain the party's complete case is laid down in Art. 12(3) RPBA (expressed by substantially identical wording to Art. 12(2) RPBA 2007, as noted in **T 1533/15**). Under Art. 12(5) RPBA, the board has discretion not to admit any part of a submission by a party which does not meet the requirements in Art. 12(3) RPBA (see chapter V.A.4.3.5d) "Discretion under Art. 12(5) RPBA" below).

This requirement to provide substantiation also applies to submissions (e.g. requests, see **T 534/21**) on which the contested decision is based. However, to cover the case law on Art. 12(3) and (5) RPBA in the context of other provisions in Art. 12 and 13 RPBA,

decisions on this requirement are presented in this chapter V.A.4, even if they do not relate to "new submissions on appeal".

Article 12(6), first sentence, RPBA concerns the admittance of submissions which were not admitted in the proceedings at first instance (see chapter V.A.4.3.6 below). Here again, this provision does not only apply to new submissions in appeal proceedings but will nevertheless be covered in this chapter V.A.4 in the overall context of Art. 12 and 13 RPBA.

Article 12(6), second sentence, RPBA relates to submissions which could and should have been submitted during the proceedings at first instance, or were no longer maintained during those proceedings, thereby preventing the department of first instance from taking a decision on them (see chapter V.A.4.3.7 below). According to the explanatory remarks in CA/3/19 on Art. 12(6) RPBA, its first and second sentences reflect established case law on Art. 12(4) RPBA 2007 (see **T 791/20**; on this case law, see also CLB, 10th edn. 2022, V.A.5.11 "Article 12(4) RPBA 2007").

Article 12(6), second sentence, RPBA (just as Art. 12(4) RPBA 2007 before) expresses and codifies the principle that each party should submit all facts, evidence, arguments and requests that appear relevant as early as possible so as to ensure a fair, speedy and efficient procedure. An appellant is not at liberty to bring about the shifting of its case to the appeal proceedings as it pleases, and so compel the board either to give a first ruling on the critical issues or to remit the case to the opposition division. Conceding such freedom to an appellant would run counter to orderly and efficient opposition-appeal proceedings. In effect, it would allow a kind of "forum shopping" which would jeopardise the proper distribution of functions between the departments of first instance and the boards of appeal and would be unacceptable for procedural economy generally. See **T 101/17**, citing **T 162/09** and **T 1848/12**, and **T 878/21**.

The requirements of the first level of the convergent approach – i.e. those set out in Art. 12(4) to (6) RPBA – apply **throughout the appeal proceedings**, i.e. also at the stages of the appeal proceedings which are governed by Art. 13(1) and (2) RPBA (see chapter V.A.4.1.2).

4.3.2 Transitional provisions

For summaries of decisions in which the transitional provisions of Art. 25 RPBA were applied (in particular of **J 12/18** and **T 1533/15**), see CLB, 10th edn. 2022, V.A.4.3.2.

4.3.3 Amendment within the meaning of Article 12(4) RPBA

It is at a board's discretion whether to admit an amendment within the meaning of Art. 12(4) RPBA. On the definition of "amendment" in this context, see chapter V.A.4.2.2 "First level of the convergent approach: amendments to a party's case – Article 12(4) RPBA".

4.3.4 Discretion under Article 12(4) RPBA

a) Principles

Pursuant to the non-exhaustive list of criteria in Art. 12(4), fifth sentence, RPBA, the boards are to exercise their discretion in view of, inter alia, the complexity of the amendment, the suitability of the amendment to address the issues which led to the decision under appeal, and the need for procedural economy.

As a further criterion, the boards have considered whether the submissions on appeal should have been filed earlier or whether – on the contrary – they were filed at the first opportunity, i.e. could be justified as a legitimate reaction to late developments in the proceedings leading to the decision under appeal. See e.g. **T 121/20**, **T 864/20**, **T 3240/19** and **T 3248/19**, which partly refer to Art. 12(6) RPBA in this context, as well as **T 73/20**, which additionally refers to the requirement in Art. 12(4), third sentence, RPBA according to which the party shall inter alia provide reasons for submitting the amendments in the appeal proceedings.

Other factors taken into account by the boards when exercising their discretion include whether the party's case takes account of the primary object of the appeal proceedings to review the contested decision in a judicial manner (see e.g. **T 1963/20**), and whether it would seem appropriate to defer dealing with a citation until any subsequent revocation proceedings, albeit without giving this factor the same importance as the criteria in Art. 12(4) RPBA (**T 1657/20**).

The decisions summarised in this sub-chapter are reported under the heading of one of these criteria but their assessment was usually based on an overall consideration of several factors. See e.g. **T 3240/19**, **T 3248/19**, **T 121/20**, **T 868/20**, **T 869/20**, **T 1516/20**, **T 1617/20**, **T 1821/20**).

Whether the boards have discretion to exclude submissions which form part of the appeal proceedings under Art. 12(2) RPBA is debatable. In many decisions the boards have considered that there is no legal basis for excluding submissions (such as prior art documents) from the appeal proceedings which had been admitted into the proceedings by the opposition division (see e.g. **T 617/16**, **T 2337/16**, **T 449/21**). In other decisions the boards have held that they review such discretionary decisions, albeit only in a limited way (see e.g. **T 2055/20**, with reference to CLB, 10th edn. 2022, V.A.3.4.1.b) and to **G 7/93**, OJ 1994, 775).

b) Requirement to identify each amendment to the case and provide reasons for timing of submission – Article 12(4), third sentence, RPBA

In **T 28/20** the appellant did not explain why a new inventive-step objection (based on a different closest prior art) was first raised on appeal. The board, considering that the requirements of Art. 12(4) RPBA were not fulfilled, made use of its discretion pursuant to Art. 12(4) RPBA not to admit this new objection into the proceedings.

In **T 73/20** the appellant argued for the first time in the statement of grounds of appeal that there was a technical prejudice in the art against combining the teachings of D1 and D2. It neither identified the amendment to its case nor provided reasons for submitting it only in the appeal proceedings. As this submission could not be justified as a legitimate reaction to late developments in the opposition proceedings and created a new situation on appeal, the board exercised its discretion not to admit the new argument.

See also the ex parte case **T 2030/21**, in which the board underlined that the statement of grounds of appeal should also have explained why it had not been necessary to file the claim request already in the first-instance proceedings (cf. Art. 12(6), second sentence, RPBA).

c) Requirement to indicate the basis for amendments to the patent application or patent in the application as filed and to provide reasons why the amendment overcomes the objections raised – Article 12(4), fourth sentence, RPBA

In **T 32/16** the respondent's response to the board's preliminary opinion contained amended claim requests and a statement from where the amendment was taken. The board noted that the introduced terminology was an explicit recitation of the language used in the application as filed. Demonstration of how these amendments overcame the objection in this particular case, where the lacking features as such had at least already been identified by the appellant, was thus **self-evident** in the amendments made. See also **T 498/21**.

A counter-example is decision **T 890/21**, in which auxiliary request 8, submitted with the reply to the appellant's (opponent's) statement of grounds of appeal, was not admitted into the appeal proceedings. In this request the product claims 1 - 5 had been deleted, but the respondent's reply did not contain any reasons why the **remaining claims** overcame the objections succeeding against the product claims and the board could not recognise the suitability of the amendment for addressing these objections.

Presenting the board with references to a **large number of text passages** with no specific explanations as to how the skilled reader would directly and unambiguously derive the claimed subject-matter from the application as filed is contrary to Art. 12(4), fourth sentence, RPBA (**T 864/20**).

In **T 248/22** the board recalled that, in exercising its discretion under Art. 12(4) RPBA, it had to consider whether the amendment was suitable for addressing the objections **raised**. However, in the case in hand, the proprietor had referred to an objection which was not part of the decision under appeal or the appeal proceedings. The objection had neither been admitted by the opposition division nor maintained on appeal by the opponent. The board held that a reason as to why an amendment overcame an **unraised** objection did not constitute a valid reason for admitting an amended request in view of Art. 12(4) RPBA.

d) Complexity of amendment

(i) New submissions not admitted

In **J 3/20** the appellant (applicant) presented a completely fresh case concerning R. 139 EPC with the statement of grounds of appeal. The Legal Board considered that these submissions would imply complex legal and factual issues which were not addressed in the decision under appeal and would thus contradict procedural economy. The Legal Board therefore used its discretion not to admit these submissions into the appeal proceedings.

In **T 652/20** the appellant raised for the first time in its statement of grounds of appeal an objection of lack of novelty over example 12 of E3 based on the argument that chitin (not only fibroin as previously alleged) anticipated a certain feature of granted claim 1. The board observed that this new reasoning raised an entirely new discussion regarding the properties of chitin. It therefore did not address the reasoning of the first instance decision as such, but merely the conclusion thereof. Moreover, in the board's view, this new discussion would have introduced complexity and hence been against procedural economy. Accordingly, the new reasoning and the supporting evidence were not admitted into the appeal proceedings.

(ii) New submissions admitted

In **T 3272/19** of 11 February 2021 D14, filed with the statement of grounds of appeal, consisted of a single table comprising a list of molecular weights which corresponded to a feature specified in operative claim 1. The board observed that D14 was not only **easy to understand** but also related to a feature which was essential for the outcome of the decision under appeal. It also noted that the appellant's (opponent's) arguments based on D14 were in support of the **same line of attack** as the one used during the opposition proceedings. The board underlined that, although D14 could have been filed earlier (since the feature the list related to was already present in claim 1 as granted), it had been filed at the first opportunity in reaction to the decision under appeal. In view of these circumstances, D14 was admitted pursuant to Art. 12(4) RPBA.

For further examples where the amendment did not lead to any complex subject-matter and was admitted, see e.g. **T 1655/20** (ex parte, further limitation of the claim by deleting "particularly"), **T 1617/20** (inter partes, deletion of one sentence in the description), **T 1516/20** (inter partes, subject-matter of the claim limited by deleting a variant).

e) Suitability to address the issues leading to the decision under appeal

(i) Suitability of claim amendments

In **T 1655/20** (ex parte) the first auxiliary request, which was filed for the first time with the statement of the grounds of appeal, was an amendment to the party's case which could be admitted only at the discretion of the board (Art. 12(2) and (4) RPBA). The board considered that the amendment (deletion of "particularly", thereby rendering a feature

mandatory) resulted in a further limitation of the claim **in a genuine attempt** by the appellant (applicant) **to respond to the objection** of lack of novelty raised by the examining division in the decision under appeal. Furthermore, this amendment did not lead to any complex subject-matter and did not appear to introduce further issues which would negatively impact on procedural economy. In view of these reasons the board admitted the first auxiliary request into the appeal proceedings.

In **T 714/20** (ex parte) the board admitted the first auxiliary request filed with the grounds of appeal, which corresponded to the main request on which the decision under appeal was based with a further amendment to remedy a clarity objection noted in this decision. This amendment used **wording employed by the examining division** itself when construing the claim. The board therefore considered this to be an appropriate response to the grounds for refusal and admitted the request into the appeal proceedings (Art. 12(4) RPBA).

For further examples in which the amendment was considered suitable to address the issues leading to the decision under appeal and admitted into the proceedings, see **T 1617/20** (amendment to the description), **T 3038/19** (limitation to a single specific composition).

By contrast, suitability for addressing the issues raised in the first-instance proceedings was denied in the following cases.

In **T 1421/20** (ex parte) the board held that, while the amendments carried out in the auxiliary requests at issue may have addressed the objection of lack of clarity raised in the impugned decision, they **did not address another objection** equally raised by the examining division. The board decided not to admit these requests into the proceedings.

In **T 1897/20** (ex parte) claim 1 of the main request submitted with the statement of grounds of appeal had been amended by omitting certain features, inter alia one which the appellant considered to be well-known in the relevant prior art and thus not necessary to delimit the claims over the prior art. The board pointed out that the **omission of features** that were **known from the prior art** was typically not suitable to overcome objections concerning inventive step. Furthermore, the board held that admitting these requests would be contrary to the requirement of procedural economy.

In **T 726/20** the board held that the amendment made in claim 1 of auxiliary request 1 was **prima facie** not supported by the teaching of the application as originally filed. Therefore, in exercise of its discretion under Art. 12(4) RPBA, the board did not admit auxiliary request 1.

(ii) Suitability of a new defence or supporting evidence

In **J 3/20** the appellant invoked the principle of protection of legitimate expectations for the first time during oral proceedings before the Legal Board and alleged that it had trusted the content of a communication in a parallel case. The Legal Board saw no reasons that could justify why the appellant had presented the new defence and the underlying facts

for the first time at such a late stage of the proceedings, thereby counteracting principles of procedural economy. Moreover, the objection did not seem to be suited to address the issues which led to the decision under appeal as it would have introduced a **completely new aspect** on which the assessment and the reasoning in the appealed decision were not focused.

For a decision in which the board admitted new evidence supporting the proprietor's defence, see e.g. **T 1720/20**. In this case the opposition division had concluded that the priority document and the PCT application from which the contested patent derived were filed by different legal entities. The board admitted documents D14 and D15 (bibliographic data and translation), as they were considered suitable for addressing the issue of the identity of the applicant. A further example is **T 415/20**.

f) Need for procedural economy

In **T 1897/20** (ex parte) the board noted with regard to the main request and auxiliary request I that the omission of features that were known from the prior art was typically not suitable to overcome objections concerning inventive step. It also considered that admitting these requests would be contrary to the requirement of procedural economy, as it would possibly make it **necessary to remit the case** for further examination. See also **T 1780/20,** concerning an amendment of independent claims by introducing features from the description.

In **T 1785/20** (ex parte) the board noted, regarding procedural economy, that the amendments introduced a number of **new potential deficiencies** (namely issues of claim construction which prima facie suggested a lack of clarity) which would have to be addressed if the amendments were admitted.

For a further decision in which the board did not admit the relevant request as it was contrary to the requirement of procedural economy, see e.g. **T 1161/20**. For an example where admitting new attacks based on different closest prior art would have been against procedural economy, see **T 526/21**.

Counter-examples where the new requests did fulfil the needs of procedural economy can be found in **T 121/20** and **T 3240/19**. In both cases auxiliary requests were filed at the first opportunity, the amendments in question clearly addressed the objections and they did not give rise to further issues. See also **T 869/20** (inter partes, straightforward clarity objections).

In **T 1657/20**, the board admitted citation A8 into the appeal proceedings primarily because it was suitable for addressing the issues that had led to the contested decision. In other words, as set out by the board, the citation was prima facie relevant despite the opposition division's finding to the contrary. However, the board also considered the fact that the two other criteria specified in Art. 12(4), last sentence, RPBA did not prevent the citation being admitted. Moreover, in the circumstances, the board did not consider it to be an appropriate solution to defer the assessment of A8 until any subsequent national revocation proceedings, despite Art. 12(4) RPBA not actually directly governing this

aspect of **inter-institution procedural economy**. Since the list in said paragraph is not exhaustive, this aspect was taken into account, albeit with less importance than the other criteria.

g) Whether the submission should have been filed in first-instance proceedings – Article 12(6), second sentence, RPBA

In many decisions, the boards, when exercising their discretion under Art. 12(4), second sentence, RPBA, have relied, in addition to the criteria mentioned in that provision, on whether requests, facts, objections and evidence should have already been filed in the proceedings that led to the contested decision. In some cases, the boards have made reference to Art. 12(6) RPBA (**T 291/21**, **T 3240/19**, **T 886/21**) whereas in others they have made no such reference (**T 121/20**, **T 864/20**, **T 1288/21**). On occasion, they have also used slightly different wording, e.g. in **T 218/20**, **T 121/20**, **T 3272/19** (first opportunity to respond/to file amendments/documents) and **T 1085/20** (timely reaction).

These decisions are described in chapter V.A.4.3.7 together with the decisions in relation to Art. 12(6) RPBA.

h) Primary object of the appeal proceedings to review the decision under appeal

It is established case law, and has been explicitly confirmed in Art. 12(2) RPBA, that the primary object of the appeal proceedings is to review the decision under appeal in a judicial manner. The purpose of the appeal proceedings is not to give the party adversely affected by the decision under appeal a second opportunity to put forward a new case (**T 1881/19**).

The appeal procedure is neither a continuation of the examination procedure nor a second, parallel procedure for the applicant to use as it sees fit (**T 1120/20**). This is also true for inter partes proceedings. As a result, the appellant cannot try another way of reacting to the same objection on appeal; in particular the appellant cannot submit amended auxiliary requests which were not submitted during the opposition proceedings (**T 1441/21**).

This principle, which is closely linked to the issue of whether the submissions concerned should have been filed earlier (see e.g. **T 1456/20**), has also been taken into account by the boards when exercising their discretion under Art. 12(4) RPBA, as exemplified in the following paragraphs.

(i) Completely fresh case presented for the first time in the appeal proceedings

In **J 3/20** the Legal Board held that presenting a completely fresh case for the first time in the appeal proceedings is tantamount to treating the appeal as a new independent proceeding rather than as a judicial review based on the facts presented in the first instance. The appellant had submitted its request for a correction of the withdrawal of Great Britain as designated state and the facts underlying this request for the first time with the grounds of appeal. Moreover the submissions implied complex legal and factual issues which were not addressed in the decision under appeal and would thus contradict

procedural economy. Therefore the board used its discretion not to admit these submissions. See also **T 2061/19**.

(ii) Examination of subject-matter deliberately foregone

Reintroducing subject-matter the examination of which was deliberately foregone in the first-instance proceedings is at odds with the purpose of the appeal proceedings as a review instance, as stipulated in Art. 12(2) RPBA. Generally, therefore, any such requests are not to be admitted under Art. 12(6), second sentence, first half-sentence, RPBA (**T 1456/20**).

In **T 1456/20** the board held that auxiliary request 7 (which corresponded to one of the auxiliary requests filed with the reply) should already have been submitted in the opposition proceedings. The novelty objection it was designed to overcome had already been discussed at the oral proceedings before the opposition division but the patent proprietor had decided at the time to limit the claimed subject-matter in a certain way and thereby deliberately foregone an examination of subject-matter now reintroduced in auxiliary request 7. The board was not persuaded by the patent proprietor's argument that this approach could be justified by the aim of limiting the number of requests in the opposition proceedings. In the board's view, it was immaterial that the additional features were features of claims as granted.

In ex parte case **T 1120/20**, the applicant filed new requests with the statement of grounds of appeal on the grounds that they addressed clarity objections raised by the examining division. However, these objections had already been raised in several communications as well as in the annex to the summons to oral proceedings before the examining division. The applicant had not reacted with requests but had opted to defer the discussion until the appeal stage.

(iii) Failure to actively maintain objection at the oral proceedings

In **T 526/21** inventive step attacks starting from D24 and D34 were raised by appellant 1 (opponent 1) in writing during the opposition proceedings (in reply to the preliminary opinion). But they were not actively maintained at the oral proceedings before the opposition division. According to the minutes the three opponents agreed that D9 was the closest prior art and the proprietor argued that an example of D2 would be a better closest prior art. The choice between D2 and D9 was then discussed but no other document considered. Neither were the attacks based on D24 and D34 mentioned in the decision. The board concluded that these attacks did not form part of the appeal proceedings according to Art. 12(2) RPBA. In exercise of its discretion under Art. 12(4) RPBA, the board decided not to admit them into the appeal proceedings, as their implicit abandonment by appellant 1 had **prevented the decision from being based thereupon**. In the board's view a re-introduction of these attacks would be against the purpose of the appeal proceedings and procedural economy.

(iv) Requirement to immediately react to surprising developments

In **T 655/20** the board held that the opponent should have immediately reacted to a perceived surprising development in the proceedings putting it in an allegedly unexpected and disadvantageous situation. This would have allowed the opposition division to deal with the issue and decide on any request the opponent might have considered appropriate to submit. The opponent however did not request any additional measures during oral proceedings. Reacting to a change of stance taken by the opposition division in the interpretation of a feature for the first time in the statement of grounds of appeal – here by filing two new documents and an objection based on them – was contrary to the primary object of the appeal proceedings (Art. 12(2) RPBA) and contrary to procedural economy (Art. 12(4) RPBA).

(v) Cases in which the primary object of the appeal proceedings was met

In **T 1963/20** the board recalled that, in view of the primary object of appeal proceedings the intention was to review the correctness of the first-instance decision rather than to continue examination by other means (**G 10/93**, OJ 1995, 172, **T 980/08**, **T 65/11**). Whereas the main request and auxiliary requests 2 to 6 filed with the statement of grounds of appeal were not admitted into the appeal proceedings, as it was not apparent why the amendments could not have been submitted in the examination proceedings, request 7, which referred exclusively to the features encompassed by claim 9 of the request forming the basis of the impugned decision, was admitted. The restriction to this claim met the primary object of appeal proceedings, the amendments were not complex, and they clearly overcame the issues which had led to the decision under appeal.

In **T 1780/20** auxiliary requests 5 and 6 were identical to auxiliary request I and II which had been discussed during the oral proceedings before the examining division and for which the examining division provided an **obiter dictum** in its decision (the appellant having maintained only its main request). Consequently, as pointed out by the board, the appellant did not present a fresh case with these auxiliary requests; rather, the situation did not substantially differ from that described in Art. 12(2) RPBA. Therefore, the board admitted auxiliary requests 5 and 6 into the appeal proceedings.

i) Application of the principles expressed in Article 12(6) RPBA to amended requests or single claims

In ex parte case **T 714/20**, the main request was based on a request not maintained at first instance, with a further amendment to remedy a clarity objection noted in the decision under appeal. Similarly, the second auxiliary request corresponded to an auxiliary request underlying the decision under appeal, which had not been admitted by the examining division, again with a further amendment to remedy said clarity objection. The board noted that Art. 12(6) RPBA did not apply as such as the **non-maintained and non-admitted requests** had been **amended**. However, in the board's view the principles in Art. 12(6) RPBA for the admittance of non-maintained or non-admitted requests can be considered in the exercise of discretion under Art. 12(4) RPBA. As regards the main request, the board observed that the amendment which had been carried out as a response to the mentioned

clarity objection was unrelated to the amendment carried out at first instance when the non-maintained request was replaced. As regards the second auxiliary request, the board similarly observed that the amendment for clarity was unrelated to the reasons given for non-admittance of the corresponding first instance request. The board was further of the opinion that the discretionary decision of the examining division was taken in a reasonable manner. The requests were not admitted.

In **T 1161/20**, claim 1 of auxiliary request 1, submitted with the notice of appeal, corresponded to an independent claim of a request that had been filed on opposition but **withdrawn** during the oral proceedings before the opposition division. According to the board, the question arose as to whether Art. 12(6), second sentence, RPBA was applicable to the case in hand even though it was not auxiliary request 1 as a whole that corresponded to the request withdrawn on opposition but **only one independent claim**. The board noted that the reintroducing the claim was at odds with the aim of Art. 12(6), second sentence, RPBA. However, the board left said question open since, in the exercise of its discretion, it could take account of the criteria set out in Art. 12(4), fifth sentence, RPBA, as well as the principle set out in Art. 12(6), second sentence, RPBA (see **T 714/20**). The opposition division had been deprived of the chance to decide on the subject-matter of independent claim 1 of the auxiliary request 1 in question. Moreover, admitting such a request would run counter to the principle of procedural economy.

j) Convergence criterion

In **T 1456/20**, the board noted in the context of its decision regarding the admission of new requests under Art. 13(2) RPBA that the convergence criterion was an expression of procedural economy, non-compliance with which in certain parts of the proceedings, pursuant to Art. 12 and 13 RPBA, could lead to new requests not being admitted even if the opponent had not raised any objection to that effect.

By contrast, the board in **T 1516/20** did not take the convergence criterion into account when exercising its discretion under Art. 12(4) RPBA. The board had had to decide whether to admit a new auxiliary request filed with the statement of grounds of appeal. It admitted said request pursuant to Art. 12(4) RPBA since it considered the amendments in claim 1 to be a direct reaction to the opposition division's decision and since the amendments addressed the inventive step issue and further limited the claimed subject-matter through the deletion of a variant. Doing so did not lead to any complex amendments. The board further noted that the convergence criterion asserted by one of the respondents was not relevant.

k) No objection raised by opposing party

In **T 3272/19** of 11 February 2021 D9a and D13 had already been filed during the opposition proceedings, in reply to the preliminary opinion of the opposition division, but had not been decided upon in the contested decision. They were filed again by the respondent (proprietor) with its response to the statement of grounds of appeal. The appellant (opponent) explicitly indicated that they had no objection to the admittance of these documents into the proceedings. The board further took into account that D9a was

relied upon by both parties, in particular during the oral proceedings. The board found it appropriate to exercise its discretion pursuant to Art. 12(4) RPBA by admitting D9a and D13 into the proceedings. See also **T 2930/19**.

l) Obvious corrections in description

In **T 1444/20** the description of the main request (filed as auxiliary request 1 with the statement of grounds of appeal) contained insertions, in several occurrences, which in the board's view were obvious corrections under R. 139 EPC that did not contravene Art. 123(2) EPC. The board saw no reason to hold this request inadmissible under Art. 12 RPBA.

4.3.5 Incomplete case in grounds of appeal or reply – substantiation requirement – Article 12(3) and (5) RPBA

a) Principles

In accordance with the principles underlying the RPBA, the statement of grounds of appeal and any reply to it must contain the party's complete case (Art. 12(3) RPBA, essentially the same as Art. 12(2) RPBA 2007). The purpose of this provision – in both its revised and former versions – is to ensure **fair proceedings** for all parties and to enable the board to start working on the case **on the basis of each party's complete submissions** (**T 2610/16**, referring to CLB, 9th edn. 2019, V.A.4.12.5; see also **T 1904/16**, **T 113/18** and **T 319/18**).

The requirement to present a complete case stipulated by Art. 12(3) RPBA is not merely a rule of administrative convenience, but the expression of a fundamental principle of court proceedings (**T 2202/21**, see also **T 1776/18**, referring to this requirement as a general procedural principle underlying the EPC). As underlined in **T 321/21**, the substantiation requirement is not limited to the statement of grounds of appeal and the reply but must also be complied with for claim requests and objections filed later in the appeal proceedings.

This provision plays a role in both, the admissibility of the appeal (see chapter V.A.2.6.3h)) and in the admittance in the appeal proceedings of incomplete or unsubstantiated requests, facts, objections, arguments or evidence (see the decisions summarised in this chapter V.A.4.3.5).

This requirement to provide substantiation also applies to submissions on which the contested decision is based (see e.g. **T 559/20** and **T 534/21** for requests and **T 557/21** for objections). However, to cover the case law on Art. 12(3) and (5) RPBA in the context of other provisions in Art. 12 and 13 RPBA, decisions on this requirement are presented in this chapter V.A.4, even if they do not relate to "new submissions on appeal".

A **sweeping reference** by the **appellant** to its case in the first-instance proceedings is not sufficient to establish why the contested decision should be reversed. This approach is at odds with the appeal proceedings, in which, the appellant is obliged under Art. 108 EPC,

R. 99(2) EPC and Art. 12(3) RPBA, to present a complete case with its statement of grounds of appeal, one that would allow the board and the other parties to understand why the contested decision should be reversed without having to make any further investigations of their own (**T 706/17**; also set out in **T 2117/18** in relation to Art. 12(2) RPBA 2007, which was only amended slightly). See also **T 2457/16** and **T 1690/22** (the latter noting that this corresponds to long-standing and well-established case law of the boards of appeal; for details see chapter V.A.2.6.5 above).

The board in **T 1041/21** also deemed **sweeping references** made by the **respondent** (patent proprietor; the successful party in the first-instance proceedings) to its case in said proceedings to be inconsistent with the requirement of Art. 12(3) RPBA. See also **T 503/20**. On the other hand, see also **T 108/20**. For further details, see chapter V.A.4.3.5b) (iii).

The requirement under Art. 12(3) RPBA to be concise does not exempt the parties from the obligation to specify expressly all the requests, facts, objections, arguments and evidence relied on (see **T 2117/18**, **T 2872/19**, **T 1615/22**).

Regarding the **legal consequences of a failure to meet the complete case requirement**, new Art. 12(5) RPBA provides that a board has discretion not to admit any part of a submission on appeal which does not meet the requirements in Art. 12(3) RPBA. In **T 503/20**, the board pointed out that it had discretion to admit passages of the reply to the opposition referred to using their specific margin references and that this depended on the specific circumstances of the case in hand. These included whether the **impugned decision had been sufficiently discussed** and, if the points at issue were irrelevant for this decision, whether it was clear enough from both parties' complete cases which points were being pursued and on what specific basis, and how these related to the **opposing party's case**.

Providing the required substantiation for a previously unsubstantiated objection or request does not qualify as a mere refinement. Fleshing out an incomplete case at a later stage was considered as an amendment within the meaning of Art. 13 RPBA in e.g. **J 3/20**, **T 2227/15**, **T 326/16**, **T 1439/16**, **T 2796/17** (see also chapter V.A.4.2.3m) "Belated substantiation of objections"). In several decisions the boards have referred to Art. 12(3) RPBA when exercising their discretion under Art. 13(1) or (2) RPBA not to admit later submitted amendments of the appeal case (see e. g. **T 1439/16** and **T 1533/15**). On whether unsubstantiated requests or objections have been validly submitted in the first place, see below chapter V.A.4.3.5b) (v) and V.A.4.3.5c) (vi).

b) Incomplete appeal case – unsubstantiated requests – Article 12(3) RPBA

(i) Required degree of substantiation

In **T 1128/21** the board explained that the degree of substantiation required under Art. 12(3) RPBA depended on the specific circumstances of the particular case. As a rule, a patent proprietor filing an amended claim request had to specify expressly and precisely (i) the basis in the application as originally filed for each amendment, (ii) which objections

were intended to be overcome and (iii) reasons why the respective amendment would overcome the objections raised. These requirements were taken as a basis in the established case law for both Art. 12(3) RPBA and Art. 12(2) RPBA 2007 (see **T 319/18** and CLB, 10th edn. 2022, V.A.5.12.6). See also **T 1221/21**, **T 731/22** (see the summary in chapter V.A.4.3.5b) (ii)).

In **T 1220/21** the board added that, if a claim request was intended to overcome novelty or inventive step objections, the proprietor should identify the **relevant documents and the features** which distinguish the claimed subject-matter therefrom (see **T 1659/20**). It also held that the specific extent and detail of the explanations required depended on the level of **detail and accuracy of the objections** to be overcome.

The boards have emphasised in several decisions the need for the appellant (patent proprietor) to address the grounds underlying the contested decision (e.g. **T 559/20**, **T 430/20**).

Blanket reasoning can be tantamount to a complete lack of reasoning. In **T 559/20**, for example, the board held that the blanket reasoning that the auxiliary requests were more limited than the main request and therefore novel and inventive **for the same reason as the main request** was clearly not sufficient to justify the allowability of the auxiliary requests if the board found the main request not to be allowable. See also **T 437/20**, **T 309/21**, **T 2013/21**. Similarly, in **T 203/20** the appellant (proprietor) filed auxiliary request 9 with the statement of grounds of appeal, but failed to provide a substantiation as to **why** the amendments made would overcome objections against any higher-ranking request.

In **T 2202/21** the board held that merely identifying the additional differences to the prior art was not sufficient, the proprietor (appellant or respondent) also had to explain why these differences were considered inventive. See also **T 2532/17** (applying Art. 12(2) RPBA 2007).

In **T 1220/21** the board pointed out that without an explicit reference and explanation by the party, information that can only be found in attached documents cannot be regarded as sufficient substantiation pursuant to Art. 12(3) RPBA.

Equally strict substantiation requirements were also applied in cases where the opposition division had **rejected the opposition**:

In **T 1128/21**, justifying these strict requirements, the board referred to the provision of Art. 12(3) RPBA that each party must set out clearly and concisely the reasons why it is requested that the decision under appeal be reversed, amended or **upheld**, and specify expressly all the arguments relied on.

In **T 904/21** the board did not admit auxiliary request 4 (which was filed by the respondent – patent proprietor – with the reply to the statement of grounds of appeal and corresponded to an auxiliary request filed during opposition proceedings), as the respondent had failed to indicate in its submissions how the additional features could overcome the objection of lack of inventive step **raised by the appellant in its statement of grounds of appeal**.

See also **T 1959/19** (summarised in section (ii) below), **T 262/20**, **T 437/20**, **T 2202/21** and **T 312/22**.

The board in **T 1220/21** pointed out that the duty to provide a basis for the amendments did not depend on whether the allowability of the request had previously been contested under Art. 123(2) EPC.

In several decisions, the boards have found there was no lack of substantiation in cases where no explanation as to why amendments were filed was needed because the amendments were **self-explanatory** (e.g. **T 731/22**, **T 2964/18**). See however **T 1220/21**.

Sweeping references made by the appellant or respondent to its case in first-instance proceedings are inconsistent with the requirement of Art. 12(3) RPBA (see chapter V.A.4.3.5b) (iii) below and chapter V.A.2.6.5).

(ii) Self-explanatory amendments

In **T 731/22** the board began by confirming that, as a rule, a patent proprietor filing an amended claim request had to specify expressly and precisely the basis in the application as originally filed for each amendment, which objections were intended to be overcome and reasons why the respective amendment would overcome the objections raised. However, the necessary scope and level of detail of the explanations could not be determined in absolute terms but depended on the specific circumstances of the particular case. Furthermore, there was no lack of substantiation in cases where no explanation as to why amendments were filed was needed because the amendments were **self-explanatory** (see CLB, 10th edn. 2022, V.A.5.12.6). The board affirmed that this was so in the case in question because only a novelty objection had been raised and it was self-explanatory that the structural limitation was an attempt to restore novelty to the document concerned.

Likewise in **T 2964/18** the board considered the deletion of claim 1 in auxiliary request 4 to be self-explanatory in the sense that the board and the other party were in a position to understand which outstanding objections were meant to be overcome.

In **T 1959/19**, on the other hand, the board rejected the respondent's argument that the wording of auxiliary requests I to XVII (which had already been submitted in the opposition proceedings) made it clear why they met the requirements of the EPC, namely simply because these requests had been further distinguished from the prior art compared with the version as granted. In the board's view, the prior art from which the subject-matter had been distinguished was not immediately discernible. Likewise, in **T 319/18** and **T 1128/21** the boards did not consider that the purpose of the respective amendments in respect of overcoming the prevailing objections was self-explanatory. See also **T 262/20**

In **T 1220/21** the board took a different approach to self-explanatory requests. It held that an amended request that was self-explanatory nevertheless did not meet the standard as set out in Art. 12(3) RPBA, because an implicit argument did not meet the requirement that the party should expressly specify the arguments relied on (citing **T 2598/12**).

(iii) Reference to requests or supporting arguments filed at first instance

A **sweeping reference** by the **appellant** to its case in the first-instance proceedings was not sufficient to establish why the contested decision should be reversed. This approach is at odds with the appeal proceedings, in which, the appellant is obliged under Art. 108 EPC, R. 99(2) EPC and Art. 12(3) RPBA, to present a complete case with its statement of grounds of appeal, one that would allow the board and the other parties to understand why the contested decision should be reversed without having to make any further investigations of their own (**T 706/17**; also set out in **T 2117/18** in relation to Art. 12(2) RPBA 2007, which was only amended slightly). See also **T 2457/16** (sweeping reference to requests filed at first instance without any further details, thereby shifting the responsibility to select a request that might ultimately be allowable to the opponent and the board).

The board in **T 1041/21** also deemed **sweeping references** made by the **respondent** (patent proprietor; the successful party in the first-instance proceedings) to its case in said proceedings to be inconsistent with the requirement of Art. 12(3) RPBA. Referring to or merely repeating arguments made in the opposition proceedings did not make it immediately clear for either the board or the other party which objections raised by the appellant in its appeal against the main request had been remedied by the amendments made in the auxiliary requests, or to what extent and why.

In **T 503/20**, the board endorsed this view and referred to the wording of Art. 12(3) and (5) RPBA and the explanatory notes to Art. 12(5) RPBA (Supplementary publication 2, OJ 2020, 57), according to which a party is required to "specify expressly" all the requests, facts, etc. relied on.

On the other hand, see also **T 108/20**, in which the board took the view that if a party refers to a submission in the first-instance proceedings to which **no response was given**, a sweeping reference is sufficient for said submission to be part of the appeal proceedings.

(iv) Claims not presented in full

In **T 1421/20** requests 1a to 5a were introduced and commented on in the statement of the grounds of appeal but no claims were filed at that stage. Hence they did not fulfil the requirements of Art. 12(3) RPBA and the board had discretion not to admit them into the proceedings for this reason only (Art. 12(5) RPBA). Since the requests were not part of the decision under appeal, they were further considered to be amendments (Art. 12(2) and (4) RPBA).

(v) Whether unsubstantiated requests have been validly filed

The boards differ in opinion as to whether an unsubstantiated request is to be considered to have been validly submitted only at the time when sufficient substantiation was provided (see e.g. **T 319/18**, **T 1191/18** and **T 2117/18**) or whether an unsubstantiated request is merely not admitted under Art. 12(5) RPBA (see e.g. **T 2457/16**, **T 1128/21**, **T 1220/21**), and the later filed substantiation not admitted under Art. 13 RPBA. For further details, see

chapter V.A.4.2.3h). See also CLB, 10th edn. 2022, V.A.5.12.6 "Unsubstantiated requests" on the case law under the RPBA 2007.

In **T 321/21** the board discussed the two approaches to dealing with unsubstantiated requests and objections and pointed out that a main difference between the two approaches appeared to be whether or not a board had to take a formal admittance decision on a claim request or objection which it considered unsubstantiated.

c) Incomplete appeal case – unsubstantiated objections or defence – Article 12(3) RPBA

(i) Required degree of substantiation

Under Art. 12(3) RPBA, the appellant (opponent) has to set out clearly the reasons for requesting that the decision under appeal be reversed and **specify expressly all** facts, objections and evidence relied on. Attacking the decision only generally or referring generally to the case made in the opposition proceedings was not enough for this (**T 2796/17**).

In other words, in order to substantiate an objection in the appeal proceedings which the opposition division did not consider convincing, it is necessary to provide specific reasons why the finding and the reasoning in the decision under appeal are supposedly incorrect with regard to this objection. Arguments which have already been put forward in the opposition proceedings may be included in these reasons, but must be put in the context of the decision under appeal (**T 2117/18** applying the substantially identical Art. 12(2) RPBA 2007; see also **T 557/21**, **T 1079/22**, **T 266/23**).

The party has to present a logical and structured chain of arguments to support the alleged objection (e.g. **T 1217/17**, **T 2883/19**, **T 2649/22**).

In **T 2253/16** the only argument the appellant (opponent) had put forward in its grounds of appeal in support of its assertion that the subject-matter of claim 1 lacked novelty over D4 was that the contested decision contradicted itself on one of the features. The board observed that there was **no analysis of D4** showing where the appellant considered what claim features to be disclosed. Art. 12(3) RPBA required that the grounds of appeal contain the appellant's complete case. The board could not simply refer to the submissions made in the opposition proceedings, it being clear from Art. 12(3) RPBA that they were not automatically part of the appeal case. An unspecific reference to the notice of opposition made no difference; Art. 12(3) RPBA required that all facts and objections be specified expressly.

For further cases relating to insufficient substantiation of an objection, see e.g. **T 2227/15** (with regard to Art. 12(2) RPBA 2007, which, as the board noted, corresponds to Art. 12(3) RPBA), **T 565/16**, **T 1617/20**, **T 186/20**. In all these cases, there was no substantiation of why the opposition division's reasoning and conclusions should be found to be incorrect.

In **T 1695/21**, on the other hand, the board considered the substantiation of an objection under Art. 84 EPC as sufficient because the subject of the objection had been essentially apparent from the specific points in the minutes of the oral proceedings before the opposition division to which reference had been made.

However, see also **T 108/20** regarding sweeping references to a submission in the first-instance proceedings to which **no response was given** (objections against auxiliary request 3).

(ii) Failure to address auxiliary requests filed in opposition proceedings but not considered in the contested decision

According to the board in **T 664/20**, the statement of grounds of appeal of an appellant (opponent) had to include its entire case as regards all the requests pending before the opposition division, including those which were not considered in the contested decision. In this case, the appellant had produced documents from an additional search only after the proprietor had re-filed requests already submitted at the oral proceedings before the opposition division but not decided upon by it. As a result, the board decided not to admit these documents under Art. 12(3) and 13(1) RPBA.

For a different view, however, see **T 2035/16**. In a similar situation the board considered that the rejoinder had been the first opportunity for the opponent to respond to the introduction of the auxiliary request in appeal proceedings. According to the board, while it was true that the same request had been submitted to the opposition division, their decision had not dealt with it, and it had not been part of appeal proceedings until the proprietor had sought to make it so.

(iii) No requirement to address all dependent claims

In **T 750/18** the board held with regard to Art. 12(2) RPBA 2007 that presenting a complete case did not imply that an appellant-opponent, impugning a decision to maintain a patent in granted or amended form, had to raise objections against all the dependent claims. The appellant/opponent had to set out clearly and concisely the reasons why it requested that the decision under appeal be reversed. Objections against an independent claim found allowable by the opposition division were therefore sufficient to comply with this requirement.

(iv) Defence – reference to first instance submissions

In **T 503/20**, in which the respondent (patent proprietor) disputed an alleged public prior use, the board decided to take no account of the part of the case in the reply to the appeal that merely made a sweeping reference to the opposition case. The board justified this in particular on the grounds that the respondent had not discussed the decision in any way, even though the decision had spelled out why the public prior use was deemed to have been proven and which patentable features were deemed to have been disclosed as a result. The board noted that simply referring to the opposition case was not a substitute for appropriate substantiation in the appeal proceedings; it was imperative to present a

complete case as per Art. 12(3) RPBA, because it cannot be left to the board to investigate which of the arguments from the opposition proceedings might still be relevant in light of the contested decision and its findings (as in **T 1792/17** regarding RPBA 2007). By the same token, the board refused to admit the extracts from the reply to the opposition and the rejoinder in the opposition proceedings included in a later submission on appeal because they merely repeated the arguments from said earlier submissions word-for-word and the patent proprietor did not discuss the opposition division's findings any further. As already established in **T 1041/21**, it made no difference whether reference was made to said arguments or whether they were resubmitted without being adapted to the case.

(v) Case not fully prepared

In **J 3/20** the appellant invoked the principle of protection of legitimate expectations for the first time during oral proceedings before the Legal Board and alleged that it had trusted the content of a communication in a parallel case, which, however, it had already received in 2016. The Legal Board highlighted that the condition in Art. 12(3), first sentence, RPBA required a complete preparation **considering all the relevant documents that were available**. Thus, in its view, no reasons were apparent that could justify why the appellant had presented the new defence and the underlying facts for the first time at such a late stage of the proceedings, thereby counteracting principles of procedural economy.

(vi) Whether unsubstantiated objections have been validly filed

On the admission of new, unsubstantiated objections, see **T 321/21** (summarised in chapter V.A.4.2.3h)).

d) Discretion under Art. 12(5) RPBA

In **T 503/20** the board held that it had discretion whether to admit passages of the reply to the opposition which had been referred to using their specific margin references, and this depended on the specific circumstances of the case in hand. These included whether the **impugned decision had been discussed to a sufficient extent** and, if the points at issue were irrelevant for this decision, whether it was clear enough from both parties' complete submissions which points were being pursued for what specific reasons and how these relate to the opposing party's case.

In ex parte case **T 1421/20** requests were introduced and commented on in the statement of grounds of appeal, but no claims were filed, and so the board had discretion not to admit them under Art. 12(5) RPBA. The board took into account that the requests contained a feature which had previously been found to be unclear. Since none of the requests at issue met the requirement of clarity, the board exercised its discretion not to admit these requests.

For further cases in which the boards considered that the requirements of Art. 12(3) RPBA were not met and exercised their discretion under Art. 12(5) RPBA not to admit the part of the appeal submissions which did not meet these requirements, see e.g. **T 2457/16**, **T 430/20**, **T 640/20**, **T 1421/20**, **T 557/21**, **T 1041/21**.

In **T 1220/21** the board explained that the purpose of Art. 12(3) RPBA was to ensure that the relevant submissions were present in the proceedings as early as possible to enable the board and the other party(ies) to start working on the case on the basis of the parties' complete submissions without being forced to speculate on their intentions. The extent to which a lack of or an incomplete substantiation runs counter to this objective was a factor that could be taken into account when exercising the discretion under Art. 12(5) RPBA (**T 1659/20**). This included addressing the question of whether the amendments and the chain of logic underlying the claim requests were self-explanatory (which was not the case here). See also **T 658/22**.

4.3.6 Submissions not admitted at first instance – error in the use of discretion – Article 12(6), first sentence, RPBA

a) Principles

It is established case law that if a discretionary decision of the examining division or the opposition division not to admit submissions is challenged on appeal, it is not the task of the board to review all the facts and circumstances as if it were in the place of the opposition division and to decide whether or not it would have exercised discretion in the same way. The board should overrule the way in which the first instance division exercised its discretion only if it concludes that the division did so according to the wrong principles or without taking into account the right principles, or that it exercised its discretion in an unreasonable way and thus exceeded the proper limit of its discretion (for recent decisions see e. g. **T 222/16**, **T 879/18**, **T 1695/18**, **T 435/20**, **T 214/20**, **T 1017/20**, **T 1617/20**, **T 1004/21**, **T 1309/21**; not to be conflated with the review of a fact-finding process in first instance, see **T 1138/20**. However, see also **T 307/22**, according to which substantive findings on which the discretionary decision is based are open to review, at least in certain cases (here in the case of validly claimed priority); see also chapter V.A.3.4.1c).

This established case law on limited review of first-instance discretionary decisions, which had been developed in view of decision **G 7/93**, has been codified in Art. 12(6), first sentence, RPBA (**T 1617/20**). See also **T 214/20** and **T 435/20** noting that Art. 12(6) RPBA reflects this case law by referring to "an error in the use of discretion".

It is for the appellant to **demonstrate** that the opposition division erred in the exercise of its discretion (**T 726/20**). The same principle applies in ex parte appeal proceedings. In **T 1421/20**, for instance, auxiliary requests were filed in preparation for the oral proceedings before the examining division, which, exercising its discretion under R. 137(3) EPC, decided not to admit them into the proceedings as late filed and prima facie unclear. Since the appellant did not provide any arguments with respect to these requests on appeal, the board saw no reason to question the decision of the examining division and decided not to admit these requests into the appeal proceedings (Art. 12(6) RPBA).

Some of the case law handed down in application of Art. 12(6), first sentence, RPBA on whether there was an error in the exercise of discretion is summarised in the following sections to provide a general overview. On the discretionary criteria to be applied by the

first instance, see also chapter IV.B.2.4, for examination, and chapters IV.C.4.5 and IV.C.5.1.7 to IV.C.5.1.11, for opposition. On review of first instance discretionary decisions by the boards of appeal, see also chapters IV.C.4.5.2 and V.A.3.4.1).

If there was an error in the use of discretion (or it can no longer be determined whether any such error occurred), the proviso in Art. 12(6), first sentence, RPBA does not apply and the board exercises its own discretion (**T 1657/20**).

According to Art. 12(6), first sentence, RPBA, there are two criteria which can justify the admittance of the request under this provision: an **error** (of the first-instance department) **in the use of discretion** or the **circumstances of the appeal case** (**T 726/20**).

b) Whether a submission was late-filed

When applying Art. 12(6), second sentence, RPBA, the boards in opposition-appeal proceedings also review findings that a submission was late-filed and assess whether the opposition division had been right to conclude that the late filing was not justified.

In **T 214/20**, for instance, the board agreed with the opposition division that the documents which were filed by the proprietor to counter a certain argument of the opponent were to be considered late-filed because they should have been filed already when the argument was first raised.

Likewise in **T 1017/20**, the board found that the main request submitted at the oral proceedings was not justified by an unexpected turn of events and was thus late-filed. The opponent had already raised the objection which this late-filed main request allegedly sought to address, in the notice of opposition.

In **T 1445/22** the board underlined that evidence submitted by an opponent after the expiry of the nine-month period according to Art. 99(1) EPC was generally to be regarded as late-filed. Exceptions to this rule were where such evidence could not have been filed earlier, for example where the subject of the proceedings had changed. The question of whether submissions were filed in due time could not depend on circumstances external to the proceedings.

See chapter IV.C.5.1.4 for more detail on the late filing of main and auxiliary requests by the patent proprietor in opposition proceedings, and chapter IV.C.4.2 for more detail on the late filing of objections and evidence in the opposition proceedings.

c) Prima facie relevance of late-filed objections and evidence

Prima facie relevance is a recognised criterion for assessing the admissibility of late-filed objections in first instance opposition proceedings (see e.g. **T 2883/19**). In numerous decisions the boards held that the opposition division applying the prima facie relevance criterion had relied on the right principles and, in the case in hand, had applied them in a reasonable way (see e.g. **T 3166/19**, **T 415/20**, **T 687/20**, **T 803/21**, **T 214/20**).

T 1161/20 illustrates the importance of giving reasons as to why the opposition division's decision not to admit objections was incorrect.

(i) Party's disagreement with the result of the substantive assessment – not sufficient to demonstrate an error in the use of discretion

The mere disagreement by the party with the result of the substantive assessment by the opposition division is not sufficient to indicate an error in the use of the discretion. This was, for instance, underlined in **T 2883/19**. In the same decision, the board also pointed out that it was not apparent that the prima facie relevance evaluation of the added-matter objection at issue was based on **manifestly incorrect technical assumptions**. The board exercised its discretion under Art. 12(6) RPBA not to admit this objection into the appeal proceedings.

Similarly, in **T 61/21** the board did not accept the appellant's (opponent's) arguments according to which the opposition division, when deciding not to admit D10 as prima facie not relevant, had incorrectly placed excessive emphasis on the supposed remoteness of the document.

In **T 307/22**, however, the board reviewed the substantive basis (valid claim of priority) for a decision of the opposition division not to admit a citation. In the board's opinion, the opposition division had failed to recognise that the claimed invention had only partial priority. The board therefore exercised its own discretion. However, it too decided not to admit the citation in question (D7), on the basis that it lacked relevance for novelty. Its relevance for inventive step had been asserted by the appellant for the first time at the oral proceedings.

(ii) Insufficiently reasoned discretionary decision – error in the use of discretion

In **T 2055/20** the board found that the opposition division had provided in the written decision only an unreasoned statement for the non-admittance of auxiliary request 1 filed during the oral proceedings. In particular, no reasoning was provided as to why this request, prima facie, did not overcome this objection. Moreover, according to the minutes of the oral proceedings before the opposition division, when dealing with the admittance of said request, only issues of added subject-matter were raised and discussed with the parties. The board concluded that the opposition division's decision resulted from an error in the use of discretion and admitted the request into the proceedings.

In **T 1657/20**, the facts on which the opposition division had based its discretionary decision were not entirely apparent from the contested decision. In particular, the opposition division had substantiated the lack of prima facie relevance only in relation to claim 1 of the main request but not the broader claim 15. It was also debatable how rigorously the opposition division had assessed prima facie relevance for inventive step. Therefore, the board exercised its own discretion and admitted A8 into the appeal proceedings under Art. 12(4) and (6) RPBA.

See also **T 1324/21** (in-house information on publicly available tablets not irrelevant, as there was no basis to assume that the analysis of the pertinent feature would present skilled person with undue burden).

d) Prima facie allowability of a request

Prima facie allowability is an established criterion as regards admittance of requests in first-instance proceedings (**T 1081/20**). For a more detailed outline of the case law on this criterion, see chapter IV.C.5.1.7b).

In numerous decisions, the boards found no errors of discretion in opposition division decisions based on the criterion of a lack of prima facie allowability (or the criterion of a lack of prima facie suitability for overcoming the outstanding objections) (see e.g. **T 430/20**, **T 1017/20**, **T 1037/20**, **T 1081/20**). In many cases, the boards also used the expression of a lack of clear allowability (see e.g. **T 337/20**, **T 1556/20**, **T 1009/21**).

In **T 1037/20** the opposition division, in not admitting auxiliary request 3, made an error in the use of its discretion because it used the prima facie criterion, but did not explain **why** the request, prima facie, was not allowable.

e) Need for procedural economy – convergence

In **T 1411/21** the board held that the convergence (or the divergence) of requests is in principle an accepted criterion for deciding on the admissibility of requests under R. 137(3) EPC. It applied not only within a set of claims filed together but also with respect to earlier requests. In **T 3097/19**, however, the board (applying Art. 12(2) and (4) RPBA 2007) underlined that non-convergence of requests is, on its own, not a sufficient reason for non-admittance. It must be reasoned that and why non-convergent requests **affect procedural economy** in view of the particular circumstances of the case. See also **T 714/20** by the same board, in which it was pointed out that when oral proceedings before the examining division were imminent, it was legitimate to expect the claims of subsequent requests to converge, so that a focused discussion could be had.

In the inter-partes case **T 2204/18**, the board (applying Art. 12(4) RPBA 2007) held that the opposition division, which had relied on the convergence criterion among others, had exercised its discretion in accordance to the right principles in a reasonable way. See however **T 683/19**, in which the board (applying Art. 12(4) RPBA 2007) overruled a decision of the opposition division based on lack of convergence as the request at issue constituted a timely bona fide reaction to the admission of a new document by the opposition division.

f) Principles of fairness and equal treatment of parties

In **T 726/20** the board rejected the appellant's argument that the discretionary decision of the opposition division not to admit auxiliary request 1, filed during the oral proceedings, had suffered from an error. The opposition division had not admitted this request because it was late-filed and based on subject-matter not previously covered by the claims. In the

board's view, these reasons were in line with the case law (see CLB, 10th edn. 2022, IV.C. 5.1.4, in particular **T 2415/13**), which confirmed that claims can be amended during oral proceedings only in a manner that the opponent **could be expected to deal with** during the oral proceedings. This had the purpose of enabling all parties and the opposition division to prepare the case adequately, and of ensuring procedural fairness and efficiency.

In **T 1617/20** the board held that it resulted in an **inconsistent approach** to base the decision on admittance of auxiliary requests 1 and 2, both filed at the oral proceedings before the opposition division, on different criteria. Moreover, using the prima facie allowability criterion to object for the first time at oral proceedings to a feature of the late-filed claim request that was **already present in higher-ranking claim requests** and had **never** been **objected** to before went against the principles of fairness and good faith.

In **T 435/20** the board pointed out that in admitting the late-filed documents D64 to D80, including new evidence, into the proceedings but not admitting documents D81 to D90 filed in direct response, the opposition division had not respected the principles of procedural fairness and of equal treatment of the parties. The board also noted that the mere fact that the opposition division's preliminary opinion was positive for one party could not in itself justify not admitting any further documents by this party which were filed by the final date set by the opposition division for making written submission under R. 116(1) EPC.

g) Board's own discretion when the exercise of discretion by the department of first instance suffers from an error

In **T 1657/20**, the board exercised its own discretion since it could no longer be determined whether the discretion had been correctly exercised in the decision not to admit. Therefore, the proviso in Art. 12(6) RPBA that a board of appeal should not replace a correct first-instance discretionary decision by exercising its own discretion did not apply. In exercising its discretion, the board used the criteria of Art. 12(4), last sentence, RPBA.

h) Admittance justified by the circumstances of the appeal case

According to Art. 12(6), first sentence, RPBA there are two criteria which can justify the admittance of the request under this provision: an **error in the use of discretion** or the **circumstances of the appeal case** (**T 726/20**). Similarly **T 1017/20**. In the following cases, the boards, after finding that the non-admittance by the opposition division was not affected by an error, examined the question of whether admittance was justified by the circumstances of the appeal case.

In **T 1017/20** compliance of a previous main request with the requirements of Art. 100b) EPC had been discussed at the oral proceedings before the opposition division and denied by the opposition division and was the reason for the submission of the amended main request. The board held that, in this particular situation, the prima facie compliance of the main request on appeal with the provisions of Art. 100(b) EPC formed part of the circumstances of the appeal case that were to be considered for the purpose of applying

Art. 12(6) RPBA. However, since the main request prima facie did not solve the issue discussed at the oral proceedings, it was not admitted.

In **T 1589/21** the appellant (patent proprietor), in response to the preliminary opinion of the board, resubmitted requests that had not been admitted into the opposition proceedings. The appellant argued that since the board had a different opinion on added subject-matter from the opposition division, the appellant's situation had changed. However, the board did not find this argument persuasive, as in its preliminary opinion, it had merely agreed with the respondent on this issue. The respondent had raised this objection of added matter already in the notice of opposition and again in the reply to the appeal.

In **T 500/20** the board considered that there was no apparent error in the opposition division's exercise of discretion regarding the admittance of E18, which was resubmitted on appeal. The board also observed that the subject-matter of the case, i.e. the **claims** at issue, was **unchanged** and concluded in its preliminary opinion that there appeared to be no new circumstances of the case that could justify the admittance of the new document in question at this stage. Since this conclusion was not challenged, E18 was not admitted into the appeal proceedings.

In **T 1556/20** the board, having found that it could not recognise any error by the opposition division in the use of its discretion not to admit late-filed requests, noted that the circumstances of the appeal case were **not different** from those existing before the opposition division since the **disputed issues remained the same**. The board therefore decided not to admit these requests into the proceedings under Art. 12(6) RPBA.

In **T 290/20** document D6 had been filed by the opponent after the date set by the opposition division under R. 116 EPC and less than four weeks before the oral proceedings, according to the opponent in reaction to the proprietor's late filing of auxiliary request 4 (single independent claim directed to a process). The opposition division had not admitted D6 as it considered that this document could have been filed earlier and that it was not more relevant than other documents already in the proceedings. The board however admitted D6 into the proceedings. The filing of auxiliary request 4 shortly before the date of the oral proceedings before the opposition division, and the arguments brought forward by the proprietor in support of inventive step of claim 1 of that request, represented a **change in the course of the opposition proceedings**, which justified the filing of a new document as a reaction by the opponent.

i) Not covered by Article 12(6), first sentence, RPBA: submissions admitted at first instance

Submissions that have been admitted at first instance do not fall within the ambit of Art. 12(6) RPBA (as noted e.g. in **T 1193/21**). Whether the boards can review such decisions and exclude the submissions concerned from the appeal proceedings is a matter of discussion.

In many decisions the boards have considered that there is no legal basis for excluding documents from the appeal proceedings which had been (correctly) admitted into the

proceedings by the opposition division, especially when the impugned decision had been based on them (see e.g. **T 617/16**, **T 449/21**, **T 205/22**, **T 1005/22**, **T 527/22**). In numerous other decisions the boards have held that they review discretionary decisions, albeit only in a limited way (see e.g. **T 2055/20**, with reference to CLB, 10th edn. 2022, V.A.3.4.1.b) and to **G 7/93**, OJ 1994, 775). See also chapters V.A.3.4.1c) and V.A.3.4.4.

4.3.7 Submissions that should have been submitted or which were no longer maintained at first instance – Article 12(6), second sentence, RPBA

a) Principles

Art. 12(6), second sentence, RPBA implies that the submissions in question had not been submitted in first-instance. The test of Art. 12(6), second sentence, RPBA is therefore often applied in the framework of the exercise of discretion under Art. 12(4) RPBA. See e.g. **J 12/18**, **T 1081/20**, **T 3240/19**. Other decisions address this question without reference to Art. 12(4) RPBA. On the concept of amendment under Art. 12(2), (4) RPBA, see above chapter V.A.4.2.2. In **T 141/20**, the board deemed Art. 12(6) RPBA to be lex specialis in relation to Art. 12(4) RPBA.

Art. 12(6), second sentence, RPBA (just as Art. 12(4) RPBA 2007 before) expresses and codifies the principle that each party should submit all facts, evidence, arguments and requests that appear relevant as early as possible so as to ensure a fair, speedy and efficient procedure (**T 101/17**, citing **T 162/09** and **T 1848/12**; on the case law under Art. 12(4) RPBA 2007 and earlier case law, see CLB, 10th edn. 2022, V.A.5.1.2, V.A.5.11).

Reintroducing subject-matter the examination of which was deliberately foregone in the first-instance proceedings is at odds with the purpose of the appeal proceedings as a review instance, as stipulated in Art. 12(2) RPBA. Generally, therefore, any such requests are not to be admitted under Art. 12(6), second sentence, first half-sentence, RPBA (**T 1456/20**).

As with Art. 12(6), first sentence, RPBA (see chapter V.A.4.3.6h)), the boards, after having established that the relevant requests, facts, objections or evidence should have been submitted in the first-instance proceedings, examine in a second step whether the circumstances of the appeal case justify admittance. See in this chapter V.A.4.3.7r).

b) New request addressing objection raised for the first time at the first instance oral proceedings

In several decisions, the boards found that, in the circumstances of the case in hand, a new (main or auxiliary) request, filed in response to a new objection raised at the first-instance oral proceedings, need not have been submitted at those oral proceedings pursuant to Art. 12(6), second sentence, RPBA.

In **T 218/20** the respondent (proprietor) filed auxiliary requests 1 to 5 with its reply to the grounds of appeal. The board accepted that these requests had been filed in response to new inventive step objections first raised in the oral proceedings before the opposition

division. In the board's view, there was no need at that moment to file any further auxiliary requests as the **opposition division** was **not convinced** by these objections. Thus, the respondent had availed itself of the first opportunity to respond to these attacks. The board further held that the requests seemed to be fair and appropriate reactions and therefore justified in the sense of Art. 12(4) RPBA. Similarly **T 121/20** and **T 172/20**. See also the decisions in chapter V.A.4.3.7c).

In **T 315/21** the board examined whether the appellant (proprietor) should have filed the amendment in question (removal of a comma from the main request, on which the impugned decision was based) already at the oral proceedings before the opposition division when the related objection of clarity was first raised. The board noted that this objection was raised together with a **number of further clarity objections**, some of which were also new, and held that the patentee was not in a position to find an appropriate response to this **complex situation** in the **little time** given during the oral proceedings. Nor was this a situation of its own making as it had filed what was then the main request more than one and a half years before the oral proceedings. Thus the board did not consider that the proprietor should have filed the present main request during oral proceedings before the opposition division.

In **T 849/22** the new main request was basically identical to the main request in the opposition proceedings apart from an amendment to address an objection under R. 80 EPC, which had been raised for the first time at the first-instance oral proceedings. The board observed that this request theoretically could have been submitted at these oral proceedings. However, the opposition division had also – incorrectly, in the board's view – considered the main request in opposition to be prima facie unallowable for prima facie lack of novelty of claim 1. The board concluded that presenting the new main request during the oral proceedings would thus **foreseeably have resulted in a further non-admittance finding** based on the same (wrong) ground. Consequently, it could not be considered that the new main request should have been submitted during the opposition proceedings.

c) New request addressing objection that was dismissed or in case of a rejected opposition

In **T 205/22** the board stressed that since the opposition had been rejected, there was no need for the patentee to file auxiliary requests before the opposition division, and a request filed at the beginning of the appeal proceedings could not be rejected solely on the ground that it should have been submitted earlier (see **T 141/20**, **T 1758/21** and **T 2202/21**). See also **T 972/21**.

In **T 290/20** the appellant (patent proprietor) filed a new auxiliary request 5 in reply to the opponent's grounds of appeal, as an attempt to overcome inventive step objections based on a **document**, which **had not been admitted** by the opposition division but for which admittance had been requested again in appeal. The board pointed out that there had been no reason for the proprietor to file a corresponding request before the opposition division or with its statement of grounds of appeal. Overcoming any objection based on

this document only became necessary when it was re-filed by the opponent with its statement of grounds of appeal.

Similarly in **T 3240/19** the board held that there was no requirement for the respondent (proprietor) to file, during the first instance oral proceedings, any requests overcoming the new objection under Art. 123(2) EPC, raised on the final date in accordance with R. 116 EPC, as the opposition division considered that this **objection did not prejudice maintenance** of the patent in amended form according to the main request. See also **T 218/20** (summarised above).

In **T 141/20**, the board pointed out that it was insufficient under Art. 12(6) RPBA that the requests could have been filed in the opposition proceedings; that requests "should have been submitted" required that there were reasons for doing so. However, the board could not discern any such reason since the opposition division had made it clear during the proceedings that it did not agree with the opponent's objection. The board explained that the objection simply being part of the proceedings did not suffice as such a reason. In the opposition proceedings, the patent proprietor **could not be expected to counter** essentially **any objection raised**, and any permutation of an objection, by filing auxiliary requests. This would constitute an undue burden for both the opposition division and the other parties. The board's decision to admit had to take account of whether there was a **need** for the request to be filed in the opposition proceedings.

In **T 938/20** the appellant's new main request, filed as auxiliary request 105 shortly before the notification of the summons to oral proceedings before the board, was considered a fair reaction to opponent 2's objection raised under Art. 83 EPC in its reply to the appeal. This objection had been raised already in its notice of opposition, but had apparently not been discussed during the oral proceedings before the opposition division (although it would have equally applied to a request then at issue). The board took into account the **high number of objections** raised by the opponents in opposition proceedings and that there was apparently no clear indication that such a request should have been filed in addition to the numerous requests filed before the opposition division, since the opposition division apparently **had not considered this objection critical** for the requirements of Art. 83 EPC. Therefore there was no reason not to admit it when considering Art. 12(6) RPBA.

d) New request in reaction to a change of opinion of the opposition division

In **T 868/20**, auxiliary request 2 was filed for the first time with the grounds of appeal after the opposition division had changed its mind at the oral proceedings by comparison with its view in the preliminary opinion, ultimately deciding that claim 8 as granted was not novel. According to the board, this explained why the patent proprietor had been unable to prepare any auxiliary requests for this situation prior to the hearing. Instead, the auxiliary requests filed previously with the reply to the opposition had been pursued, and one of these had been found allowable. In submitting auxiliary request 2, the patent proprietor was pursuing the legitimate goal of limiting the patent as granted to a lesser extent than in the version held allowable. After consideration of other discretionary factors, the board decided to admit the auxiliary request into the proceedings.

In **T 847/20** however, where the opposition division had also diverged from its preliminary opinion at oral proceedings, the board nevertheless held that the auxiliary requests at issue, filed for the first time with the statement of grounds of appeal, should have been filed in the proceedings before the opposition division. The objection which the appellant (patent proprietor) intended to address had already been raised in the notice of opposition. Although the opinion of the opposition division had changed in the course of the proceedings, the appellant had had several opportunities to address this objection by filing new requests and had filed several requests during oral proceedings to this end. The board could not see any valid reason that would justify the filing of further requests to address this very same issue at the appeal stage.

e) New request – amended pages of the description

In **T 1617/20** the appellant (proprietor) filed, with the statement of grounds of appeal, as main request a set of claims identical to the claims of auxiliary request 2 underlying the appealed decision as well as amended pages of the description. The board examined whether the amended description should have been submitted in opposition proceedings. It pointed out that it was **common practice** in proceedings before the opposition division that when amended claims are filed, corresponding amendments to the description are carried out only once (and only if) the amended claims are admitted into the proceedings and found to be allowable. Since auxiliary request 2 had not been admitted, there was no need for the appellant at that time to file amended description pages.

f) New request – opportunity in opposition proceedings to address the issue

In several decisions, the boards decided not to admit submissions that addressed objections raised in the opposition proceedings, because the proprietor had had ample opportunities to address these objections (see **T 825/20** and **T 1326/21**, summarised below, and **T 847/20**, summarised in chapter V.A.4.3.7d) above). However, in other decisions the boards have held that a proprietor confronted with numerous objections of added subject-matter was justified in not having filed auxiliary requests for all possible combinations of individual amendments already before the opposition division (**T 1311/21**, **T 1928/22**). See further the decisions in chapter V.A.4.3.7c) and in particular **T 141/20**, in which the board pointed out that there needed to be a reason to file auxiliary requests, not just the possibility of doing so.

In **T 825/20** the four auxiliary requests filed for the first time with the statement of grounds of appeal aimed at overcoming the opposition division's inventive step objection to the main request. However, in its preliminary opinion the opposition division had already drawn the parties' attention to this issue. The appellant was given the opportunity to react and did so by filing several new auxiliary requests, however not those filed in appeal. The board concluded that the latter could and should have been filed during the first-instance opposition proceedings. Similarly **T 1820/22**.

A counter-example where the board took the view that the patent proprietor had not been obliged to respond immediately during the oral proceedings, is **T 487/20**. In this case the opposition division had indicated in its preliminary opinion that the opponent's objections

under Art. 100(c) EPC were not convincing and the arguments addressed by auxiliary request II filed with the statement of grounds of appeal had been only briefly discussed during the oral proceedings.

In **T 1326/21** the appellant (patent proprietor) explained that the main request in appeal which addressed only two out of three objections under Art. 100(c) EPC discussed during the first instance oral proceedings, could not have been submitted at that moment. This was because the opposition division had come to the conclusion that all three objections were justified; such a request would not have been admitted. The board however pointed out that the relevant objections had been raised and substantiated already in the notice of opposition and that the opposition division had given a preliminary opinion on all of them in the annex to the summons. Thus, the appellant had had ample opportunities to file requests addressing any of the above-mentioned objections. Accordingly, the appellant had **deliberately chosen not to file** in opposition proceedings any amendments aimed at overcoming the objections under Art. 100(c) EPC, but to respond solely with arguments.

However, in **T 1311/21** the board took the view that, where the opposition division had decided on several objections of added subject-matter at the same time, resulting in the filing of a single amended request overcoming all objections during the first-instance proceedings, Art. 12(6) RPBA did not prevent the board from admitting a new request overcoming only some of these objections. In the same vein **T 1928/22** (dealing with a situation where numerous objections of added matter had been raised in opposition proceedings, which had been individually addressed but not in all possible combinations). See also **T 849/22** (summarised in chapter V.A.4.3.7b), concerning an objection under R. 80 EPC and an incorrect novelty objection).

g) New request – opportunity in examination proceedings to address the issue

In **T 2012/20** the request in hand was only submitted with the grounds of appeal without an indication of reasons. The board emphasised the primary object of the appeal proceedings (Art. 12(2) RPBA) and recalled that appeal proceedings were not a continuation of examination proceedings. In the board's view, the request at hand should have been submitted at the latest during oral proceedings before the examining division. The decision under appeal did not contain any surprising content which would have justified the filing of a new request at the appeal stage. All the objections were known and the applicant was explicitly given the opportunity to respond to these objections during the oral proceedings. See also **T 1512/21**.

In **T 836/20**, the appellant had merely submitted that it was not foreseeable that the examining division would stand by its objections even after the appellant's detailed explanations. However, the board emphasised that the appellant's confidence in its own case was not sufficient as a circumstance to justify late admission.

In **T 789/22** the amendments made did not address the actual reasons for the application's refusal. In the board's view, their sole purpose was to "tidy up" the claims, even though the examining division never expressed concerns in this respect. These amendments should already have been submitted during the examination proceedings.

h) New request – examination of subject-matter deliberately foregone

Reintroducing subject-matter the examination of which was deliberately foregone in the first-instance proceedings is at odds with the purpose of the appeal proceedings as a review instance, as stipulated in Art. 12(2) RPBA. Generally, therefore, any such requests are not to be admitted under Art. 12(6), second sentence, first half-sentence, RPBA (**T 1456/20**).

In **T 1456/20** the board concluded that auxiliary request 7 (which corresponded to one of the auxiliary requests filed with the reply) should already have been submitted in the opposition proceedings. The novelty objection it was designed to overcome had already been discussed at the oral proceedings before the opposition division but the patent proprietor had decided at the time to **limit the claimed subject-matter in a certain way** and thereby deliberately foregone an examination of subject-matter now reintroduced in auxiliary request 7. The board held that reintroducing this subject-matter was at odds with the purpose of appeal proceedings referred to in Art. 12(2) RPBA. The board was not persuaded by the patent proprietor's argument that this approach could be justified by the aim of limiting the number of requests in the opposition proceedings. In the board's view, it was immaterial that the additional features were features of claims as granted.

In **T 1116/20**, in the first-instance proceedings the patent proprietor had merely pursued the maintenance of the patent in its version as granted and had not requested to file a new auxiliary request until after the decision, which was to its detriment, had been pronounced. In this regard, the board noted that in the opposition proceedings there had been both a **reason** for preparing and submitting an auxiliary request and the **possibility** of doing so. The patent proprietor's conduct had ultimately prevented the opposition division from taking a decision on auxiliary requests. Yet the appellant cannot defer the matter to the department of second instance as it sees fit.

The situation was different in **T 541/20**, where, in reply to the summons, the proprietor had filed several auxiliary requests in which three dependent claims had been deleted, but had not maintained these auxiliary requests during oral proceedings before the opposition division. They were replaced by requests which contained the deleted claims again. The board underlined that by replacing the earlier requests the proprietor **had not avoided a decision** on the deleted claims. The board therefore admitted three requests filed on appeal, in which the dependent claims had once more been deleted.

In **T 1404/20**, the main request (patent as granted) was rejected but the patent was maintained in amended form as per auxiliary request 0, which had been submitted at the oral proceedings and ranked higher than auxiliary request 1. On appeal, the patent proprietor **changed** the **order** and ranked auxiliary request 1 above auxiliary request 0. In this regard, the board noted that the patent proprietor had selected the original order on its own initiative, which it had been entitled to do within the framework of the procedural disposition principles. The patent proprietor had known that if auxiliary request 0 were successful, no decision would have been taken on auxiliary request 1. Changing the order resulted in a new status of the requests. In the board's view, taking auxiliary request 1 into account in the appeal proceedings was subject to the provisions of Art. 12(6), second

sentence, RPBA. The board held that auxiliary request 1 should have been presented effectively for a decision in the opposition proceedings.

For further decisions that deal with the issue of "examination of subject-matter deliberately foregone", see e.g. **T 1326/21** (summarised in chapter V.A.4.3.7f), **T 921/21** and **T 1820/22**.

i) New request – repeated attempts to meet EPC requirements

In **T 864/20** the board observed with respect to the new main request filed with the statement of grounds of appeal, that there could not be an indefinite right to have newly amended claims admitted into the proceedings whenever the examining division (or the board of appeal) raised an objection under Art. 123(2) EPC. An applicant had the burden to consider carefully whether the amended claims it intended to file had a basis in the application as filed, in particular when the amendments were made in response to an earlier objection under Art. 123(2) EPC. Hence, the board considered that the main request, being a repeated attempt to bring the claims in conformity with Art. 123(2) EPC, could have been filed in the first-instance proceedings in response to one of the earlier objections under Art. 123(2) EPC.

j) New request – unambiguous indication how to address the objection

In **T 1188/16** the board, applying Art. 13(1) RPBA and Art. 12(6) RPBA, came to the conclusion that the request of the appellant (proprietor) should have been filed in the first-instance proceedings. At the latest during the oral proceedings before the opposition division, the appellant, which had already been aware of a general objection regarding an intermediate generalisation, had received an unambiguous indication which features were missing from the claim and thus been in a position then to file requests including the omitted features. For a counter-example, see **T 938/20** summarised in this chapter V.A.4.3.7c) above.

k) New defence or evidence in response to objections raised late in the proceedings

In **T 291/21**, the respondent (patent proprietor) submitted a test report with the reply. The board considered this report to be a reaction to the specific objections raised against the examples of the patent for the first time just before the oral proceedings before the opposition division. Since the report had been submitted so close to the date of the oral proceedings, the patent proprietor realistically would not have been able to carry out more comparative tests. Moreover, the opposition division's preliminary opinion regarding inventive step had been positive. The board also considered that the content of the submitted tests did not go beyond the scope defined in the patent, so the tests were admitted (Art. 12(4) and (6) RPBA).

Similarly, in **T 802/20** the appellant (patent proprietor) filed the experimental report D22 with the statement of grounds of appeal in order to show the presence of a technical effect over the closest prior art. The board admitted the report under Art. 12(4) and (6) RPBA, for the following reasons. The auxiliary request at issue (main request in appeal) had been

filed shortly before the final date under R. 116 EPC, the corresponding objection of lack of inventive step only shortly before the oral proceedings. In the board's view, filing D22 with the statement of grounds of appeal could be seen as having been made at the earliest opportunity. See also **T 1778/21** (response to opponent's inventive step objection raised only two months prior to date of oral proceedings).

See however **T 1198/21**, in which two experimental reports filed with the statement of grounds of appeal in response to experimental data filed by the opponent two months before the oral proceedings were not admitted.

l) New defence in response to a change of opinion by the opposition division at the oral proceedings

In **T 2973/19** D27 to D30, submitted by the patent proprietor for the first time on appeal, related to the validity of the priority claim of the patent. The opposition division's assessment of the validity of this priority changed during the oral proceedings. The board held that in preparation for the oral proceedings before the opposition division the patent proprietor had no reason to expect that it would need further evidence to defend the priority claim of the patent.

See also the related issue of requests filed in reaction to a change of opinion of the opposition division (chapter V.A.4.3.7d) above).

m) New objections or defence in response to views in the opposition decision that had already been set out in the preliminary opinion

The boards have repeatedly indicated that filing new documents on appeal is not to be regarded as a direct response to the decision of the opposition division, if the finding the to which the party is reacting had already been expressed by the opposition division in its preliminary opinion (**T 2973/19**, **T 892/21**; see also **T 882/21**, in which the board also took into account that the opposition division's preliminary opinion had deemed all the other inventive step attacks not convincing).

In **T 2973/19** the board saw no convincing reason why the inventive step attack starting from D14 was not already raised in the opposition proceedings. The opposition division had indicated in the annex to the summons that the subject-matter of the claims of the main request was novel also in view of D14.

In **T 892/21** the board dealt with the admittance of experimental data (D22), which according to the appellants (patent proprietors), had been filed to address a reason given in view of Art. 56 EPC in the appealed decision, namely the lack of evidence proving a certain technical effect. However, the opposition division had already pointed to the absence of this experimental evidence in its preliminary opinion. The board stressed that a further circumstance speaking against the admittance of D22 was that the respondent had disputed the meaningfulness of the experimental data it related to. Thus the admission of this document would have rendered the case substantially more complex.

n) New objections or evidence in response to the patent proprietor's submissions at first instance

(i) In response to requests filed by the patent proprietor at an early stage of the proceedings

The boards have repeatedly ruled that new objections against claims as granted or against claims filed with the reply to the notice of opposition should have already been filed in the opposition proceedings. The opposition division **rejecting other objections previously raised** by the opponent has **not** been deemed to be a **surprising development in the proceedings** that could justify raising new objections only on appeal (see e.g. **T 2917/19**, **T 523/20**).

In **T 2917/19**, the appellant had relied on documents D6 to D11 (patents or patent applications submitted with the statement of grounds of appeal) both to demonstrate the common general knowledge and as secondary documents for its inventive step attack. The board noted that patents and patent applications usually cannot establish the common general knowledge. In so far as said documents were used as secondary documents (D6 to D10), the board held that they created a **fresh case**. The claims at issue were, however, those of the patent as granted. The opposition division having acknowledged an inventive step **could not be regarded** as a **surprising development of the proceedings**, nor did it give rise to the option of reacting by filing new documents. On the other hand, the board did take document D11 (manual reflecting the common general knowledge) into consideration. The document was similar to D2, which was already part of the proceedings, but was a newer document and supplemented the content of D2.

In **T 186/20**, documents E18 and E19 were filed to support the appellant's (opponent's) arguments in relation to the inventive step of features that were already present in claim 1 as granted. In the board's view, therefore, there were no discernible circumstances that would justify not submitting documents E18 and E19 until the statement of grounds of appeal.

For further examples, see **T 557/21** (objection against claim 1 as granted, no circumstances justifying admittance), **T 3280/19** (new objections against the main request, which was the patent as granted; additionally the documents on which these objections were based were not prima facie novelty destroying), **T 186/21** (new objections of added subject-matter arguing unallowable intermediate generalisation and multiple selections).

(ii) In response to requests filed by the patent proprietor by the final date as per R. 116 EPC

As regards whether an opponent can still be expected to react at the opposition proceedings stage to requests filed by the patent proprietor on the last possible date under R. 116 EPC, the boards have come to differing decisions (partly due to the respective circumstances of the various individual cases).

In **T 1520/20** the board had to decide on the admissibility of an attack submitted for the first time in the appeal proceedings regarding the inventive step of claim 1 of auxiliary request 4. As to whether this attack could have been filed earlier, the board indicated that auxiliary request 4 filed with the grounds of appeal was identical to auxiliary request 1 filed at the oral proceedings before the opposition division, and that this auxiliary request 1 had in turn encompassed the subject-matter of a previous auxiliary request filed on the final date as per R. 116 EPC (two months before oral proceedings). The opponent had therefore had several weeks to prepare attacks in this regard.

In **T 351/20**, however, two documents were admitted, which had been filed with the statement of grounds of appeal to pursue lines of argumentation already raised in opposition and addressing a feature that had been introduced two months prior to the oral proceedings before the opposition division. See also the similar conclusion reached in in **T 1578/20**, where the features introduced two months prior to the oral proceedings in opposition were, moreover, taken from the description.

In **T 2035/16** the board dealt with a case where the final date for making written submissions pursuant to R. 116(1) EPC had been set as one month before the oral proceedings. The proprietor had filed auxiliary request II shortly before this date and refiled this request in its reply to the appeal. In its rejoinder the opponent submitted, for the first time, an inventive step attack against auxiliary request II starting from document D25. The board held that the opponent could not have submitted D25 before the opposition division as there had been insufficient time left before the oral proceedings to find the document and incorporate it into the case. Moreover, it considered that the **rejoinder** had been the **first opportunity** for the opponent to address this request, as it had **not been dealt with in the decision** of the opposition division and had only become part of the appeal proceedings when the proprietor had refiled it. (For a different opinion on this last point, however, see **T 664/20**, which is summarised in chapter V.A.4.3.5c) (ii)).

(iii) In response to a defence or contestation by the patent proprietor during written proceedings

If the patent proprietor asserts a defence or dispute during the written proceedings before the opposition division, the opponent may also have to react in the opposition proceedings by making further submissions.

In **T 1279/20** the appellant (opponent) filed F18 only with their statement of grounds of appeal. F18 addressed the relevance to inventive step of the examples in a secondary document (F14) relied on by the opponent. The relevance of these examples had however already been disputed by the patent proprietor in reply to the notice of opposition. The board concluded that this evidence should have been filed during the opposition proceedings in order to be considered by the opposition division.

For a counter-example, see **T 1729/22**. Since the patent proprietor had first mentioned a particular technical effect on the date fixed under R. 116(1) EPC, and that effect was discussed for the first time in the oral proceedings, the board considered the statement of

the grounds of appeal as the first possible opportunity for the opponent to file the means of proof related to this question.

(iv) In response to submissions at a very late stage of the proceedings

T 1362/20 and **T 186/20** concerned objections or evidence filed with the statement of grounds of appeal in response to claim amendments made **during first-instance oral proceedings** which included **new claim features taken from the description**. The new submissions

In **T 186/20**, documents E17 and E20 were submitted for the first time with the statement of grounds of appeal inter alia in relation to a feature that had not been added to the claim in question until the first-instance oral proceedings. In addition, this feature had been taken from the description. The board concluded that neither E17 nor E20 could have been submitted during the first-instance oral proceedings.

Similarly in **T 1362/20**, the board admitted the clarity objection, raised by the appellant for the first time with the statement of grounds of appeal, against a particular feature that had already been included in the auxiliary requests filed at the oral proceedings before the opposition division. The board indicated that these late-filed auxiliary requests included features taken from the description and the opponent had had just half an hour to deal with each one. In the board's view, although the opponent could have identified a clarity issue and raised an objection within that amount of time, this could not have been expected of the opponent under Art. 12(6), second sentence, RPBA. Since the amendments had been taken from the description and admitted into the opposition proceedings at a very late stage, **fairness** dictated that new objections against the amended claims should still be admitted if they were raised at the earliest opportunity in the appeal proceedings.

In **T 1520/20**, on the other hand, the board did **not admit** a new attack raised only on appeal against a set of claims which corresponded to an auxiliary request filed at the oral proceedings before the opposition division and covering **the subject-matter of a previous auxiliary request** that had been filed on the final date stipulated under **R. 116 EPC**.

In **T 1085/20** the board admitted a document (D6) filed on appeal by the respondent (opponent) in **reaction to a new defence by the proprietor** at the oral proceedings before the opposition division. This document presented attempts at reproducing an example of a prior art document to prove that it anticipated the subject-matter of claim 1 of the main request. The aim of this declaration was to corroborate the content of a first declaration, filed in response to the summons to oral proceedings before the opposition division. The patent proprietor reacted to this first declaration only at the oral proceedings. The board considered the filing of D6 with the reply to the statement of grounds of appeal to be a timely reaction.

In **T 2973/19** the board held that the opponents could not have been surprised by the fact that a **claim feature** – here a certain term – **whose omission they had contested** for the first time at the oral proceedings before the opposition division was then added to the claim

at issue in an auxiliary request filed at these oral proceedings. As such, this could not justify the late filing of documents in reaction to a new claim request containing this term.

(v) Not necessarily to be considered for admittance: prima facie relevance, lack of knowledge of prior art, difficult retrieval

As pointed out in **T 576/18** referring to **T 724/08**, in cases in which objections or evidence should have already been submitted in the opposition proceedings, it is not necessarily relevant for admittance (in this case under Art. 12(4) RPBA 2007) if said objections or evidence are prima facie relevant. The board noted that neither RPBA 2007 nor the current version of the RPBA specified prima facie relevance as a factor to be taken into account. Other decisions in which the board pointed out that prima facie relevance was not a factor to be taken into account when deciding on admission under Art. 12(6), second sentence, RPBA can be found in chapter V.A.4.3.7r) (ii) below (**T 1522/21** and **T 765/20**).

See also **T 980/19** and **T 2964/18** (both on Art. 12(4) RPBA 2007), in which the boards followed the view expressed in **T 724/08**, that it was of no relevance whether certain disclosures were difficult to retrieve. Similarly, in **T 1309/21** it was found that a mere lack of knowledge of documents was inadequate as grounds for their admission in the appeal proceedings; unsuccessful attempts to obtain these documents on time from a third-party company had not been proven.

o) New evidence for objection raised early in opposition proceedings

In **T 623/20** an experimental report was filed by respondent 1 with the reply to the grounds of appeal. It was intended to demonstrate lack of reproducibility of a certain starting material prepared in an example of the impugned patent. However, the board considered that this experimental report should have been filed before the opposition division. The respondent had raised this objection that the example in question could not be identically reproduced during opposition proceedings and they **should then also have filed any evidence** in support of this objection. According to the established case law of the boards of appeal, each of the parties to the proceedings bears the **burden of proof** for the facts it alleges.

p) Objection to admittance of a claim request

In **T 687/20** the appellant (opponent) objected to the decision of the opposition division to admit an auxiliary request with the argument that it was late filed at the oral proceedings and comprised not only unsearched matter taken from the description, but also features derived from the figures. The board however held that the appellant should have objected to the admittance of this request upon its submission at the oral proceedings if it was of the opinion that the amendments introduced at such a late stage of the discussion negatively affected its position in the opposition proceedings. The opponent failed to do so. Therefore, the appellant's objection to the admittance of the corresponding auxiliary request in appeal proceedings was not admitted into the proceedings.

q) Submissions that were no longer maintained in first instance and counter-examples

(i) Replaced requests

Replacing a previously filed request by a new version results "de facto" in the withdrawal of the previous one (**T 1897/20**, **T 687/20**, **T 541/20**).

In **T 1897/20** the board explained that, according to Art. 12(2) RPBA, it was decisive on which requests the decision under appeal was based and not for which requests an opinion of the examining division was communicated to the applicant. By replacing previous versions of the claims in the reply to the examining division's preliminary opinion annexed to the summons, the applicant had **renounced the possibility of obtaining a reasoned decision** on these requests. As a consequence, the board did not admit the auxiliary requests, which corresponded to these previous requests, into the appeal proceedings.

Similarly, in **T 687/20** the board did not accept the appellant's (patent proprietor's) argument that the request at issue had not been "actively withdrawn". The request at issue had been replaced by a new version in the course of the oral proceedings. The opposition division's statement mentioned in the minutes expressed a preliminary opinion. By replacing the previous version the appellant had deprived the first instance department of the possibility to rule thereon. See also **T 1094/22**, where all previous requests were replaced by a new main request at the oral proceedings before the examining division.

See also chapter V.A.4.2.2d) dealing with the related question of when submissions were "maintained in the proceedings leading to the decision under appeal" within the meaning of Art. 12(4) RPBA.

(ii) Objection no longer maintained

In **T 2137/22** the board noted that the respondent's objection based on document D1 qualified as an amendment under Art. 12(4) RPBA as it had not been maintained in the proceedings leading to the decision under appeal. In fact, in the opposition proceedings, in response to the chairperson's question about the closest prior art, the opponent had only referred to other documents. Since the objection had not been maintained, the Art. 12(6), second sentence, RPBA was lex specialis to Art. 12(4) RPBA and the board did not see any circumstances that justified its admittance.

For a further example, see **T 266/23** (withdrawal noted in minutes of the oral proceedings).

(iii) Counter-examples: submissions that were considered maintained

In **T 19/20** the appellant (opponent) raised an Art. 123(3) EPC objection against the main request in opposition. The board considered that this objection had been maintained against lower-ranking requests, which differed from the main request by amendments unrelated to the objection, even if not explicitly repeated. The statement of the appellant before the opposition division that there were no objections under Art. 123(3) EPC against

auxiliary request 2 (later main request in appeal) had to be understood as expressing that there were no further objections. Hence, in the board's view the condition of Art. 12(6), second sentence, RPBA ("no longer maintained") did not apply.

r) Admittance justified by the circumstances of the appeal case

(i) Examples of new submissions admitted

In **T 1734/20** the opposition division's decision was based on a misconception of data in an experimental report submitted by the appellant (opponent). The appellant became aware of this only after the written decision had been issued and filed, with the statement of grounds of appeal, a new report which contained identical data apart from additional information aimed at preventing the misconception. The board considered that these circumstances justified the admittance under Art. 12(6) RPBA.

In **T 2043/20** the board, applying Art. 12(6), second sentence, RPBA, considered that the third auxiliary request in appeal, which was based on the second auxiliary request filed before the examining division, but in which certain claims had been **deleted**, responded to an objection under R. 43(2) EPC. But it also held that this request could have been filed before the examining division, as the objection had already been present in the annex to the summons. However, since the new request **overcame** the R. 43(2) EPC **objection** and did **not** constitute a **complex** amendment, the board admitted it.

(ii) Counter-examples

In **T 1522/21** claim 1 under consideration corresponded to claim 1 as granted. For this reason the board could not see any circumstances justifying admitting new, late-filed evidence (D1 and O9) against this claim. The board did **not** see **prima facie relevance** of the new evidence as an aspect to be taken into account.

In **T 765/20**, the board found that potential prima facie relevance was not critical and did not admit a document that had been submitted for the first time with the grounds of appeal. See however also **T 1017/20** in which the board considered that, in the particular situation of the case, the prima facie compliance of the main request on appeal with the provisions of Art. 100 b) EPC formed part of the circumstances of the appeal case to be taken into account for the purpose of applying Art. 12(6) RPBA.

For a further example decision in which the board did not accept that the circumstances in the appeal proceedings justified the admittance of the amendment of the appellant's case, see **T 608/20**. See **T 1094/22** for an example of a decision in which the board noted that the appellant had **not submitted** any justifying circumstances.

4.4. Second level of the convergent approach – submissions made after filing of grounds of appeal or reply – Article 13(1) RPBA

4.4.1 Principles

Art. 13(1) RPBA implements the second level of the convergent approach applicable in appeal proceedings. It defines the conditions under which a party may amend its appeal case after the initial stage of the proceedings (in particular with the appellant's rejoinder).

The onus is on the party to **explain and justify** any amendment to its case (see CA/3/19, section V.B.a), point 49; see also chapter V.A.4.4.4 below). That includes providing reasons for not submitting the amendment at an earlier stage in the appeal proceedings (Art. 13(1), third sentence, RPBA, underlined e.g. in **T 136/16** and **T 2688/16**). The boards have repeatedly emphasised the duty on the parties to file all facts, evidence, arguments and requests **as early and as completely as possible** (see e.g. **T 1014/17** and **T 1203/16**).

The admittance of the amendment is subject to the **board's discretion** (see CA/3/19, section VI, explanatory remarks on Art. 13(1) RPBA, Supplementary publication 2, OJ 2020, 59). Pursuant to Art. 13(1) RPBA, the boards exercise their discretion in view of inter alia, the current state of proceedings, the suitability of the amendment to resolve the issues which were admissibly raised by another party or raised by the board, whether the amendment is detrimental to procedural economy, and in case of an amendment to a patent application or patent, whether the party has demonstrated that any such amendment prima facie overcomes the issues raised and does not give rise to new objections.

As confirmed by the board in **T 1217/17** and **T 2101/16**, the list of **criteria for applying that discretion** given in Art. 13(1) RPBA is **non-exhaustive** (see also. **T 1213/19**, citing CA/3/19, section VI, Explanatory remarks on Art. 13(1), fourth sentence, RPBA, Supplementary publication 2 to OJ 2020). Moreover, Art. 13(1), second sentence, RPBA stipulates the application mutatis mutandis of **Art. 12(4) to (6) RPBA**, which includes the criteria in Art. 12(4), fifth sentence, RPBA (inter alia, complexity of the amendment, see e.g. **T 32/16**, **T 310/18**). According to **T 1213/19** (citing **T 731/16**, **T 2796/17** and **T 310/18**), it is established case law that, besides the criteria enumerated in Art. 13(1) RPBA, further decisive criteria for admitting late-filed documents can be their prima facie relevance and whether they introduce any complex matter. Prima facie relevance of the submissions however does not always prevail over the fact that the respondent could and should have submitted them (in a substantiated manner) when initially formulating its appeal case (see e.g. **T 1333/20**). In **T 154/16** the board considered inter alia the potential for the other party to be taken by surprise and the principle of procedural fairness. The latter was also considered in **T 1014/17**.

In several decisions the boards have admitted new requests at this stage because they were considered filed in good time and prima facie allowable (see e.g. **T 851/18**, **T 131/18**) or at least prima facie suitable to overcome the objections discussed in the appealed decision (see e.g. **T 2044/20**). Some requests that should have been filed earlier were

nevertheless admitted, e.g. because they were prima facie allowable and not detrimental to procedural economy (see e.g. **T 1597/16**).The boards have repeatedly highlighted that the criteria set out in Art. 13(1) RPBA (in its current version) **reflect established case law** developed through the stringent application of the requirements of Art. 13(1) RPBA 2007 (see e.g. **T 634/16**, **T 32/16**, **T 1480/16**, **T 1597/16**, **T 658/17**).

As mentioned in chapter V.A.4.1.2 "Primary object of appeal proceedings and the convergent approach to amendments made to party's case" above, the requirements of the second level of the convergent approach (Art. 13(1) RPBA) also play a role at the **third level**. As envisaged in the explanatory remarks on Art. 13(2) RPBA and confirmed by case law (e.g. **T 989/15**, **T 584/17**, **T 954/17**, **T 1869/18**), the boards may in the exercise of their discretion under Art. 13(2) RPBA also rely on **criteria** applicable at the second level of the convergent approach. It is noted that decisions applying the criteria of Art. 13(1) RPBA are therefore presented not only in this chapter but also in chapters V.A.4.5.4e), V.A.4.5.5b) and V.A.4.5.5j) below.

4.4.2 Transitional provisions – immediate applicability of Article 13(1) RPBA

According to Art. 25(1) RPBA, the RPBA (in their version which entered into force on 1 January 2020) apply, as a general rule, to any appeal pending on, or filed after, the date of entry into force. While this principle of immediate application is subject to the two exceptions provided for in Art. 25(2) and (3) RPBA, these exceptions do not apply to the second level of the convergent approach. For more details, see CLB, 10th edn. 2022, V.A.4.4.2.

4.4.3 Amendment to appeal case within the meaning of Article 13(1) RPBA

Under Art. 13(1) RPBA, any amendment to a party's appeal case after it has filed its grounds of appeal or reply must be justified and may be admitted only at the board's discretion. On the definition of "amendment to a party's appeal case", see chapter V.A.4.2.3.

4.4.4 Party's duty to justify amendment

a) Principles

As stated in CA/3/19 (section V.B.a), point 49), one of the most important elements of the "convergent approach" is that the onus is on a party to explain and justify any amendment to its case. That includes providing reasons for not submitting the amendment at an earlier stage in the appeal proceedings (Art. 13(1), third sentence, RPBA; see chapter V.A.4.4.4b) below). In the case of an amendment to a patent application or patent, the party must indicate the basis for it in the application as filed (Art. 13(1), second sentence, in conjunction with Art. 12(4), fourth sentence, RPBA) and demonstrate that, prima facie, it overcomes the issues raised by either another party in the appeal proceedings or by the board and does not give rise to new objections (Art. 13(1), fourth sentence, RPBA).

b) Party's duty to provide reasons for not submitting amendment at an earlier stage

In **T 2688/16** the board observed that it was a **fundamental requirement** under Art. 13(1) RPBA for consideration – at the board's discretion – of an amended appeal case that reasons be given for not making the amendment at an earlier stage in the proceedings. In the case in hand, a second experimental report filed with the patent proprietor's reply revealed a synergetic effect that was decisive for inventive step. The opponents contested the effect, but the board refused to admit the supporting evidence (in particular **experimental reports**), which they had not filed until about one month before the oral proceedings. The board observed that the opponents had had ample time (over 1.5 years) to file suitable evidence. A counter-example may be found in **T 23/17** where the opponent's argument that new documents (filed about a year in advance of the oral proceedings) had been filed in response to experimental data produced by the patent proprietor in its reply was held plausible and understandable.

In **T 256/17** the board refused to admit two **new lines of attack** based on lack of inventive step which the appellant (opponent) had filed in response to the respondent's reply to the statement of grounds of appeal. Both lines of attack were based on documents submitted during the first-instance proceedings. The appellant gave no reasons for first raising these objections after having filed the statement of grounds of appeal, and the board could see no reason for it either.

In **T 1759/17** the appellant did not explain which allegedly new submissions of the respondent (patent proprietor) were to be addressed by the **new documents** and these were therefore not admitted.

In **T 967/16** the board noted that the objection the respondents (proprietors) sought to overcome had already been raised in the notice of opposition. No reasons had been provided by the respondents why the auxiliary **request** in question could not have been filed at earlier stages of the proceedings.

For a further case where the party concerned did not provide any reasons for submitting **new requests** at this stage of the proceedings and the amendments were not admitted, see **T 1005/22**.

However, in **T 938/14** the board exceptionally admitted auxiliary request 2, filed in response to the respondent's submissions and identical to the main request underlying the decision under appeal, despite the fact that no justification was offered for the late reintroduction, as the request allowed the board to review the decision under appeal.

Whether the submissions should have been filed earlier is an important factor the boards have considered in exercising their discretion; see chapter V.A.4.4.5a) and V.A.4.4.6a) in particular.

c) Requirement to substantiate the amendments to the patent application or patent

(i) Explanation required with regard to the request at issue and in view of all outstanding objections

In **T 667/18** the board noted that it was established case law that requests which were not properly substantiated were not admissible. In the case in hand, the claims of the new main request filed in reply to the board's preliminary opinion (but Art. 13(2) RPBA not yet applicable) combined features which had never been claimed before, without any explanation. In the board's view this was detrimental to procedural economy. As regards inventive step, the appellant's (applicant's) submissions were restricted to an unclear reference to items in its statement setting out the grounds of appeal, which related to novelty and inventive step of the then main request.

In **T 2222/15** auxiliary requests 2.2 and 2.3 had been amended by the deletion of the method claims so that only the device claims remained. The board observed that the claimed product was essentially defined by the method. The objection of lack of novelty against the method was, therefore, equally relevant to the product, even if this was **not explicitly mentioned** in the statement of grounds of appeal. The board held that if the subject-matter of the product claims was patentable on grounds different from those that applied to the method claims, these grounds would have had to be submitted as a justification for the amendment.

In **T 608/20** the board pointed out, among other things, that the appellant, when submitting auxiliary request 8 as a reaction to the respondents' allegedly new objections on inventive step in their replies to the grounds of appeal, failed to substantiate this amendment of its appeal case in view of the **other outstanding objections**, contrary to the further requirement of Art. 13(1), fourth sentence, RPBA.

In **T 938/20** the board noted that "giving rise to new objections" was understood to mean that the appellant had to show that **prima facie no valid new objection** is recognisable (see Supplementary publication 2, OJ 2020, Table setting out the amendments to the RPBA and the explanatory remarks). It did not mean that any new objection raised by the opponents – whether justified or not – rendered the request inadmissible. In the case in hand it meant in particular with respect to Art. 123(2) EPC that a basis for the amendment should be easily recognisable, which was the case.

(ii) Self-evident substantiation

In **T 32/16**, in its written response the respondent (patentee) had stated from where the amendment was taken (Art. 12(4) RPBA). The board noted that the introduced terminology was an explicit recitation of the language used in the application as filed. Demonstration of how these amendments overcame the objection in this particular case, where the lacking features as such had already been identified by the appellant (opponent), was thus **self-evident** in the amendments made.

By contrast, the board in **T 700/15** found that the appellant (patent proprietor) had not demonstrated, as required under Art. 13(1) RPBA, that the amendment – namely new auxiliary requests (1', $1'_0$, 1'a, etc.) – overcame, prima facie, issues raised by the board; nor was this apparent to the board from the amendment itself. It therefore refused to admit the auxiliary requests.

(iii) Impact of insufficient substantiation on valid filing

In **T 319/18** (where it was not immediately apparent how auxiliary request 5 was directed to overcoming the inventive-step objection over document D1) the board pointed out that it was established jurisprudence of the boards that requests that were not self-explanatory became **effective only** on the date on which they were **substantiated** (with reference to **T 1732/10**). See also **T 2457/16**.

A contrary view was however taken in **T 1220/21**. In this decision the board held that a lack of or insufficient substantiation of a request could lead to its non-admittance, but this did not imply that the request had not been validly filed. For a discussion of the two approaches to this question, see also **T 321/21**.

4.4.5 Discretion under Article 13(1) RPBA – new requests

a) Time of filing – whether request should have been filed earlier

The question of whether requests should have been filed earlier is an important criterion for the exercise of discretion under Art. 13(1) RPBA (see also chapter V.A.4.4.4b) on a party's duty to provide reasons for not amending its case at an earlier stage in the proceedings; some decisions also refer to Art. 12(6), second sentence, RPBA, which applies mutatis mutandis at the second level of the convergent approach (Art. 13(1), second sentence, RPBA, see e.g. **T 938/20**).

(i) Response to objection not considered critical by opposition division – high number of objections

In **T 938/20** the appellant's (proprietor's) new main request, filed as auxiliary request 105 shortly before the notification of the summons to oral proceedings, was considered a fair reaction to opponent 2's objection raised under Art. 83 EPC in their reply to the appeal. This objection had already been raised in the notice of opposition but had apparently not been discussed during the oral proceedings before the opposition division (although it would have equally applied to a request then at issue). The board noted that the request could have been filed before the opposition division, but took into account the total **number of objections** raised by the opponents in opposition proceedings and that there was apparently no clear indication that it should have been filed in addition to the **numerous requests filed before the opposition division**, since the opposition division apparently did **not** consider this objection **critical** for the requirements of Art. 83 EPC. Therefore, there was no reason not to admit it when considering Art. 12(6) RPBA.

(ii) Response to new objections raised by the other party

In **T 131/18** the board first of all assessed whether, hypothetically, it would have admitted auxiliary request 3 filed in response to the reply, because, apart from two amendments, its wording and content were identical to the new auxiliary request 6 now at issue. It considered auxiliary request 3 admissible for the following reasons: the main request the appellant had filed with its grounds of appeal had been a first attempt to remedy the infringement of Art. 123(2) EPC established in the contested decision and, as it had demonstrated, the further minor amendments made in auxiliary request 3 had simply been its response to the additional objections to that main request **raised in the reply** under Art. 123(2), 83 and 84 EPC. Moreover, auxiliary request 3 had not been filed so late that the respondent (opponent) had no longer been able to react. The board found that the amendments made overcame the existing problems without giving rise to any new ones and so concluded that it would have exercised its discretion under Art. 13(1) RPBA to admit auxiliary request 3. The editorial adjustments to that request which had been made in auxiliary request 6 in order to remove inconsistencies were also admitted under Art. 13(2) RPBA (see under chapter V.A.4.5.4 n)).

In **T 524/18** the board considered the filing of auxiliary request B1 as legitimate and timely reaction to the filing of experimental reports **with the reply** to the statement of grounds of appeal, which experimental reports comprised new data in order to strengthen the respondent's position.

(iii) Response to clarification of objections

In **T 32/16**, with regard to the respondent's reasons for submitting the request in issue only in response to the board's preliminary opinion (Art. 13(1) RPBA applied instead of Art. 13(2) RPBA), the board highlighted the special circumstances of the case in hand, where the board's communication had **crystallised for the first time** what the board itself had deduced to be the relevant elements of the appellant's lengthy arguments concerning its objections under Art. 100(c) EPC. Although the appellant had stated that its set of arguments was always supposed to have been understood in the way the board had deduced, the board took the view that its statement could be understood as having identified the salient argument for the first time. The board also noted that the respondent's amended request had been submitted on the day it received the board's preliminary opinion.

(iv) Further examples where the reaction was considered timely and legitimate – inter partes

For further inter partes cases where the boards admitted new requests which were considered a timely and legitimate reaction, see e.g. **T 32/16** (summarised in chapter V.A.4.4.5 d) below), **T 2101/16** (legitimate reaction to clarification of Art. 83 EPC objection raised in statement of grounds of opposition), **T 102/16** (inventive-step objection raised for the first time in the board's preliminary opinion, essentially a combination of two claims of the patent as granted, no need to adjourn).

(v) Examples where the reaction was considered timely and legitimate – ex parte

In ex parte case **T 278/17** the amendments in the (sole) claim of the main request were a reaction to issues raised by the board for the first time during a telephone conversation with regard to auxiliary request 2. Auxiliary request 2 had in turn been a serious attempt to overcome all of the issues raised – mainly for the first time – in the communication under Art. 15(1) RPBA 2007. Since the amendments were directed to and clearly overcame all of the objections raised in the telephone conversation and the communication under Art. 15(1) RPBA 2007, the board admitted the new main request, having regard to Art. 13(1) RPBA and Art. 13(1) and (3) RPBA 2007.

For a further ex parte case, see **T 2129/16** (request clearly overcame the clarity objection raised for the first time in the board's preliminary opinion).

(vi) In response to board's communication confirming the opposition division's or opponent's opinion

In **T 136/16** the board considered the criteria under Art. 13(1) RPBA – which under Art. 25(3) RPBA applied in this case instead of Art. 13(2) RPBA – and exercised its discretion not to admit auxiliary request 1. It found, first, that the amendment made in auxiliary request 1 prima facie led to a new objection under Art. 84 EPC and, second, that this amendment could and should have been made at an earlier stage in the appeal proceedings. Indeed, **in the contested decision** the opposition division had already pointed out the fundamental importance of the interpretation of a disputed term in the claim. The opposition division had construed this term narrowly in the light of paragraph 7 of the description, but in its statement of grounds the appellant (opponent) had submitted detailed arguments contradicting this narrow interpretation on the basis of other passages of the description. Since the amendment had been made in view of an issue of fact that had already been discussed extensively, the respondent (patent proprietor) had already had cause to make it together with its reply. Its argument that the large number of attacks put forward prevented it from formulating meaningful auxiliary requests until it had the board's preliminary opinion did not convince the board either, given the fundamental importance of the interpretation of the term at issue in almost all the objections raised.

In **T 1004/18** the board found that it had already been foreseeable for the respondent (patent proprietor) on the basis of the **grounds of appeal** that it would take the same line as either the opposition division or the appellant and that, accordingly, it should already have come up with auxiliary requests as a fallback position in its reply to the grounds of appeal. Therefore the board did not admit the auxiliary request in question.

The board in **T 700/15** similarly held that a communication from the board which merely summarised and reiterated the interpretation already reached by the opposition division in the **contested decision** and advocated by the opponent in its **reply** to the grounds of appeal and did not include any new aspects or arguments or raise any new objection could not be taken as justification for filing new auxiliary requests that could have been filed earlier (referring to CLB, 9th edn. 2019, V.A.4.7). The requests were not admitted.

For a further case in which the new request was not admitted because the issues underlying the board's conclusions had already been raised in the decision under appeal, see **T 1384/16**.

For a further case in which an objection had been on file since the filing of the **grounds of appeal** and new requests in reaction to a statement of the board reiterating this objection were not admitted under Art. 13(1) RPBA, see e.g. **T 1170/16**.

For a case in which the new request was considered late because the objections it intended to overcome had been part of the appeal proceedings from the outset, but the request was nevertheless admitted in view of other discretionary criteria, see **T 1597/16**.

b) Whether the amendment prima facie overcomes the issues raised without giving rise to new objections

As outlined in chapter V.A.4.4.4, the onus is on a party to explain and justify any amendment to its case. This includes demonstrating that any amendment to a patent application or patent prima facie overcomes the issues raised by another party in the appeal proceedings or by the board and does not give rise to new objections.

(i) Request does not prima facie overcome objection

In **T 1187/15** (in which, in accordance with Art. 25(3) RPBA, Art. 13(2) RPBA did not yet apply) the board, in the exercise of its discretion under Art. 13(1) RPBA, took into account, whether the appellant (applicant) had demonstrated that the amendments, prima facie, overcame the issues raised by the board and did not give rise to new objections. The board noted that this was a **key criterion** developed in the boards' case law on the exercise of their discretion under Art. 13(1) RPBA 2007 (CLB, 9th edn. 2019, V.A.4.4.2). Art. 13 RPBA 2007 also applied in the case in hand (Art. 25(3) RPBA). The board found that, prima facie, auxiliary request XI did not overcome the objections under Art. 123(2) EPC since the omission of certain features constituted an unallowable intermediate generalisation. In view of this and the fact that the appellant had had an opportunity to respond to the points raised by the board of its own motion, the board exercised its discretion not to admit auxiliary request XI into the proceedings. Moreover, the board rejected the appellant's **request for another interruption** to enable it to prepare another request to replace auxiliary request XI. It was not compatible with the principle of procedural economy that oral proceedings were conducted in such a way that the appellant was given the opportunity to repeatedly file new requests until a version of the claims was found that was acceptable to the board.

In **T 1338/16** (in which Art. 13(2) RPBA did not yet apply), the board considered, in view of the appellant's submissions, that the amendments made in the main request and auxiliary requests 1 to 3 were primarily directed to overcoming objections in relation to added subject-matter, clarity and support, but prima facie did not overcome its objections to patentability under Art. 54 and 56 EPC. Consequently, the board exercised its discretion under Art. 13(1) RPBA not to admit these requests into the proceedings.

In **T 700/15** too, the board concluded (with regard to requests 1', $1'_0$, 1'a, etc.) that the appellant (patent proprietor) had not, as required under Art. 13(1) RPBA, demonstrated that the amendment in the auxiliary requests prima facie overcame the issues raised by the board.

More decisions on the duty to provide reasons showing that an amendment overcomes the objections raised are reported in chapter V.A.4.4.4c) "Requirement to substantiate the amendments to the patent application or patent".

(ii) Claim amendments that prima facie give rise to new objections

In **T 700/15** the board had doubts about whether claim 1 of each the auxiliary requests at issue (0, 1_0, $1a_0$, etc.) was compatible with Art. 123(2) and 84 EPC. The claim contained a feature related to the result envisaged in the application. Finding that the amendments made in claim 1 of each of the auxiliary requests gave rise, at least prima facie, to new objections, the board exercised its discretion under Art. 13(1) RPBA not to admit the auxiliary requests.

The board in **T 136/16** likewise exercised its discretion not to admit two auxiliary requests, in particular because the amendment in auxiliary request 1 gave rise prima facie to a new objection under Art. 84 EPC. It also considered that the amendment could and should have been made at an earlier stage in the proceedings.

In **T 2257/19** the board found that an inescapable trap intrinsically precluded the admission of new requests under Art. 13(1) and (2) RPBA, as the requirements of Art. 123(2) and (3) EPC could not both be satisfied.

(iii) Claim amendments that overcome the objections

In **T 851/18** of 10 January 2020 (in which the 2020 version of Art. 13(1) RPBA, but not of Art. 13(2) RPBA, was applicable under Art. 25(3) RPBA), the auxiliary request in question differed from the claims with which the patent had been maintained by the opposition division in two respects. First, its claim 1 combined the subject-matter of claims 1 and 3 as maintained. Second, the subject-matter of claim 3 had also been included in the second independent claim 7 for the first time. The board considered that these two amendments were relatively straightforward, did not give rise to any new issues and were appropriate and so, despite the late stage reached in the proceedings, saw no reason not to admit the auxiliary request. The inclusion of the features of claim 3 as maintained in claim 1 amounted, in essence, to a deletion of the broader claim 1 as maintained and answered all the objections in a procedurally efficient way, while claim 3 as maintained had not been contested in the proceedings up to that point. The second amendment obviously overcame a novelty objection the board had raised to claim 7.

In **T 2044/20** the board considered it sufficient that **all grounds discussed in the appealed decision** were overcome. The filing of auxiliary request 1, filed in reaction to the reply to the appeal, was considered an appropriate reaction of the appellant to the course of the opposition proceedings, where the appellant had found itself in a so-called

inescapable trap, in which scenario, as noted by the board, it is usually not self-evident how to overcome an objection under Art. 123(2) EPC. The further grounds for opposition pursuant to Art. 100(a) and (b) EPC **had not been discussed conclusively** in the opposition proceedings. Hence, the board saw no reason why the appellant should be limited to filing auxiliary requests which on a prima facie basis overcame all outstanding objections raised in the opposition proceedings. The purpose of the appeal proceedings was instead to focus on the grounds discussed in the appealed decision.

In several decisions dealing with late-filed requests in which certain claims had been deleted, the boards have admitted these requests inter alia because they were considered prima facie allowable. For instance, in **T 1597/16** the board considered that the new request did not lead to any other disputed points of fact or patent law, that the opponent was thus able to react and that the request prima facie allowable since it appeared to overcome all remaining objections without creating any new issues.

c) Whether the amendment is detrimental to procedural economy

In **T 2638/16**, the patent proprietor had filed its reply to the grounds of appeal late (shortly after expiry of the period prescribed in Art. 12(1)(c) RPBA), its request for an extension having been refused. Exercising its discretion under Art. 13(1) RPBA, the board took into account that the reply had been received immediately after notification of the refusal of the request for an extension and so at a still early stage in the proceedings and that the belated filing had not prevented it from considering the complete cases of all the parties. It could see no indication that the late filling had been a tactical abuse of procedure or impaired procedural economy. It thus took the reply, and a document filed with it, into account under Art. 13(1) RPBA.

In ex parte case **T 786/16** the request at issue was filed at a late stage of the oral proceedings before the board. **Possibly unsearched features** were added from the description, along with expressions which were not literally disclosed in the application as filed. The addition of the unsearched features further meant that the claim now included three alternatives, each requiring separate examination. The board noted that either an extensive examination of the new features with respect to compliance with Art. 83, 84, 123(2), 54 and 56 EPC would have had to be undertaken at the oral proceedings before the board or the case would have had to be remitted to the examining division for further examination. In the board's view, neither of these steps would have been consistent with the need for procedural economy, even less so considering the primary purpose of appeal proceedings (Art. 12(2) RPBA).

For further decisions in which procedural economy was considered and the requests were not admitted, see e.g. **T 136/16** and **T 2112/16**.

d) Complexity of the amendment

In **T 32/16** the board accepted the respondent's reasons for submitting the new main request at a late stage and held that demonstration of how the amendments overcame the objection in this particular case, where the lacking features as such had at least already

been identified by the appellant, was self-evident in the amendments made. Moreover, the amendments were not complex (Art. 13(1), second sentence, RPBA, referring to Art. 12(4) RPBA) in any sense, nor had this been argued to be the case. The request was therefore admitted.

e) Convergence of claim requests

(i) Claim requests becoming non-convergent by later submission of further requests

In **T 2112/16** the appellant (proprietor) filed auxiliary requests 1 to 14 with the grounds of appeal, and later, but before the notification of the summons to oral proceedings, new auxiliary requests 1A and 4. The board exercised its discretion under Art. 13(1) RPBA not to admit auxiliary requests 1A and 4 into the proceedings. On auxiliary requests 2, 3 and 5 to 14, the board held that the sequence of the auxiliary requests had been changed during the course of the appeal proceedings due to the introduction of auxiliary request 1A, and this involved a material change in the focus of the claimed invention. The board took the view that the selected sequence of the auxiliary requests led to an evident broadening and lack of convergence in the requests. Such a change made after a party had presented its complete case did not meet the requirement for procedural economy set out in Art. 13(1) RPBA. The board exercised its discretion under Art. 13(1) RPBA not to admit the auxiliary requests 2, 3 and 5 to 14 into the proceedings. See also **T 1185/17** by the same board.

However, see also **T 1520/20**, in which the board drew a distinction with case **T 2112/16** as to whether there had been an amendment to the submissions at all. In the case at issue, all auxiliary requests were submitted with the statement of grounds of appeal, and contested auxiliary request 4 had already provided the basis for the first-instance decision. The board held that auxiliary request 4 did not become inadmissible as a result of the submission of new auxiliary requests 1 to 3, which, according to the opponents, were divergent.

(ii) Non-convergent requests filed in response to diverging objections

In **T 938/20** the main request had been submitted as auxiliary request 105 shortly before the notification of the summons to oral proceedings. When exercising its discretion under Art. 13(1) RPBA the board observed that, in the case at issue, where an extremely large number of objections of different kinds had been raised against all the requests on file, convergence was particularly difficult to achieve and under the given circumstances should not be used as the only criterion for denying admissibility of this request. It further noted in this context that a series of requests that are drafted in defence against a single objection are expected to converge, but **equality of arms** would be undermined if the opponent was free to raise a multitude of diverging objections, whereas the patentee was restricted to only one line of defence against all of these.

f) Deletion of claims or alternatives within claims

A recurrent topic that the boards have dealt with when applying Art. 13(1) RPBA are requests in which the claimed subject-matter has been limited by deletions of claims or alternatives in claims. In these cases the issue arises whether this is an amendment within the meaning of Art. 13 RPBA in the first place, which is answered in the affirmative by the majority view. For decisions on this issue, see chapter V.A.4.2.3d). Decisions deciding on admittance under Art. 13(1) RPBA are summarised in the following. For decisions dealing with requests limited by deletions of claims and alternatives in claims filed at the last stage of the appeal proceedings, see chapter V.A.4.5.4 j).

In **T 1597/16** the admission of the new main request, which had been filed before the entry into force of the 2020 version of the RPBA, was at the board's discretion under Art. 13(1) RPBA (which applied instead of Art. 13(2) RPBA by virtue of the transitional provisions). In the board's view, the respondent had not given any cogent reasons for waiting until the final stage of the appeal proceedings to file the amendment to the claim. The objections it mentioned had been part of the appeal proceedings from the outset. Nonetheless, the board decided to admit the new main request into the proceedings for the following reasons. Limiting the claimed subject-matter to two out of the three alternatives in claim 1 as granted did **not lead to any other disputed points of fact or patent law**. The appellant (opponent) had been able to formulate an objection for lack of inventive step straight away and could otherwise refer to its written case, which matched that from the first-instance proceedings. Moreover, the board considered the new request to be prima facie allowable since it appeared to overcome all remaining objections without creating any new issues.

Similarly, in **T 494/18** the board admitted auxiliary request 8 (directed exclusively to method claims, the product and use claims having been deleted), considering among other things that the respondent had provided reasons for submitting the amendment at this stage of the proceedings, that the closest prior art for the discussion of the opponent's sole objection against inventive step did not change and that the additional comments of the parties for the assessment of inventive step **merely specified** their **previous arguments**. The board also considered that the method of this new request was prima facie clearly allowable under Art. 123(2) and 56 EPC.

In **T 682/16** the board noted that, by deleting certain claims, the respondent had **addressed all issues** raised by the appellant and by the board. The request, which moreover did not give rise to new objections and **contributed to the efficiency** of the procedure, was admitted under Art. 13(1) RPBA (the 2020 version of Art. 13(2) RPBA not being applicable yet). See also **T 1439/16** and **T 2897/18** (both referring to procedural economy).

In **T 608/20** the board reached a different conclusion in the circumstances of the case. It considered that the request limited to the method claims **could and should** have been submitted **in the first-instance proceedings**, or at the very latest together with the appeal grounds and it did not consider that the circumstances in the appeal proceedings justified its admittance (Art. 12(6), Art. 13(1), second sentence, RPBA). In particular, the board took

the view that, taking into account the circumstances in the opposition proceedings, the refusal to grant a further possibility to submit an amended request in the afternoon of the third day of oral proceedings could not justify the admittance of further auxiliary requests at a later stage in the appeal proceedings.

4.4.6 Discretion under Article 13(1) RPBA – new facts, objections, arguments and evidence

a) Time of filing – whether the new submissions should have been filed earlier

(i) Duty of the party to properly conduct the proceedings

In **T 1014/17** the board considered that, in the circumstances, the appellant had already had ample opportunity to revise its position on the clarity of claim 1 and raise appropriate objections, and could have done so in its grounds of appeal at the latest. What was more, it had had a responsibility to do so in view of what was required for properly conducted proceedings, including the duty on the parties to file all facts, evidence, arguments and requests **as early and as completely as possible** (Art. 12(2) RPBA), and also for reasons of fairness towards the respondent (patent proprietor), who had to be able to see as early as possible to what extent its patent was being challenged and on what grounds. The board refused to admit the objection under Art. 13(1) RPBA and Art. 13(1) and (3) RPBA 2007.

(ii) Response to new evidence submitted by the patent proprietor

In **T 23/17** the board exercised its discretion under Art. 13(1) RPBA and held plausible and understandable the argument made by the appellant (opponent) that the new documents (filed after the statement of grounds of appeal but before the notification of the summons to oral proceedings) had been filed in **response to** the **experimental data** presented by the respondent (patent proprietor) **in its reply** to the appeal and so, as Art. 13(1) RPBA, put it, "to resolve the issues which were admissibly raised by another party in the appeal proceedings". The board could not see that there had been any reason to file these documents at an earlier stage of the proceedings.

In **T 446/16** too, the appellant (opponent) had filed experimental report D35 after its grounds of appeal but before the summons with a view to **rebutting** the **experimental results** in D33, which the respondent (patent proprietor) had **filed with** its **reply**. The board accepted the reasoning that this response to D33 could not have been filed earlier, finding that the appellant could not be denied an opportunity to cast doubt on the results in D33 in this way.

However, see also **T 2688/16** for an example of a case in which a board refused to admit experimental results owing to a **lack of adequate reasons** for their late filing (see chapter V.A.4.4.4b)).

In **T 1759/17** the appellant (opponent) filed new documents in direct response to the respondent's reply to the grounds of appeal and in particular to the new evidence filed by

the respondent. Since there were **no objections from the respondent** (patent proprietor) against admission of these documents, the board decided to admit them into the proceedings.

(iii) Response to new claim requests filed with the reply after opposition had been rejected

In **T 1038/18** the respondent (proprietor) filed new requests with its reply to the statement of grounds of appeal. In its rejoinder the appellant (opponent) submitted for the first time during the proceedings that the priority of the patent was not validly claimed and that consequently claim 1 of auxiliary request 2 did not involve an inventive step over D1 and D3, the latter representing in view of the invalid priority claim state of the art within the meaning of Art. 54(2) EPC. However, auxiliary request 2 corresponded to the claims of a request submitted already during first-instance proceedings. The respondent argued that the new attack should have been presented earlier, but the board did not agree. It pointed out that the opposition had been rejected by the opposition division and hence the appellant was only required in the statement of grounds of appeal to **substantiate** why they considered non-convincing the reasons given by the opposition division **in respect of the patent as granted**. The question of the validity of the priority and of the status of document D3 as state of the art only became pertinent when subsequently the respondent, in reply to the statement of grounds of appeal, filed the amended claims of auxiliary request 2.

(iv) Need to reply to proprietor's detailed case in the grounds of appeal

In **T 329/16** the board referred to Art. 12(3) RPBA and concluded that the onus had been on the opponents to make a substantiated case in support of its inventive-step objections in its reply, even though the opposition decision had found in its decision that the subject-matter of claim 1 of auxiliary request 1 lacked novelty. Given that the patent proprietor had made a detailed case in support of the subject-matter's novelty in its grounds of appeal, the opponent could not rely on the board's reaching the same conclusion as the opposition division.

(v) New lines of attack based on documents submitted during first-instance proceedings

In **T 256/17** the board had to decide whether to admit two new lines of attack submitted against claim 1 of the patent on the basis of a lack of inventive step which the appellant (opponent) had filed in response to the respondent's reply. Both lines of attack were based on documents submitted during the first-instance proceedings, but one of them combined for the first time two documents previously discussed as the closest prior art and the other, starting from a known combination, argued on the basis of a different technical problem. The appellant gave no reasons for first raising these objections after having filed the statement of grounds of appeal, and the board could no reason for this either. It pointed out that, by acting this way, the appellant had prevented the respondent from reacting to the attack during the opposition proceedings and the opposition division from deciding on the matter. With the late submission the appellant had confronted the board and the respondent with a fresh case, which was contrary to the very aim of appeal proceedings (Art. 12(2) RPBA). The board thus decided to exercise its discretion not to admit the new

lines of attack under Art. 12(2), (4) RPBA 2007, Art. 25(2) RPBA and Art. 13(1) RPBA, Art. 25(1) RPBA.

(vi) Defence which should have been presented before the opposition division

In **T 1303/18** the board did not admit into the proceedings the appellant's (proprietor's) defence (raised for the first time after the filing of the grounds of appeal and the replies) relying on entitlement to partial priority. The appellant had argued that the subject-matter of claim 1 as granted should at least be entitled to partial priority from D49 in accordance with decision **G 1/15**. The board observed that an objection as to the validity of the priority claimed from D49 had already been raised by the respondents in their notices of opposition. Decision **G 1/15** had been published in the Official Journal of the EPO before the oral proceedings were held before the opposition division. Therefore, the appellant's defence claiming a right to partial priority could and should have been included at the latest in the statement of grounds of appeal. Moreover, the new defence was not merely a presentation of a new argument pertaining to the interpretation of law but comprised a new allegation of fact. The board decided not to admit it into the proceedings, as the required new factual assessment would have been complex and the appellant had provided no justification for this late amendment.

(vii) Common general knowledge

In **T 2741/19** the board did not find the appellant's (opponent's) justification convincing that the document was only found during the preparation of the opposition against a patent originating from a divisional application filed in relation to the present patent. The board pointed out that the document was **part of the public domain**. Nor did the board accept the appellant's argument that the document was submitted as evidence for the skilled person's common general knowledge at the time. Even if it were common general knowledge, this did **not** mean that it could be filed **at any time** of the proceedings. Evidence of common general knowledge could be filed at a later stage only if it served to back up argumentation that has already been put forward.

In **T 1333/20** the board held that the respondent (opponent) could and should have submitted its **complete case**, including the alleged proof of common general knowledge supporting its insufficiency of disclosure objections against the patent as granted, at least when forming its appeal case with its reply to the statement setting out the grounds of appeal. The appellant had already focused on insufficient evidence as regards Art. 100(b) EPC in the opposition proceedings and in the statement setting out the grounds of appeal.

In **T 1417/18**, by contrast, D10, a textbook referred to by the appellant within the time limit set by the board in its communication under R. 100(2) EPC, was taken into account. D10 had already been submitted by the opponent (subsequent appellant) in the opposition proceedings, but had not been admitted. The board held that D10 was relevant for assessing common general knowledge. It also took into account that both parties were already familiar with D10. The fact that D10 had not been admitted in the first-instance proceedings was considered immaterial.

(viii) Developments in parallel proceedings

In **T 1038/19**, in exercise of its discretion under Art. 13(1) RPBA, the board admitted a new objection of added subject-matter of claim 1 of the main request. The appellant (opponent) had raised this objection shortly after a similar issue had been decided in its favour in parallel proceedings (**T 1773/18**). The board saw this as justified, especially in view of the developments in the parallel appeal case. It also took into account that the other parties to the proceedings had had sufficient time to consider the objection.

A counter-example is **T 1808/21**. In this case presentation slides (D26) and a compilation of alleged facts (D27), which were subject of parallel pending UK proceedings, were submitted by appellants 2 and 3 only after filing their respective grounds of appeal. The appellants argued that, since this evidence had not yet been referred to at trial in the English proceedings, it was not possible to file it at an earlier stage in the appeal proceedings. The board however pointed to the possibilities of seeking consent from the patent proprietor or getting permission from the English court. In view of this, the board was convinced that there had been no legal obstacles and that it was rather the choice of the appellants not to submit these documents at an earlier stage. Therefore the board did not admit D26 and D27 into the appeal proceedings.

(ix) Late discovery of documents

In **T 603/21**, after filing its statement of grounds of appeal (but before notification of the summons to oral proceedings), the appellant (opponent) made new attacks on inventive step, based on, among other things, two new documents. It argued that the documents had only recently come to light by chance during research into another case and were prima facie relevant. The board stressed, however, that the chance discovery was not sufficient to justify the late filing, as generally admitting such changes would allow the arbitrary extension of the subject of the proceedings beyond that of the opposition proceedings, and thus run counter to the primary object of the appeal proceedings as set out in Art. 12(2) RPBA. In particular, this would undermine the requirement of Art. 12(6) RPBA, and failure by one of the parties to comply with it would be detrimental to the opposing side. Similarly **T 1684/17** (summarised in chapter V.A.4.4.6d) and **T 2741/19** (the fact that the document could not be easily found was not considered a justification for late filing). However, see also **T 1213/19** (also summarised in chapter V.A.4.4.6c) (ii).

However, see also **T 463/19**, in which, even at the third level of the convergent approach, the board admitted a late-filed document that was objectively difficult to find, had undoubtedly not been withheld intentionally, belonged prima facie to the state of the art and was prima facie very relevant. See chapter V.A.4.5.5m).

(x) New document originating from the patent proprietor submitted by the appellant-opponent

In **T 533/17** the appellant (opponent) argued that a poster (D19) and two related documents, filed after its grounds of appeal, should be considered since the respondent

(patent proprietor) had apparently concealed this earlier own publication. The board, however, noted that R. 42(1)(b) EPC did not put a stringent obligation on applicants to acknowledge prior art known to them at the time of filing their application. Therefore, the failure to acknowledge D19 in the patent in suit was not a sufficient reason for admitting this document into the appeal proceedings. Moreover, the appellant had not provided a convincing justification of why it had not been possible to find D19 when preparing this case at the opposition stage. The new documents were therefore not considered, in accordance with Art. 13(1) and 25(3) RPBA.

(xi) Public prior use

In **T 552/18** the board did not admit further evidence of a public prior use filed in reply to its communication under Art. 15(1) RPBA 2007 for the following reasons: These documents had been submitted at a very late stage of the proceedings and raised new questions. Although appellant 2 (opponent) had provided reasons why the documents had only been retrieved when they were, the board considered that there was no justification why they could not have been retrieved earlier if **sufficient effort** had been made. The board also held that the admission of these documents would go against the interests of procedural economy as laid down in Art. 13(1) RPBA. Moreover, the documents presented did not enable the issues raised to be resolved, as was required by Art. 13(1) RPBA. The board also underlined that these issues' pertinence had already been known in the opposition proceedings.

Likewise in **T 1117/16** the board considered it immaterial that the appellant had only actually become aware of the alleged public prior use – in this case by a third party – a few months after the filing of the statement of grounds of appeal. In particular, it took into account that the search for possible citations is the **responsibility of the opponent**. The fact that it did not discover a state of the art in time did not justify disregarding either the requirement of procedural economy or the need to act fairly towards the other parties. The board held that other criteria for the exercise of discretion mentioned in Art. 13(1), fourth sentence, RPBA also precluded admission to proceedings (see the summary in chapter V.A.4.4.6 b).

By contrast, in **T 34/18** the board considered the filing of new pieces of evidence of prior use (minutes of a hearing before a technical section of the Austrian Patent Office and a witness's written statements), which were intended to prove the existence of an obligation of confidentiality, to be admissible under Art. 13(1) RPBA. In particular, the board took into account that the opposition division had assumed there was no such agreement, that the evidence was therefore prima facie relevant, that its admittance did not appear to be detrimental to procedural economy and that the appellant had convincingly argued that the new evidence could not have been provided earlier.

b) Suitability to solve the issues raised

In **T 1117/16** the board first emphasised that the fact that the appellant had not discovered the public prior use at issue in time did not justify disregarding the requirement of procedural economy or the need to act fairly towards the other parties. The board also

could not see how the amendment to the appellant's case could resolve questions admissibly raised by the respondent. Rather, these amended submissions amounted to a completely new attack on the patent in suit, and one which had **not been prompted** by the respondent's submissions. Admitting the amendment would also have been detrimental to procedural economy, since, in the board's view, the documents submitted could not, prima facie, prove the alleged prior use up to the hilt ("lückenlos").

For further examples where the suitability criterion was among others applied, see **T 23/17** (summarised in chapter V.A.4.4.6 a) (ii)), **T 552/18** (summarised in chapter V.A.4.4.6 a) (xi)) and **T 1217/17**.

c) Prima facie relevance for assessment of patentability

(i) Not a sufficient justification for late submission

As observed in **T 731/16** (citing CLB, 9th edn. 2019, V.A.4.13.2), it was the boards' established case law that a decisive criterion for admitting late-filed documents was their prima facie relevance. Such material needed to be prima facie highly relevant in the sense that it was highly likely to prejudice maintenance of the European patent.

In many decisions in which the revised (2020) version of Art. 13(1) RPBA is applied, boards have pointed out that besides the listed criteria further decisive criteria for admitting late-filed documents could be their prima facie relevance and whether they introduced any complex matter (see **T 1213/19**, citing **T 731/16**, **T 2796/17** and **T 310/18**; for a contrary view, see **T 1684/17**, in which the board notes that prima facie relevance is not mentioned in Art. 13(1) RPBA). In **T 361/19** the board considered that admission of a late filed, but prima facie novelty-destroying document was, in principle, **covered by Art. 114 EPC** and also by Art. 13(1) RPBA. In the board's view these provisions leave sufficient discretion to a board to admit such documents. However, numerous decisions illustrate that, while this aspect is considered, it does not necessarily prevail over other criteria, in particular the time of filing (see e.g. **T 361/19 T 1203/16**, **T 1333/20**).

In **T 1203/16** the appellant (opponent) submitted, in reply to the preliminary opinion of the board, new lines of attack based on a document considered in opposition, and additionally, a new novelty objection based on a new document. As justification for these late amendments to its case, the appellant merely argued that the new lines of attack were relevant for assessing the patentability of the opposed patent and avoiding maintenance of a patent not fulfilling the requirements of the EPC. The board emphasised that such a justification was not sufficient. These new lines of attack could and should have been filed before. The board emphasised the leading principle of the RPBA, namely that on appeal parties' cases should be complete at a very early stage. It therefore decided in exercise of its discretion not to admit the new lines of attack and the corresponding document into the proceedings pursuant to Art. 12(4) RPBA 2007, Art. 13(1) RPBA and Art. 13(1) and (3) RPBA 2007.

(ii) Examples where prima facie relevance was considered, and the late submission taken into account

In **T 1213/19** the appellant (opponent) justified the late filing of D8, more than six months after the filing of the statement of grounds of appeal, by the fact that it was found by chance during a search for another patent. In the board's view, the document could have been found earlier as it lay in the same technical field as the patent, had been published five years before the end of the opposition period and seemed to have been pivotal in the examination proceedings of a divisional application derived from the European patent application on which the patent was based. However, the board weighed these aspects against the considerations that the respondent must have been familiar with the content of this document and that, at first glance, D8 could reasonably be expected to prejudice the maintenance of the patent. In view of the above, the board exercised its discretion to admit document D8 under Art. 13(1) RPBA.

For a further case in which prima facie relevance was one criterion among others that were taken into account and the relevant submissions were admitted, see e.g. **T 34/18** (prima facie relevance of evidence rebutting a public prior use, summarised above in chapter V.A.4.4.6 a) (xi)).

(iii) Example where prima facie relevance did not prevail over other criteria

In **T 1333/20** the board held that in the case in hand the alleged relevance of the new submissions (objections under Art. 123(2) EPC) did not prevail over the fact that the respondent **could and should** have submitted them in a substantiated manner **when forming its appeal case**, namely, in the case in hand, with its reply to the statement setting out the grounds of appeal (Art. 12(3) RPBA).

(iv) Examples where late submissions were rejected as inadmissible for lack of prima facie relevance

In **T 731/16** citation D12 had only been filed in response to the board's communication under Art. 15(1) RPBA 2007. In the board's view, it was out of the question that it would have been self-evident for the skilled person to combine the teaching of D4, a citation already on file, with that of newly filed D12. It therefore held that D12 was not highly relevant prior art and refused to admit it.

In **T 2796/17** prima facie relevance was one of several factors the board considered in exercising its discretion (Art. 13(1), 25(1) RPBA and Art. 13 RPBA 2007, Art. 25(3) RPBA). The board found that the new submission (an inventive-step objection to the subject-matter of claim 1, based on a combination of two documents filed with the notice of opposition) was not prima facie relevant, because the appellant (opponent) had not substantiated why the skilled person starting from the asserted closest prior art would have consulted the second document (without hindsight) or how that document disclosed the features added to the new main request. Not only had the appellant, without providing any justification, raised the objection for the first time at the oral proceedings, but the objection involved a complex new set of facts. The board therefore refused to admit it.

For further cases where (prima facie) relevance was considered but not acknowledged, see e.g. **T 102/16** (concerning D26), **T 1877/16** (concerning D20 and D21).

d) Whether the amendment is detrimental to procedural economy

In **T 1684/17** the board did not admit a new objection of lack of inventive step, which was based on a newly filed document which the appellant alleged had only become known to it in parallel appeal proceedings. The objection concerned the subject-matter of claim 1 of the patent as granted and, in the board's view, should already have been raised by the opponent in the course of the opposition proceedings. The opponents' approach was inconsistent with the principle of procedural economy that applied to all parties to the proceedings and therefore also inconsistent with the principle set out in Art. 12(6), second sentence, RPBA. The prima facie relevance claimed by the appellant was not a decisive criterion to be taken into account when applying Art. 13(1) RPBA. On this last point, see also chapter V.A.4.4.6c).

Likewise in **T 140/15**, **T 2227/15**, **T 154/16**, **T 1117/16**, **T 1217/17** and **T 552/18** the boards, exercising their discretion under Art. 13(1) RPBA, concluded that admitting late submissions would (among other things) be inconsistent with the need for procedural economy and did not admit them into the proceedings.

By contrast, the board in **T 553/22** admitted into the proceedings the opponent's reply to the statement of grounds of appeal, which was received 6 minutes after the expiry of the time limit set forth in Art. 12(1)(c) RPBA, as it did not prevent the board from considering the complete case of all the parties, nor seemed to be a tactical abuse of procedure, nor was contrary to procedural economy.

e) Complexity of the amendment

As pointed out in **T 1213/19**, besides the criteria listed in Art. 13(1) RPBA, according to established case law, **further decisive criteria** for admitting late-filed documents under Art. 13(1) RPBA can be their prima facie relevance and **whether they introduce any complex matter** (**T 731/16**, **T 2796/17** and **T 310/18**).

(i) New objection relying on previously discussed documents

In **T 310/18** the appellant (opponent) raised an objection regarding lack of inventive step starting from D2 in view of D15 for the first time about a month before the oral proceedings. However, since an attack starting from D15 in view of D2 had already been dealt with in the decision under appeal, the relevant technical content of these documents had been discussed extensively during the earlier stages of the appeal proceedings. The board considered that starting from D2 instead of D15 did not introduce any complex matters but merely relied on a combination of the previously discussed features. Under these circumstances the board decided to admit the objection into the proceedings (Art. 13 RPBA 2007, Art. 13(1) and (3) RPBA, the 2020 version of Art. 13(2) RPBA not yet being applicable).

However, in **T 140/15** a late-filed new objection based on a known combination of documents was not admitted. The board held that it made no difference that an objection based on the same documents but in reverse order had been raised earlier in the proceedings; this was still a new objection and its discussion would not necessarily take a similar course to that of the earlier one.

(ii) Mere development of previous submissions

In **T 3212/19** the submission of documents which had already been submitted with the grounds for opposition but not yet in the appeal proceedings, was considered in the case at hand to be just a development in the appellant's appeal case. The board considered that these documents simply served to help explain the operating modes of the devices described in documents already forming part of the proceedings. The board therefore saw no reason not to admit them into the appeal proceedings. See similarly, **T 2271/17** (new facts presented in terms of references to specific documents, mere development of objections outlined previously, adequate time for respondent to react thereto).

(iii) Examples where submissions introduced new complexity and were not admitted

In **T 2227/15**, applying Art. 13(1) RPBA as well as Art. 13(1) and (3) RPBA 2007 and considering all the circumstances of the case, the board concluded that admitting the new inventive-step attack into the proceedings would not only substantially add to and considerably change the complexity of the matter to be discussed, but would also be contrary to the need for procedural economy and would take the respondent by surprise.

In **T 1303/18** the board did not admit the appellant's (proprietor's) defence (raised for the first time after the filing of the grounds of appeal and the replies) relying on entitlement to partial priority into the proceedings. The required new factual assessment would have been complex and the appellant had provided no justification for this late amendment.

See also e.g. **T 2796/17** (summarised in chapter V.A.4.4.6c) (iv)) and **T 1217/17**.

4.5. Third level of the convergent approach – submissions filed after notification of the Article 15(1) RPBA communication or after expiry of period specified in Rule 100(2) EPC communication – Article 13(2) RPBA

4.5.1 General principles

a) Overview

Article 13(2) RPBA implements the third level of the convergent approach applicable in appeal proceedings. Art. 13(2) RPBA imposes the most stringent limitations on a party wishing to amend its appeal case at an advanced stage of the proceedings, namely after expiry of a period set by the board of appeal in a communication under R. 100(2) EPC or, where no such communication is issued, after notification of the communication under Art. 15(1) RPBA (see document CA/3/19, section VI, explanatory remarks on Art. 13(2)

RPBA, published in Supplementary publication 2, OJ 2020, 60, as well as OJ 2023, A103 on the latest amendment of Art. 13(2) RPBA).

In the version of Art. 13(2) RPBA which entered into force on 1 January 2020 the third level was triggered, in cases where no R. 100(2) EPC communication had been sent, by notification of the summons; this is reflected in part of the case law presented in this chapter. However, in order to avoid that the third level of the convergent approach is triggered by an early summons, as from 1 January 2024 (see Art. 2 of the decision of the Administrative Council of 13 December 2023, OJ 2023, A103), it is for all pending appeal proceedings the notification of the communication under Art. 15(1) RPBA, rather than the summons, which triggers the third level.

Article 13(2) RPBA provides that any amendment to a party's appeal case made at this stage of proceedings will, in principle, not be taken into account unless there are exceptional circumstances, which have been justified with cogent reasons by the party concerned.

In numerous decisions the boards have emphasised the party needs to **set out compelling reasons** why the circumstances are exceptional, in the absence of which the submissions concerned are not admitted (see e.g. **T 1107/16**, **T 2486/16**; see however the exception stated in **T 1294/16**). See also chapter V.A.4.5.1c) below. Furthermore, Art. 13(1) RPBA – including the **duties to provide justification** it lays down – also applies to the third level of the convergent approach (see e.g. **T 2360/17**).

Applying Art. 13(2) RPBA, the boards have consistently refused at this advanced stage of the proceedings to admit new submissions that should have been made earlier and that were considered detrimental to procedural economy or the rights of the other parties (see in particular the decisions cited in chapters V.A.4.5.4f), V.A.4.5.4g), V.A.4.5.4h), V.A.4.5.4i), V.A.4.5.4m) and V.A.4.5.4q)).

However, in cases in which the unjustified late submission ran contrary to neither the principle of procedural economy nor the legitimate interests of a party to the proceedings, the boards have come to different conclusions in their interpretation of Art. 13(2) RPBA.

In some of their decisions, the boards have considered that there needs to be a causal link between the "exceptional circumstances" and the time of filing in the proceedings (e.g. **T 2463/16**, **T 2486/16**), or that the "exceptional circumstances" need to justify the filing of new submissions at this advanced stage of the proceedings (e.g. **T 1904/16**, **T 482/19**, **T 1590/19**, **T 2795/19**). This interpretation of Art. 13(2) RPBA is based on, among other things, the parties' **duty to facilitate due and swift conduct of the proceedings** (**T 2843/19**) and on the aim of ensuring **fair proceedings for all parties** (**T 1904/16**).

In many other decisions, however, the boards have interpreted "exceptional circumstances justified with cogent reasons" in a broader sense. In **T 2920/18** the board pointed out in this context that it was clear from the explanatory remarks that the legislator had had the intention to give the boards discretionary power (Supplementary publication 1, OJ 2020, Annex 2, 221). In **T 339/19** the board explained that, in each case, it was incumbent on

the deciding board to balance the right to be heard with the public interest in doing justice in good time. In the same way, numerous decisions have considered "exceptional circumstances" to be circumstances in which admission **did negatively impact neither the procedural rights of another party** (or of the other parties in inter partes proceedings) **nor procedural economy** (see, for example, **T 1294/16**, **T 101/18**, **T 1290/18**, **T 1598/18**, **T 2920/18**, **T 339/19** and **T 2465/19**). For further details see chapter V.A.4.5.4k) below. See also V.A.4.5.5b) to V.A.4.5.5 e).

On the various related interpretations of "exceptional", see also chapter V.A.4.5.1e). On the meaning of "in principle" in Art. 13(2) RPBA, see chapter V.A.4.5.1f).

These different interpretations of "exceptional circumstances justified with cogent reasons" within the meaning of Art. 13(2) RPBA also influence whether admissibility under Art. 13(2) RPBA is examined **in one or two steps**. See chapter V.A.4.5.1g) below.

As regards the applicable criteria for exercising discretion, there seems to be consensus that at the third level of the convergent approach the boards of appeal are free to apply the criteria set out in Art. 13(1) RPBA when exercising their discretion under Art. 13(2) RPBA in deciding whether to allow an amendment at this stage in the proceedings (see, for example, **T 989/15**, **T 584/17**, **T 954/17**, **T 752/16**, **T 764/16**, **T 709/16**, **T 995/18**, **T 1780/20**; see also **T 1609/16** and **T 1421/20**, which apply these criteria without citing Art. 13(1) RPBA). In **T 2429/17** the board held that at the third level of the convergent approach it could also use criteria that applied to the first level, i.e. the criteria set out in Art. 12(4) to (6) RPBA. See also chapters V.A.4.5.4 and V.A.4.5.5, which provide a more detailed description of the case law on admitting new requests or new facts, objections, arguments or evidence, arranged by specific procedural situation or topic.

b) Events which trigger the third level of the convergent approach

Art. 13(2) RPBA, which imposes the most stringent limitations on a party wishing to amend its appeal case, concerns in its version as from 1 January 2024 amendments to a party's appeal case made after the expiry of a period specified in a communication under R. 100(2) EPC or, where such a communication is not issued, after notification of a communication under Art. 15(1) RPBA (see decision of the Administrative Council of 13 December 2023, OJ 2023, A103). In the previous version of Art. 13(2) RPBA which entered into force on 1 January 2020 the third level was triggered, in cases where no R. 100(2) EPC communication had been issued, by notification of the summons. In the following, decisions are summarised which deal specifically with these trigger events.

In **T 2125/18** the board pointed out that the standardised communication accompanying the copy of the statement of grounds of appeal is not a communication under R. 100(2) EPC.

Decision **T 2384/18** concerned the particular situation where the communication under Art. 15(1) RPBA contained an invitation under R. 100(2) EPC to the parties to reply to two issues highlighted in a specific point of the communication. The board used its discretion

under Art. 13(1) RPBA to admit auxiliary request 1a, which had been filed within the period specified and specifically addressed the highlighted issues.

c) Duty under Article 13(2) RPBA to provide cogent reasons to demonstrate exceptional circumstances and duties under Article 13(1) RPBA

Article 13(2) RPBA provides that, for new submissions at the third level of the convergent approach to be taken into account, the party concerned must **justify** with cogent reasons that there are exceptional circumstances.

In **T 482/19**, for instance, the board found that the patentee had not provided any exceptional circumstances justified with cogent reasons, as to why the auxiliary requests in question had been filed only at a late stage of the proceedings (namely after notification of the summons to oral proceedings). Hence both auxiliary requests were not taken into account, in accordance with Art. 13(2) RPBA (see however also chapters V.A.4.5.1d) to V.A.4.5.1g) on the different interpretations of "exceptional circumstances").

In **T 2423/19** the board underlined with reference to the explanatory notes relating to Art. 13(2) RPBA (Supplementary publication 2, OJ 2020, 60) that, if the board raises an objection in a communication, which in the party's view is raised for the first time, it is up to that party to explain precisely why they consider this objection not to fall under objections previously raised.

An exception may be found in **T 1294/16**. In this decision, the board held that there was no need for a party to put forward cogent reasons where the circumstances were beyond that party's control (e.g. board's judgment as to whether it can, without undue delay, deal with the submission at issue; other party's agreement) and a board, bearing in mind the purpose of the convergent approach, considered ex officio the circumstances to be exceptional (see also **T 1790/17**; on the different views of what constitutes "exceptional circumstances", see however chapters V.A.4.5.1d) to V.A.4.5.1g) below). A further exception is described in **T 2465/19**. In the board's view, considering that the amendments were filed following the express invitation from the board, requiring such an explanation from the appellant would be clearly counter-intuitive.

In **T 552/16** the board did not admit a late-filed document, because exceptional circumstances for its late filing within the meaning of Art. 13(2) RPBA had **neither** been **presented nor** were they **evident** from the case (see also **T 553/22**).

Duties to provide justification can additionally arise under **Art. 13(1) RPBA**, which also applies to the third level of the convergent approach. In **T 2360/17**, for instance, the board did not admit the new request inter alia because the appellant's arguments did not constitute a justification for the amendment as required by Art. 13(1), first sentence, RPBA. On these duties under Art. 13(1) RPBA, see also chapter V.A.4.4.4.

d) Whether a causal link between the exceptional circumstances and the time of filing is required

The question whether the term "exceptional circumstances" should be interpreted such that these circumstances must be the cause of or, in other words, justify the time of filing, has been answered in the case law in different ways.

(i) Decisions according to which a causal link is required

In **T 2486/16** the board emphasised that a party, when providing its "cogent reasons", should not only identify the circumstances invoked and explain why they were to be regarded as exceptional but also explain why these circumstances had the **direct result** of preventing it from filing its requests at an earlier stage (see also **T 1707/17** by the same board, which referred to **T 1033/10**). In the case in hand, the appellant, which had filed the new request at issue and was successor in title of the original applicant, had invoked receivership and a transfer of ownership as exceptional circumstances. However, in the view of the board, even if these difficulties experienced by the original applicant were considered to constitute exceptional circumstances within the meaning of Art. 13(2) RPBA, the requirement of establishing a **causal link** had not been fulfilled. The new appellant had submitted no evidence that the original applicant had been experiencing any such difficulties at the date of filing the statement of grounds of appeal. See also **T 2463/16** and **T 1433/18**.

Similarly, in **T 2795/19** the board held that Art. 13(2) RPBA required the party not only to explain why the case involved exceptional circumstances but also to explain why its amendment, in terms of both **content and timing**, was a **justified response** to these circumstances. In particular, where a party sought to amend its case at a very late stage in the proceedings, the cogent reasons referred to in Art. 13(2) RPBA should include reasons why it had not been possible to file such an amendment earlier (citing **T 1707/17**; see also **T 755/16** and **T 482/19**). In **T 1190/17** the board held that its inclusion of a new argument in the chain of arguments leading to the finding of lack of inventive step did not open the door to the introduction of amendments whose content would have gone well beyond that needed to refute the new argument (see also **T 1869/18**).

In **T 2843/19** the board emphasised the **duty** of parties **to facilitate due and swift conduct of the proceedings** and did not admit the appellant's new objection, since no exceptional circumstance had been presented that could have justified its late submission so close to the scheduled date for oral proceedings.

In **T 2482/22** the board rejected the argument that concerns regarding the validity of the patents issued by the EPO had to trump any other considerations. The legislator had seen this differently, as evident from Art. 12(2) RPBA (as adopted by decision of the Administrative Council of 26 June 2019), according to which the primary object of the appeal proceedings is to review the decision under appeal and a party should direct their appeal case at the requests, facts, objections, arguments and evidence on which the decision under appeal is based. As a consequence, the possibility for a party to change its case or add to it was very limited, increasingly so as the appeal procedure progressed.

The board noted that Art. 12(4) and 13(1) RPBA still included criteria that could be seen as relating to the merit or relevance of any such new material albeit subject to a reasoned justification. However, such criteria are entirely absent from the wording Art. 13(2) RPBA. Thus, merit or relevance was not somehow subsumed in the sole criterion of "exceptional circumstances", which could only relate to circumstances that arise from the way the proceedings have developed, i.e. the **procedure itself and not its subject**. In the same vein, see the earlier case **T 1590/19**.

(ii) Decisions according to which no causal link is required

Other decisions have not required such a causal link between exceptional circumstances and late filing. Rather, these held that, even if late filing was not justified, other aspects could be taken into account when determining whether there were exceptional circumstances. In **T 339/19**, for instance, the board explained that, in each case, it was incumbent on the deciding board to balance the right to be heard with the public interest in doing justice in good time. Thus, numerous decisions have considered "exceptional circumstances" to be circumstances in which admission **did not negatively impact either the procedural rights of another party** (or other parties in inter partes proceedings) **or procedural economy** (see, for example, **T 1294/16**, **T 101/18**, **T 1290/18**, **T 1598/18**, **T 2920/18**, **T 339/19** and **T 2465/19**, some of which are summarised below, as well as the other decisions cited therein). Similarly **T 713/14**, **T 545/18** and **T 1686/21** (in which the large number of different objections was also taken into account).

In **T 1294/16** the board noted that the major motivation for the convergent approach was the procedural economy of the appeal proceedings. The board deduced from this that if admittance of a (late-filed) submission was not detrimental to procedural economy, it was appropriate to accept that there were "exceptional circumstances" within the meaning of Art. 13(2) RPBA , provided that this did not adversely affect the other party. In the ex parte case in hand, the board admitted the three late-filed auxiliary requests, since the amendment could be dealt with during the oral proceedings. This decision was followed e.g. in **T 1290/18**, **T 339/19** and **T 2465/19** (the latter specifically addressing the situation in ex parte cases). See also **T 424/21** which points out that prohibiting the deletion of dependent claims at a late stage might lead to a huge number of auxiliary requests at an early stage and thus not be in the interest of procedural economy.

In **T 339/19** the board agreed that the term "exceptional circumstances" should be interpreted in light of the principles underlying the RPBA. It added that these principles had been developed by the boards in connection with the right to be heard (Art. 113 EPC), the right to oral proceedings (Art. 116 EPC) and the right to a fair hearing both under Art. 6 ECHR (as per decisions **G 1/05**, OJ 2007, 362, **G 2/08** of 15 June 2009; **T 1676/08**, **R 19/12** of 25 April 2014) and Art. 125 EPC (**T 669/90,** OJ 1992, 739). The right to be heard also related to the right to introduce and have heard evidence as defined in Art. 117 EPC (**T 2294/12**). Art. 114(2) EPC, however, clarified that such a right was not absolute. In each case it was thus incumbent on the deciding board to balance the right to be heard with the public interest in doing justice in good time. The board agreed with **T 855/96**, in which the board had emphasised the position of the Boards of Appeal as the only judicial instance in proceedings before the EPO.

In **T 2920/18** the board noted that the wording of Art. 13(2) RPBA did not require the amendment to be triggered by exceptional circumstances. The exceptional circumstances could also be **of a legal nature**. In addition, a teleological interpretation which considered the purpose of the EPO's power to disregard late submissions as enshrined in Art. 114(2) EPC and Art. 123(1) EPC seemed to support this conclusion. Indeed, it followed from the preparatory documents to the EPC 1973 (see **T 122/84**, **T 951/91**) that this procedural possibility was intended to prevent the parties from improperly delaying the proceedings. This power did not constitute a procedural end in itself. See also **T 2295/19** by the same board, confirmed e.g. in **T 1800/21**.

This approach was further confirmed in e.g. **T 1857/19**, **T 1709/20** and **T 732/21** (in the latter the board held that the purpose of the RPBA was the defence of the parties' rights to a fair hearing within a reasonable time).

Many decisions following this approach relate to late-filed requests in which only a single category of claim or dependent claims were removed from the previous request. See, for example, the discussion of the related case law in **T 1800/21**, as well as chapter V.A.4.5.4j).

e) Meaning of "exceptional"

According to one line of case law "exceptional circumstances" within the meaning of Art. 13(2) RPBA generally concern **new or unforeseen developments** in the appeal proceedings, such as new objections raised by the board or another party (e.g. **T 1702/18**, see also **T 1780/19**), whereas circumstances outside the appeal proceedings (e.g. **T 2329/15**, **T 1583/21**, **T 2482/22**) or the normal course of events (**T 1870/15**, **T 2214/15**, **T 2271/17**, **T 24/18**, **T 1436/19**, **T 1959/19**, **T 599/21**) cannot justify late submissions. See also **T 1558/22** and **T 2124/21** for circumstances in the sphere of responsibility of the submitting party.

Accordingly, exceptional circumstances have been acknowledged where, for instance, the filing of new requests constituted a legitimate and timely response to a new objection raised by the board (in its communication under Art. 15(1) RPBA, see e.g. **T 2306/17**, **T 1255/18**, **T 974/20**, or at the oral proceedings, see e.g. **T 1561/15**). In this context, a "new objection" means one not covered by those previously raised by the board or a party (**T 2610/16**, **T 42/17**).

In contrast, where an objection had already been raised by the first-instance division or a party, the board's raising of these objections (e.g. **T 1187/16**; even where this involved a change in the board's opinion, e.g. **T 752/16**, **T 995/18**), or objections merely developing the objections originally raised or stating them more precisely (e.g. **T 2539/16**, **T 1080/15**) or objections to unsuccessful attempts at overcoming previously identified issues (**T 2214/15**) has been seen as an **ordinary development** in the appeal proceedings which could therefore not justify the filing of new requests.

However, in other decisions, in particular regarding the deletion of claim categories, the boards have found that "exceptional" could be interpreted more broadly:

In **T 1294/16**, for instance, the board noted that the example of exceptional circumstances provided in the explanatory remarks in CA/3/19 (namely a new objection raised by the board) suggested that exceptionality was not necessarily linked to events being exceptional in the sense of deviating from the expected, but could also be caused by **considerations related to the legal framework**. Since the major motivation for the "convergent approach" was the procedural economy of the appeal proceedings, it was appropriate to accept that there were "exceptional circumstances" if admittance of a (late-filed) submission was not detrimental to procedural economy, provided that this did not adversely affect any other party. See also e.g. **T 1598/18** (by the same board, inter partes) and **T 2920/18** (inter partes), in which the board confirmed that exceptional circumstances could be of a **legal nature**.

For further examples of case law giving "exceptional circumstances" a broad meaning which accommodates cases in which procedural economy and the rights of the parties are safeguarded, see **T 713/14**, **T 101/18**, **T 545/18**, **T 1968/18**, **T 339/19**, **T 2111/19**. See also the decisions cited in chapter V.A.4.5.1d) above and in V.A.4.5.4k) dealing in particular with requests in which claims or claim alternatives have been deleted.

In **T 2352/19** the board held that the term "exceptional circumstances" needed to be interpreted in the light of the principles underlying the EPC and the RPBA. The board derived from this that exceptional circumstances could justify the admittance of a new request filed in response to a new aspect raised by the board, only if this aspect was ultimately relevant for the board's final conclusion. Otherwise, the parties' right to be heard was not affected and there would be no reason for exceptions to be applied.

f) Meaning of "in principle"

In several decisions the boards have discussed the question of how the term "in principle" in Art. 13(2) RPBA had to be construed.

In **T 1294/16** (see also the summary in chapter V.A.4.5.1e)) the board discarded the possibility that this term was meant to provide a residue of discretion for the board to admit a request even in the absence of exceptional circumstances (or where no cogent reasons were supplied as justification for them) and concluded that it should be ignored. In **T 2125/18** the board underlined that the wording "in principle" could not be understood to mean that Art. 13(2) RPBA could be applied simply where the board considered it fitting. Highlighting the convergent approach, the board found that, for the board to take the amendment to the appeal case into account, exceptional circumstances must have arisen. In the same vein, in **T 2920/18**, the board explained that the principle laid down in Art. 13(2) RPBA was precisely that amendments to a party's case were not to be taken into account at this late stage of the procedure ("in principle"). The exception to this principle then followed in the half sentence introduced by the phrase "unless".

However, in **T 172/17** the board held that Art. 13(2) RPBA did not remove the board's discretion to admit an amendment of a party's appeal case. The obligation expressed by "shall" was qualified by "in principle", and it was also up to the board to assess whether "exceptional circumstances" exist. The board referred to Art. 114 EPC in this context and

to the explanatory remarks on Art. 13(2) RPBA (see supplementary publication 2, OJ 2020, 60), according to which the board may admit the amendment "in the exercise of its discretion". Citing **T 172/17**, the board in **T 574/17** explained that when applying Art. 13(2) RPBA a board may also rely on the criteria referred to in Art. 13(1) RPBA. This was part of the board's exercise of discretion under Art. 13(2) RPBA. This discretion was inherent to the assessment of whether there were "exceptional circumstances" and was furthermore expressed by the phrase "in principle". Similarly, in **T 424/21** the board interpreted the wording "shall, in principle," in Art. 13(2) RPBA such that it leaves the board some discretion in its assessment of the alleged exceptional circumstances. Sensibly applying this discretion appeared to the board to be particularly important in technical fields with patents containing a large number of dependent claims.

g) Whether assessment of "exceptional circumstances" and exercise of discretion to admit an amendment is a two-step evaluation

In some decisions, the boards have assessed admission under Art. 13(2) RPBA **in two steps**. First, they have assessed whether it has been shown that there are exceptional circumstances justifying the late submission or whether any such circumstances are apparent. And only if that is the case have they gone on in a second step to apply the criteria for exercising discretion laid down in Art. 13(1), fourth sentence, and Art. 12(4), fifth sentence, RPBA and, if relevant, taken account of other considerations (see, for example, **T 989/15**, **T 709/16** and **T 924/22**). In **T 709/16** it was emphasised that, if the board accepted the party's argument that the circumstances were exceptional, it was still within the board's discretion whether to admit the request into the appeal proceedings. In **T 2486/16** the board explained that the criteria of Art. 13(1) RPBA could supplement, but not supplant, the separate requirements of Art. 13(2) RPBA. In **T 1558/22** the board held that there was no exceptional circumstance beyond the respondent's sphere of responsibility that might have justified the late filing of auxiliary request 4a. That made it irrelevant whether other criteria for exercising discretion laid down in Art. 12(4) and 13(1) RPBA (e.g. whether the amendment was uncomplicated) – which could be considered **in addition** to the strict requirements of Art. 13(2) RPBA – had been met.

In other decisions, all aspects, including in particular the criteria in Art. 13(1) RPBA about the exercise of discretion, have been used to assess whether "exceptional circumstances" exist. In **T 1773/22**, for instance, the board explained that assessing whether there are exceptional circumstances was not separate from exercising discretion to admit an amendment (confirmed in **T 152/22**). The board noted that not separating them was consistent with the view that exceptional circumstances could be of a legal nature (citing **T 2295/19**, **T 339/19**, **T 1800/21**). Further examples of this approach can be found in, for example, **T 713/14**, **T 1904/16**, **T 988/17**, **T 1055/17**, **T 1790/17**, **T 1227/19**, **T 916/21** and **T 172/22**.

4.5.2 Transitional provisions

According to Art. 25(3) RPBA, where the summons to oral proceedings or a communication of the board under R. 100(2) EPC was notified before the date of entry into force (1 January 2020), new Art. 13(2) RPBA did not apply. Instead, Art. 13 RPBA 2007

continued to apply. For summaries of decisions in which these transitional provisions were applied, see CLB, 10th edn. 2022, V.A.4.5.2.

4.5.3 Amendment to an appeal case within the meaning of Article 13(2) RPBA

Article 13(2) RPBA provides that any amendment to a party's appeal case made after the expiry of a period specified by the board in a communication under R. 100(2) EPC or after notification of a communication under Art. 15(1) RPBA (as of 1 January 2024; previously notification of a summons to oral proceedings) will, in principle, not be taken into account. On what is meant by "amendment to a party's appeal case", see chapter V.A.4.2.3 "Second and third levels of the convergent approach: amendments to a party's appeal case – Article 13(1) and (2) RPBA".

4.5.4 Admittance of new requests

The main principles of the case law on admitting new submissions at the third level of the convergent approach have already been outlined in chapter V.A.4.5.1. Structured around particular procedural situations or topics, the following now looks in more detail at the case law on admitting new requests.

a) Waiting for the preliminary opinion not compatible with convergent approach

(i) Preliminary opinion not an invitation to make further submissions

The primary purpose of a board's preliminary opinion is to establish the framework of the appointed oral proceedings, i.e. to prepare the oral proceedings, rather than being an invitation to a party to make further submissions or to file further requests (**T 2703/16**, with reference to **T 1459/11**). See also e.g. **T 752/16** (summarised in chapter V.A.4.5.4 h)), **T 995/18**, **T 2271/18**, **T 121/20**, **T 920/20**.

In **T 2778/17** the appellant (applicant) argued that a reaction in response to the provisional opinion of the board should be possible. For reasons of procedural economy, it would not be expedient to file beforehand a plurality of auxiliary requests without knowledge of the opinion of the board. The board did not agree. It recalled the basic principle of the third level of the convergent approach that, at this stage of the appeal proceedings, amendments to a party's appeal case were not to be taken into consideration and that only a limited exception was provided for. The board could not see any exceptional circumstances justified with cogent reasons by the appellant. The appellant had merely stated that it considered it desirable and justified to amend its requests after having been provided with the board's provisional opinion on the merits of the case.

(ii) Requirement to respond to the case made by the opposing party

Each party to appeal proceedings must present its own case at the outset – if necessary, by responding to the case made by the opposing party immediately – rather than waiting to see whether the board later confronts it with an unfavourable opinion (**T 995/18**). See also **T 1937/19**, **T 924/22**.

In **T 121/20** the respondent (patent proprietor) filed auxiliary request 1 in reaction to the board's preliminary opinion and argued that it appeared from this opinion that among the various objections of added matter raised by the appellant only one was convincing and that accordingly the amendments addressing the other objections were not necessary. The board, however, noted that the preliminary opinion was predominantly intended to give the parties an opportunity to thoroughly prepare their arguments, not to file new submissions. The board added that it would be against the principle of procedural fairness if the board allowed a party to take advantage of such a preliminary opinion to put them in a better position compared to the position they took in reply to the other party's case.

b) Justified response to new objections raised in board's communication, in subsequent submissions or at oral proceedings

In numerous decisions, the boards have treated situations in which the proprietor was first confronted with new objections, arguments or evidence in the communication under Art. 15(1) RPBA, in subsequent party submissions or at the oral proceedings as exceptional circumstances (with reference to the explanatory remarks on Art. 13(2) RPBA in Supplementary publication 2, OJ 2020, 60; see e.g. **T 2461/17**, **T 1255/18**). They have then admitted requests which, in terms of both their content and timing, were a justified response to those circumstances. It was sometimes the situation as a whole, including the justified response to the new objections, that was treated as amounting to exceptional circumstances; see chapter V.A.4.5.1 on the various different interpretations of Art. 13(2) RPBA.

When exercising their discretion in this respect, they have also relied on the criteria in Art. 13(1) RPBA and Art. 12(4) RPBA; on this, see chapter V.A.4.5.4e) "No carte blanche to amend claims at will – criteria set out in Articles 13(1) and 12(4) RPBA".

(i) Examples from ex parte proceedings

In **T 1255/18**, for instance, the board observed that, as was apparent from the appellant's (applicant's) submissions, the filing of the auxiliary requests concerned constituted not only a **legitimate** but also a **timely response** to the additional objection under Art. 76(1) EPC, raised by the board in the communication under Art. 15(1) RPBA. The amendment introduced into these auxiliary requests did not go beyond amending the feature whose presence in the higher-ranking requests had been newly objected to by the board. The board acknowledged that there were exceptional circumstances within the meaning of Art. 13(2) RPBA which justified taking the newly submitted auxiliary requests into account.

In **T 2351/17** the board found that there were exceptional circumstances, given that it had raised a new objection under Art. 123(2) EPC in its preliminary opinion and that the amendments were designed to overcome that objection and did not give rise to any new ones.

For further ex parte cases where the board raised an objection or argument for the first time in its preliminary opinion or at the oral proceedings and considered this (partly together with the fact that the reaction to this objection was appropriate) to be an

exceptional circumstance, see e.g. **T 1870/15** (auxiliary requests aimed at overcoming new clarity objection), **T 2461/16** (new clarity objection in provisional opinion an exceptional circumstance which justified the filing of new requests intended to overcome this objection), **T 2429/17** (main request filed to address issues newly raised under Art. 84 EPC and Art. 123(2) EPC), **T 1166/18** (legitimate reaction to objections under Art. 84 and 123(2) EPC), **T 1768/20** (main request and auxiliary requests admitted as legitimate defence against fresh line of argument against inventive step).

(ii) Counter-examples from ex parte proceedings

A counter-example, where a board did not admit requests filed in response to objections or arguments raised for the first time at the oral proceedings, is **T 2214/15** (summarised in chapter V.A.4.5.4i) "Repeated attempts at overcoming deficiencies"). The identification of problems newly introduced when the appellant attempted to solve issues discussed in the proceedings up to that point was to be seen as an ordinary development of the discussion.

In **T 1869/18** the board emphasised that while objections raised by the board for the first time in a communication under Art. 15(1) RPBA could be considered to give rise to exceptional circumstances and could possibly justify the filing of amendments which specifically respond to the new objections, this did not open the door to additional amendments which were **unrelated to the new objections**. Similarly **T 1190/17**.

(iii) Examples from inter partes proceedings

In **T 1756/16** a clarity objection to auxiliary request 1 filed with the reply was raised for the first time by the board, of its own motion, in its preliminary opinion under Art. 15(1) RPBA. The respondent (patent proprietor) sought to overcome this objection at the oral proceedings by filing a "new auxiliary request 1" containing just one minor amendment (lowering of the indices for intensity features "I44" and "I45"). The board found that its objection amounted to an exceptional circumstance justifying the filing of the auxiliary request at this stage.

In **T 1482/17** the board admitted auxiliary requests filed during the oral proceedings. As regards the requirement that their filing be justified by exceptional circumstances, the board observed that adding another clarifying feature was a **direct response** to a **new line of argument** that the board had, of its **own motion**, raised for the first time during the oral proceedings. This line of argument was a departure from its preliminary opinion that the earlier auxiliary request 1 was allowable; this implied that there was little prospect of the other auxiliary requests being allowable either. In view of this exceptional circumstance, the board considered that, even at this late stage in the proceedings, the patent proprietor was entitled to be given a chance to overcome the newly raised objections. Moreover, the amendments amounted to an elaboration on the gist of the invention. In the board's view, both the amendments and the resulting subject-matter were technically straightforward and did not entail unexpected combinations. The new auxiliary requests also did not put the appellant (opponent 2) at a disadvantage because there was essentially no change in either the closest prior art or the invention's technical contribution.

Another case in point is **T 135/17**, in which the filing of the second auxiliary request during the oral proceedings before the board did not present a fresh case and could be regarded as an **appropriate reaction** to a novelty objection raised during the oral proceedings against the independent method claim of the first auxiliary request. Moreover, it did not increase the technical and procedural complexity of the case and the opposing party did not object.

For further examples of inter partes cases in which the proprietor was confronted with a new objection or argument raised in the board's preliminary opinion or at the oral proceedings and the board admitted the new request as a legitimate response taking into account further aspects, see **T 1152/17**, **T 2091/18**, **T 655/19**, **T 935/19**, **T 953/20**, **T 974/20**, **T 1489/20**, **T 623/23**. See also **T 32/16** (in which the board highlighted the special circumstances of the case in hand, where the board's communication had crystallised for the first time what the board itself had deduced to be the relevant elements of the appellant's lengthy arguments concerning its objections under Art. 100(c) EPC); see however also **T 1362/21**, in which the board distinguished its case from **T 32/16**. See also chapter V.A.4.5.4e) "No carte blanche to amend claims at wish – criteria set out in Articles 13(1) and 12(4) RPBA".

(iv) Counter-examples from inter partes proceedings

The board in **T 2632/18** explained that the mere fact that a "new" objection was raised by a board could not per se amount to "exceptional circumstances" within the meaning of Art. 13(2) RPBA (citing **T 2271/18**). Nothing else could be derived from the decisions cited by the appellant (**T 1482/17** and **T 1278/18**). In both these cases, the aspect relating to "new objections" was considered as only one of several other criteria, including the complexity or the clear allowability of the amendments made (see also chapter V.A.4.5.4e) "No carte blanche to amend claims at will – criteria set out in Articles 13(1) and 12(4) RPBA".) In the case in hand, no new objection had been raised.

In **T 2352/19** the board held that exceptional circumstances could only justify the admittance of a new request filed in response to a new aspect raised by the board, if this aspect was ultimately **relevant for the board's final conclusion**. Otherwise, the parties' right to be heard was not affected and there would be no reason for exceptions to be applied.

c) Justified response to an objection – earlier response could not be expected

In some cases involving objections or arguments that were not entirely new but had in fact already been submitted at first instance or in the opposing party's written submissions, the boards have nevertheless decided that filing requests in response at an earlier stage could not have been expected.

(i) Response to individual aspect of an overall unconvincing line of argument

In ex parte case **T 916/21** the amendments made in auxiliary request 3 were a response to an explanation of the interpretation of the claims given in the board's preliminary opinion.

The same explanation had already appeared in the contested examination decision, but there it was just part of a line of argument that was fundamentally unconvincing as a whole. In the board's view, the appellant could not have been expected to file amendments in response to this individual aspect of an overall unconvincing line of argument as early as when filing the appeal. The board therefore treated the amendments as a response to its preliminary opinion and admitted them on the basis that the request clearly met the EPC requirements and so it could take a decision without holding oral proceedings.

(ii) Early objection raised but not pursued by examining division

In **T 922/17** the board took into consideration that, while the objection at issue had already been introduced by the examining division in an earlier communication, it was contained in neither the communication underlying the contested decision with respect to the main request nor the contested decision. The board therefore held that, in the case in hand, the fact that it had reintroduced the Art. 123(2) EPC objection in its communication under Art. 15(1) RPBA could be regarded as an exceptional circumstance within the meaning of Art. 13(2) RPBA. Moreover, the effect of the amendments at issue was readily apparent, such that the board was satisfied that the appellant had justified the amendments by cogent reasons as required by Art. 13(2) RPBA.

However, see also the following decisions, in which the boards considered the requirement of exceptional circumstances not to be fulfilled for objections or arguments that had already been raised by the examining division: **T 2778/17**, **T 2279/16**, **T 14/20**, **T 1080/15**, **T 597/16**, **T 689/15**.

(iii) Objection raised previously but without substantiation

In **T 1224/15** the appellant (patent proprietor) had filed a new auxiliary request 3 in response to an objection raised by the board under Art. 123(2) EPC in its preliminary opinion. The respondent (opponent) contended that this objection had already been raised in its reply to the grounds of appeal. The board, however, observed that the respondent had merely **referred to its notice of opposition** and had not countered the arguments on which the contested decision was based, as was required under Art. 12(2) RPBA 2007. This objection was therefore disregarded. The board thus considered the amendment made in auxiliary request 3 to be a direct response to its preliminary opinion. Since this amendment (deletion of a dependent claim) also did not give rise to any new objection or entail any change to the arguments in support of insufficient disclosure and lack of novelty, the board found the new request admissible (Art. 13(2) RPBA).

(iv) Objection of opposition division not reflected in the appealed decision

In **T 1771/17** the respondent (proprietor) filed new auxiliary request 2B in response to the board's objection under Art. 123(2) EPC against auxiliary request 2A in its communication under Art. 15(1) RPBA. The board considered that it was irrelevant whether the opposition division had already referred to the objected claim wording in its preliminary opinion, as this was in any case not reflected in the decision under appeal. Nor had the appellant raised this issue against auxiliary request 2A which had been filed with the reply to the

appeal. Thus, the objection was not part of the appeal proceedings until it was mentioned in the board's communication and the respondent had no reason to file auxiliary request 2B earlier. Moreover, no new issues were raised by auxiliary request 2B. The board admitted this request.

(v) Response to further development of an argument

In **T 1609/19**, the appellant's arguments had developed at the oral proceedings and finally led to the board's conclusion on novelty. The board underlined that it was thus appropriate to give the respondent an opportunity to react to this new line of argument as it could not have anticipated the way in which the appellant's arguments would develop. The board held that a party's argument developing in such a way as to be decisive for the decision on the request, yet not being seen as a change of the party's case, was to be seen as an exceptional circumstance which in the present case justified taking auxiliary request 12 into account.

d) Purpose of oral proceedings especially in ex parte proceedings

In the ex parte proceedings **T 1790/17** the board explained that, although its discretion under Art. 13(2) RPBA was rather limited, it still had to consider and balance all relevant circumstances when using its discretion. These circumstances included the development of the case and the purpose of oral proceedings. In the board's view, the purpose of oral proceedings was, for the appellant, to better explain its case and, for the board, to understand and clarify points which perhaps had not been sufficiently clear up to that point. The board underlined that this was particularly relevant in ex parte cases. If amendments resulting from such discussions were not possible, oral proceedings would be pointless. In the board's view, the new auxiliary request had been filed as a **direct reaction to the exchange of arguments** in the oral proceedings and addressed the board's objections and concerns. Furthermore, the request overcame the grounds on which the appealed decision was based. It was therefore admitted into the proceedings.

However, in **T 3258/19** the board took the view with respect to oral proceedings, that the right to be heard related only to the opportunity for an appellant in an ex parte case to orally present arguments relating to the requests already made in the written part of the underlying proceedings. If a board, moreover, has communicated a preliminary opinion based on the written submissions on file, the purpose of the oral proceedings for the party concerned would mainly be to explain why this opinion was wrong on the basis of the submissions and evidence already on file (citing **T 1213/19**).

See also **T 1870/15**, summarised in chapter V.A.4.5.4g) (iii), in which a request filed in response to a mere elucidation at the oral proceedings of the assessment in the preliminary opinion was not admitted.

On the purpose of oral proceedings, see also chapter III.C.2.

e) No carte blanche to amend claims at will – criteria set out in Articles 13(1) and 12(4) RPBA

Irrespective of whether the admissibility of new claim requests under Art. 13(2) RPBA is examined in one or two steps (on this, see chapter V.A.4.5.1g)), exceptional procedural developments justifying a response never give carte blanche (see **T 1080/15**) to make just any amendment whatsoever to the claims. Instead, the "new objections" aspect is treated as just one of several criteria, including the complexity of the amendments made or whether they are clearly allowable (as was made clear in e.g. **T 2632/18** with reference to **T 2271/18**, **T 1482/17** and **T 1278/18**).

According to established case law, at the third level of the convergent approach, the boards may, in the exercise of their discretion under Art. 13(2) RPBA, also rely on criteria applicable at the second level of the convergent approach, i.e. those set out in Art. 13(1) RPBA (see e.g. **T 989/15**, **T 2010/15**, **T 584/17**, **T 954/17**, **T 752/16**, **T 764/16**, **T 709/16**, **T 855/16**, **T 101/18**, **T 995/18**, **T 1869/18**, **T 416/19**, **T 541/20**, **T 920/20**, **T 1780/20**, **T 719/22**). As underlined e.g. in **T 2429/17**, this includes the criteria applicable at the **first level** of the convergent approach, i.e. those set out Art. 12(4) to (6) RPBA (see also the reference to these provisions in Art. 13(1), second sentence, RPBA).

(i) Whether amendments prima facie overcome the issues raised and do not give rise to new objections

As noted in **T 1107/16**, according to the explanatory remarks on Art. 13(1) RPBA, the **onus** is on the appellant **to demonstrate** both why the amendment overcomes the issues raised by the board and why the amendment, prima facie, does not give rise to new objections.

In ex parte case **T 1609/16** the board noted that the main request had manifestly been filed in reply to new clarity objections raised in its preliminary opinion. Moreover, the amendments to the original claims were straightforward, clearly addressed the outstanding issues in a manner already contemplated in the board's written opinion, and did not introduce any new subject-matter or raise new objections requiring further consideration. Hence the board decided to admit the main request into the appeal proceedings.

For further cases where the boards examined these criteria and were satisfied that they were fulfilled, see e.g. **T 1107/16**, **T 1338/16**, **T 545/18**, **T 1278/18**, **T 416/19**, **T 655/19**.

In the examples below, by contrast, the criteria were not fulfilled and the boards therefore refused to admit the requests.

In **T 953/16** the appellant (applicant) submitted that the new auxiliary requests at issue were a legitimate response to a clarity objection raised by the board in its communication under Art. 15(1) RPBA. The board noted, however, that although the amendments made to claim 1 in these requests constituted an attempt to clarify the claims, the inventive-step objections raised by it in its communication had already taken the features concerned into account in the interpretation of claim 1. It was therefore apparent to the board that the

amendments did not add anything of substance to the discussion of inventive step and, therefore, they did not address all of the outstanding issues raised by it. In view of its negative conclusions on inventive step for the higher-ranking requests, the board saw no exceptional circumstance that could justify the admission of the new auxiliary requests into the appeal proceedings.

In **T 709/16** (ex parte) the board exercised its discretion under Art. 13(2) RPBA in view of the suitability of the amendment in auxiliary request I to resolve the issue of lack of inventive step raised by the board. However, the amendment was not suitable to resolve this issue as it was only meant to clarify a certain feature and the inventive-step objection against the main request had already been based on the understanding this led to.

In **T 2257/19** the board found that an inescapable trap intrinsically precluded the admission of new requests under Art. 13(1) and (2) RPBA, as the requirements of Art. 123 (2) and (3) EPC could not both be satisfied. Consequently, and irrespective of the discussion whether there were exceptional circumstances that would justify filing the new requests at this very last stage of the procedure, auxiliary requests 4A to 4C were not admitted into the proceedings under Art. 13(1) and (2) RPBA, because they prima facie could not overcome the objections under Art. 123(2) EPC without infringing the requirements of Art. 123(3) EPC.

For further cases where the new requests were not admitted because, among other things, they did not (prima facie) overcome the issues raised, see **T 2429/17** (ex parte, clarity objection), **T 2692/18** (inter partes, inventive step objection), **T 884/18** (inter partes, issue of priority), **T 2271/18** (ex parte, clarity objection), **T 416/19** (ex parte, mere presentation of information), **T 920/20** (inter partes, objection under Art. 123(2) EPC, new requests filed only at oral proceedings).

For further cases in which the new requests gave rise to new objections, see e.g. **T 995/18** (inter partes, objection under Art. 123(2) EPC), **T 2271/18** (ex parte, clarity objection), **T 855/16** (ex parte, objection under Art. 123(2) EPC), **T 920/20** (inter partes, objection under Art. 123(2) EPC, new requests filed only in oral proceedings), **T 2795/19** (ex parte, objection under Art. 123(2) EPC, request substituting all former requests filed only at oral proceedings).

(ii) Procedural economy and complexity

In **T 764/16** claim 1 of the amended auxiliary requests necessarily included a feature, which had been only optional in claim 1 of the main request. The board, however, observed that there had been no discussion of this feature in the contested decision, the proceedings at first instance having concentrated on objections relating to alternative feature 1k. Moreover, it considered the feature to require interpretation. Filing the auxiliary requests after the summons thus confronted the board and the appellant with new facts involving complex issues which, if the requests were admitted, might mean having to remit the case to the opposition division. The amendments in the auxiliary requests were therefore detrimental to procedural economy. The board could not see any exceptional

circumstances within the meaning of Art. 13(2) RPBA that could have justified the late filing of the auxiliary requests.

In **T 920/20** the board observed that the respondents could already have responded to the appellants' objections under Art. 123(2) EPC in their reply to the appeal. It further found that the criteria set out in Art. 13(1) RPBA, which could be relied on additionally when applying Art. 13(2) RPBA (see e.g. **T 989/15**), were not met, because the combination of granted claims on which the new claim 1 was supposed to be based resulted in a completely new and complex case in which it was extremely doubtful "prima facie" whether the proposed amendments could overcome the objections raised and also likely that they would give rise to new objections. The board considered that the thorough discussion which would be required would be detrimental to procedural economy and highly unreasonable at such a late stage in the proceedings.

In **T 541/20** the board also considered, in addition to prima facie allowability of the amendments, that they had reduced the complexity of the case, as the objections against the deleted claims became moot, and hence admitted the request at issue.

(iii) Convergence

In **T 528/19** the board pointed out that convergence was a criterion for use when considering **procedural economy** for the purposes of Art. 13 RPBA.

In **T 1436/19** the appellant (patent proprietor) requested a few weeks before the oral proceedings to reorder the requests filed with the statement of grounds of appeal. The board decided that this constituted an amendment to the appellant's appeal case and that it could not be taken into account, inter alia because the proposed reordering of the requests clearly resulted in lack of convergence thereof. See also chapter V.A.4.5.4 g) "Requests reordered".

In ex parte case **T 1080/15** the independent claims of auxiliary request VII, filed after notification of the summons to oral proceedings, related to an **embodiment** disclosed in one of the figures and in the description which, however, had **never** been **claimed**. The embodiment had not been examined and did not amount to a converging development of the subject-matter claimed in any of the higher-ranked auxiliary requests. The board held that, although an objection raised for the first time by the board could qualify as an exceptional circumstance justifying the admission of a request, it did not give the appellant carte blanche to amend the claims at wish. The amendments should, as a rule, remain within the framework of the embodiments that had been examined by the first-instance department.

A further example can be found in **T 1717/17**.

f) Board's preliminary opinion that confirms in essence objections or arguments previously raised

In many decisions, ex parte as well as inter partes, the boards have emphasised that a preliminary opinion of the board containing, or giving an opinion on, objections that were already part of the proceedings did not qualify as an exceptional circumstance within the meaning of Art. 13(2) RPBA (e.g. **T 2778/17**, summarised in chapter V.A.4.5.4a) (i) and the examples below). According to some of the case law, however, exceptional circumstances can nevertheless arise in view of other factors in such cases (see chapters V.A.4.5.4j) and V.A.4.5.4k)).

In several decisions the boards have pointed out that it was irrelevant for the purposes of Art. 13(2) RPBA whether the opinion in their communication diverged from a previous position or differed from the contested decision (e.g. **T 752/16**, **T 2610/16**, **T 1962/17**).

Objections or arguments that were confirmed **in essence** in the preliminary opinion were not considered as new objections, which could be a reason for providing the proprietor with a further opportunity to file new claim requests (e.g. **T 3171/19**, ex parte). For examples, see the summaries and further references below in sections (ii) and (iii). In some of these cases the board's reasoning departed to some extent from the objections previously raised (e.g. **T 689/15**) or refined/developed the previous argumentation (**T 1080/15**, **T 450/20**, **T 599/21**).

(i) Duty to substantiate why the objection is new

In **T 42/17** the board recalled the principles set out in the explanatory remarks on Art. 13(2) RPBA (in CA/3/19, section VI), and in particular the following: if an appellant submitted that the board had raised an objection for the first time in its communication, it had to explain precisely why this objection was new and did not fall under objections previously raised by the opposition division or the respondent (opponent). The issues in question in the case in hand had already been discussed in the first-instance proceedings and had been referred to by the respondent in its reply to the grounds of appeal. The appellant (patent proprietor) therefore had to expect that the board might express a provisional opinion that was different from the opposition division's opinion. The appellant did not demonstrate that the board's provisional opinion contained any objection not raised previously. See likewise **T 2423/19**.

See also chapter V.A.4.5.1c) regarding more generally the duty under Art. 13(2) RPBA to provide cogent reasons to demonstrate exceptional circumstances.

(ii) Preliminary opinion confirming (in essence) objections or arguments raised by the examining division

In **T 689/15** the application was refused because, inter alia, the subject-matter of claim 1 of the then first auxiliary request lacked inventive step over the combined disclosures of documents D1 and D2. The board's assessment of inventive step in its preliminary opinion was based on the same documents and the board identified the same closest prior art

(D1). However, the board identified only one difference with respect to D1, whereas the examining division had identified two differences. As a result, the board defined an objective technical problem which was not as broad as the one defined by the examining division. But the board confirmed the examining division's assessment that the person skilled in the art would implement the teaching of D2 in the method known from D1. The board was therefore not convinced that the arguments set out in its preliminary opinion differed from the arguments set out in the decision under appeal to such an extent that they presented a whole new line of reasoning. Hence, the board saw no exceptional circumstances which would justify admitting the auxiliary request into the proceedings.

Similarly, in **T 2279/16** the combination of documents on which the board based its inventive-step objection in its preliminary opinion was exactly the same as the one which had led to the refusal of the application, and hence this was not a new objection from the board (even if the board's reasoning differed in certain details). The board saw no exceptional circumstances.

In **T 599/21** the board held that using a passage of the description to confirm the examining division's broad interpretation of a term in the claims did not confront the appellant with facts previously unknown to it and did not constitute an "exceptional circumstance" which could justify amendments to the appeal case in the present case.

See also the following cases, where, in the board's view, its preliminary opinion did not raise a new objection which could have justified the filing of new requests: **T 14/20** (examining division's assessment already based on the same understanding of the features and definitions at issue), **T 1080/15** (objection raised by the board was a mere development of the objection originally raised by the examining division), **T 597/16** (board's observations consistent with the decision under appeal), **T 2486/16** (board, while departing in some respects from the reasoning of the examining division on inventive step, reached the same conclusion), **T 1294/16** (board cited D7 as evidence that an argument of the examining division was based on common general knowledge, but exceptional circumstances acknowledged for other reasons; see chapter V.A.4.5.5k)), **T 167/17** (board merely explained, in detail and by highlighting all relevant aspects, why it was of the preliminary opinion that the examining division had not erred in finding that the main request did not meet the requirements of Art. 76(1) EPC), **T 1639/18** (board argued in essentially the same manner as the examining division), **T 1058/20** (board's preliminary opinion merely confirmed the reasons given in the contested decision).

(iii) Preliminary opinion confirming (in essence) objections or arguments raised by the opposition division or the opponent

In **T 1187/16** the board held that, where all objections addressed in a board's communication had already been raised earlier on in the proceedings, the communication could not be regarded as creating exceptional circumstances within the meaning of Art. 13(2) RPBA. The objections in this case had already been set out in detail, in particular in the reply filed by the respondent (opponent). The board thus concluded that the appellant had already had **ample opportunity** before notification of the summons to oral proceedings **to respond** to the existing objections by filing precautionary auxiliary

requests. In the board's view, considerations of procedural economy and the fact that the appellant had filed the auxiliary request more than one month before the oral proceedings were irrelevant in such circumstances (for a different view, see however chapters V.A.4.5.1a) and V.A.4.5.1d)).

In **T 121/19** the board held that its endorsing one of the opponent's arguments was neither surprising nor unforeseeable; it was instead in the very nature of a decision-making body's process of determining the legal situation.

In **T 121/20** the respondent (patent proprietor) filed auxiliary request 1 in reaction to the board's preliminary opinion and argued that it appeared from this opinion that among the **various objections** of added matter raised by the appellant **only one** was **convincing** and that accordingly the amendments addressing the other objections were not necessary for meeting the requirements of Art. 123(2) EPC. The board, however, recalled that the preliminary opinion was predominantly intended to give the parties an opportunity to thoroughly prepare their arguments, but not to file new submissions.

In several decisions the fact that, in its communication under Art. 15(1) RPBA or at the oral proceedings, the board's opinion **differed from the contested decision** was not considered an exceptional circumstance within the meaning of Art. 13(2) RPBA.

The board in **T 2610/16**, for instance, refused to accept the line of argument put forward by the appellant (patent proprietor) that the amendment at issue had been made in response to the communication under Art. 15(1) RPBA and that there had been no need to file it during the opposition proceedings because the patent had been maintained as granted. The board instead pointed out that the objection (included in its communication) had already been raised in the grounds for opposition and reiterated in the grounds of appeal. In these circumstances, that the position it had taken in its communication differed from the contested decision was not a cogent reason justifying an exceptional circumstance within the meaning of Art. 13(2) RPBA. See also **T 752/16** (summarised in chapter V.A.4.5.4h).

The board in **T 1962/17** followed this case law (citing **T 764/16** and **T 2610/16**). It also remarked that, in doing so, it was even sticking to the practice before the revised RPBA's entry into force on 1 January 2020 (see **T 1906/17**). For further examples, see **T 1897/16**, **T 172/17**, **T 1422/17**, **T 1569/17**, **T 1717/17**, **T 1962/17**.

In other decisions the boards have also addressed the question of whether the objection it had raised in its preliminary opinion went **beyond the scope** of the one already raised previously in the proceedings or the facts asserted in support of it.

In **T 2539/16** the board found that this was not the case and that it had at most clarified the arguments made by the appellant on the basis of the facts already asserted.

Likewise, in **T 2775/17** the board rejected the respondent's argument that it had only been on reading the communication with the board's preliminary opinion that it had been able

to understand the tenor of the objections to its auxiliary request 2. The board found that its communication had not introduced any new aspect.

In **T 1891/16** the clarity objection raised in the board's communication to claim 1 of the fourth auxiliary request had been explicitly submitted in the opponent's reply only in relation to claim 1 of the first auxiliary request. However, the **same contested feature** was also present, unchanged, in the fourth request. Since, in the board's view, this was readily apparent to the patent proprietor, it could have filed the fifth auxiliary request as an immediate response to the opponent's reply instead of waiting for the board's summons.

In **T 2632/18** the board observed with regard to the case in hand that no new objections had been raised in the board's communication under Art. 15(1) RPBA. Only reasoning was provided as to why the appellant's arguments as regards novelty in view of feature (d) were not persuasive.

In **T 450/20** the board pointed out that a party could **refine** an objection within the previously established framework without this automatically constituting an amendment of its appeal case which could justify the filing of a new claim request. This also applied to a board taking up and refining arguments introduced by a party (citing **T 1891/20** of 15 November 2021). **T 450/20** was followed in **T 719/22**, in which exceptional circumstances were denied. Similarly **T 1656/20** (citing **T 1891/20** and **T 2563/17**) and **T 3258/19**.

g) Other cases in which amendments should have been filed earlier

As a rule, patent proprietors must not wait to see which objections the board follows up in its preliminary opinion before filing amended claim sets in response to them and, as illustrated in chapters V.A.4.5.4a) and V.A.4.5.4f), instances of such behaviour are one situation in which the boards have frequently found that the proprietor's requests should have been filed earlier. Other decisions in which the boards have reached this conclusion are summarised below. However, in some of the case law, the boards have taken the view that, even in cases where the requests should have been filed earlier, exceptional circumstances can nevertheless arise in view of other factors (see in particular chapters V.A.4.5.4j) and V.A.4.5.4k)).

(i) Amendments should have been filed before the first-instance department

In **T 2703/16** claim 1 of the main request and auxiliary request 1, filed for the first time less than two weeks before the oral proceedings, differed from claim 1 of the claim set underlying the appealed decision and of the claim set filed with the statement of grounds of appeal in that certain **limiting features** had been **removed**, with the result that the claimed method had significantly changed. According to the board, by deleting the limitations which had been introduced during the examination proceedings and maintained until its conclusion, the appellant had essentially reset the case and thereby let the appealed decision become irrelevant. Thus, a **fresh case** had been created. The board held that if it were to admit the new requests, it would be compelled to either give a first ruling on a significantly changed subject-matter, which would run counter to the primary

purpose of appeal proceedings, or remit the case to the department of first instance, which would clearly be contrary to procedural economy. In addition, the board saw issues under Art. 84 and 83 EPC. In view of the above, the board decided not to admit the new requests into the appeal proceedings.

In **T 1421/20** the board considered that the auxiliary requests at issue (0b', 0b'-1 and 0c'), which had been filed after the board had issued the summons to oral proceedings and which contained features which had **never** been **included in any of the claims** filed and discussed before the examination division, could and should have been filed during first-instance proceedings. Moreover, the board considered that it could not deal with requests comprising such features without undue burden, since it was not even certain that appropriate prior art was readily available in the file. Exercising its discretion under Art. 13 RPBA, the board decided not to admit the requests into the proceedings.

Similarly, in **T 2154/19** the board considered that the amendments requested at the oral proceedings before it could already have been filed at the opposition stage after the opposition division had found the main request not allowable at the oral proceedings. According to the board, that several different claim sets would have to have been filed at that point to overcome all the different novelty attacks addressed in the opposition proceedings was by no means an exceptional circumstance within the meaning of Art. 13(2) RPBA.

In **T 1058/20** (ex parte) the board explained that the **principles underlying Art. 12(2), (4) and (6) RPBA** can also be applied when assessing whether exceptional circumstances are present according to Art. 13(2) RPBA. Indeed, an amendment that would not have been admitted at the beginning of the appeal proceedings (as it could and should have been submitted during the first-instance proceedings) can normally not be justified at a later stage of the appeal proceedings either. In the case in hand, the board held that exceptional circumstances which could justify the admittance of the new first auxiliary request – restricted to only one of the previously claimed embodiments – were not present; the filing of a request limited to this embodiment would have been reasonable during the examining proceedings and the circumstances had neither changed in view of the impugned decision nor during the appeal proceedings. Moreover, the admittance of the new claim request would have changed the framework of the proceedings. The board pointed out that refraining from the submission of the new request in the first-instance proceedings contravened procedural economy. See also **T 1639/18**. On deletion of claims or claim alternatives, see also chapter V.A.4.5.4j).

(ii) Party initially addresses new objection raised in preliminary opinion only by providing arguments

In **T 428/18** the appellant (applicant) argued that the amended main request, filed during the oral proceedings and attempting to overcome a new objection raised in the board's preliminary opinion, should be admitted because it had not understood the objection until the oral proceedings. However, in the board's view the objection in its communication was sufficient to inform the appellant of its concern. It was then up to the appellant to consider, at the earliest opportunity, whether it was necessary to amend the application and to

carefully examine whether there was a basis for any such amendment in the application as filed. For the main request filed with its letter of reply, the appellant had chosen not to address the objection by making an amendment and instead argued that the objected-to features did in fact have a basis in the application as filed. Therefore, the board did not deem the circumstances mentioned by the appellant to be exceptional.

In inter partes case **T 1937/19**, in the board's view the respondent (patent proprietor) could and should have replied directly to the objections that the appellant had raised in its rejoinder against auxiliary request 2. The board emphasised that waiting for its preliminary opinion before making appropriate amendments was not commensurate with the purpose of the RPBA.

(iii) Board's opinion at the oral proceedings in essence confirms its preliminary opinion

In **T 1870/15** the appellant argued that the board's claim interpretation at the oral proceedings could not have been anticipated. The board, however, observed that its communication pursuant to Art. 15(1) RPBA had provided a preliminary assessment of inventive step of the claimed subject-matter over D1 as closest state of the art, which had already been thoroughly discussed in the proceedings before the examining division. The board's claim interpretation at the oral proceedings was merely a further elucidation of its inventive-step assessment which did not have any influence on the determination of the distinguishing features of the claimed subject-matter over document D1 and was entirely consistent with its previously communicated preliminary opinion on this issue. This was regarded by the board as a normal course of events during a discussion at oral proceedings.

In **T 545/19** the board's reasoning given during the oral proceedings differed from the shorter one in its preliminary opinion. But the board held that, this notwithstanding, the respondent had been informed of its preliminary negative opinion on the feature in question and could therefore not have been surprised that it came to a negative finding during the oral proceedings.

(iv) Requests replacing late-filed requests

In **T 640/20** the respondent argued that it was the board's communication under Art. 15(1) RPBA that had first raised doubts based on Art. 12(6) RPBA about the admissibility of the auxiliary requests it had filed with its reply to the appeal. It therefore considered that the new sets of claims it had submitted in response had been filed at the first opportunity. However, the board could not see any exceptional circumstances in this course of events. In particular, it observed that the conditions for admissibility under Art. 12 RPBA applied irrespective of whether the opponent had raised a related objection (see **T 1426/17**).

According to the boards in **T 2599/19** and **T 380/21**, their respective pointing to substantive issues in requests which were eventually not admitted under Art. 12(6) RPBA could not serve as a valid justification for the presence of exceptional circumstances.

h) Change of the board's opinion

The principles described in chapter V.A.4.5.4f) above also apply to a revised opinion of a board if it contains in essence objections already made by parties at an earlier stage of proceedings. Whether it diverges from a previous preliminary opinion was considered irrelevant in such cases.

In **T 752/16**, for instance, the board considered that it was irrelevant for the purposes of Art. 13(2) RPBA whether the revised preliminary opinion in its second communication under Art. 15(1) RPBA diverged from a previous position or differed from the contested decision. Parties to proceedings before the boards always had to reckon with an unfavourable preliminary opinion at any time up to announcement of the decision. The board observed in this connection that the main purpose of communicating a preliminary opinion under Art. 15(1) RPBA was to define the scope of the oral proceedings and that it was a procedural measure designed to make it easier for the parties to prepare for them efficiently, not an "invitation" to make further amendments (see e.g. **T 1459/11**). Patent proprietors were not entitled to hold back on making amendments in response to an opponent's objections until being confronted with an unfavourable preliminary opinion of the board or realising that the board was not going to endorse their position and arguments (see e.g. **T 136/16**, **T 2072/16**). See also **T 1187/16** and **T 646/17**.

In **T 995/18** too, the board held that it was irrelevant for the purposes of Art. 13(2) RPBA whether it departed at the oral proceedings from its preliminary opinion in the communication under Art. 15(1) RPBA. Each party to appeal proceedings had to present its own case **at the outset** – if necessary, by responding to the case made by the opposing party immediately – rather than waiting until the board confronted it with an unfavourable opinion. Changing an opinion expressly referred to as preliminary in the light of the oral discussion of arguments that were all already known from the written proceedings could not serve as justification for the purposes of Art. 13(2) RPBA. The board nevertheless admitted the auxiliary request filed at the oral proceedings on the basis that it did not regard it as an amendment within the meaning of Art. 13(2) RPBA (see chapter V.A.4.2.3d) above).

Similarly, in **T 924/22**, the board explained that given that the opinion in the communication under Art. 15(1) RPBA is preliminary, it was an objectively possible and foreseeable outcome of the oral proceedings that this opinion may change in the light of the submissions made at the oral proceedings (if this were not so, then oral proceedings would serve little purpose). It was therefore not an exceptional circumstance.

For further examples where the board changed its opinion in the course of the proceedings, but this was not accepted as an exceptional circumstance in the case at issue, see e.g. **T 24/18** and **T 920/20**. This situation has to be distinguished from that where the amendment has been filed as a direct response to a new line of argument raised by the board of its own motion (see e.g. **T 1482/17**).

i) Repeated attempts at overcoming deficiencies

In **T 2214/15**, the board held that there were no exceptional circumstances which would justify taking a further amended claim request (auxiliary request 3) into account. Rather, the identification of problems newly introduced when the appellant attempted to solve issues discussed in the proceedings up to that point was to be seen as an ordinary development of the discussion. Contrary to the appellant's submission, in the board's opinion, the present case was a typical case, where a central objection (that of lack of support) had been among the grounds for refusal, was identified and agreed with by the board and was the central topic throughout the appeal proceedings, thus typically not warranting the opportunity to file a further auxiliary request. The board pointed out that the topics of discussion in view of auxiliary request 2 (admitted but rejected as unallowable) did not differ in substance from those identified in the summons. The amendments were unsuccessful attempts at overcoming previously identified issues of clarity and lack of support already raised in the summons. The further objections concerning clarity raised by the board during the oral proceedings did **not** go **beyond the framework of the previous discussions**, which were defined by the underlying claim deficiencies. The board noted that if the appellant's argument that identifying newly introduced problems amounted to exceptional circumstances were correct, this would mean that the appellant would have to be given repeated opportunities to file amended claims until no new problems were introduced, which would be at odds with the primary object of the appeal proceedings of a judicial review of the impugned decision (Art. 12(2) RPBA). See also **T 975/20**.

Likewise in **T 1880/20** (ex parte) the board did not recognise exceptional circumstances in the following sequence: indication of the basis for claimed subject-matter only during the oral proceedings, conclusion of the board that the requirements of Art. 123(2) EPC were still not met, filing of amended claim request 6.

The board in **T 2578/19** observed that filing amended claims always entailed the possibility that the proposed amendments might lead to new objections, in particular under Art. 84 EPC or Art. 123(2) EPC. In addition, objections to features introduced at a late stage and first at issue on appeal were – just like objections to the admissibility of late-filed requests – necessarily new. That meant that treating such objections as creating exceptional circumstances within the meaning of Art. 13(2) RPBA would undermine the spirit and purpose of the provisions on admissibility in Art. 12 and 13 RPBA, which prescribed that late-filed amendments were to be admitted on appeal only in exceptional cases. See also **T 2214/15** (concerning an objection under Art. 123(2) EPC newly raised by the board to amendments made in auxiliary request 2).

In **T 2256/17** the board took a different approach in a case where it had raised a new inventive step objection in its communication under Art. 15(1) RPBA. In response to this communication, the appellant (applicant) had filed further requests. During the oral proceedings, the board raised objections of lack of clarity against these further requests for the first time. In response, the appellant filed another set of claims (sole request) with the aim of overcoming these new objections. In the board's view, these were exceptional circumstances within the meaning of Art. 13(2) RPBA.

j) Deletion of claims or alternatives in claims

It is now widely accepted that even an uncomplicated amendment to a set of claims, for example deletion of an entire claim category, always **constitutes an amendment to the appeal case** as per Art. 13 RPBA, regardless of whether this alters the factual or legal framework of the proceedings and thus leads to a "fresh case" (see e.g. **T 1800/21** with references to the case law; for more details, see chapter V.A.4.2.3d)).

However, in the case of deletions of claim categories, dependent claims or alternatives in claims, in a majority of decisions the boards have come – in the circumstances of their respective case – to the conclusion that exceptional circumstances were present and admitted the requests, even if these could have been filed earlier (e.g. **T 713/14**, **T 1224/15**, **T 1597/16**, **T 1439/16**, **T 853/17**, **T 1569/17**, **T 306/18**, **T 1857/19**, **T 489/20**, **T 2019/20**, **T 424/21**). The reasons given for this were among other things that the reduced claim-set did not change the scope of the appeal proceedings but simplified the proceedings (e.g. **T 306/18**, similarly **T 2019/20**), that it enhanced procedural economy without disadvantaging the opponent (e.g. **T 1857/19**, **T 424/21**), that the remaining claims had always been the principle focus in appeal proceedings (e.g. **T 489/20**), that the principles of procedural economy and procedural fairness were safeguarded (e.g. **T 2295/19**, in the same vein **T 1800/20**) that the factual and legal scope of the respondent's appeal case was not altered and the appellant was not faced with any new subject-matter (**T 2084/22**).

Examples, in which the reduced claim-sets were not admitted may be found in e.g. **T 355/19** (auxiliary requests 1 and 2), **T 499/20** and **T 1558/22**. In **T 499/20** the requests were not admitted essentially for the reason that the amendment altered the factual or legal framework of the proceedings. In **T 355/19** and **T 1558/22**, however, the boards focussed on the time of filing. In **T 1558/22** the board held that filing the amended request only at the oral proceedings despite a previous objection by the appellant was not compatible with the convergent approach.

On the interpretation of "exceptional circumstances", see also chapter V.A.4.5.1d) to V.A.4.5.1g).

(i) Amendments admitted

In **T 424/21** the board (referring to **T 1857/19**) held that deleting dependent claims 4 and 5 **enhanced procedural economy** as doing so clearly overcame existing objections without giving rise to any new issues. In the board's opinion these were cogent reasons justifying exceptional circumstances. The board took into account that this deletion did not affect the objections for the other claims, all of which had been addressed in the statement of grounds of appeal, the reply and the board's communication under Art. 15(1) RPBA. The appellant (**opponent**) was therefore **not disadvantaged** by the admittance of the request. The board interpreted the wording "shall, in principle," in Art. 13(2) RPBA such that it left the board at least some discretion in its assessment of the alleged exceptional circumstances. Sensibly applying this discretion appeared to be particularly important in technical fields with patents containing a **large number of dependent claims**. Generally

prohibiting the deletion of dependent claims in reaction to the development of the appeal proceedings would require a huge number of auxiliary requests to be filed at an early stage covering all combinations and permutations of possible fall-back positions. This would not be in the interest of procedural economy and not be in line with the aim and purpose of the RPBA.

In **T 2295/19** the board admitted auxiliary request 5, from which the substance claims had been removed, even though it considered that it would already have been possible and reasonable to file such a claim set together with the reply to the appeal. Its reason for this was that some boards had acknowledged exceptional circumstances in similar cases so long as admitting the amendment was not detrimental to procedural economy, the convergent approach laid down in the RPBA or the legitimate interests of a party to the proceedings (see **T 1598/18**, **T 1294/16**, **T 339/19**). Agreeing with this approach, the board observed that the wording of Art. 13(2) RPBA did not require that an amendment be triggered by exceptional circumstances. It was instead enough that exceptional circumstances existed, and these could therefore be of a **legal nature** too. That did not conflict with the explanatory remarks (Supplementary publication 1, OJ 2020, Annex 2, 221), which appeared to illustrate only the main scenario for applying the rule. In addition, a teleological interpretation, which takes into account the purpose of the power enshrined in Art. 114(2) and 123(1) EPC to disregard facts, evidence and requests not submitted in due time, seemed to support this conclusion. The "travaux préparatoires" for the EPC 1973 (see **T 122/84**, **T 951/91**) showed that this procedural possibility was intended to prevent parties from improperly delaying the proceedings. In the board's view, there was no reason to disregard requests filed at a late stage in the proceedings unless there was a risk of prejudice to the **principles of procedural economy and fair proceedings** (see also **T 339/19**). See also e.g. **T 2920/18** (decided by the same board), **T 2186/21** and **T 2022/22**.

The board in **T 355/19**, while pointing out in relation to auxiliary requests 1 and 2 that a "trial-and-error" approach or tactics by elimination ("salami" tactics) were not acceptable in proceedings of a judicial nature, admitted auxiliary request 3 on the basis that the amendments had been made well in advance of the oral proceedings and the deletion of claims **clearly simplified** the matter to be examined. See also **T 376/22**.

In **T 489/20** the board, citing **T 2080/18** (see chapter V.A.4.2.3d) above), admitted the new main request, in which all process claims had been deleted, as these deletions merely set aside the objection of lack of inventive step against the process as defined in claim 20 as granted (explicitly raised for the first time one month before by the respondent) without affecting the issues, submissions and conclusions with regard to the **remaining claims**, which had **always been the principal focus** of the opposition and appeal proceedings.

In **T 2019/20** all product claims had been deleted from the request filed during the oral proceedings before the board. The board considered that the claimed subject-matter and the attacks against it were fully encompassed by both the appellant's and the respondent's initial appeal case within the meaning of Art. 12(1) to (3) RPBA. Moreover, the request limited the potential issues for discussion. This meant that, in view of the totality of the facts of the present case, the filing of this request, although formally an amendment, in

substance did not constitute an amendment of a party's case within the meaning of Art. 12(4) RPBA, but rather a **partial abandonment of the initial appeal case**. There was no apparent reason not to admit such a request under any of the Art. 12(5) RPBA, Art. 13(1) RPBA or Art. 13(2) RPBA.

In **T 1800/21** only the device claims remained in auxiliary request V, which had been filed after notification of the summons to oral proceedings. Interpreting the term "exceptional circumstances", the board endorsed the view taken in **T 2295/19** that Art. 13(2) RPBA was intended to safeguard the principles of procedural economy and procedural fairness and that an auxiliary request could therefore be admitted if the amendment did not alter the factual or legal framework of the proceedings, did not require a re-evaluation of the matter at issue and did not run counter to procedural economy or the legitimate interests of any of the parties. A consistent line of case law appeared to be developing to the effect that exceptional circumstances within the meaning of Art. 13(2) RPBA could be accepted where an uncomplicated amendment such as the deletion of a whole claim category led to a request on the basis of which the patent could clearly be maintained. The board considered this line of case law to be in keeping with the convergent approach established by the RPBA, also in terms of the degree of relevance required of the amendment.

(ii) Amendments not admitted

The board in **T 355/19** conceded that cases where claims could be admissibly deleted at a late stage in the proceedings were possible, but that did not mean that the proprietor was completely free to adapt the claims throughout the proceedings, and especially not when the starting point was a claim set with seven independent claims and amended sets of claims had repeatedly been filed over the course of the proceedings. Giving a party that freedom would amount to allowing it to take a "trial-and-error" approach or use a process of elimination ("salami" tactics), both of which were unacceptable in any kind of proceedings, let alone in those of a judicial nature such as appeal proceedings. See also **T 172/22**.

In **T 499/20**, which concerned the deletion of alternatives within a claim, the board first observed that the filing of a set of claims in which granted claim 1 was further limited would already have been possible and reasonable with the reply to the statement of grounds of appeal. Moreover, the board held that the limitation in the first auxiliary request did not simplify the procedure in the sense that it would immediately overcome the objection of lack of inventive step. Therefore, it could not be held that the first auxiliary request did not alter the factual or legal framework of the proceedings, nor that there was no need for a re-weighting of the subject of the proceedings.

In **T 1558/22**, however, the factor the board based its assessment on was not whether the proceedings were simplified but rather the procedural conduct of the respondent (patent proprietor). It had argued that its auxiliary request 4a (in which two method claims had been deleted) was a corrected version of auxiliary request 4, which had already been filed during the opposition proceedings and then again with the reply to the appeal. There had been an obvious error in the deleted method claims, in that certain restrictive features had been left out by mistake. The board, however, could not see any obvious error and similarly

did not consider the correction to be obvious. It also found that the respondent could not have been taken by surprise at the oral proceedings by its opinion on inventive step of claims 12 and 13 according to auxiliary request 4. The respondent could not assume that where the preliminary opinion did not reiterate objections in relation to subordinate auxiliary requests, the objections did not apply to those requests, even though the facts were the same. The respondent had first sought to make amendments in response at the oral proceedings, but the board considered that it was precisely that kind of wait-and-see procedural conduct that the convergent approach laid down in the RPBA was designed to prevent. The board therefore held that there was no exceptional circumstance **beyond the respondent's sphere of responsibility** that might have justified the late filing of auxiliary request 4a. That made it irrelevant whether other criteria for exercising discretion laid down in Art. 12(4) and 13(1) RPBA (e.g. whether the amendment was uncomplicated) – which could be considered in addition to the strict requirements of Art. 13(2) RPBA – had been met.

k) Amendment not detrimental to procedural economy and no other party negatively affected

While in numerous decisions the boards have considered that there needs to be a causal link between the "exceptional circumstances" and the time of filing of new submissions in the proceedings (e.g. **T 2463/16**, **T 2486/16**), or that the "exceptional circumstances" need to justify the filing of new submissions only at this advanced stage of the proceedings (e.g. **T 1904/16**, **T 1590/19**, **T 2795/19**), in numerous other decisions the boards have interpreted "exceptional circumstances justified with cogent reasons" in a broader sense. In **T 339/19** the board explained that, in each case, it was incumbent on the deciding board to balance the right to be heard with the public interest of doing justice in good time. There have been numerous other decisions in the same vein in which "exceptional circumstances" were seen as ones in which admittance would **not impair the procedural rights of another party or procedural economy** (see e.g. **T 1294/16**, **T 101/18**, **T 1290/18**, **T 1598/18**, **T 2920/18**, **T 339/19** and **T 2465/19**). For an overview of the case law on the interpretation of "exceptional circumstances" and, more generally, of the various different approaches to interpreting Art. 13(2) RPBA, see chapter V.A.4.5.1.

Many of the decisions adopting the more lenient approach concern cases in which a claim alternative, dependent claims or an entire claim category has been deleted. On these cases see chapter V.A.4.5.4j). In the following, some further decisions are summarised in which the boards following this approach have dealt with amendments other than deletions of claims or claim alternatives.

In ex parte case **T 1294/16** the board observed that the example of exceptional circumstances provided in the explanatory remarks (namely a new objection raised by the board) suggested that exceptionality was not necessarily linked to events being exceptional in the sense of deviating from the expected, but could also be caused by considerations related to the legal framework, notably the principles underlying the RPBA. Art. 12 and 13 RPBA implemented the "convergent approach", the **major motivation** for which was the **procedural economy** of the appeal proceedings. The board deduced from this that if admittance of a (late-filed) submission was not detrimental to procedural

economy, it was appropriate to accept that there were "exceptional circumstances" within the meaning of Art. 13(2) RPBA, provided that this did not adversely affect the other party. In the case in hand, the board admitted the three late-filed auxiliary requests because they were filed in ex parte proceedings and the board was able to deal with the amendment without undue delay during the oral proceedings.

In **T 2465/19** (likewise ex parte) the claims and the adapted description (main request) had been filed as a response to the **express invitation of the board** in its communication under Art. 15(1) RPBA to file such amended application documents. The board was satisfied that the amendments prima facie appeared suitable to overcome the outstanding objections and admitted the request under Art. 13(2) RPBA. In the board's view, Art. 12 and 13 RPBA mainly served to prevent the raising of issues that could not be expected to be treated by other parties or the board within the foreseeable extent of the appeal proceedings.

In inter partes case **T 339/19**, in which the respondent replaced two percentage ranges by two percentage values in its new main request, the board agreed with the interpretation of "exceptional circumstances" explained in **T 1294/16** and held that "exceptional circumstances" were those that compromised neither the procedural rights of the other party, nor procedural economy. The new main request had been filed after receipt of the preliminary opinion, which had not raised any points of fact or of law that had not already been addressed. But the board found it a good-faith attempt to overcome the inventive step objection raised against the main request then on file. Moreover the request did not raise new issues, could be dealt with within the current framework of proceedings and posed no additional difficulties or surprises for either the other party or the board.

Decision **T 1294/16** was also followed in **T 2920/18**, in which the board added that a teleological interpretation of "exceptional circumstances" which considered the purpose of the EPO's power to disregard late-filed facts or evidence and the discretionary power to refuse new requests as enshrined in Art. 114(2) EPC and Art. 123(1) EPC seemed to support this view. Indeed, it followed from the preparatory documents to the EPC 1973 (cf. **T 122/84**, **T 951/91**) that this procedural possibility was intended to prevent the parties from improperly delaying the proceedings. In particular, it served to **ensure** the principles of **procedural economy** and of **procedural fairness**. The power to disregard late submissions under the EPC did not constitute a procedural end in itself.

In **T 1686/21**, concerning a new specific combination of features, the board likewise held that exceptional circumstances could justify the admissibility of a request filed for the first time at the oral proceedings before the board even when the amendment were made in response to an objection raised long ago. In the case in hand, the board held that the amendment, which clearly solved the issue raised against the patent as maintained, could not be considered surprising for the appellant in such a way as to negatively affect its position in the appeal proceedings. Furthermore, the amendment did not give rise to new objections and was not detrimental to procedural economy. The board also pointed out that, in view of the **large number of different objections** raised under Art. 76(1) EPC, the number of requests to be filed at the very beginning of the appeal proceedings in order to provide appropriate fall-back positions for every possible outcome of the assessment of

compliance with Art. 76(1) EPC would have been extremely high and therefore not compliant with procedural efficiency.

The case in **T 1774/17** concerned a clarifying claim-amendment during oral proceedings which was **not objected to by the other party**. The single-word amendment which was intended to overcome an Art. 123(2) EPC objection merely made explicit a feature which the opposition division had already considered to be implicit in the request on which the decision under appeal was based. The board therefore decided to admit the request. The other party's agreement was also mentioned in **T 1294/16** as an element to be taken into account when establishing exceptional circumstances.

For further inter partes cases in which amendments were not detrimental to procedural economy and did not negatively affect any other party, see e.g. **T 1055/17**, **T 732/21**, **T 1758/22**.

See however also those decisions cited in chapter V.A.4.5.1d) to V.A.4.5.1g), which advocate a stricter approach to the interpretation of Art. 13(2) RPBA, focussing on the time of filing and the party's duty to facilitate due and swift conduct of the proceedings.

l) Right to be heard violated and no other party affected

In **T 545/18** the appellant (applicant) submitted for the first time during the oral proceedings before the board that its right to be heard had been violated in the first-instance proceedings. The board considered that, given the great importance attached to the right to be heard in the EPC and in the case law and the facts that no other party was affected by the late raising of this objection and that the board was in a position to take a decision on this issue without postponing the oral proceedings, there were exceptional circumstances within the meaning of Art. 13(2) RPBA. See likewise **T 2111/19**.

m) Prima facie and clear allowability

In **T 2482/22**, which concerned the last stage of appeal proceedings, the board rejected the argument that concerns of validity of the patents issued by the EPO had to trump any other considerations. The legislator had seen this differently, as evident from Art. 12(2) RPBA. As a consequence, the possibility for a party to change its case or add to it was very limited, and increasingly so as the appeal procedure progressed. See also the summary in chapter V.A.4.5.1d). See also **T 967/16**, in which the board found that there was no established "last chance" doctrine or any absolute right for a patent proprietor to such a "last chance" request (with reference to CLB, 9th edn. 2019, V.A.4.12.7, and to **T 837/07** and **T 1624/16**).

In **T 1185/17** the appellant argued that auxiliary request 1, filed after notification of the summons to oral proceedings, overcame the objection under Art. 123(2) EPC referenced in the board's preliminary opinion and was prima facie allowable. The board, however, underlined that these were criteria under Art. 13(1) RPBA that applied to any amendment of the party's appeal case after it had filed its grounds of appeal and therefore could not

simultaneously be cogent reasons justifying exceptional circumstances for taking an amendment into account under Art. 13(2) RPBA. See also **T 2787/17**.

In **T 2964/18** the board held that the question of whether auxiliary requests 2a and 2b might be clearly allowable had no bearing on its conclusion that no exceptional circumstances existed that would justify the filing shortly before the oral proceedings. Similarly see **T 1058/20**, according to which prima facie allowability as such did not justify exceptional circumstances under Art. 13(2) RPBA. See also **T 975/20**, **T 1959/19** and **T 1610/22**.

However, decisions in which clear allowability together with the fact that no other party was negatively affected were considered to constitute exceptional circumstances and the late-filed requests were admitted are contained in chapter V.A.4.5.4k) "Amendment not detrimental to procedural economy and no other party negatively affected". See also chapter V.A.4.5.4 j) on "Deletion of claims or alternatives in claims". In **T 541/20** the board emphasised that it would be at odds with one of the declared aims of the RPBA, namely "to increase efficiency, by reducing the number of issues to be treated", that a board could not consider the criterion of prima facie allowability when deciding on the admittance of a request which simplified the case in hand in a substantial manner (by deletion of dependent claims).

In other situations, taking prima facie allowability as a criterion for exercising discretion can result in a refusal to admit the filed set of claims even where it was a timely response to new objections. On this see chapter V.A.4.5.4 e) "No carte blanche to amend claims at will – criteria set out in Articles 13(1) and 12(4) RPBA".

n) Editorial amendments to remove inconsistencies and typographical errors

In **T 131/18** the main request at issue (filed after notification of the summons to oral proceedings) was, save for two amendments, identical in wording and content to auxiliary request 3, which had already been filed in response to the reply and which the board considered to meet the conditions for admission under Art. 13(1) RPBA. The two amendments in the main request served to clear up inconsistencies remaining in auxiliary request 3 (wording incompatible with Art. 123(2) EPC removed from claim 1 but left in dependent claim 2, and an unclear expression replaced in claim 1 but not in claim 6). The board concurred with the appellant that the amendments were merely editorial changes occasioned chiefly by its communication under Art. 15(1) RPBA, and classed this as an exceptional circumstance within the meaning of Art. 13(2) RPBA. Art. 13(2) RPBA had not been intended to rule out entirely the possibility of making minor amendments such as ones correcting obvious discrepancies or grammatical errors, which were admissible under R. 139 EPC for instance, once the summons to oral proceedings had been issued. See also **T 911/20**, in which a linguistic mistake was corrected that had first been objected to at the oral proceedings before the board.

Similarly, in **T 676/21**, the board admitted a new auxiliary request 1, filed during the oral proceedings before the board, in which a typographical error had been corrected. This typographical error was already contained in the claims as maintained by the opposition

division and contravened Art. 123(3) EPC. It had been overlooked by all up to the oral proceedings.

In **T 1558/22**, by contrast, the board refused to admit an amendment filed at the oral proceedings that went beyond correcting obvious inconsistencies or grammatical errors. The correction took the form of deleting method claims 12 and 13, which, according to the patent proprietor, contained an obvious error in that certain – clearly intended – features had been left out by mistake. The board, however, could not see any obvious error; nor did it consider it obvious what had originally been intended. It held that the proprietor was obliged, as part of its procedural duty to act diligently, to go through its own requests again ahead of the oral proceedings, and to correct them if necessary.

o) Adaptation of the description

In **T 1968/18** the board took the view that the filing of amended description pages resulted in an amendment to the patent proprietor's appeal case. However, in the board's view the term "exceptional circumstances" was not restricted to new or unforeseen developments in the appeal proceedings but could be interpreted more broadly (e.g. **T 713/14**, **T 1294/16**, **T 545/18**, **T 661/18** and **T 1598/18**). The board pointed out that according to established case law, if the claims of a patent as granted were amended, the description had to be made consistent therewith (e.g. **T 977/94**, **T 1883/11**, **T 1252/11**, **T 237/16**, **T 987/16**, **T 1024/18** and **T 121/20**). Moreover it was established practice of the boards of appeal to deal with the question of adapting the description only after the board had concluded that the claims of the patent as amended were allowable. Against this background, the board saw exceptional circumstances in that the amended description pages were filed to adapt the description to the claims of the main request, which was considered allowable.

Referring to **T 1968/18**, the board in **T 1695/21** confirmed the view that an adapted description should normally only be filed after the board has concluded that there is an allowable version of the claims. See also **T 2465/19**.

See also chapter V.A.4.2.3k) on whether adapting the description is even to be treated as an amendment. The board in **T 2178/17**, for instance, considered that it was not.

p) Response to a large number of objections

In **T 24/18** the proprietor had argued among other things that the late filing of auxiliary requests 2a and 2b was justified by the change of opinion of the board and the vagueness of the relevant objections of the opponents. The reason for not having filed these requests earlier was that the proprietor had not wanted to cover all possible permutations of amendments as this would have led to an excessive number of requests due to the large number of objections raised. The board rejected this argumentation as the circumstances cited by the proprietor appeared to describe a fairly normal course of events. It was not uncommon for the board to modify its preliminary opinion in view of the details discussed or the questions raised during the oral proceedings. The allegedly high number of objections was also not a reason to justify the late filing of requests, because this was by no means an exceptional circumstance. The board further considered that the fact that the

requests would not present the opponents with completely new subject-matter, was not relevant when exercising the board's limited discretion under Art. 13(2) RPBA.

In **T 1686/21**, on the other hand, the board pointed out that, in view of the large number of different objections raised under Art. 76(1) EPC, the number of requests to be filed at the very beginning of the appeal proceedings in order to provide appropriate fall-back positions for every possible outcome of the assessment of compliance with Art. 76(1) EPC would have been extremely high and therefore not compliant with procedural efficiency. The board considered this to be an exceptional circumstance.

q) Requests reordered

In **T 1436/19** the appellant (patent proprietor) justified the proposed reordering by referring to the need for procedural economy in view of the preliminary opinion of the board, which stated that auxiliary request 4 was likely to overcome all the objections raised under Art. 83 EPC, Art. 84 EPC and Art. 123(2) EPC. The board decided that the reordering of the requests constituted an amendment to the appellant's appeal case and that it could not be taken into account because, inter alia, allowing the proposed reordering would force the board to first decide on a **fully new main request** not underlying the decision under appeal. This would be contrary to Art. 12(2) RPBA. In fact, the proposed reordering of requests would potentially lead to a situation where the board would have to remit the case to the department of first instance without having decided on requests underlying the decision under appeal still on file. This would be contrary to the scope of the appeal proceedings and might be also **detrimental to procedural economy as a whole**.

In **T 2166/22** the board admitted the change of order of the auxiliary requests. It pointed out that the **factual and legal framework** of the respondent's (proprietor's) appeal case had **not changed** with the reordering of the auxiliary requests. Indeed, all the auxiliary requests had been submitted in opposition proceedings and resubmitted with the reply to the statement of grounds. Moreover, contrary to the appellant's argument, the change of order did not affect the procedural economy.

For a further example where a renumbered request was admitted, see **T 369/22**.

See also chapter V.A.4.2.3i) on the different views on whether reordering requests amounts to an amendment of the appeal case.

r) Procedural requests – requests for non-admittance of other party's submissions

In **T 847/20** the admittance of a request submitted with the statement of grounds of appeal was challenged by the respondent (opponent) only during oral proceedings. The board considered that the objection to admittance of this request should have been raised in the respondent's rejoinder and exercised its discretion under Art. 13(2) RPBA not to admit it into the proceedings.

In **T 1774/21** the appellant had raised an allegedly new line of attack against a feature of the main request (patent as maintained) in its statement of grounds of appeal. The

respondent had requested only in its response to the board's communication under Art. 15(1) RPBA that it not be admitted into the proceedings pursuant to Art. 12(2), (4) and (6) RPBA. The board rejected this request and did not agree with the respondent's argument that it was under the obligation, ex officio, to assess and decide on admittance of this attack. It explained that a board may indeed examine of its own motion the question of whether an objection was filed "late", since it was not restricted to the facts, evidence and arguments provided by the parties and the relief sought (Art. 114(1), second sentence, EPC). Moreover, Art. 114(2) EPC indeed gave the board the power to "disregard facts or evidence" which were not submitted in due time. However, the fact that Art. 114(2) EPC stated that the EPO "may" do so, also meant that a board was not obliged ex officio to examine this issue. Such an obligation could also not be inferred from the principle of ex officio examination laid down in Art. 114(1), first sentence, EPC as in general this principle was to be applied in opposition appeal proceedings in a more restrictive manner (**G 9/91**, OJ 1993, 408). The board disagreed with decision **T 1006/21** in this respect.

On whether a request for non-admittance of a new submission filed after the initial phase of the appeal proceedings constitutes an amendment to the party's appeal case in the first place, see chapter V.A.4.2.3j).

s) Circumstances in the sphere of the representative

(i) Change of representative or clerk

It is the boards' established case law that a change of representative usually does not qualify as an exceptional circumstance that could justify late submission (see e.g. **T 1080/15**, citing CLB, 9th edn. 2019, V.A.4.8.2, as well as **T 1904/16**, **T 301/17**, **T 664/17** and **T 1758/22**, and the other decisions cited there).

In **T 615/17**, for instance, the board confirmed that the admissibility of an amendment could not depend on whether there had been a change of representative, which was down to the choice made by the appellant for its own – possibly even strategic – reasons. It also reiterated that it was ultimately the applicant's responsibility to determine the subject-matter of a patent (**T 382/96**).

The board in **T 1952/19** held that the same considerations applied in cases where responsibility for handling an appeal passed from one of the appellant's clerks to another.

(ii) Representative unable to contact appellant

In **T 2329/15** the board did not accept the appellant's lack of involvement in the prosecution of the case in hand as an exceptional circumstance. Exceptional circumstances generally concerned new or unforeseen developments in the appeal proceedings themselves. In the same vein, see **T 190/19**, in which, in addition, the late-filed amendments prima facie did not overcome all objections raised, gave rise to new objections and did not exclusively relate to objections raised for the first time by the board in its communication under Art. 15(1) RPBA.

4.5.5 Admittance of new facts, objections, arguments and evidence

The main aspects of the case law on admitting new submissions at the third level of the convergent approach have already been outlined in chapter V.A.4.5.1. Structured by topic, the following now looks in more detail at the case law on admitting new facts, objections, arguments and evidence.

a) Waiting for the preliminary opinion not compatible with convergent approach

(i) Preliminary opinion not an invitation to make further submissions

In **T 1756/16** the board refused under Art. 13(2) RPBA to admit an inventive-step objection raised only after the summons to oral proceedings. It did not accept the appellant's argument that it had to be taken into account because it had been submitted within the period set in the board's communication under Art. 15(1) RPBA. It pointed out that – even if, as in this case, a communication under Art. 15(1) RPBA often set the parties a time limit for filing any submissions, which would then be subject to the admission criteria in Art. 114(2) EPC and Art. 13 RPBA – it was not a communication under R. 100(2) EPC inviting them to file observations within a specified period. The appellant had therefore not been entitled to presume that any new objections would be admitted simply because they had been filed before that time limit. See also **T 884/18**.

In **T 1767/18** the board pointed out that a communication sent by a board in preparation for oral proceedings was not binding. It was intended solely as an aid to preparing for the oral proceedings and was precisely not to be understood as an invitation to make new submissions.

(ii) Requirement to respond to the case made by the opposing party

In **T 1108/16** the board found as follows: a party's omitting to carefully analyse the opposing party's written pleadings and preferring to wait for the board's preliminary opinion before responding to an objection (here: objection of extended scope of protection) was at odds with the function of appeal proceedings, which were aimed at reviewing the contested decision, and with the rule designed to ensure the necessary procedural economy that parties had to present their complete cases at an early stage (Art. 106(1) EPC, R. 99(2) EPC and Art. 12(2) RPBA). The respondent's conduct ran counter to procedural economy and so the board refused to admit the arguments it had submitted only in response to the board's communication.

See also chapter V.A.4.5.5f) "Board's opinion based exclusively on earlier party submissions or reasoning of the first-instance division" and chapter V.A.4.5.5g) "Importance of a direct response to the other party's written submissions".

b) Justified response to new requests in the reply to the appeal

In **T 924/22** the respondent (proprietor) had submitted auxiliary request 5 with the reply to the statement of grounds of appeal. The appellant objected to this request in its rejoinder,

which was, in the board's view, the first reasonable opportunity to do so, after the summons but well before the board issued its preliminary opinion. The board held that the appellant (opponent) should be given a fair opportunity to respond to the respondent's requests that they could not foresee when they filed their appeal, even if these requests were those **filed already in opposition**. This situation represented exceptional circumstances under Art. 13(2) RPBA. The board then applied the criteria of Art. 13(1) RPBA referring to Art. 12(4) to (6) RPBA and found that all three criteria (amendment of the appellant's case should be suitable in regard of the relevant issues, not detrimental to procedural economy and not complex) were met.

For decisions on whether the appellant-opponent has to raise objections against auxiliary requests which were not considered in the appealed decision but raised in the first-instance proceedings as early as in its grounds of appeal, see also chapter V.A.4.3.5c)(ii), in particular **T 664/20**, in which the board took a different view.

c) Justified response to new line of arguments in the board's preliminary opinion

While it is incompatible with the convergent approach for a party to wait for the board's communication under Art. 15(1) RPBA instead of responding directly to the other parties' submissions (see chapter V.A.4.5.5a) above), a new line of arguments in that communication may well give rise to exceptional circumstances or at least be taken into account in assessing whether such circumstances exist.

In **T 1309/16** the board admitted new citations (D23-D25) forming common general knowledge that had been filed in response to a new line of argument in its preliminary opinion.

In **T 1038/18** the appellant (opponent), in reply to the preliminary opinion expressed by the board in its communication under Art. 15(1) RPBA, submitted for the first time during the appeal proceedings arguments of lack of inventive step over document D1 in respect of a claimed feature that did not correspond to the features identified by the opposition division as new but had subsequently been identified in the board's preliminary opinion as the sole distinguishing feature over document D1. The board did not agree with the respondent (patent proprietor), who objected that the appellant's arguments could have been submitted with the statement of grounds of appeal as precautionary measure and therefore should not be admitted. It instead acknowledged cogent reasons justifying exceptional circumstances and, in the exercise of its discretion under Art. 13(2) RPBA, admitted the appellant's arguments into the proceedings.

In **T 1287/21** the validity of Annexes A to C, which served to prove the identity of a product used in the examples of the patent, was for the first time questioned in the proceedings by the board in its preliminary opinion. The appellant had not previously contested this evidence. In the board's view the submission of Annexes E and F in response to the new arguments set out in the preliminary opinion was therefore justified by exceptional circumstances. See also **T 1756/21** (expert statement in reaction to a new argument of the board).

d) Justified response to a reweighting of the case in the board's preliminary opinion

In **T 1780/19** the respondent (patent proprietor) submitted test report P6' after receiving the summons. The board viewed the repeated test reported there as supplementing the test carried out by the appellant (opponent) and described in E21. E21 had already been discussed in the opposition proceedings, but another finding had then been added on appeal. In its preliminary opinion, the board attached particular importance to this addition, which resulted in a reweighting of the matters at issue in the case. The board found that the filing of the repeated test in P6' was to be seen as a response to this. Moreover, consideration of P6' did not disadvantage the appellant, who had opened the way for this amendment by submitting an incomplete test report.

See also **T 935/19** (new submissions relating to Art. 83 EPC in response to a point made clear in the board's preliminary opinion).

e) Justified response to new developments in the case following the communication under Article 15(1) RPBA

In **T 415/20** D15 and D16 were ISO standards filed two days before the oral proceedings before the board in support of an argument concerning the measurement in the report D14. D15 and D16 were submitted in reaction to an argument of appellant I raised only two weeks before the oral proceedings. Thus, the submission of D15 and D16 resulted from the development of the case on appeal and took place at the **earliest possible point in time**. This, in the board's view, constituted exceptional circumstances in favour of their admittance in the sense of Art. 13(2) RPBA. In **T 1411/19** the appellant raised an objection of lack of inventive step to claim 1 of auxiliary request 1 on the basis of documents D1 and D2 for the first time during oral proceedings before the board. Its related submissions went well beyond the objection, likewise based on documents D1 and D2, previously raised in the written proceedings to the subject-matter of granted claim 4. However, these new submissions had followed a change in the interpretation of claim 1 of the auxiliary request in the light of the arguments made during the oral proceedings and a discussion, for the first time, of certain aspects of the disclosure of D1. The board held that, in view of this new legal and factual situation, there were exceptional circumstances within the meaning of Art. 13(2) RPBA which justified the admission of the new objection on grounds of procedural fairness.

f) Board's opinion based exclusively on earlier party submissions or reasoning of the first-instance division

In **T 908/19** the appellant (opponent) justified the late submission of a further document and new lines of attack only at the oral proceedings by arguing that neither the document nor the objections could have been raised earlier since they were filed in response to the board's preliminary opinion expressed in the annex to the summons. The board could not accept this argument, as its preliminary opinion had been based exclusively on the submissions made by the parties in the grounds of appeal and the reply. Nor had the appellant identified any particular aspect that might be new or surprising to it, but rather appeared motivated by the fact that the board had pronounced itself provisionally in favour

of the respondent. See also **T 2271/17** (summarised above in chapter V.A.4.5.4g)) and **T 1639/18** (ex parte).

As made clear by the board in **T 662/22**, the fact that it had concurred with the patent proprietor's submission on a particular point did not amount to an exceptional circumstance that could justify the admission of new submissions. Indeed, it was in the nature of inter partes proceedings for a board to find one party's arguments more convincing than those made by the other and, as a result, to reach a conclusion in favour of that first party (in this case at the oral proceedings).

In **T 2843/19** the board pointed out that in its communication under Art. 15(1) RPBA it had merely expressed its preliminary opinion that E3 might not be novelty destroying for the subject-matter of granted claim 1. Even if by doing so it had made an assessment of the arguments put forward by the respondent, it had not raised a new issue. This could not be seen as an exceptional circumstance that could justify the late submission of the new objection of lack of inventive step over E3 so soon before the scheduled date for the oral proceedings.

In **T 73/20** the appellant argued that D7 contained experimental evidence responding to a statement by the board in its preliminary opinion regarding an alleged technical prejudice. The board disagreed and pointed out that the board's indications did not give rise to new issues. They merely pointed to the fact that the appellant's new submission was not supported by suitable evidence, as required by Art. 12(3) RPBA. As underlined by the board, a party cannot shift its responsibility under this provision to the board and wait for a negative opinion to complete its case.

See also **T 276/17** (D 23 not admitted, because the board's communication had merely addressed an issue already raised by the opposition division and made the connection with one of the appellant's arguments).

See also the decisions summarised in chapter V.A.4.5.5g) "Importance of a direct response to the other party's written submissions" and **T 684/18** summarised in chapter V.A.4.5.5h) "Inventive step objection following unsuccessful novelty objection".

g) Importance of a direct response to the other party's written submissions

In several decisions, the boards have stressed the importance of a direct response to the other party's written submissions, in particular to the reply to the appeal. It is incumbent upon each party to submit all objections it considers relevant at the earliest possible stage in the proceedings (see, for example, **T 2271/17**).

In **T 1756/16** the board considered that the fact that auxiliary request 1, initially filed with the reply, had been slightly amended again in response to its communication under Art. 15(1) RPBA did not justify the new objection (lack of inventive step) subsequently filed by the appellant, because the new auxiliary request 1 was similar in content to the old one and the appellant had already had an opportunity to respond to the filing of that older request. In this connection, the board observed that the new RPBA instructed the boards

not to send a summons in inter partes proceedings any earlier than two months after receipt of the reply (Art. 15(1) RPBA, only one month since 1 January 2024, see OJ 2023, A103). The aim of this timing was to give parties an opportunity to respond to another party's written reply.

In **T 2843/19** too, the board found that the appellant had not submitted any cogent reasons for not providing its answer to the arguments in the reply to the appeal in direct response to it, but instead only shortly before the oral proceedings. As the board emphasised, the RPBA required that the parties make their submissions in the proceedings in good enough time to enable the board to take them into account when drafting the summons. Where the submissions were intended to counter lines of attack or auxiliary requests that had not already been considered in the contested decision but were submitted by the respondent in its reply to the appeal, filing a rejoinder in response to that reply was the appropriate course of action for the appellant. The board rejected the argument that it was unreasonable to have to present a whole chain of successive lines of argument for every position the board might conceivably take. In inter partes appeal proceedings, the parties had a **duty to facilitate due and swift conduct of the proceedings**, for reasons of fairness towards the other party, but also in order to bring the proceedings to a close within a reasonable period of time.

In **T 2271/17** it was not until the oral proceedings that the appellant (opponent) raised a new inventive step objection against auxiliary request 3 which had been filed already with the reply to the grounds of appeal. The board pointed out that, independently of whether the board's opinion (which had triggered the new submission) was foreseeable, it was the responsibility of the appellant to **prepare for the possibility that the board may decide against it** in relation to a specific objection, and accordingly, to submit all objections it considered relevant at the earliest possible stage in the proceedings.

h) Inventive step objection following unsuccessful novelty objection

In its communication under Art. 15(1) RPBA, the board in **T 684/18** expressed doubts about the arguments the appellant (opponent) had put forward on the novelty of claim 1 of the main request. This prompted the appellant to attack inventive step. The board held that its comment in relation to the novelty of the claimed subject-matter had not in itself given rise to any new issue that could have justified responding with a new attack on inventive step.

In **T 1042/18** the appellant (opponent) had raised new objections of lack of inventive step over D4 or D5, which it had previously taken as a basis for novelty objections. In the board's view, these novelty objections could not be regarded as exceptional circumstances justifying the admission of new objections of lack of inventive step over these documents. The findings in **T 131/01** and **T 597/07** had to be understood against the specific background of those cases and the legal situation at the time (see, by contrast, **T 1029/14**, **T 448/03** and **T 184/17**). In particular, the board held that the finding that it was impossible to substantiate lack of inventive step as a ground for opposition if lack of novelty was already being asserted on the basis of the same document could not be applied in such a general sense to appeal proceedings. Along the same lines **T 1179/17** and **T 1407/18**.

i) Further cases in which the new submissions should have been filed earlier

(i) No right to raise objections against amendments to the patent under Article 123(2) and 84 EPC at any time

In **T 482/18** it was not until the oral proceedings on appeal that the appellant (opponent) raised objections under Art. 123(2) and 84 EPC to a term in the claims according to the main request (identical to the auxiliary request on the basis of which the opposition division had maintained the patent). It had not contested the feature in question under Art. 123(2) EPC before the opposition division, which had rejected a clarity objection to this feature. The board dismissed the opponent's arguments in support of admitting this amendment to its appeal case. In particular, it could see no basis for inferring from Art. 114 EPC 1973 (identical to Art. 114 EPC) any essentially absolute right to raise such objections in any circumstances and at any time or even any duty of the board of the kind asserted by the opponent to investigate of its own motion.

(ii) High number of auxiliary requests generally does not justify late submission

In **T 2964/18** the board rejected the appellant's argument that its new inventive-step objections raised only at the oral proceedings should be admitted in view of the high number of auxiliary requests. In the board's view, in the current case, the number of auxiliary requests (namely seventeen) filed with the reply to the appeal was not excessive, especially in view of the numerous inventive-step objections raised by the appellant in the statement of grounds of appeal. In fact, seven documents had been indicated by the appellant as documents possibly representing the closest prior art.

Likewise in **T 2391/18**, contrary to the appellant's opinion, the board did not see any insurmountable or unreasonable task in dealing with fifteen auxiliary requests which had been filed in a timely manner (with the reply to the statement of grounds of appeal) and comprised a limited number of well-defined amendments, which were moreover repeated and combined in the different auxiliary requests – including the mere deletion of granted claims in some cases. Thus, the lines of attack on novelty and inventive step of the third auxiliary request (now main request) could and should have been raised in a timely response to their filing.

(iii) Late-filed objection that would have equally applied to earlier requests

In **T 1771/17** the appellant (opponent) raised a novelty objection against claim 1 of auxiliary request 2B, which had been filed as a legitimate response to the board's preliminary opinion and so admitted. The board noted that auxiliary request 2B was based on an earlier request already on file and against which no objection had been raised by the appellant in the written proceedings. Since the new novelty objection would have equally applied to the earlier request and the appellant had not provided any cogent reasons why it had not been filed earlier, the board decided not to take it into account.

(iv) New objection or argument based on finding concerning a divisional application

In **T 1266/19** the board recalled that it was established case law that proceedings against a parent and a divisional application are separate independent proceedings. Thus, the facts, evidence, and submissions made or filed in these proceedings were not automatically part of the parent procedure and vice versa. No exceptional circumstances in the sense of Art. 13(2) RPBA could be inferred from decisions relating to a different case, or arguments submitted therein. See also chapters II.F.4.1.1 and II.F.4.1.5.

j) Basis of the appeal proceedings unchanged and amendment not detrimental to procedural economy

On the interpretation of the term "exceptional circumstances" in Art. 13(2) RPBA, the board in **T 988/17** observed that neither Art. 13(2) RPBA nor the related explanatory remarks in CA/3/19 (see also Supplementary publication 2, OJ 2020, 60) explained how to determine in general whether circumstances are "exceptional". However, the remarks did mention, as an example of such circumstances, situations where the board raised an objection for the first time in a communication. According to these remarks, the changed basis of the appeal proceedings in such a situation justified amending submissions. The board concluded that the question of whether, conversely, amended submissions also changed the basis of the appeal proceedings was thus a possible criterion to be applied when assessing whether the circumstances were exceptional. In addition, the board had to consider the criteria under Art. 13(1) RPBA when exercising its discretion under Art. 13(2) RPBA. In the case before it, the board concluded that the amended submissions (on whether there was an inventive step), which were based on facts and evidence already submitted earlier on in the appeal proceedings, did not change the basis of the proceedings, helped to resolve the issue raised and were therefore not detrimental to procedural economy. It therefore exercised its discretion to admit the new submissions into the proceedings.

k) Immediately apparent that objection raised against different request also applies to request at issue

In **T 2219/18** the board considered that there were exceptional circumstances in the case in hand, because the arguments submitted by the opponent against claim 1 of auxiliary request 3 during oral proceedings were entirely identical with the arguments submitted in the statement of grounds of appeal against claim 1 of auxiliary request 1. According to the board it was immediately apparent that these arguments likewise applied to claim 1 of auxiliary request 3. Consequently, the opponent's submissions during oral proceedings were by no means unexpected and were taken into consideration by the board.

l) Appellant's silence in response to unsubstantiated submissions by the respondent

In **T 1903/17** the respondent (opponent 3) referred in its reply to the appeal to submissions in its notice of opposition, but these merely stated that submissions made with respect to another claim should apply "by analogy". The board considered the objection to be incomplete, as it left it to the other parties and the opposition division or board themselves

to determine which of these submissions were intended to apply by analogy to the contested claims and to what extent. The board emphasised that the reference in the reply to the appeal to these unsubstantiated submissions did not give the appellant (patent proprietor) any reason to address them in substance. The board therefore rejected the respondent's argument that there were exceptional circumstances and that new arguments had to be taken into account to substantiate the objection.

m) Prima facie relevance

A finding of prima facie relevance has not been considered a sufficient reason on its own for admission at this stage of the proceedings (see, for example, **T 2113/17**, **T 187/18**, **T 482/18**, **T 1042/18**, **T 741/20** and **T 1305/21**). However, depending on the circumstances of the case, prima facie relevance has been regarded as a possible factor when considering Art. 13(2) RPBA (see, for example, **T 574/17**, **T 2391/18**, **T 463/19** and **T 307/22**).

In **T 187/18** the board first noted that the appellant's (opponent's) new line of attack against claim 1 based on a new combination of documents was a change to its case. It then recalled that, according to Art. 13(2) RPBA, exceptional circumstances justified by cogent reasons were required and that therefore alleged prima facie relevance was **not per se a consideration**. Since the appellant did not identify any special reasons for the amendment to its case, the board did not admit this new line of attack into the proceedings. See also **T 1042/18** (in which the board found that the possibility that a piece of evidence might be prima facie relevant was not sufficient on its own) and **T 1876/18** (underlining that such an interpretation of the requirements of Art. 13(2) RPBA would allow the indiscriminate admittance of any relevant evidence and objections even if filed at the latest stage of the proceedings which would clearly be against the principle of procedural economy); similarly **T 1305/21**.

In **T 482/18** it was not until the oral proceedings on appeal that the appellant (opponent) raised objections under Art. 123(2) and 84 EPC to a term in the claims according to the main request (identical to the auxiliary request on the basis of which the opposition division had maintained the patent). The board rejected the opponent's argument that under Art. 114(1) EPC 1973 it had to examine compliance with the requirements of Art. 123(2)and 84 EPC of its own motion. It also did not agree that the new submissions were no more than arguments based on facts already at issue in the proceedings. Moreover, it explained that the criterion of prima facie relevance, which the boards – generally rightly – still considered even though it was not referred to in Art. 13(1) RPBA, could not be decisive here in view of the stage reached in the proceedings and the fact that the new submissions had not been occasioned by any statements made in the proceedings before the board.

The board in **T 574/17** confirmed that when exercising its discretion under Art. 13(2) RPBA, a board may also rely on the criteria referred to in Art. 13(1) RPBA. This discretion was inherent to the assessment of whether there were "exceptional circumstances" and was furthermore expressed by the phrase "in principle" (**T 172/17**). The board noted that the criteria referred to in Art. 13(1) RPBA included the suitability of the amendment to

resolve the issues raised. In the case in hand, this translated into whether the newly raised objections against auxiliary request 14 would prima facie be successful. The board pointed out however that it was not necessary to assess the prima facie relevance of an objection in order to conclude that there were no exceptional circumstances under Art. 13(2) RPBA (see **T 2787/17**). Whether it was appropriate to conduct this kind of prima facie assessment depended on the specific circumstances of the case. The case at issue was characterised by the fact that the opposition division had maintained the patent as granted. Auxiliary request 14 had never been examined or objected to. In this specific procedural situation, the board found it appropriate to consider the (lack of) prima facie relevance of the two objections raised for the first time in the oral proceedings before the board. The board explained in this context that the obiter dictum in **G 10/91**, point 19 of the Reasons, was fully respected when the prima facie relevance of an objection was considered in the context of assessing whether there were exceptional circumstances justifying its admittance pursuant to Art. 13(2) RPBA.

In **T 463/19**, the board decided to take the opponent's late-filed document E65a into account under Art. 13(1) and (2) RPBA, in view of the following exceptional circumstances. The document had been objectively difficult to find. It had undoubtedly not been withheld intentionally, with the opponent only becoming aware of it after it had been cited for the first time by a third party in other opposition proceedings. In the board's view, it was prima facie part of the state of the art and was prima facie very relevant.

n) Submission of new evidence

(i) Evidence filed with unnecessary delay

In **T 1904/16** the board did not see any cogent reasons why the new facts and evidence could only have been filed at the latest possible stage of the appeal proceedings, i.e. at the oral proceedings. In the board's view, the issue raised by the new submissions should have been brought up immediately in reply to the statement of grounds of appeal. To admit these submissions into the proceedings would be against the principle of fair proceedings, since the respondent's conduct had led the appellant to believe that this objection was no longer a matter for discussion. Furthermore, it would be **contrary to procedural economy**, since its admission would require additional discussions, which could not be held without adjournment of the proceedings.

In **T 2271/17** the respondent (patent proprietor) submitted experimental data shortly before the oral proceedings before the board, allegedly in reaction to a surprising preliminary opinion of the board in relation to inventive step vis à vis D1. The board however pointed out that the board's communication in relation to this issue was based only on aspects of the case already comprised in the written submissions of the parties in appeal proceedings. Moreover, as admitted by the respondent, the experimental data were available much earlier. In the board's view, this unnecessary delay at least contributed to the appellant having insufficient time before oral proceedings to prepare an appropriate response, and was not appropriately justified.

(ii) Evidence filed at the earliest opportunity

In **T 34/18** the board took account of evidence (two Austrian judgments) submitted around one month before the oral proceedings with a view to rebutting new evidence and arguments previously submitted by the opposing party.

See also **T 415/20** (summarised in chapter V.A.4.5.5e).

o) Allegation of public prior use

In **T 1583/21** the board did not consider it an unforeseen development in appeal proceedings – and so an exceptional circumstance – that an alleged public prior use, which would otherwise have been difficult and required great effort to find, had been discovered by chance as a result of a change of staff. The board, noting the claim that the prior-use rotor blade had been made publicly available in 2005, found that it should in principle have been possible to find it from then on. Besides, admitting a prior-use allegation shortly before oral proceedings was only rarely compatible with the principle of procedural economy.

See also **T 2607/19** (prior use originating from a company belonging to the same group as the opponent).

p) Allegation and evidence of common general knowledge

In **T 1759/17** the board observed that evidence of common general knowledge could be filed at a later stage if it served to back up arguments that had already been put forward, e.g. to solve a dispute over whether facts relied on by a party were common general knowledge. This however was not the case here because the document at issue presented new information which had not been argued before to be part of the common general knowledge.

q) Decisions and opinions by national courts filed at the earliest opportunity

In **T 526/21** a decision and an opinion were handed down by a UK court (D49) and a Swiss court (D50) respectively in national proceedings concerning the patent at issue and filed by appellant 1 (opponent 1) after summons to oral proceedings had been notified. The board noted that, according to established case law, in the interest of the **harmonisation** of national and international rules of law, the boards of appeal will take into consideration decisions and opinions rendered by national courts in interpreting the law (**G 5/83**, OJ 1985, 64, point 6 of the Reasons). Such considerations did not exonerate a board from its duty as an independent judicial body to interpret and apply the EPC (**T 154/04**). The board acknowledged exceptional circumstances in the sense of Art. 13(2) RPBA and admitted the documents into the appeal proceedings. See also **T 1057/21**.

r) Filing of translations

Whether a board admitted a translation filed at this late stage of proceedings depended on the circumstances of the case.

In **T 1720/20** the board admitted D14 (certified translation of the bibliographic data of the Chinese priority document of the patent in suit), filed by the appellant (patent proprietor) with its statement of grounds of appeal. D16 (another certified translation of the bibliographic data of the priority document), filed by the respondent (opponent) in reply to the communication under Art. 15(1) RPBA, was also admitted. In view of the **considerable cost of a certified translation**, the board considered it unreasonable that in such circumstances the respondent should have filed the certified translation as a precautionary measure in response to the statement of grounds of appeal.

In **T 1795/19**, however, the board could not see any cogent reasons for exceptional circumstances. In particular, it saw no reason why the opponent had waited until the oral proceedings to submit an improved translation. In the board's view, the opponent had to have known from the outset that the previous machine translation was in places difficult or even impossible to understand. The board also rejected any analogy with Art. 14(2) EPC.

s) Circumstances in the sphere of the representative

In **T 1904/16** the board considered that the belated submissions (new evidence and new line of argument concerning public availability of D16) were not justified by the change of representative shortly before the oral proceedings. It recalled that a change of representative was a fact which belonged to the sphere of the party affected and, being extraneous to the proceedings, could not influence the decision whether a procedural action had been performed in time. On the contrary, a new representative was bound by the procedural actions performed by their predecessor (**T 1585/05**). The board concluded that a change of representative as such was not a sufficient justification for late filings (citing CLB, 9th edn. 2019, V.A.4.8.2).

t) No absolute right to discussion of all objections raised at first instance

In **T 48/17** the board observed that the EPC did not confer on opponents any absolute right to have all objections they raised at first instance discussed. In this case, the opposition division had allowed the opponent's opposition. Given the main purpose of appeal proceedings, the chief effect of the patent proprietor's appeal was that the contested decision would be reviewed in light of the objections on which it was based. Other admissible objections before the opposition division would have to be expressly raised in the reply to the appeal. If the objections raised at the oral proceedings on appeal had been admitted, the patent proprietor would not have had any opportunity to prepare for this. Such an approach would be at odds with both the principle of procedural economy and the right to a fair hearing.

u) Further illustration of the technical teaching by means of photographs

In **T 100/18** the appellant (patent proprietor) produced photographs at the oral proceedings with a view to using them for illustrative purposes. The board, however, found that the wish to make additional use of photographs to illustrate the teaching already disclosed by drawings in the patent and in the prior art prior was not an exceptional circumstance within the meaning of Art. 13(2) RPBA.

5. Parallel proceedings

The board in **T 18/09** stressed that, in the case of parallel proceedings before a national court and the boards of appeal, parties should inform both tribunals of the position as early as possible and ask the appropriate tribunal for acceleration in order to avoid duplication of proceedings. Whether acceleration is requested by one party, or both or all parties in agreement, or by a national court, all parties must accept a strict procedural framework including short time limits. It must also be understood that acceleration can have no effect on the equal treatment of all parties and cannot confer any advantage on any one party.

6. Change in composition of a board

Article 8 RPBA sets out the consequences of a change in the composition of a board. According to Art. 8(1) RPBA, if the composition of a board is changed after oral proceedings, the parties shall be informed that, at the request of any party, fresh oral proceedings shall be held before the Board in its new composition. In **T 956/19** the board made clear that in view of Art. 8(2) RPBA any fresh oral proceedings would be restricted to any submissions not decided on in the preceding interlocutory decision.

7. Termination of appeal proceedings

7.1. Closure of the substantive debate

Article 15(5) RPBA reads: "When a case is ready for decision during oral proceedings, the Chair shall state the final requests of the parties and declare the debate closed. No submissions may be made by the parties after the closure of the debate unless the Board decides to re-open the debate."

According to the established practice, the closing of the debate marks the last moment in the oral proceedings at which parties can still make submissions.

As long ago as **T 595/90** (OJ 1994, 695) it was noted that submissions filed after closure of the debate could not be taken into account unless the board decided to reopen the debate.

In **T 577/11** the board stated that as to the significance of the closing of the debate, the Enlarged Board confirmed in **G 12/91** (OJ 1994, 285) that, once the debate has been closed, further submissions by the parties must be disregarded unless the department allows the parties to present comments within a fixed time limit or decides to re-open oral

proceedings for further substantive debate of the issues. These considerations of principle equally apply to proceedings before the boards of appeal (cf. **R 10/08**, **R 14/10**). Hence, the closing and also, as a rule, the re-opening of the debate are at the board's discretion.

7.1.1 Decision taken as the file stands

In **T 784/91** the board took the view that if in ex parte proceedings the appellant indicated that he did not wish to comment on the case, this could be construed as signifying agreement to a decision being taken on the case as the file stood. See also **T 230/99**.

7.1.2 Proceedings after delivery of the decision

In **T 843/91** (OJ 1994, 818) it was stated that once a decision had been taken the board was no longer empowered or competent to take any further action apart from drafting the written decision (see also **T 296/93**, OJ 1995, 627, where the board disregarded statements filed after the announcement of the decision, and **T 515/94**). In **T 304/92** the respondent's request to file new claims after the Chair had announced the board's decision was rejected, but recorded (with the response) in the summary of facts.

However, in **T 212/88** (OJ 1992, 28) a request for apportionment of costs submitted after the substantive decision had been announced at the end of the oral proceedings had been, exceptionally, admitted. In **T 598/92** an error in a claim was corrected at the request of the appellant one day after the decision was delivered at the end of oral proceedings.

After the board in **T 1518/11** had announced its decision to dismiss the appeal against the refusal of the application in suit and closed the oral proceedings, the appellant stated by letter that the appeal was withdrawn. However, since the decision had already been announced at the oral proceedings and thereby became effective on that day, the appeal proceedings had already terminated (following **T 843/91**, OJ 1994, 818) and the appellant's submission made after the announcement of the board's decision was without any legal effect. Furthermore, a statement of withdrawal of appeal made by the (sole) appellant after the final decision of the board had been announced at oral proceedings did not relieve the board of its duty to issue the decision in writing, setting out the reasons for the decision, and notify the appellant of it (following **T 1033/04**). See also **T 2264/18** and **T 437/21**.

7.2. Interlocutory decisions of a board

The boards issue interlocutory decisions on the admissibility of the appeal (**T 152/82**, OJ 1984, 301), on re-establishment in respect of the time limits for appeal (**T 315/87** of 14 February 1989 and **T 369/91**, OJ 1993, 561), on the admissibility of an opposition (**T 152/95** of 3 July 1996), and to inform the public rapidly (pending the final decision) that a mention of grant in the European Patent Bulletin was incorrect because of the appeal's suspensive effect (**J 28/94**, OJ 1995, 742). Referral of a point of law to the Enlarged Board is also an interlocutory decision.

7.3. Withdrawal of the appeal

Under the EPC it is possible to withdraw a patent application, opposition or appeal. Decision **J 19/82** (OJ 1984, 6) ruled that partial withdrawal is also possible.

7.3.1 Article 114(1) EPC and withdrawal of the appeal

Under Art. 114(1) EPC the EPO shall examine the facts of its own motion in proceedings before it. The question has arisen whether this is relevant in the event of the withdrawal of the appeal.

In **G 7/91** and **G 8/91** (OJ 1993, 346 and 356) the Enlarged Board ruled that as far as the substantive issues settled by the contested decision at first instance were concerned, appeal proceedings – whether ex parte or inter partes – were terminated when the sole appellant withdrew his appeal. The Enlarged Board found that the provision of Art. 114(1) EPC 1973 did not allow for continuation of the proceedings once the appeal had been withdrawn. This was evident from the legislative rationale of the EPC. If Art. 114(1) EPC 1973 applied to all withdrawal situations, then the R. 60(2) EPC 1973 (R. 84 EPC) exception for oppositions would be superfluous. Nor was withdrawal of the appeal covered by "relief sought" within the meaning of Art. 114(1), second part of sentence, EPC 1973 to which the EPO would not be restricted in examining the facts; it constituted a procedural act not requiring the consent of the relevant board (point 8 of the Reasons). The appeal procedure was that proper to an administrative court, so any exception from general procedural principles such as the "principle of party disposition" had to be supported by much weightier grounds than in administrative proceedings. Neither Art. 114(1) EPC 1973 nor the interests of the general public or the respondent constituted arguments against this interpretation. Art. 114(1) EPC 1973 was restricted to the examination of the facts. The interests of the general public were primarily safeguarded by the opposition system. It could be assumed that the patent did not disturb those who had not filed an opposition, so there was no need to continue the appeal proceedings in order to safeguard their interests. Nor were the respondents' interests any more in need of protection if they had not themselves filed an appeal, as was explained in detail in **G 2/91** (OJ 1992, 206). Finally, the Enlarged Board pointed out that when the sole appellant withdrew his appeal, the suspensive effect of the appeal lapsed and the opposition division's decision thus became final as regards the substantive issue.

7.3.2 Board's powers to decide on issues after withdrawal of the appeal

If the sole appellant says he has withdrawn his appeal, but the parties are in dispute as to whether he did so admissibly, then the board is empowered to rule on that issue (**T 659/92**, OJ 1995, 519).

After withdrawal of an appeal it is still permissible to decide on ancillary questions (**T 85/84**). Thus in **J 12/86** (OJ 1988, 83), **T 41/82** (OJ 1982, 256) and **T 773/91**, the board of appeal dealt with requests for reimbursement of the appeal fee filed after withdrawal of the appeal, and in **T 117/86** (OJ 1989, 401), **T 323/89** (OJ 1992, 169), **T 614/89** and **T 765/89** with requests for apportionment of costs.

In **T 333/20**, the board observed that a withdrawal of the appeal brought the proceedings to a close as regards the substantive merits of the appeal case itself but not as regards requests relating to issues not settled by the withdrawal. The request for reimbursement of the appeal fee filed by the appellant on withdrawing the appeal was therefore not covered by the closure of the proceedings (see **T 41/82**, OJ 1982, 256; **T 89/84**, OJ 1984, 562; **J 12/86**, OJ 1988, 83; **T 773/91; J 37/97** and **T 433/21**).

7.3.3 Partial withdrawal of appeal by sole appellant and opponent

Partial withdrawal of an appeal by the sole appellant (opponent) following an allowable limitation of the patent's subject-matter under Art. 123 EPC 1973 during appeal proceedings deprived the board of its discretionary power to examine the substantive merits of the remaining, limited subject-matter. The patent had to therefore be granted in its amended form (**T 6/92** and **T 304/99**). In **T 127/05** the board recalled that an opponent who was the sole appellant had the possibility of withdrawing his appeal if he found that the outcome would be disadvantageous to himself. In **G 7/91** and **G 8/91** (OJ 1993, 346 and 356) the Enlarged Board ruled that as far as the substantive issues settled by the decision at first instance were concerned, appeal proceedings were terminated when the sole appellant withdrew his appeal. It followed that an opponent who was the sole appellant could, if he so wished, force the non-appealing patent proprietor to "live with" a deficiency which he had introduced. A patent proprietor who filed an appeal could prevent himself from being placed in such a situation. The board also did not agree that decision **G 1/99** (OJ 2001, 381) restricted amendment to a response to an objection first raised in appeal proceedings.

7.3.4 No withdrawal of appeal with retrospective effect

The mere fact that a representative had filed a notice of appeal before taking note of the appellant's adverse instruction did not justify a correction to the effect that no appeal had been filed. The request amounted to a withdrawal of the appeal with retrospective effect, which was not provided for in the EPC (**T 309/03**, OJ 2004, 91).

7.3.5 Request for withdrawal of appeal to be unambiguous

Effective withdrawal does not depend on the term "withdrawal" being used (**J 7/87**, OJ 1988, 422); a request for withdrawal should only be accepted without question if it is completely unqualified and unambiguous (**J 11/80**, OJ 1981, 141); and where any doubt as to a party's intent exists, the declaration made can be construed as a withdrawal only if the related subsequent facts confirm that such is the party's true intent (**J 11/87**, OJ 1988, 367).

A notice of abandonment of the patent was held to be tantamount to withdrawing the appeal in **T 1003/01**. In **T 60/00**, however, the appellant's statement that it had decided not to pursue the appeal was not regarded as unambiguous withdrawal of the appeal. In **T 2347/11** of 16 October 2012 the letter of "withdrawal" of an application in this case did not relate unambiguously and without doubt to the case at issue and thus could not be understood as withdrawal of the appeal. See also **T 2514/11** and **T 158/16**.

According to the board in **T 1244/08**, where an appellant holding a patent revoked by an opposition division stated that it did not agree with the text of the patent as granted and was not proposing an amended one, this was tantamount to a withdrawal of the appeal and immediately brought the proceedings to an end.

7.3.6 Conditional withdrawal of appeal

Procedural declarations may be made with the proviso that certain conditions are met, as long as a case is already pending (**J 16/94**, **T 854/02**) and these conditions do not concern facts outside the proceedings (**T 502/02**). Thus, whereas a conditional appeal is not possible, the conditional withdrawal of an appeal may be valid (**T 6/92**, **T 304/99**). However, the withdrawal of an appeal can take effect only if the appeal is still pending (**T 1402/13** of 25 February 2016).

In addition, the declaration of conditional withdrawal of an appeal is as a rule ineffective if it leaves open whether the appeal proceedings can be continued. This applies in particular if the condition is not purely internal to the proceedings or is unclear (**T 419/21**).

When an appellant has clearly withdrawn his appeal, the appeal proceedings can be closed without a reasoned written decision, even if the appellant has appended to his declaration of withdrawal an obviously non-allowable request for a refund of the appeal fee (**T 1142/04**).

7.3.7 Correction of withdrawal of appeal under Rule 139 EPC

In principle, a correction of a withdrawal of appeal is possible under the EPC (**R 3/22**, **T 695/18**, **T 2148/18**, **T 2474/19**, **T 433/21**), though only in exceptional circumstances has such a request for correction been held allowable (see e.g. **T 2148/18** where the withdrawal and the request for correction of the withdrawal reached the EPO on the same day).

To be allowable, a request for correction of a withdrawal needs to fulfil the strict criteria of R. 139 EPC, as set out e.g. in **T 610/11**, in which the board came to the conclusion that the declaration submitted by the appellant's representative to withdraw the appeal could not be considered to contain an error to be corrected under R. 139 EPC. The board stated that the representative did not make any error when declaring the withdrawal of the appeal. Rather, the appellant gave instructions to the representative, which, as it turned out later, did not represent its true intention. In other words, an error occurred during the process of deciding how the appellant should deal with the application. The board referred to the jurisprudence of the boards of appeal according to which, as a general rule, an applicant is bound by its procedural acts notified to the EPO, provided that the procedural statement was unambiguous and unconditional (cf. **J 11/87**, OJ 1988, 367; **J 27/94**, OJ 1995, 831), and is not allowed to reverse these acts so that they can be considered as never filed (**J 10/87**, OJ 1989, 323; **J 4/97**). The board concluded that in cases where a professional representative acts on behalf of an appellant, an error or mistake in a procedural declaration before the boards of appeal can be corrected under R. 139 EPC only if this error or mistake has been made by the representative himself (see also **J 19/03**).

7.4. Deemed withdrawal of patent application

If a European patent application is finally deemed to be withdrawn after an admissible appeal against a decision refusing it has been filed, the appeal can usually be considered disposed of, because there is no possibility of a European patent being granted for the application. However, where, as in the case before the board, the sole aim of the appeal is to obtain a finding by the board that a substantial procedural violation occurred in the first-instance proceedings, such that the appealed decision is to be set aside and the appeal fee reimbursed, the appeal cannot be dealt with in this way. In these circumstances the appellant has a legitimate interest in receiving a decision on the merits of the appeal (**T 2434/09**).

7.5. Legitimate interest in the continuation of the grant and the appeal proceedings

In **T 36/19** the application was pending for more than 20 years. As the term of a European patent amounts to 20 years from the date of filing (Art. 63(1) EPC), a patent which may eventually be granted for the present application will have already expired. The board nevertheless considered that the appellant still had a legitimate interest in the continuation of the grant and the appeal proceedings. Since a European patent application already confers rights after its publication pursuant to Art. 67 EPC, a grant decision by the EPO, even if taken only after expiry of the patent term, might become relevant for the determination of these rights.

8. Reasons in abridged form

8.1. Abridged reasons under Art. 15(7) RPBA

Under Art. 15(7) RPBA, the reasons for the decision, or parts thereof, may, with the explicit consent of the parties, be put in writing in abridged form.

In **T 1497/17**, the parties agreed that an abridged decision within the meaning of Art. 15(7) RPBA and referring to what the board had set out in its summons could be issued on the points of novelty and inventive step. See also **T 561/18**, **T 947/19** and **T 1050/19**.

8.2. Abridged reasons under Art. 15(8) RPBA

Art. 15(8) RPBA states: if the board agrees with the finding of the department which issued the decision under appeal, on one or more issues, and with the reasons given for it in the decision under appeal, the board may put the reasons for its decision in abridged form in respect of that issue.

In **T 1687/17** the board noted that all the relevant arguments raised by the parties during the appeal proceedings had already been put forward and considered in the first-instance proceedings. No new arguments had been presented on appeal, as acknowledged by the parties at the oral proceedings. On all issues, the board agreed with the opposition division's findings and the reasons given for the contested decision and so considered it

expedient to put its decision in abridged form in respect of all those issues, as per Art. 15(8) RPBA.

In **T 2227/15** the board stated that in accordance with Art. 15(8) RPBA, the reasons for its decision were given in abridged form for those issues in respect of which the board agreed with the findings of the opposition division. This clearly did not apply to the appellant's submissions which contained issues on which the impugned decision was not based within the meaning of Art. 12(2) RPBA. Recourse to Art. 15(8) RPBA required that the board agreed with the findings and reasoning of the decision under appeal in respect of one or more issues. The board concluded from this precondition of concurrence with (parts of) the decision under appeal as well as from the legislator's intention (see explanatory notes to Art. 15(7) and (8) RPBA) that in the reasons for the decision in hand it was possible for the board to refer to those parts of the findings and reasons in the decision under appeal with which it agreed. The board followed the similar approach in decision **T 1687/17**. See also **T 2555/16** and **T 1418/17**.

9. Remittal to the department of first instance

9.1. General

9.1.1 Article 111(1) EPC

Under Art. 111(1) EPC, the boards, having examined the allowability of an appeal, decide on it either by exercising any power within the competence of the department which was responsible for the decision appealed or by remitting the case to that department for further prosecution. Art. 111(1) EPC thus establishes the legal framework for the decision-making powers of the boards.

Which of these two options the board chooses will depend on the specific facts of the case before it and is a matter for its discretion.

9.1.2 Article 11 RPBA

Under Art. 11 RPBA the board shall not remit a case to the department whose decision was appealed for further prosecution, unless special reasons present themselves for doing so. As a rule, fundamental deficiencies which are apparent in the proceedings before that department constitute such special reasons.

The RPBA 2020 entered into force on 1 January 2020 (Art. 24and 25(1) RPBA). Art. 11 RPBA was completely revised and applies to any appeal pending on, or filed after, that date of entry into force.

According to the explanatory remarks on Art. 11 RPBA (Supplementary publication 2, OJ 2020), the aim of the new provision is to reduce the likelihood of a "ping-pong" effect between the boards and the departments of first instance and a consequent undue prolongation of the entire proceedings before the EPO. When exercising their discretion under Art. 111 EPC, the boards should take account of this aim. Whether "special

reasons" present themselves is to be decided on a case-by-case basis. The boards should not normally remit a case if they can decide all the issues without undue burden. Decisions **T 1531/16**, **T 1089/17** and **T 335/18** referred to these remarks.

In **T 2154/15** it was further clarified that the RPBA could not deprive the boards of the discretion conferred on them by Art. 111(1) EPC, a point which was explicitly codified in the RPBA themselves, specifically in Art. 23 RPBA; the RPBA did not limit the powers of the boards established in Art. 111 EPC.

In **T 350/17** the board noted that the concept of "special reasons" in Art. 11 RPBA should not be narrowly interpreted in a way which unduly restricts the discretion of the board to remit a case enshrined in Art. 111(1) EPC, as this would be contrary to the spirit of the Convention, which, in case of conflict, takes precedence (see Art. 23 RPBA).

9.1.3 Art. 11 RPBA 2007

Under the old Art. 11 RPBA 2007, the boards were to remit a case to the department of first instance if fundamental deficiencies were apparent in the first-instance proceedings, unless special reasons presented themselves for doing otherwise.

A summary of decisions handed down pursuant to Art. 11 RPBA 2007 can be found in the CLB, 9th edn. 2019, V.A.7. The factors considered by the boards when deciding whether to remit a case included procedural economy (9th edn. 2019, V.A.7.3), non-examined patentability issues (9th edn. 2019, V.A.7.4), new submissions filed on appeal (9th edn. 2019, V.A.7.5), substantial amendments to claims (9th edn. 2019, V.A.7.6) and fundamental deficiencies in the first-instance proceedings (9th edn. 2019, V.A.7.7).

9.2. Exercise of discretion to remit

9.2.1 No absolute right to have issue decided on at two instances

It is the boards' settled case law that parties do not have a fundamental right to have their case examined at two levels of jurisdiction. Accordingly, they have no absolute right to have each and every matter examined at two instances; Art. 111(1), second sentence, EPC leaves it instead to the board's discretion to decide on an appeal either by exercising any power conferred on the department of first instance or by remitting the case to that department (**R 9/10**, **T 83/97**, **T 133/87**, **T 557/94**, **T 402/01** of 21 February 2005, **T 399/04**, **T 1252/05**, **T 1363/10**, **T 1803/14**, **T 1521/15**, **T 418/17**, **T 113/18**). In choosing what to do, the board must consider the circumstances of the individual case, also bearing in mind other factors such as the need for procedural economy (**T 392/89** of 3 July 1990, **T 1376/07**, **T 1253/09**, **T 2266/13**).

It is well-recognised that any party should, where possible, be given the opportunity to have two readings of the important elements of a case (**T 1084/03**, **T 1907/06**, **T 286/09**, **T 1627/17**). Although there is no absolute right to have an issue decided upon at two instances, it is also not the function of the board to consider and decide upon issues which had not been examined at all by the department of first instance (**T 2839/19**).

In **T 270/19** the board noted that the relevant circumstances of the case were to be taken into account when exercising discretion. In particular, consideration was to be given as to whether further investigations would be required, whether the facts of the case had changed significantly since the contested decision and what view the applicant took of the possible "loss of an instance". The weight given to each factor depended on the circumstances of the case in hand.

9.2.2 Remittal and admittance of auxiliary requests

There is no right of the parties to choose in which form the board should exercise its competences under Art. 111(1) EPC. Thus, the board is entitled to decide on the issue of admittance of the auxiliary requests without being bound to the respondent's request for prioritisation of the request for remittal (**T 1731/19**; see also **T 238/19**).

9.2.3 Remittal and scope of review

a) Primary object of appeal proceedings is to review decision under appeal in a judicial manner

In several decisions, the boards have pointed out that Art. 11 RPBA is to be read in conjunction with Art. 12(2) RPBA, which provides that the primary object of the appeal proceedings is to review the decision under appeal in a judicial manner (**T 731/17**).

b) Ex parte proceedings

In ex parte cases too, proceedings before the boards of appeal are primarily concerned with reviewing the contested decision.

In **T 2154/15** the board observed that the legal framework had been interpreted by the Enlarged Board in **G 10/93** (OJ 1995, 172), which had held that in ex parte proceedings the boards of appeal were restricted neither to examination of the grounds for the contested decision nor to the facts and evidence on which that decision was based, and could include new grounds in the proceedings. Proceedings before the boards of appeal in ex parte cases were primarily concerned with examining the contested decision. If, however, there was reason to believe that a condition for patentability might not have been satisfied, the board either incorporated it into the appeal proceedings or ensured by way of referral to the examining division that it was included when examination was resumed. Stating that Art. 111(1) EPC gave the boards discretion and that they could not be deprived of this discretion by the RPBA, the board concluded that the RPBA did not limit the powers of the boards as laid down in Art. 111 EPC.

c) Inter partes proceedings

In **T 1370/15** the board stated that remitting a case because of new submissions would generally be contrary to what was intended by Art. 11 RPBA. It noted that, while the Enlarged Board had found in **G 10/91** (OJ 1993, 420) that the appeal procedure in inter partes cases was less investigative than the procedure before the opposition division,

Art. 114(1) EPC – which required the EPO to examine the facts of its own motion – still applied. This meant that a board was not precluded outright from introducing new facts and evidence in inter partes proceedings. The RPBA similarly did not prohibit a board from raising issues of its own motion. See also **T 862/16**.

9.2.4 TRIPS

Nor does Art. 32 TRIPS limit the board's discretion concerning remittal. In **T 557/94** the board held that Art. 32 TRIPS (which provides for the judicial review of any decision to revoke a patent) did not oblige the reviewing instance to remit the case to the department of first instance, where the department of first instance did not revoke the patent and the reviewing instance intended to deviate from the decision of the first instance. Art. 111 EPC 1973 empowered the board to decide on the merits of the case without restriction and it would be alien to at least the majority of legal systems in the EPC contracting states to limit the power of the reviewing instance in such a way that – dependent upon the "result" of the decision under attack – it would be bound to remit the case to the department of first instance (see also **G 1/97**, OJ 2000, 322).

9.3. Special reasons for remittal

9.3.1 Introduction

Under Art. 11 RPBA, a case is not to be remitted to the department whose decision was appealed, unless special reasons present themselves for doing so.

Whether "special reasons" present themselves is to be decided on a case-by-case basis. If all issues can be decided without undue burden, a board should normally not remit the case (see explanatory remarks on Art. 11 RPBA in Supplementary publication 2, OJ 2020).

In **T 1531/16**, the board held that, in view of the legislative intent reflected in the revised version of Art. 11, first sentence, RPBA, a case should be remitted only if special reasons presented themselves for doing so, i.e. in exceptional cases (see also **T 3247/19**).

When deciding whether or not to remit a case, the boards have to decide whether any special reasons within the meaning of Art. 11 RPBA present themselves. To do so, the boards examine e.g. whether there has been a comprehensive assessment of the case during the proceedings at first instance (see chapter V.A.9.3.2), whether the claims have been substantially amended (see chapter V.A.9.3.5), whether the search was complete (see chapter V.A.9.3.6) and whether the first-instance proceedings have been vitiated by fundamental deficiencies (see chapter V.A.9.4.). Other factors have also been taken into account, such as the need for procedural economy, the length of the proceedings, fairness of the proceedings and whether the parties requested remittal of the case. The weight given to each factor depended on the circumstances of the case in hand.

In essence, the boards tend to find that there are special reasons to remit the case when they would otherwise have to decide on material issues for the first time or in some other

way essentially take the place of the department of first instance to too large an extent in order to bring the case to a conclusion (see e.g. **T 1966/16**).

9.3.2 Non-examined patentability issues

a) Issues undecided at first instance but which become relevant during or after appeal proceedings

Since the main purpose of appeal proceedings is to give a losing party an opportunity to challenge a decision on its merits, remittal in accordance with Art. 111(1) EPC has generally been considered by the boards where essential questions regarding the patentability of the claimed subject-matter have not yet been examined and decided on by the department of first instance. This applies to both ex parte and inter partes proceedings.

In particular, remittal is considered by the boards where a first-instance department has issued a decision against a party based solely on one particular issue which was decisive for the case and left open those that were not or on which comments would have been obiter dicta. This can be the case where at first instance a particular objection determines the fate of the application or patent; in such cases, the department of first instance does not necessarily examine any further objections. Any such further objections can however become relevant where on appeal the objection considered decisive in the first-instance proceedings is overcome or the board overturns the decision on that point (see e.g. **T 986/16)**.

In several such decisions, the board deemed it to constitute special reasons within the meaning of Art. 11 RPBA for remitting the case, as the board would otherwise have had to examine these objections for the first time.

This current practice is in keeping with the primary object of appeal proceedings of reviewing the decision under appeal in a judicial manner (Art. 12(2) RPBA). The boards have repeatedly pointed out that Art. 11 RPBA is to be read in conjunction with Art. 12(2) RPBA, which provides that the primary object of the appeal proceedings is to review the decision under appeal in a judicial manner (**T 731/17**). This principle would not be respected if the board were to conduct a complete examination of the application or patent (**T 1966/16**; see also **T 547/14**, **T 275/15**, **T 1077/17**, **T 1508/17**, **T 2519/17** and **T 3218/19**).

In the cases reported in the following sections, the boards found that there were special reasons justifying remittal to the department of first instance.

b) Primary object of the appeal proceedings

In **T 1966/16** the board stated that the sole ground for the refusal set out in the decision under appeal, namely a lack of inventive step, was not justified. The board held that special reasons were apparent in the case in hand because the examining division had not taken an appealable decision on open issues with respect to Art. 83, 84 and 123(2) EPC. Art. 11 RPBA did not entail the board carrying out a full examination of the application for

compliance with the requirements of Art. 83, 84 and 123(2) EPC, for which no decision at first instance existed yet (see also **T 2519/17**).

In **T 731/17** inventive step over documents D1 to D4 had not yet been assessed in detail. Moreover, it might still have been necessary to investigate whether document D2 belonged to the state of the art under Art. 54(2) EPC at all. Not remitting the case to the examining division would have required the board to perform these tasks in both first- and last-instance proceedings and to effectively replace the examining division rather than review the contested decision in a judicial manner (see also **T 658/17**).

In **T 1627/17** sufficiency of disclosure was the only ground for opposition on which a decision had been taken. All the parties to the appeal proceedings had requested remittal of the case to the opposition division for consideration of the other grounds for opposition raised by the opponent in its notice of opposition (lack of novelty and lack of inventive step). The board stated that, although the EPC did not guarantee the parties an absolute right to have all the issues in the case considered at two instances, it was well recognised that any party could be given the opportunity to have two readings of the important elements of a case. The essential function of an appeal was to consider whether the decision issued by the first-instance department was correct. In the case in hand, the aforementioned facts, including the request made by both parties, were in the board's view special reasons within the meaning of Art. 11 RPBA. See also **T 516/18**.

In **T 2450/17**, the contested decision was based solely on the grounds for opposition under Art. 100(b) and 100(c) EPC. Since the novelty and inventive-step objections raised against the patent had not been fully examined by the department of first instance, the board found that there were special reasons for remitting the case to the department of first instance for further prosecution, as requested by all the parties. Had the case not been remitted, the losing side would have had to accept a first yet final decision on key patentability requirements, without the option to appeal, solely because a decision had already been handed down on other patentability requirements, albeit one that ultimately did not stand up to legal scrutiny. See the similar cases **T 731/17**, **T 1754/15** and **T 1966/16**.

c) Undue burden

Where boards would have to examine patentability issues for the first time, they remit the case if examining these issues constitutes an undue burden. The boards decide on a case-by-case basis whether there are any special reasons within the meaning of Art. 11 RPBA and that is not the case if all the relevant issues can be decided on without undue burden.

Where the basis required to decide on the key patentability issues can only be established in further examination proceedings, this is considered an undue burden (**T 1531/16**; see also **T 601/19**, **T 2669/17**).

A typical scenario is where there is a sole ground for refusal mentioned in the contested decision (e.g. only insufficiency of disclosure) and there are no substantive arguments in the appeal proceedings relating to any patentability issues other than on the sole ground for refusal. If the board considers that there are further open issues relevant to

patentability, e.g. the examination of novelty, inventive step and clarity, the appeal cannot be decided upon without undue burden (**T 3247/19**; see also **T 1650/19**).In **T 578/16** the board stated that ruling on novelty and inventive step for the first time on appeal would constitute an undue burden and run counter to the very purpose of a judicial review within the meaning of Art. 12(2) RPBA (see also **T 411/17**).In **T 131/18**, the outstanding issues were too complex to have been handled by the board from scratch without undue burden.

d) Different interpretation of terms

Where a board of appeal interprets terms differently than the department of first instance, there can be a different outcome and potentially a different view of how the application or patent should be assessed. These are circumstances in which boards have found that a difference in the interpretation of certain terms ultimately leads to special reasons for remitting the case.

This can present itself in the form of a **different interpretation of the prior art**. For example, in **T 1265/15** the board found that the subject-matter of claim 1 of the main request was novel in view of the disclosure of D1 and thus overcame the reasons for refusal given in the decision under appeal. It also found that claim 1 involved an inventive step in view of D1. Having based these findings on a different interpretation of D1 from that in the decision, the board judged it appropriate to remit the case to the examining division for further prosecution, so that it had the opportunity to reassess the invention in view of the other prior art on file.

Another scenario is where the board has a **different interpretation of the claims**. In **T 2024/15** the examining division had based its inventive-step objection on an interpretation of claim 1 which was not in line with either the normal meaning of the terms used or the description in the application. Thus, if the board decided not to remit the case to the department of first instance, it would have to carry out a full examination of the application as to the patentability requirements on the basis of the correct interpretation of the claims. This, however, was the task of the examining division (see **G 10/93**, OJ 1995, 172). The board would even have to determine whether an additional search was necessary. Hence, it concluded that the issues relevant to patentability in this case could not be decided upon without undue burden (see **T 3247/19**) and, despite the long duration of the proceedings, remitted the case to the department of first instance.

In **T 607/17** the board interpreted the wording of claim 1 differently from the opposition division, namely in a substantially broader sense. The facts of the case were fundamentally changed by this new interpretation of the claim wording. The consequence was that the subject-matter of claim 1 of the main request lacked novelty over D1, whereas the appealed decision had concluded that neither D1 nor any other available prior art document anticipated this subject-matter. This meant the board would have to assess the patentability of the subject-matter of claim 1 of the auxiliary requests on the basis of this new interpretation of the claim wording for the first time. This amounted to a fresh case, and that alone justified remitting the case to the department of first instance for further prosecution.

9.3.3 Procedural economy

Procedural economy and minimising overall duration of the proceedings concerning a patent or patent application are principles underlying Art. 11 RPBA. However, there are cases in which other considerations outweigh them. In particular where the board would have to examine certain issues for the first time (as a result of a procedural violation or otherwise), boards have made clear that procedural economy is only one of the considerations when deciding whether there are special reasons for remittal (**T 2002/17**, **T 1028/17)**.

Where the main request in appeal proceedings is different from the patent maintained as amended but the opposition division has exhaustively discussed all the requirements of the EPC that are likewise relevant for assessing the main request, for reasons of procedural economy in particular, it is expedient and reasonable to use the discretion under Art. 111(1) EPC and Art. 11 RPBA for the board to examine and rule itself on the objections raised by the opponent (**T 1561/15**). Procedural economy in itself can speak against remittal, in particular where it is coupled with the interest of legal certainty in the case of a patent that is close to expiry (**T 368/17**).

Where on the other hand the department of first instance has not already discussed all the relevant issues, the scales might tip the other way. For instance in **T 350/17** the board considered that, in the case in hand, the patentee's request to have the question of inventive step examined at two different levels of jurisdiction took precedence over procedural economy, because the patentee had been deprived of a decision at first instance on this matter as a result of the substantial procedural violation.

In **T 894/20** the board observed that inventive step was not among the reasons for the appealed decision. As the primary object of appeal proceedings was to review the decision under appeal, the board considered this, and the fact that the case had been taken considerably out of turn, meaning there were another 14 years of a potential 20-year patent term left to run, to be special reasons for remitting the case to the examining division.

In **T 2017/16** the board remitted the case to the opposition division for consideration of the ground for opposition of lack of inventive step, even though this would inevitably lengthen the proceedings and cause the parties additional costs.

9.3.4 Financial situation of a party

In **T 2092/18** the appellant (patent proprietor) requested that the case not be remitted to the opposition division for a discussion of novelty and inventive step since it would be a financial burden and unfair to him who was a private individual. The board held that special reasons under Art. 11 RPBA were immediately apparent in the case in hand as the contested decision had not dealt with the issues of novelty and inventive step. The board further agreed with the respondent (opponent) that showing particular concern for a party's financial situation would go against the principle of procedural equality of the parties to the

proceedings. Such a consideration could not justify depriving the respondent of a two-instance procedure with respect to issues never considered by the opposition division.

9.3.5 Remittal following amendments to the claims

In the following decisions, remittal was ordered due to substantial amendments to the claims that necessitated further substantive examination.

a) Ex parte cases

In **T 278/17** the contested decision dealt only with the requirements of Art. 76(1) EPC; patentability had not been discussed. Since the request was considerably different from the requests considered in the contested decision, the board's judicial review could cover only Art. 123(2) and 76(1) EPC.

In **T 1534/18**, all the grounds for refusal in the contested decision had been overcome by suitable amendments in the set of claims submitted on appeal. As a result, the contested decision was no longer valid and had to be set aside. Since the facts of the case had become fundamentally different from those on which the examination division had based its decision, the board exercised its discretion to remit the case to the department of first instance for further prosecution given the sheer amount of examination work required for the outstanding issues.

In **T 1007/15**, the amended claims overcame the objections under Art. 83 and 84 EPC on which the contested decision was based. However, the issues of novelty and inventive step had not been discussed in the first-instance examination proceedings, and so the board would have had to examine them for the first time. That would have gone far beyond the primary object of appeal proceedings, which is to review the contested decision in a judicial manner. Moreover, the appellant had agreed to the board's remitting the case and withdrawn its request for oral proceedings in the event that it did so.

In **T 2453/16** the examining division had not assessed the inventive step of the subject-matter of the claims before the board, which differed significantly from the searched claims. The appellant's position was that the cited prior art and the state of the file allowed the board to continue with an assessment of novelty and inventive step. However, the board concluded that in order to decide on the questions of novelty and inventive step, it would have to consider those questions anew in proceedings forming both the first and last instance, thereby effectively replacing the examining division.

For further examples see **T 1278/18** (the amendments to the claims clearly overcame all outstanding objections without introducing new issues; the question of whether or not the claimed invention was inventive had not been addressed in the appealed decision); **T 901/16** (claim 1 of the amended main request overcame the objections which had led to the refusal of the application but it might also be necessary to consider prior art documents other than those mentioned in the decision); **T 2670/18** (the appellant filed amendments to the claims which overcame the objection under Art. 84 EPC); **T 1028/19** (the sole

reason given by the examining division for refusing the set of claims of the main request was not applicable to the subject-matter of the new set of claims).

b) Inter partes cases

In **T 1443/15** the decision under appeal was confined to an assessment of added subject-matter under Art. 100(c) and Art. 123(2) EPC. The set of claims of the main request before the board had overcome the related issues. Having regard to the board's function of reviewing the decision under appeal and given that two of the parties had explicitly requested remittal, the remaining party had not objected to remittal and the opposition division had not ruled on the issues of novelty, inventive step and sufficiency of disclosure, the board considered that there were special reasons for remitting the case to the opposition division for further prosecution.

In **T 1174/15**, the board held that remittal to the opposition division was justified as auxiliary requests 1-3 had not been dealt with in the contested decision or commented on by the opposition division. Moreover, the respondent had requested remittal and the appellant had withdrawn its request to the contrary.

In **T 1174/18** the board remitted the case to the opposition division despite the parties' preference against remittal. The subject-matter of auxiliary request 7 had not been examined by the opposition division as to its patentability. In particular it was questionable whether document D3 was still the most relevant piece of prior art.

c) Discrepancies between the clean and the annotated versions of a request

In **T 353/18**, when admittance of objections to auxiliary request 3 under Art. 123(2) EPC was discussed at the oral proceedings before the board, there turned out to be a discrepancy between the wording of the claim in the clean and the annotated versions of that request. The respondent contended that the clean version was the valid one and that the discrepancy was due to an error when preparing the annotated version of auxiliary request 3. However, having relied on the correctness of the annotated version of auxiliary request 3, the appellant had not provided any written submissions on the specific wording of claim 1 of the clean version, in particular as far as Art. 123(2) EPC was concerned. A ruling on the valid (i.e. clean) version of auxiliary request 3 would therefore have required a substantive discussion for the first time during the oral proceedings before the board, without any prior exchange of arguments between the parties. Handling the case in this way would clearly have run counter to the primary object of the appeal proceedings, which was to review the decision under appeal in a judicial manner.

9.3.6 Incomplete search

a) Features considered non-technical

Where the subject-matter of an application is considered non-technical, the examining division may carry out no search. This can also be the case for individual non-technical features, i.e. no search is carried out against such features and they are not taken into

account in the patentability assessment at the examination stage, e.g. under the COMVIK approach.

In several cases in which boards of appeal considered that the subject-matter of an application or a feature that the examining division deemed non-technical was in fact technical, the boards remitted the case to the examining division. The boards did so because they could not further assess the application without an additional search.

Since the primary object of appeal proceedings is to review the decision of the department of first instance (Art. 12(2) RPBA), where the invention had not yet been searched on the basis of the features since found to be technical, and in some cases novelty and inventive step had not been examined either, the boards considered that special reasons presented themselves to remit the matter to the department of first instance for a search and further examination. See e.g. **T 547/14**, **T 1749/14**, **T 943/16**, **T 658/18** and **T 1984/18**.

b) Closest prior art not suitable or misinterpreted

Where the board finds that the closest prior art used to assess inventive step should be from another field than that from which the department of first instance selected what it considered the closest prior art, the search is incomplete and the board will remit the case for further prosecution (**T 97/14**).

If the examining division finds the invention obvious based on a misinterpretation of a piece of prior art , there is a possibility that the search into the state of the art was stopped too early and was incomplete, justifying remittal of the case (**T 565/17**, **T 2496/17**)).

c) Additional prior-art search necessary

The following cases were remitted to the department of first instance for an additional search.

In **T 1159/15** the board, referring to the established case law, held that a prior art search should have been carried out before refusing the application for lack of inventive step, since the claims contained at least one feature that was not notoriously well known. Since a prior art search was deemed necessary and its outcome could not be anticipated in advance, the assessment of the claimed subject-matter with respect to inventive step (and the other requirements of the EPC) had to be carried out anew. This constituted, in essence, a fresh case going beyond the issues discussed in the decision under appeal.

In **T 1877/19**, amendments to the application documents meant that the subject-matter claimed was no longer based entirely on a combination of claims as originally filed. In view of this, the examining division's search might not have included one of the claimed features, so the board could not be sure that the relevant prior art had been identified for it.

In **T 1928/14** no written prior art had been consulted during the first-instance proceedings. The board was not sure whether the publications cited as A documents in

the international search report covered the aspects of the additional features of claim 1 according to the request in hand. The supplementary European search report merely contained a "no-search declaration".

See also **T 1338/16** (the board was not in a position to decide whether the scope of the search carried out by the department of first instance had also covered the subject-matter of claim 1 according to auxiliary request 5); **T 568/17** (the question arose as to whether the search was complete; this was a question that the board was not equipped to answer); **T 1278/18** (the board stated that since the added feature had been taken from the description and drawings, an additional search for relevant prior art might be necessary); **T 2573/17** (the claims had been amended considerably during the proceedings at first instance and the board had doubts as to whether the search was complete).

9.3.7 Opposition withdrawn

In **T 1627/18** the opposition had been withdrawn and so the question arose as to whether the opposition proceedings should be continued pursuant to R. 84(2) EPC for assessment of the grounds of opposition under Art. 100(a) and 100(b) EPC, which were outstanding issues on which no decision had been taken. The board considered that the circumstances constituted special reasons for remitting the case to the opposition division, as requested by the appellant. After remittal, the opposition division would then have to exercise its discretion as to whether the opposition proceedings should be continued pursuant to R. 84(2) EPC. See also **T 1223/15**, **T 1981/16** and **T 430/17**.

9.4. Remittal following fundamental deficiencies

9.4.1 Article 11 RPBA

Article 11 RPBA states that the board is not to remit a case to the department whose decision was appealed for further prosecution, unless special reasons present themselves for doing so. As a rule, fundamental deficiencies which are apparent in the proceedings before that department constitute such special reasons (see explanatory remarks on Art. 11 RPBA, Supplementary publication 2, OJ 2020).

9.4.2 Article 11 RPBA 2007

Under Art. 11 RPBA 2007, a board was to remit a case to the department of first instance if fundamental deficiencies were apparent in the first-instance proceedings, unless special reasons presented themselves for doing otherwise. In other words, the rule was that a case was to be remitted if a fundamental procedural deficiency had been identified, but a board could exceptionally refrain from doing so if it found that there were special reasons not to. Fundamental deficiencies included a violation of the right to be heard, deficient reasoning for the decision, a breach of Art. 19(2) EPC, a lack of clarity as regards the parties' requests and a failure to hold oral proceedings.

If any special reasons were established, the boards were to refrain from remitting a case to the department of first instance even if there had been fundamental deficiencies in the

proceedings before it. Special reasons identified by the boards against remitting the case included the lengthy duration of the proceedings to date, the age of the application or patent and the fact that the department of first instance had considered all the arguments.

See CLB, 9th edn. 2019, V.A.7.7.

9.4.3 The term "fundamental deficiencies"

The term "fundamental deficiencies" referred to in Art. 11 RPBA and the notion of a "substantial procedural violation" in R. 103(1)(a) EPC are used synonymously (see **T 2231/09**). A "fundamental deficiency" does not appear to be any different from a "substantial procedural violation" (see **T 2346/10**). A board is to remit the case if fundamental deficiencies, such as a substantial procedural violation, are apparent in the first-instance proceedings (**J 16/17**, **T 1414/18**).

9.4.4 Fundamental deficiencies

a) Violation of right to be heard

According to the established case law of the boards of appeal, the violation of the right to be heard under Art. 113(1) EPC is a fundamental procedural deficiency in the first-instance proceedings that amounts to a special reason within the meaning of Art. 11 RPBA and justifies remittal to the department that issued the contested decision. The right to be heard was found to have been violated in the following cases:

T 2538/18 (lack of opportunity to make comments), **T 1879/17** (the opposition division had violated the patent proprietor's right to be heard by deciding not to admit an auxiliary request into the proceedings without having looked at it), **T 314/18** (witness offered but not heard), **T 1817/16** (the opposition division had violated the patent proprietor's right to be heard by issuing the decision to revoke the patent before expiry of the time limit it had previously set for making written submissions), **T 1928/17** (a party must not be taken by surprise by the inclusion of previously unknown grounds in the reasons for the decision), **T 1414/18** (lack of opportunity to make comments), **T 97/14** (the appellant's arguments had not been properly taken into account), **T 560/20** (the appellant had not had an opportunity to present its comments on the sole ground on which the impugned division was based) and **T 545/18** (the appellant had been unable to present arguments in relation to the objection under Art. 56 EPC).

b) Reasons for decision deficient

Rule 111(2) EPC gives parties to EPO proceedings a fundamental procedural right to be provided with the reasons for a decision. A breach of R. 111(2) EPC is a fundamental procedural deficiency that can lead to a remittal as a special reason within the meaning of Art. 11 RPBA. The following cases were remitted to the department of first instance:

T 2475/17 (insufficient reasons given for the first-instance decision, which also did not address the version of claim 1 filed by the applicant), **T 942/18** (the board considered lack

of compliance with R. 111(2) EPC to be a fundamental deficiency, not a minor defect), **T 78/17** (all relevant arguments have to be given appropriate consideration in the written decision), **T 1928/17** (inadequate reasons) and **T 571/19** (reasons for the decision must enable both the parties and the board of appeal to understand whether or not the decision is justified).

c) Missing signatures

In **T 989/19**, the board held the contested decision to be invalid because the cover page had not been signed by all the members of the examining division, which amounted to a fundamental procedural deficiency in the proceedings before the examining division. Since the established case law had it that remittal of an appeal case did not adversely affect the appellant, the decision in this case could be issued without oral proceedings (see e.g. **T 42/90** and **T 382/10**).

In **T 2348/19** the Chair of the opposition division had not signed either the minutes or the reasoned decision, and in neither case had it been explained in writing why the first examiner had signed on the Chair's behalf. The case was remitted to the opposition division for further prosecution.

d) Failure to hold oral proceedings

In **T 170/21** the decision to refuse the application without summoning the applicant to oral proceedings had taken the appellant by surprise, thereby depriving it of a further opportunity to present its final comments and/or its final fallback positions and denying it the right to be heard as guaranteed by Art. 113(1) EPC. This conclusion was in line with established case law of the boards of appeal; see for example **T 1423/13**, which dealt with almost identical circumstances (refusal without summoning to previously announced oral proceedings).

e) Incorrect application of R. 137(5) EPC

In **T 2431/19** the board stated that the incorrect interpretation and application of R. 137(5) EPC in the case in hand constituted a substantial procedural violation within the meaning of R. 103(1)(a) EPC as well as a fundamental deficiency under Art. 11 RPBA, justifying a remittal to the examining division for further prosecution (Art. 111(1) EPC).

9.5. Requests for or against remittal

Under Art. 11 RPBA, parties need not request remittal since the boards have discretion to remit a case and can do so without any such request (**T 78/17**; see also **T 1805/14**).

In many cases, the parties explicitly requested remittal to the department of first instance; see for example the ex parte cases **T 1754/15**, **T 1966/16** and **T 2519/17**. Similarly, in the inter partes cases **T 240/16**, **T 1376/17**, **T 2908/18**, **T 323/18** and **T 395/18**, the requests made by both parties were taken into account.

In **T 1964/17** the complete absence of any analysis of the grounds for opposition of lack of novelty and lack of inventive step in the decision under appeal and the requests for remittal made by both parties were considered special reasons within the meaning of Art. 11 RPBA.

In **T 194/17** the board noted that the substantial procedural violation could in principle be a sufficient reason for setting aside the contested decision and remitting the case to the opposition division. However, the appellant had requested that the case **not** be remitted to the opposition division and that the board itself decide on it. In view of the principle of procedural economy, the length of the opposition (appeal) proceedings to date, the already advanced age of the patent and the fact that the violation concerned dependent claims, the board granted the appellant's request.

In **T 1655/20** the board remitted the case to the examining division for further prosecution despite the appellant's request that the board decide on all the outstanding issues. In the case in hand the examining division had dismissed the main request only on the ground of lack of novelty and so without assessing inventive step. In addition, the first auxiliary request filed with the appeal had been modified and so differed from the first auxiliary request considered in the decision under appeal. The board deemed these circumstances to amount to special reasons justifying remittal of the case within the meaning of Art. 11 RPBA. See also **T 97/14** and **T 568/17**.

9.6. No remittal to the department of first instance

9.6.1 Discretion despite special reasons

Under Art. 111(1) EPC, a board, having examined the allowability of an appeal, decides on it either by exercising any power within the competence of the department which was responsible for the decision appealed or by remitting the case to that department for further prosecution. Which of these two options the board chooses depends on the specific facts of the case before it and is a matter which is at its discretion. Art. 11 RPBA sets out that as a rule, fundamental deficiencies which are apparent in the proceedings before that department constitute such special reasons.

In **T 3085/19** the board pointed out that the wording "as a rule" ("in der Regel", "en règle générale") is mirrored as meaning "normally" ("normalement", "in der Regel") in the explanatory remarks on Art. 11 RPBA (Supplementary publication 2, OJ 2020). This correctly reflects that Art. 11 RPBA does not deprive the boards of the discretion conferred on them by Art. 111(1) EPC. Hence, even if a fundamental deficiency is apparent, the board still has discretion not to remit the case to the examining division but to deal with the substance of the case itself (see also **T 1635/19**).

9.6.2 Same legal and factual framework

In **T 418/17** the board stated that, although the primary object of the appeal proceedings was to review the decision under appeal in a judicial manner (see Art. 12(2) RPBA), there was no absolute right to have every issue decided at two instances. In the case in hand,

although the decision under appeal was limited to the main request, auxiliary request 1 did not alter the legal and factual framework because it resulted from a combination with a granted dependent claim.

In **T 1561/15**, the contested decision had maintained the patent as amended on the basis of auxiliary request 3. The opposition division had exhaustively discussed all the requirements of the EPC that were likewise relevant for assessing the new main request. For reasons of procedural economy in particular, the board found it expedient and reasonable to use the discretion conferred on it under Art. 111(1) EPC and Art. 11 RPBA to examine and rule itself on the objections raised by the opponent.

In **T 1355/18**, the opposition division had already discussed the novelty and inventive step of a similar request to auxiliary request 1, so no special reasons as per Art. 11 RPBA presented themselves for remitting the case.

In **T 2085/17** the board stated that remitting the case to the examining division pursuant to Art. 11 RPBA, as requested by the appellant, did not seem appropriate. While the board's decision was based formally on a different legal provision, namely Art. 56 EPC instead of Art. 52(2) and (3) EPC (as cited by the examining division), the underlying issue of excluded subject-matter was the same, and the board had reached its finding on the basis of the same facts and arguments, which seemed to be quite clear.

In **T 113/18** the board's position was that the respondent's silence could not lead to automatic remittal of the case to the opposition division to decide whether there were any remaining objections likely to prejudice maintenance of the patent; that would deprive the board of the discretion conferred on it by Art. 111(1) EPC, the purpose of which was to weigh up all the circumstances of the case in hand, including, in particular, whether there were any additional contentious issues which had not been brought to its attention. Accordingly, in the absence of any objection raised by the respondent against the main request, the board decided not to remit the case to the opposition division.

In **T 464/17** the essential facts and evidence had already been part of the first-instance proceedings, so no fresh case was created.

In **T 1388/17** the board did not consider the use of a different secondary document from the one which the opposition division had used in finding that the requests before it lacked inventive step to constitute a special reason for remittal.

The boards' ruling in the inter partes cases **T 1936/16**, **T 1388/17** and **T 2202/19** and the ex parte case **T 786/16** similarly could not see any special reasons for remitting the case to the department of first instance.

9.6.3 Objections raised by the board

Objections raised by the board for the first time do not in themselves constitute special reasons for remittal. In **T 1089/17** the board underlined this with reference to the stated aim of Art. 11 RPBA to reduce the likelihood of a "ping-pong" effect between the boards

of appeal and the departments of first instance and a consequent undue prolongation of the entire proceedings before the EPO. The board had introduced a new document (a patent application filed by the appellant itself) in a communication.

The board in **T 1803/14** rejected the appellant's request for a remittal because fairness of the proceedings had been guaranteed in that the board had raised its objections twice, at points in time which had given the appellant the opportunity to consider them and respond accordingly.

Even when the board raises a fresh objection at the oral proceedings, this does not as such necessarily constitute special reasons for a remittal. In **T 1538/17** the board's new clarity objection was directly related to its and the appellant's diverging views on the interpretation of claim 1. This divergence had to be resolved before the examining division's decision refusing the then first auxiliary request (which essentially corresponded to the main request filed on appeal) for lack of inventive step could be reviewed. The board therefore considered it appropriate to deal with the clarity objection in the appeal proceedings.

9.6.4 Opportunity to comment

The fact that a party has refrained from commenting on the substance of requests, though they had had ample opportunity, carries little weight in deciding to remit or not. Where the version as upheld by the opposition division fails on appeal, it is to be expected that undecided lower-ranking requests that are clearly not inadmissible, for example because they were duly filed in opposition, would most likely need to be examined by the board for the first time. Such circumstances did not constitute special reasons for remittal. In **T 184/19** auxiliary requests 3, 4, 5 and 6 corresponded to the like numbered auxiliary requests filed shortly before the oral proceedings in opposition and which were not examined. The appeal was directed at the opposition division's interlocutory decision concerning maintenance of the patent in suit in amended form. Opponent 1 had requested remittal should these auxiliary requests 3, 4, 5 and 6 be admitted, as it could not have been prepared to discuss these requests. The board noted that the appellant proprietor and opponent 1 had both in fact made substantive submissions for these requests, and that in principle they could be discussed within that framework.

9.7. Obiter dicta

Obiter dicta are sometimes included in first-instance decisions in order to avoid remittal. They thereby serve overall procedural economy and effectiveness (**T 493/13**). In the interests of overall procedural economy and effectiveness, the board in **T 473/98** (OJ 2001, 231) also found it entirely appropriate and desirable that an opposition division should include in the reasons for a revocation decision pursuant to Art. 102(1) EPC 1973 employing the standard decision formula, by way of obiter dicta, findings which could obviate a remittal in the event of the revocation being reversed on appeal. See also **T 2446/16** (ex parte proceedings).

9.8. Remittal for hearing of witnesses

In **T 1551/14** the board remitted the case to the opposition division with an order that a witness be heard again, if necessary under oath before a national court.

9.9. Remittal for adaptation of the description

Article 11 RPBA only applies to cases that are remitted "for further prosecution". In particular, it does not apply to cases that are remitted with an order by the board to grant a patent or to maintain a patent in amended form, be it with or without adaptation of the description (see explanatory remarks on Art. 11 RPBA, Supplementary publication 2, OJ 2020).

In **T 1716/12** the board stated that remittal "with a description to be adapted" had become common practice of the boards of appeal and was, effectively, a remittal for further prosecution within the meaning of Art. 111(1) EPC and subject to the limits imposed in Art. 111(2) EPC.

In **T 146/17** the board stated that it was customary to remit cases to the department of first instance with an instruction to maintain the patent with an adapted description. It saw no reason to deviate from this standard course of action in the case in hand simply because the patent proprietor had not attended the oral proceedings.

In **T 32/16** the board stated that, regarding adaptation of the description to the new claims, the respondent's (patent proprietor's) preference to perform this at the oral proceedings was not followed. The required amendments to the description were seen to be of not inconsiderable scope, and the appellant indicated its need to fully consider any amendments made without being under time pressure. Under these circumstances, the board thus decided to remit the case to the opposition division under Art. 111(1) EPC for the description to be adapted to the claims found allowable. With regard to Art. 11 RPBA, the board noted that remittal of a case for adaptation of the description was not a remittal for "further prosecution", such that no "special reasons" needed to be present (see also **T 801/18**, **T 1968/18**).

9.10. Remittal to a differently composed department of first instance

In **T 2475/17** the board dealt with the issue of a board's power to order a different composition of a department of first instance when remitting a case to it.

Whether a case can be remitted to a differently composed department of first instance when the original first-instance decision is found to be vitiated by a substantial procedural violation is dealt with in detail, in the context of suspected partiality of members of the departments of first instance, in chapter III.J.4.2 "Remittal and rehearing of a case".

9.11. Accelerating proceedings after remittal

The EPC is silent on the possibility for a board to order acceleration of proceedings before the department of first instance after remittal. In **T 1108/21**, the board did issue such an order. It had accelerated the appeal proceedings (Art. 10(3) RPBA). It then remitted the case to the opposition division for further prosecution and explicitly ordered an acceleration of the opposition proceedings. By contrast, in **T 2916/19** the board refused to instruct the opposition division to accelerate the proceedings after remittal. It held that it was not empowered to impose any timeline/time constraints on the department of first instance and considered that when or at which pace the case was to be dealt with by the opposition division was a matter of managerial decisions to be taken by the department of first instance.

10. Binding effect

10.1. Binding effect of decision remitting case to department of first instance

10.1.1 Department of first instance bound by decision of board of appeal

a) Notion of ratio decidendi and binding effect

Article 111(2) EPC provides that, where a board of appeal remits a case to the EPO department of first instance whose decision was appealed, that department is bound by the board's ratio decidendi, in so far as the facts are the same. If the decision under appeal was taken by the Receiving Section, the examining division is also bound by the board's ratio decidendi.

The boards' decisions generally acquire their binding effect on being issued. While the EPC does not expressly refer to "res judicata", it is a generally recognised principle in the contracting states that is acknowledged by the boards (see e.g. **T 167/93**, OJ 1997, 229; **J 3/95**, OJ 1997, 493; **T 365/09**, **T 449/15**). It means a matter finally settled by a court of competent jurisdiction, rendering that matter conclusive as to the rights of the parties and their privies, such a final judgment constituting an absolute bar to a subsequent legal action involving the same claim, demand or cause of action, and the same parties or their privies (**T 934/91**, OJ 1994, 184; see also **T 1666/14**).

The boards have assumed in several decisions (**T 934/91**, **T 113/92**, **T 843/91** of 5 August 1993, OJ 1994, 832, **T 609/94**, **J 8/98** and **T 694/01**) that their decisions are final. In practical terms, that at the very least means that a board's decision on the version of a patent is binding on the department of first instance and that, therefore, this version can no longer be amended in proceedings before the EPO (for more details on this point, see **T 2558/18**).

A decision's binding effect under Art. 111(2) EPC applies only to the case decided on (**J 27/94**, OJ 1995, 831). Art. 111 EPC does not provide for such binding effect for cases not decided by the boards, although there will generally be good reasons for departments

of first instance to follow their decisions in order to maintain a consistent practice and avoid unnecessary appeals.

The ratio decidendi of a board's decision binds the administrative department dealing with the same application in the subsequently resumed examination proceedings (see Art. 111(2) EPC) and indeed the board in any fresh appeal against the then ensuing examination decision. By contrast, a decision taken on appeal in examination proceedings has no such binding effect in any subsequent opposition proceedings or on appeal against the opposition division's decision because opposition proceedings are separate and distinct from examination proceedings (especially in that different parties are involved) and differ from them in terms of the nature of the public interest involved (**T 1666/14**).

The ratio decidendi of a decision under Art. 111(2) EPC 1973 is the ground or the reason for making it – in other words, the point in a case which determines the outcome of the judgment (**T 934/91**, OJ 1994, 184). It is not contained in the order but in the section "Reasons for the Decision" and it is thus of no importance for its binding effect that a particular matter is not mentioned in the order (**T 436/95**). The order of a board's decision provides a first point of reference for establishing the extent to which the binding effect applies. However, where a case is remitted for further prosecution on the basis of claims of auxiliary requests following rejection of higher-ranking claim requests, the order is usually confined to the setting aside of the decision under appeal and the remittal for further prosecution. Thus, the order has to be seen in context with the reasons for the decision as a whole in order to determine the extent to which the decision is final (**T 449/15**).

b) Binding effect on examining divisions

The board in **T 366/92** pointed out that according to Art. 111(2) EPC 1973 the examining division was bound by the board's decision only to the extent that it had been decided that the subject-matter of Claim 1 was novel when compared with the prior art known from D2 and that the claim met the requirements of Art. 84 and 123(2) EPC 1973. See also **T 255/92**.

In **T 2558/18**, the board dealt with the binding effect on an examining division of a remittal with precisely specified documents for the purposes of R. 71(3) EPC. It observed that, under Art. 111(1), second sentence, EPC, a board could either exercise any power within the competence of the department which was responsible for the decision appealed (alternative 1) or remit the case to that department for further prosecution (alternative 2). In its Catchword, the board summarised as follows: where a board remits a case to the examining division for the grant of a patent in a precisely specified version, i.e. with precisely specified claims, description and drawings, the decision on this version is taken by virtue of the first alternative in Art. 111(1), second sentence, EPC. The version is binding on the examining division in accordance with the legal principle enshrined in Art. 111(2) EPC , on the basis of which the remittal is also ordered. The procedure under R. 71(6) EPC is inapplicable in view of the binding effect arising from Art. 111(2) EPC by virtue of Art. 164(2) EPC.

c) Binding effect on opposition divisions

When after remittal the proprietor files new requests which require examination to be re-opened on issues that have already been judged upon by the board of appeal, without the justification that might be provided, for example, by the proprietor's being faced with a new situation, then such requests should be deemed inadmissible (**T 383/11**).

In **T 308/14** the board held that if a case is remitted to the opposition division in appeal proceedings, after the board has taken a decision under Art. 84 EPC on the clarity of a certain feature in a claim, this decision is final and thus binding on the opposition division in the subsequently resumed opposition proceedings. The binding effect did not only cover the decision on Art. 84 EPC as such; it also extended to any finding of fact that led to this decision. Therefore, if in the resumed opposition proceedings an insufficiency objection is made under Art. 83 EPC on the basis that this very feature was ambiguous (insufficiency arising out of ambiguity), the opposition division should not reopen the discussion on whether this feature is clear, and should accept any finding of fact that the board made in arriving at its decision on Art. 84 EPC.

According to **T 934/91** (OJ 1994, 184), a board's decision apportioning costs constituted an absolute bar to the opposition division's considering afresh, let alone deciding upon, either the fact or the quantum of the apportionment, or their reviewing the reasons (ratio decidendi) for which the apportionment had been made. The board found that the purported decision of the opposition division on this point was in law a mere communication of the clear and immutable legal position brought about by the earlier decision of a final court of competent jurisdiction, namely, the technical board of appeal.

10.1.2 Binding effect in opposition proceedings after remittal to an examining division

A decision by a board of appeal on an appeal from an examining division decision is not binding in subsequent opposition proceedings or on appeals therefrom (**T 26/93**; **T 167/93**, OJ 1997, 229; **T 694/01**, OJ 1997,229; **T 2291/08**; see also **T 1853/16**). The binding effect is also not restricted to cases where the composition of the board remained unchanged (**T 436/95**). Following **T 167/93**, the board in **T 1099/06** pointed out that opposition proceedings are separate and distinct from examination proceedings and are characterised by the nature of the public interest. The legislative and procedural framework has quite clearly been designed to allow the public interest in challenging granted patents by opposition to take priority over any considerations of certainty or apparent consistency. The board pointed out that to the extent this principle is recognised in the law of the EPC, it is of extremely narrow scope and must meet the six criteria set out in **T 167/93** (OJ 1997, 229) – the issue must have been (a) judicially determined; (b) in a final manner, (c) by a tribunal of competent jurisdiction; (d) where the issues of fact are the same; (e) the parties (or successors in title) are the same; and (f) the legal capacities of the parties are the same. Thus, a decision in earlier examination appeal proceedings could not be binding in subsequent opposition appeal proceedings, the criteria (c), (e) and (f) not being satisfied.

10.1.3 Board of appeal bound in subsequent appeal proceedings following remittal

The problem of being bound by an earlier board of appeal decision where a case is remitted also arises in connection with a subsequent appeal against the ensuing decision.

In a number of decisions, the boards have observed that they are bound by their own initial decision if a second appeal relating to the same subject-matter is brought before them (a "self-binding" effect, known by the German term *Selbstbindung*). The binding effect of the initial decision extends to all further findings made by the board in so far as they were decisive for the outcome of that decision and the facts have not changed (**T 961/18**; see also **T 1545/08**). However, the board can be bound only in so far as the facts are the same and only in so far as its legal assessment in the initial decision itself went (**T 2337/16**). However, they are not so bound where the facts underlying the initial decision have changed (Art. 111(2) EPC) (**T 21/89**; see also **T 153/93**, **T 1545/08** and **T 2036/21**). This is often based on the argument that board of appeal decisions are final and without appeal, so that no EPO body – not even boards of appeal – can take a new decision on facts which have already been decided. In **T 690/91** the argument was that the same binding effect applied to any subsequent appeal proceedings since, according to Art. 111(1) EPC 1973, the board might exercise the same power as was within the competence of the department which was responsible for the decision appealed.

See also **T 720/93** for the extent to which a board considered itself bound by an earlier board of appeal decision in the same case. Although the claim pending before the board represented different facts from in the first proceedings since it was a different type of claim and contained a number of different features, the board found some findings of the first decision binding for the second proceedings.

The board in **T 736/16** had to rule on a second appeal brought by the appellant on the basis that it had no longer been open to the opposition division to examine compliance with Art. 123(3) EPC because the board had already settled that matter in relation to the same request when ruling on its first appeal in **T 1909/12**. The board agreed that both the opposition division and it itself were bound under Art. 111(2) EPC by the ratio decidendi in its decision on the first appeal (and, indeed, by those in **R 3/14**, another earlier decision issued in the same case). However, since it had not explicitly referred to Art. 123(3) EPC in either in the order or the reasons for that decision, it first had to ascertain whether it could be clearly inferred from any parts of the reasons that it had indeed already decided that the appellant's request met the requirements in that article. It concluded that it had not done so.

In **T 449/15** the board had to compare the subject-matter of respective claim 1 of the main request decided upon in **T 449/13** and of auxiliary requests 4 and 5 pending before the board for consideration in the second appeal proceedings. The amendments only amounted to an inclusion of redundant linguistic additions and merely represented cosmetic changes without any effect on the scope of the claims. Therefore, the board concluded that the amendments undertaken did not alter the subject-matter claimed in substance compared to the subject-matter finally decided upon in **T 449/13**, or the facts on which said decision was based. Consequently, the finding that the claimed subject-

matter lacked an inventive step had been finally settled and bound the board. In this context, the board noted that there have also been other decisions in the jurisprudence of the boards of appeal in which the competent boards considered themselves as being prevented from deciding on an issue due to the binding effect of board decisions even though the claims under consideration were not literally identical to the claims decided upon in the earlier decision (see e.g. **T 1872/08**, **T 572/07**, **T 436/95**).

On the binding effect of a final decision on the subject-matter of the parent application in proceedings relating to divisional applications, see chapter II.F.2.4.

10.1.4 Binding effect: remittal for the continuation of proceedings

Where a board of appeal issued a decision rejecting certain claimed subject-matter as not allowable and remitted the case for further prosecution in accordance with an auxiliary request, under Art. 111(2) EPC 1973, the examination for allowability of the rejected claimed subject-matter could not be re-opened, either by the examining division during its further prosecution of the case, or by the board of appeal in any subsequent appeal proceedings (**T 79/89**, OJ 1992, 283).

In the opposition proceedings following the remittal for continuation of the proceedings, an amendment of the patent claims could change the actual basis of an appeal decision. In such a case the binding effect of Art. 111(2) EPC 1973 no longer applied (**T 27/94**).

Art. 111(2) EPC 1973 stated unambiguously that the department of first instance and the board of appeal which was again concerned with the case were bound by the ratio decidendi of the remitting decision only "in so far as the facts are the same". The opposition division was thus not bound by the first decision if new claims were submitted which were not in conflict with the ratio decidendi of the decision (**T 609/94**).

10.1.5 Binding effect: remittal only for adaptation of the description

A decision remitting a case to the opposition division with the order to maintain a patent on the basis of amended claims is binding in the sense that neither the wording nor the patentability of those claims can be challenged again in subsequent EPO proceedings (**T 843/91**, OJ 1994, 832). The decision on the claims' patentability remains final even where the facts have changed (**T 27/94**). When the first board of appeal delivers its decision, the content and the text of the patent claims are finally settled and can no longer be amended in proceedings before the EPO (**T 113/92**). Only objections to the amendments made to the description by the opposition division can be examined on appeal (**T 1063/92**).

Remittal for the description to be amended does not render it possible for an opponent to challenge substantive patentability again by appealing the opposition division's decision after remittal, where a final decision has been taken on this and the scope of the patent (**T 1063/92**). Following **T 843/91** (OJ 1994, 832), the board in **T 153/93** found that all findings of fact that were a conditio sine qua non of the finally binding parts of the decision were finally settled with the result that new facts, evidence or arguments seeking to cast

doubt upon these facts could not be considered either by the opposition division or the board of appeal.

Where the board, in the decision remitting the case to the department of first instance, is silent on the question of the adaptation of the description, this does not necessarily imply that no adaptation is required, but merely that the matter was not considered or decided. The point is therefore not finally settled and so can be raised in a subsequent appeal (**T 636/97**).

10.2. Binding effect of interlocutory referral decision on subsequent proceedings

The EPC is silent on this issue. Art. 111(2) EPC provides that if a board of appeal remits a case to the department of the EPO whose decision was appealed, that department is bound by the ratio decidendi of the board of appeal, in so far as the facts are the same; however, Art. 111(2) EPC is not applicable to the relationship between an earlier interlocutory decision of a board and the subsequent proceedings before the same board. In **T 116/18** of 28 July 2023, the board decided that it was bound by its earlier decision in the same case referring a question to the Enlarged Board. The scope of the subsequent proceedings was therefore limited to the application of the Enlarged Board's decision to the unresolved issue that gave rise to the referral and to any other issues not dealt with in that decision.

11. Reimbursement of appeal fees

11.1. Introduction

According to R. 103(1)(a) EPC (R. 67 EPC 1973) the reimbursement of appeal fees is ordered in the event of interlocutory revision or where the board of appeal deems an appeal allowable, if such reimbursement is equitable by reason of a substantial procedural violation.

Rule 103(1)(b) EPC, introduced with the EPC 2000, goes some way towards compensating for the lack of a cross-appeal facility. Appeals filed as a precaution – in case the other party appeals – can be withdrawn if the other party does not file an appeal, at an early stage of the proceedings, during the period between the expiry of the respective periods for filing the notice of appeal and filing the statement of grounds of appeal, i.e. before any great expense or effort on the part of the parties or the EPO (see notes to R. 67 EPC 1973, OJ SE 1/2003, 184).

Rule 103(2) EPC, introduced by decision of the Administrative Council of 13 December 2013 (CA/D 16/13; OJ 2014, A3), provided for a reimbursement of the appeal fee at 50% if the appeal was withdrawn after expiry of the period under R. 103(1)(b) EPC provided the requirements set out under R. 103(2)(a) and (b) EPC were met. This provision was amended by the decision of the Administrative Council of 12 December 2019 (CA/D 14/19; OJ 2020, A5), which entered into force on 1 April 2020. Following these amendments, the appeal fee may be reimbursed at 75% (R. 103(2) EPC), 50% (R. 103(3) EPC), or 25% (R. 103(4) EPC) if the appeal is withdrawn

(or a request for oral proceedings is withdrawn in the case of R. 103(4)(c) EPC) and the requirements set out in the respective provisions are met (see in this chapter V.A.11.9. and following).

Rule 103(6) EPC (formerly R. 103(2) EPC; then R. 103(3) EPC until the latest revision of 1 April 2020) governs the competence of the department of first instance and of the board of appeal in the matter of the reimbursement of the appeal fee and codifies the case law of the Legal Board (**J 32/95**, OJ 1999, 733; **G 3/03**, OJ 2005, 344; see in this chapter V.A.11.4.2. "Competence to decide on reimbursement").

For the rules formally applicable to patent applications pending on the date of entry into force of the EPC 2000, see **J 10/07** (OJ 2008, 567); for the applicability of R. 103(1)(b) EPC see **T 2052/08**.

11.2. Examination ex officio

The boards may, even in the absence of a request to this effect, examine ex officio whether the reimbursement of the appeal fee is equitable by reason of a substantial procedural violation (**J 7/82**, OJ 1982, 391; **T 271/85** of 22 March 1989; **T 346/88**; **T 598/88**; **T 484/90**, OJ 1993, 448 and **T 736/14**).

11.3. Appeal deemed not to have been filed

11.3.1 Appeal deemed not to have been filed due to late filing of the notice of appeal and/or late payment of the appeal fee

For the issue of reimbursement of the appeal fee the distinction between an appeal not deemed to have been filed and an inadmissible appeal is relevant. When the appeal is deemed not to have been filed the appeal fee must be reimbursed since the purpose of this fee cannot be achieved. On the contrary, when an appeal is inadmissible it is in principle not possible to repay the appeal fee (**T 445/98**; see also **T 372/99** and **T 752/05**).

As a result of diverging case law on this distinction, the President of the EPO referred a point of law to the Enlarged Board. The latter answered the referred question in Opinion **G 1/18** (OJ 2020, A26) on whether an appeal is to be treated as not filed or as inadmissible in cases of a failure to observe the two-month time limit under Art. 108 EPC owing to belated payment of the appeal fee and/or belated filing of notice of appeal. This question had previously been submitted to the Enlarged Board in **G 1/14** and **G 2/14** – however the question had not been addressed because in **G 1/14** the referral was found to be inadmissible and in **G 2/14** the patent application was abandoned.

According to **G 1/18**, the different factual scenarios falling within the scope of the referred question and encountered in earlier case law should be treated as follows.

An appeal is deemed not to have been filed in the following cases: (a) where notice of appeal was filed within the two-month time limit prescribed in Art. 108, first sentence, EPC and the appeal fee was paid after expiry of that two-month time limit; (b) where notice of

appeal was filed after expiry of the two-month time limit prescribed in Art. 108, first sentence, EPC and the appeal fee was paid after expiry of that two-month time limit; (c) where the appeal fee was paid within the two-month time limit prescribed in Art. 108, first sentence, EPC for filing notice of appeal and notice of appeal was filed after expiry of that two-month time limit.

In the cases referred to in (a), (b) and (c) in the preceding paragraph, reimbursement of the appeal fee is to be ordered ex officio.

In addition, where the appeal fee was paid within or after the two-month time limit prescribed in Art. 108, first sentence, EPC for filing notice of appeal and no notice of appeal was filed at all, the appeal fee is to be reimbursed.

With this ruling, the Enlarged Board effectively overruled earlier decisions in which, where facts were the same as envisaged in **G 1/18**, the appeal fee was not reimbursed because the board considered that the appeal was inadmissible. For an overview of relevant decisions predating **G 1/18**, see CLB, 9th edn. 2019, V.A.9.3 "Appeal deemed not to have been filed or inadmissible appeal".

11.3.2 Translation of notice of appeal

In **T 323/87** (OJ 1989, 343) the translation of the notice of appeal had not been filed in due time. The board held that, pursuant to Art. 14(5) EPC 1973, the notice of appeal was deemed not to have been filed, and ordered reimbursement of the appeal fee. In **T 1152/05** it was also decided that, since the appeal of the patent proprietor was deemed not to have been filed, it followed that the appeal fee was paid without reason and had to be reimbursed. In **T 126/04**, on the other hand, the board decided that failure to file a translation of the notice of appeal in due time meant that the appeal was inadmissible.

11.3.3 No legal ground for payment

The grounds for reimbursement listed in R. 103(1) EPC aside, fees may also be refunded if there was no legal ground for their payment, e.g. in the event of payment by mistake or overpayment, unless this amount is insignificant: see Art. 12 RFees e contrario as interpreted in **T 1284/09**.

11.3.4 Request for re-establishment in respect of the time limit for filing the notice of appeal and/or for paying the appeal fee

In **T 1192/07** the request for re-establishment in respect of the time limit for paying the appeal fee was refused. As a result, the appeal was deemed not filed because the appeal fee had not been paid in time and the appeal fee was refunded.

In **T 1465/08** the board refunded the appeal fee in a case where the request for re-establishment in respect of the time limit for paying the appeal fee was itself deemed not to have been filed with the consequence that the appeal was deemed not to have been filed.

In **T 257/07** the request for re-establishment in respect of the time limit for filing the notice of appeal was refused, and therefore the appeal was deemed not to have been filed and the appeal fee reimbursed (see also **T 1962/08**).

11.3.5 No legal basis for retaining appeal fee in case of intervention in opposition appeal proceedings

In **T 791/06** the intervention of appellant III was considered by the board to be an admissible intervention in opposition appeal proceedings, and so only the required opposition fee needed to be paid, as established by **G 3/04**. Hence there was no legal basis for retaining the appeal fee, which in any case had been paid as a precaution. The board concluded that the appeal fee paid by the intervener should be reimbursed.

11.3.6 Several appellants

In **T 552/97** the board interpreted R. 67 EPC 1973, looking in particular at the English text, as meaning that, where several appeals have been filed, each appellant's appeal fee may be reimbursed if such reimbursement was equitable.

11.3.7 No reimbursement if appeal filed in accordance with the requirements of Article 108 EPC

In **J 15/01** the Legal Board ruled that the fact that an appeal was against a communication, as opposed to a decision under Art. 106(1) EPC 1973, did not justify refunding the appeal fee. If – as in the case before it – the board concluded that there had not been an appealable decision under Art. 106(1) EPC 1973, this made the appeal inadmissible but did not mean it had never existed, the requirements under Art. 108 EPC 1973 having been met. The appeal fee could not therefore be refunded.

In **J 18/12** the Legal Board held that the final non-existence of the patent application in a substantive sense did not mean that the appeal proceedings had not come into existence (as opposed to the legal fiction of non-existence when an appeal was deemed not to have been filed). This situation regularly arose in proceedings before the EPO, e.g. where a decision of the Receiving Section not to accord a filing date was appealed.

In **T 1284/09** the board did not order reimbursement of the appeal fee for either of the two appeals because the requirements of Art. 108 EPC were fulfilled for each of the appeals. The original opponent and its purported assignee (the opposition division had rejected the assignment request) had each filed an identical notice of appeal against the same decision and each separately paid the appeal fee.

11.4. Reimbursement of appeal fee in case of interlocutory revision

The appeal fee may be reimbursed in full under R. 103(1)(a) EPC in the event of interlocutory revision.

11.4.1 Requirements

Pursuant to Art. 109 EPC a department whose decision is contested must rectify its decision if it considers the appeal admissible and well founded; this applies in ex parte cases only. R. 103 EPC (R. 67 EPC 1973) allows for reimbursement of the appeal fee in the case of interlocutory revision. In **G 3/03** (OJ 2005, 344) it was held that the grant of interlocutory revision constituted a necessary, but not sufficient, prerequisite for the department of first instance to allow a request for the reimbursement of appeal fees (see also **T 1222/04**). In **T 939/95** the words "if such reimbursement" in R. 103 EPC were held to refer both to interlocutory revisions and appeals, meaning that it was also a prerequisite for interlocutory hearings that a substantial procedural violation had occurred and that reimbursement was found equitable in the discretion of the deciding body (see also **T 79/91**, **T 536/92**).

11.4.2 Competence to decide on reimbursement

As to the question of which department is competent to decide on the request for reimbursement, in cases of interlocutory revision, the legal situation defined by **G 3/03** (OJ 2005, 344) and **J 32/95** (OJ 1999, 733) is now enshrined in R. 103(6) EPC (see **T 625/09**, **T 206/10**). In **J 32/95** the Legal Board held that if the department of first instance considered the request for reimbursement of the appeal fee not to be well-founded in the event of interlocutory revision, it had to remit the request to the board of appeal for a decision. In **G 3/03** the Enlarged Board held that in the event of interlocutory revision under Art. 109(1) EPC 1973, the department of first instance whose decision had been appealed was not competent to refuse a request from the appellant for reimbursement of the appeal fee. The board of appeal which would have been competent under Art. 21 EPC 1973 to deal with the substantive issues of the appeal if no interlocutory revision had been granted was competent to decide on the request. **G 3/03** was, for example, applied in **T 1379/05**, **T 1315/04**, **T 245/05**, **T 1863/07** and **T 2352/13**.

In **T 21/02** the board, distinguishing the facts from **G 3/03** and **J 32/95**, held that it was not empowered to decide on the request for reimbursement of the appeal fee as the request had been submitted in the absence of a pending appeal and hence could not constitute an ancillary issue to be dealt with in appeal proceedings. An appeal had been fully dealt with by interlocutory revision by the department of first instance and was thus no longer pending when a request for reimbursement of the appeal fee was submitted (see also **T 1703/12**, **T 2134/12**, **T 2008/14**).

In **T 242/05** the board held that once interlocutory revision had been granted, the appeal was finally settled. In the absence of a pending appeal, any request for reimbursement of the appeal fee filed after the decision to grant interlocutory revision will be considered inadmissible, regardless of whether the decision was taken by the examining division or the board of appeal as the body competent to consider the appeal (see also **T 70/08**). In **T 955/20**, the board endorsed the reasoning in **T 242/05** and **T 70/08**; it distanced itself from that in **T 21/02** and **T 893/13**.

In **T 893/13** the board disagreed with **T 21/02** and **T 242/05**, and found that since the examining division was not competent to decide that the appeal fee was not to be reimbursed, an interlocutory revision without an order for reimbursement could not be construed as a decision not to reimburse. The board further stated that a request for reimbursement of the appeal fee could be validly filed even after interlocutory revision, since R. 103(3) EPC (now R. 103(6) EPC) entrusted the boards with the decision on all other matters of reimbursement based on only two conditions: that the decision was rectified and that the appeal fee was not reimbursed by the examining division.

In **T 657/17** interlocutory revision was granted by the examining division yet the matter was referred to the board for a decision on reimbursement of the appeal fee in the absence of any request for such reimbursement. The board referred to **G 3/03** (point 3 of the Reasons) according to which, in the absence of a request for reimbursement of the appeal fee, the decision of the department of the first instance granting interlocutory revision pursuant to Art. 109(1) EPC should make no mention of the issue of reimbursement of the appeal fee, and the appellant would not be adversely affected by the decision. In the case in hand, the issue of reimbursement of the appeal fee should therefore not have been referred to the board and the board was not empowered to decide on this issue.

11.4.3 Examining division should have rectified decision

In **T 647/93** (OJ 1995, 132) it was pointed out that when the examining division did not make use of the possibility of granting interlocutory revision after the **mistake** had been pointed out in the grounds of appeal, this was normally deemed to constitute a procedural violation justifying the reimbursement of the appeal fee (see also **T 808/94**, **T 898/96**, **T 861/03**, **T 1113/06**, **T 971/06**, **J 7/07**; see also **T 685/98**, OJ 1999, 346).

In **T 183/95** the board held that the appellant's request for reimbursement of the appeal fee in the event of interlocutory revision could not be granted under R. 67, first half sentence, EPC 1973, since the examining division had not rectified its decision. However, it held that a refund of the appeal fee may be ordered under R. 67, second half sentence, EPC 1973, if the appeal is allowed and the board finds this equitable by reason of a substantial procedural violation. In **T 2528/12** the board also declined to order reimbursement, because although interlocutory revision had not been granted, as it should have been, that was not a substantial procedural error. That the grant proceedings had taken longer as a result had not adversely affected the appellant in a legal sense.

In **T 794/95** the board did not consider it equitable to order the reimbursement of the appeal fee, since the examination procedure up to the decision under appeal was not tainted with any failure and the necessity for the appellant to file an appeal emerged exclusively from the substance of the decision, not because of any procedural shortcomings up to this stage and equally not from the later incorrect handling of the appeal by the examining division (i.e. the failure to rectify its decision).

In **T 685/98** (OJ 1999, 346) the board held that where a fundamental procedural right had manifestly been violated in a refusal pursuant to Art. 97(1) EPC 1973, or in the foregoing examination procedure, a further substantial procedural violation occurred if the examining

division failed to grant interlocutory revision on appeal (following **T 647/93**, OJ 1995, 132; see also **T 1765/13**), since such a right had to be safeguarded irrespective of the substantive merits of the case.

In **T 898/96** the board took the view that the decision of the examining division to refuse the application having regard to Art. 113(2) EPC 1973 should have been rectified by way of interlocutory revision. The failure to rectify such a decision in this way was a substantial procedural violation. However, the board did not consider the refund of the appeal fee to be equitable because the applicant did not approve this text of the application until he filed an appeal.

In **T 704/05** the board found that the examining division could have set its decision aside by way of interlocutory decision pursuant to Art. 109(1) EPC 1973. However, given that the examining division was expressly precluded from giving its reasons for not granting interlocutory revision, it was not open to the board to criticise this omission. The mandatory but necessarily silent judgment made pursuant to Art. 109(1) EPC 1973 as to whether an appeal refuted the reasons for a refusal was not an exercise of discretion and ipso facto left no room for an inquiry as to whether discretion had been properly exercised. The board was aware that a number of decisions of the boards of appeal had taken a different view on this point – to the extent of sometimes castigating such omission as a substantial procedural violation – but respectfully suggested that these decisions had not given sufficient weight to the implications of the silence imposed on the examining division by Art. 109(2) EPC 1973.

In case **T 1982/07** the board said that it was fundamental to the principle of fair trial that in the examination an applicant, when confronted with new prior art documents, was not only given the right to be heard, but also the right to react thereto by amending the claims in order to overcome the prior art references. In the case at issue, the way the examining division exercised its discretion under R. 86(3) EPC 1973 (now R. 137(3) EPC) was erroneous, as it did not allow the applicant to react appropriately, but rather tied its hands to an extent neither mandated by procedural efficiency nor justified in the light of the prior art documents. The examining division thus exercised its discretion in an unduly restrictive manner, thereby committing a substantial procedural violation. It would have been incumbent on the examining division to rectify the decision pursuant to Art. 109(1) EPC, but this was not done. The board ordered the remittal to an examining division that had not previously dealt with this case.

11.4.4 A rectification decision maintaining earlier decision

In **T 691/91** the board held that Art. 109 EPC 1973 provided for two legally viable alternatives: to maintain or to annul the decision which was appealed. In the case at issue, the examining division had chosen a third way: to maintain the earlier decision by issuing a decision on rectification, which resulted in the appellant having to file a second appeal against the decision on rectification. This alternative was not covered by the provisions of Art. 109 EPC 1973. This decision was thus held to be ultra vires and the board ordered reimbursement of the second appeal fee. Reimbursement of the first appeal fee was also

ordered because a violation of the right to be heard had occurred during the examination proceedings (see also **T 252/91**).

11.4.5 Re-opening examination after rectification

In **T 142/96** the practice of re-opening examination after rectification was held to be contrary to the principle of procedural economy underlying Art. 109 EPC 1973 and so constituted a substantial procedural violation.

In **T 2247/09** the examining division had granted interlocutory revision, then proceeded with the examination of the new subject-matter put forward with the appeal, before refusing the application again in its second decision. The appellant claimed that he had had to pay two appeal fees in order to have the claims considered by a board of appeal. The board noted that the reasons given in the examination division's second decision differed from those given in its first decision. Moreover, the decision to grant interlocutory revision had been correct because the applicant's new request had removed the reasons for the decision under appeal. The mere fact that the further examination again resulted in the refusal of the application did not constitute a substantial procedural violation.

11.5. Allowability of the appeal

Rule 103(1)(a) EPC stipulates as a precondition for reimbursement that the appeal must be allowable. In **J 37/89** (OJ 1993, 201) the board stated it was clear from the wording and purpose of the provision that "allowable" was to be understood to mean that the board of appeal, in substance at least, "follows" the relief sought by the appellants, in other words that the board allows their requests (see also **T 1111/09**). In **J 18/84** (OJ 1987, 215) the board held that the fact that the appeal was allowed only in part was no impediment to a refund (see also **T 129/01**, **T 604/01**, **T 863/08**, **J 1/13**).

11.6. Substantial procedural violation

One of the preconditions for reimbursement of the appeal fee under R. 103 EPC is that a substantial procedural violation has taken place. A "substantial procedural violation" is an objective deficiency affecting the entire proceedings (**J 7/83**, OJ 1984, 211). Whether or not there has been a substantial procedural violation is to be determined on an objective basis (**J 32/95**, OJ 1999, 733; **T 160/09**).

11.6.1 Violation must be of a procedural nature

In **T 12/03** the board stated that a substantial procedural violation is an objective deficiency in the procedure in the sense that the rules of procedure have not been applied in the manner prescribed by the EPC. According to **J 6/79** (OJ 1980, 225), the giving of incorrect information by the EPO about the rules of procedure, which, if followed by the applicant, could lead to the same consequences as the incorrect application of those rules, could also be considered as lying within the scope of a "procedural violation". In **T 690/06** the board held that an error of judgment on substantive issues by the examining division did

not constitute a "procedural" violation (see also **T 698/11**, **T 658/12**). See also in this chapter V.A.11.6.10.

In **T 990/91** the board held that the lack of opportunity to reply to a new argument from the examining division in its decision to refuse the application that was supererogatory and incidental could not be considered to be a procedural violation (see also **T 1085/06**).

In **T 683/14** the board held that the examining division had committed a substantive error rather than a procedural one. The procedural consequences were caused exclusively by the implementation of the division's erroneous substantive position and did not constitute an independent procedural violation for the purposes of R. 103(1)(a) EPC. The examining division had wrongly refused to take into account a confidentiality agreement, having considered that the debate had been closed and a decision had been taken during oral proceedings. The board explained that the examining division had erred in that the oral proceedings had not been terminated by a formal decision and that even if the debate had been formally closed, it could have been re-opened. The board cited **T 595/90** and held that, on re-opening the debate, considerations analogous to those that apply to the boards of appeal apply to the department of first instance: "[o]bservations submitted [after closing the debate] could only be taken into account if the Board reopened the debate (Art. 113 EPC) which depends on its discretion."

In **T 68/16** the board noted that the opposition division had not used the problem-solution approach. The board stated that this fact in itself did not constitute a substantial procedural violation. The problem-solution approach was not enshrined in the EPC and its use was not mandatory. The board agreed that, as a rule, a division that does not use the problem-solution approach should indicate its reasons for doing so, if only to dispel the impression that it acts arbitrarily. However, the Guidelines only stated that any "deviation from this approach should be exceptional" (see Guidelines G-VII, 5 – November 2017 version; this passage was subsequently deleted in the November 2018 version) and did not require a justification.

11.6.2 Violation must be substantial and affect the entire proceedings

In **T 682/91** the board of appeal emphasised that a procedural violation which did not adversely affect the rights of the parties could not be considered substantial. The seriousness of a procedural violation derived from its adverse effects.

In **J 14/99**, as in **J 15/99**, **J 21/98** (OJ 2000, 406), **J 22/98** and **J 6/99**, it was decided that a procedural violation which had not played any part in the decision could not be considered substantial (see also **T 2385/10**). In **T 2249/08** the board found it a requirement that the criticised discretionary decision of the department of first instance must be decisive for the outcome of the decision under appeal. In **T 49/13** the board held that an error which would not have led to a different outcome of the proceedings was not a substantial procedural violation (see also **T 1340/10**, **T 1740/06**).

In **T 5/81** (OJ 1982, 249) it was stated that an alleged violation affecting a part of the decision other than its ratio decidendi could not be a substantial violation within the meaning of R. 67 EPC 1973 (see also **T 959/00**).

In **T 712/97** the board held that the opposition division had considered the respondent's experimental report, but had not relied on it in a way adverse to the appellant. Therefore, the refusal to admit the appellant's experimental report into the proceedings, while a violation of the appellant's right to present comments on the respondent's experimental report, had no substantive effect on the outcome of the proceedings and did not amount to a substantial procedural violation.

In **T 219/93** the board remitted the case to the department of first instance since it clearly called for revision under Art. 109 EPC 1973. The contested decision had also been inadequately reasoned on one point within the meaning of R. 68(2) EPC 1973. Nevertheless, the refusal had been made principally on other grounds, and the board did not consider the procedural violation to be so substantial within the meaning of R. 67 EPC 1973 that reimbursement of the appeal fee would be equitable.

In **T 107/05** the board held that the opposition division's lack of consideration of the opponent's arguments on E5 had not been conclusive for the outcome of the appealed decision. The opposition division had considered E5 "acting of its own motion" and had assessed within its power of discretion that it was not relevant – an analysis confirmed in the appeal proceedings. The mistake made by the opposition division could be regarded as a procedural violation but in this particular case not as a substantial one.

In **T 1607/08** (see also **T 2246/13**) a procedural violation of the principle of the protection of legitimate expectation occurred. Since this violation led to the revocation of the patent and came as a surprise to the patent proprietor, it constituted a substantial procedural violation (see also **T 1423/13**). In **T 2321/08**, the examining division violated the procedure foreseen in Art. 94(3) EPC. This procedural violation was considered substantial because its immediate consequence was the refusal of the application.

In **T 1232/16** the board held that although the board normally orders reimbursement of the appeal fee on account of a substantial procedural violation, this would not be equitable in the case in hand in view of the refusal additionally being based on other grounds not tainted by the procedural violation.

11.6.3 Procedural violation must be committed by the department whose decision is under appeal

In **T 469/92** the alleged procedural violation was not an act of the opposition division, whose decision was the subject of the appeal, but instead that of the examining division. Even if such an act were in breach of the procedural requirements of the Convention, a board of appeal would not have the power to order reimbursement.

In **T 1875/07** the board stated that a substantial procedural violation could only be committed by one of the departments charged with the procedure mentioned in

Art. 15 EPC 1973, not by the President acting under Art. 10 EPC 1973. Therefore, the non-disclosure to the public of the details of a system for performance evaluation for examiners cannot amount to a substantial procedural violation.

11.6.4 Search

In **T 1411/08** and **T 1515/07** the boards considered that the examining division had to be held to have committed a substantial procedural violation because it had not performed an additional search that was manifestly necessary (see also **T 1924/07**). In **T 1924/07** the board held that a distinction had to be drawn between, on the one hand, whether the examining division had acted despite realising that the features were technical and not notorious, thereby indicating a situation where a search was "manifestly necessary" (cf. **T 1515/07** and **T 1411/08**), and on the other hand, whether the features had been erroneously overlooked or misjudged, i.e. an "error of judgment" had occurred (cf. **T 690/06** and **T 698/11**); the latter case could not be considered a procedural violation (see in this chapter V.A.11.6.10).

In **T 736/14** the board held that, if an applicant whose application is non-unitary responds unclearly and/or in a misleading way to an invitation from the examining division to designate which searched invention it wishes to prosecute further, it could not be automatically assumed that the applicant selected the invention covered by the main request for examination. Rather, the examining division had to clarify, e.g. via a further communication, which of the searched inventions the applicant actually wanted it to examine. Confronting the applicant with an irrevocable decision not to admit an auxiliary request covering one of the inventions searched, without giving an opportunity to comment on its admissibility beforehand, constituted a substantial procedural violation of the applicant's right to be heard. In **T 291/93** it was held that a simple reference by the appellant to an inadequate search of the prior art could not be taken as sufficiently supporting an allegation that a substantial procedural violation had occurred.

11.6.5 Guidelines

In **T 42/84** (OJ 1988, 251) the board held that the Guidelines were not legally binding and a failure by the examining division to follow them was not in itself a procedural violation within the meaning of R. 67 EPC 1973 unless it also constituted a violation of a rule or principle of procedure governed by an article of the EPC or one of the Implementing Regulations (see also **T 647/93**, OJ 1995, 132; **T 51/94**; **J 24/96** OJ 2001, 434; **T 937/97**).

11.6.6 Request for interview

In **T 182/90** (OJ 1994, 641), **T 119/91**, **T 523/91**, **T 366/92**, **T 397/94** and **T 245/15** the boards of appeal stated that it was not a substantial procedural violation within the meaning of R. 67 EPC 1973 if a request to be called back by or have an interview with the primary examiner was ignored. It was for the examiner's discretion whether to conduct such informal discussions in accordance with the Guidelines, bearing in mind the particular circumstances of the case (see also **T 300/89**, OJ 1991, 480).

11.6.7 Oral proceedings

a) Failure to summon for oral proceedings

The refusal of a request for oral proceedings usually amounts to a breach of the right to be heard, and as such, a violation justifying the reimbursement of the appeal fee (see inter alia **T 209/88**, **T 283/88**, **T 598/88**, **T 668/89**, **T 663/90**, **T 766/90**, **T 795/91**, **T 35/92**, **T 686/92**, **T 556/95**, **T 647/99**, **T 1972/13**).

In **T 405/96** the board held that receipt of the request for oral proceedings by the EPO was proven by the appellants. The fact that the department of first instance could not be held responsible for the loss within the EPO was irrelevant (see also **T 671/95**).

Failure to summon the parties to oral proceedings was considered to be a substantial procedural violation in **T 209/88** and **T 93/88** (see also **J 16/02**). In **T 560/88** the board of appeal held that there was a substantial procedural violation where a clear auxiliary request by the appellant for oral proceedings had not been granted (see also **T 543/92**, **T 460/16**).

In **T 19/87** (OJ 1988, 268), however, the board held that the finding – albeit wrong – that there had been no request for oral proceedings was not a procedural violation within the meaning of R. 67 EPC 1973. Furthermore, failure to seek clarification from the appellant did not constitute a breach of any procedure.

In **T 731/93** the board held that the refusal of a request for "further" oral proceedings constituted a substantial procedural violation where fresh evidence had been admitted. Whilst Art. 116(1), second sentence, EPC 1973 does give the EPO the discretionary power to reject a request for further oral proceedings before the same department, it does so only "where the parties and the subject of the proceedings are the same".

b) Submissions of parties as response to summons

In **T 1183/02** (OJ 2003, 404) the board held that a response to a summons to oral proceedings before the examining division which contained good faith responsive amendments and arguments did not stay the summons. Hence omitting to confirm that the summons remained valid did not constitute a substantial procedural violation within the meaning of R. 67 EPC 1973.

In **T 343/08** the board stated that there was no general duty for an examining division to provide feedback on an applicant's reply to a summons to oral proceedings, in advance of such oral proceedings.

c) No reasons for refusal of request for postponement

In **T 1505/06** the board held that the failure of the opposition division to include in its decision its reasons for refusing the request for postponement was a substantial procedural violation.

In ex parte case **T 1750/14**, the appellant's representatives requested a postponement of the final date for making submissions (under R. 116(1) EPC) repeatedly and separately from their request to postpone the date for oral proceedings. The request for postponement of the final date was never withdrawn and the appellant's desire to file amended claims was made clear even during oral proceedings before the examining division. Because of the lack of substantiation within the meaning of R. 111(2) EPC as to the refusal of the request for postponement of the final date for making submissions, the board held that the examining division had committed a substantial procedural violation. Nevertheless, the board considered that a party could not gain a procedural advantage from an omission of its own. Its procedural behaviour spoke against regarding the reimbursement of the appeal fee as equitable within the meaning of R. 103(1)(a) EPC.

d) No reasons for refusal of request to change location for oral proceedings

In **T 689/05** and **T 933/10** the boards held that the examining division's rejection of the applicant's request that the oral proceedings be held in Munich instead of The Hague had to be reasoned, R. 111(2) EPC, R. 68(2) EPC 1973. In **T 933/10** it was held that this violation justified the reimbursement of the appeal fee. However, in **T 689/05** the board held that the established procedural violation did not affect the entire proceedings before the examining division. It would have been disproportionate to set aside the entire impugned decision because of the partial lack of reasoning of the decision under appeal. In **T 1142/12** the board rejected the appellant's argument that under Art. 116 EPC the parties have not only a right to oral proceedings but also the right to have their case heard at the proper place (here, Munich instead of The Hague). Therefore, no substantial procedural violation occurred.

e) Repeated postponements of oral proceedings

In **T 679/14** the board held that it was contrary to the principles of procedural efficiency and legal certainty to repeatedly adjourn oral proceedings. Referring to the Guidelines E-II, 7.1 – June 2012 version, the board concluded that the postponement of oral proceedings on five occasions at the instigation of the examining division without serious reasons, as far as apparent from the file, constituted a procedural deficiency in the circumstances of the case in hand. The board nevertheless refrained from deciding on whether it amounted to a substantial procedural violation. The appeal fee was however reimbursed due to violation of R. 111(2) EPC (insufficient reasons).

f) Minutes

In **T 642/97** the board held that if a party was of the opinion that the minutes were incomplete or wrong since essential submissions were not reflected in the file it could request the opposition division to correct the minutes to preserve its rights. In the absence of such a request, the allegation of a substantial procedural violation could not be justified (see also **T 231/99**, **T 99/08**). In **T 1277/15** the opposition division had not commented on the appellant's request for correction of minutes either in the contested decision on the merits or in any other, separate decision. The board, however, found that this procedural error had not had any impact on the outcome of the opposition proceedings.

In **T 835/10** (referring to **T 437/98**) the appellant alleged that new arguments had been given in the decision of the examining division. The board did not agree and stated that the minutes gave a summary of what was discussed and did not have to expand the different steps of the reasoning given in writing later.

In **T 685/14** the board took the view that the failure to transmit the minutes to the appellant was a procedural deficiency but, per se, not a fundamental one. A party should be in a position to file an appeal based on its own notes. Moreover, even after having received the minutes, the appellant had neither challenged their consistency with the decision, nor extended its case by any additional considerations. The board dismissed the appeal and refused the request for reimbursement of the appeal fee.

In **T 853/10** the board held that, when judging whether a substantial procedural violation had occurred during the oral proceedings, the board could rely only on the minutes of the oral proceedings, which were not disputed by the patent proprietor (see also **T 642/97**), and on the facts agreed upon by all parties.

11.6.8 Right to be heard

The right to be heard (see chapter III.B.) is an important procedural right intended to ensure that no party is caught unawares by reasons given in a decision turning down his request on which he has not had the opportunity to comment (**R 2/14** of 22 April 2016). A decision which fails to take into account the arguments submitted by a party and which is based on a ground on which the party had had no opportunity to present its comments, contravenes Art. 113(1) EPC and constitutes a substantial procedural violation, see among many other cases **J 7/82**, OJ 1982, 391; **T 197/88**, OJ 1989, 412; **T 880/91**; **T 892/92**, OJ 1994, 664; **T 951/92**, OJ 1996, 53; **T 1101/92**; **T 220/93**; **T 479/94**; **T 778/98**; **T 594/00**; **T 1039/00**; **T 2294/12** (comparative tests), **T 203/15** and **T 2492/18**.

Other violations of Art. 113(1) EPC may also constitute a substantial procedural violation, see the various cases listed in chapter III.B.2. For a case in which the board found a violation of the right to be heard but held that a reimbursement was not equitable, see **T 433/08** (see in this chapter V.A.11.7.1).

The infringement of Art. 113(2) EPC has, in principle, also to be considered to be a substantial procedural violation justifying the reimbursement of the appeal fee (see **T 647/93**, OJ 1995, 132; see also **T 32/82** and **J 19/84**), for example when the final requests were not clarified (**T 666/90**, **T 552/97**, **T 1439/05**, **T 382/10**) or when the opposition division overlooked amended claims presented in a submission **T 543/92** and **T 89/94**). See chapter III.B.3. "Text submitted or agreed by applicant (patent proprietor) – Article 113(2) EPC".

11.6.9 Inadequate reasons given in the decision at first instance

The obligation to provide adequate reasoning in a decision in accordance with R. 111(2) EPC (R. 68(2) EPC 1973) is closely linked to the principle of the right to be heard under Art. 113 EPC (**T 1340/10**). A failure to do so is to be considered a substantial

procedural violation justifying the reimbursement of the fee for appeal (see among many other cases **T 493/88**, OJ 1991, 380; **T 522/90**; **T 392/91**; **T 142/95**; **T 278/00**; **T 571/03**; **T 897/03**; **T 1366/05**; **T 1612/07**; **T 87/08**; **T 353/11**; **T 2366/11**; **T 129/14** and **T 679/14**).

In **T 75/91** the board stated that the impugned decision enabled the reader to follow a line of argument for refusing the application. Whether these reasons were convincing and had to be accepted by the board had nothing to do with a procedural violation. See also **T 698/10**, where the board added that the examining division was under no obligation to explicitly address every argument presented by the applicant as long as the reasoning given enabled the appellant and the board to examine whether the decision was justified or not. See also chapter III.B.2.5. "Consideration of the parties' arguments, submissions and evidence".

In **T 2340/13** there was a discrepancy between what was stated in the "Summary of facts and submissions" of the written decision of the opposition division, where it was stated that, inter alia, Art. 123(3) EPC was discussed in detail, and the minutes, which although very detailed, did not mention any discussion concerned with Art. 123(3) EPC. Neither was there any discussion of this matter in the "Grounds for the decision", except that the title above point 3 read "Added subject-matter (Art. 100(c), 123(2), 123(3) EPC)". The board found that if the matter had been discussed, the opposition division should properly have given an indication thereof in the minutes and indicated in the decision whether and why Art. 123(3) EPC was regarded as being complied with. The board held that the omission of any reasons in respect of Art. 123(3) EPC was not only a violation of R. 111(2) EPC but also of Art. 113(1) EPC.

In **T 2282/17** the board held that where a decision only refers to one or more previous communications, leaving it to the board and the appellant to speculate as to which of the reasons given by the examining division might be essential to the decision to refuse the application, it does not meet the requirements of R. 111(2) EPC. Since the examining division's decision clearly contravened R. 111(2) and Art. 113(1) EPC, and since the appellant had to appeal in order to obtain a fully reasoned decision, the board found it was equitable to reimburse the appeal fee pursuant to R. 103(1)(a) EPC.

For cases concerning the obligation under R. 111(2) EPC, R. 68(2) EPC 1973, see chapter III.K.3.4. "Reasons for the decision", and in particular chapter III.K.3.4.4.

11.6.10 Error of judgment by a department of first instance

A number of decisions have discussed whether an error of judgment by a department of first instance could be regarded as a substantial procedural violation justifying reimbursement of the appeal fee.

a) Communications

In **T 19/87** (OJ 1988, 268, see also above in this chapter at V.A.11.6.7 a)) the board found the examining division had made an error of judgement and not a procedural violation when it erroneously held the appellant had made no request for oral proceedings. The

board found there was no basis for ordering reimbursement of the appeal fee in accordance with R. 67 EPC 1973.

In **T 621/91** the board held that misinterpretation of a letter to an EPO department constituted an error of judgment and not a substantial procedural violation.

In **J 9/05** and **J 18/05** the board had to decide on the examining division's decisions that R. 69(1) EPC 1973 communications were deemed to have been duly delivered to the addressees on the tenth day following its posting. The board held in each case that whilst the examining division had evaluated the evidence as to the postal delivery incorrectly, this amounted to an error of judgment and could not be characterised as a procedural non-compliance, a prerequisite for the application of R. 67 EPC 1973.

b) Wrong assessment of prior art or technical content

According to the established jurisprudence of the boards of appeal, a misinterpretation of a document normally constitutes an error of judgment rather than an error of law and is therefore no "procedural" violation, let alone a substantial one (**T 1031/12**). In **T 162/82**, OJ 1987, 533, the board held that an error in interpreting a document could not possibly be regarded as a procedural violation (see also **T 1049/92**, **T 976/11**).

In **T 367/91** the board stated that to base a decision only on a wrong assessment of prior art and/or the claimed invention had to be regarded as a substantive error, not a procedural violation (see also **T 144/94**, **T 12/03**, **T 1340/10**, **T 997/15**). In **T 68/08** the board held a wrong assessment of the claimed invention (or of the prior art) would always be a substantive issue.

In **T 17/97** the appellant's request for reimbursement of the appeal fee was based on the fact that the opposition division had disregarded a document. In the board's judgment an erroneous assessment of the relevance of a document did not, by its very nature, constitute a procedural violation within the meaning of R. 67 EPC 1973.

The misinterpretation of a document does not constitute a procedural violation (**T 1049/92**; **T 162/82**, OJ 1987, 533; **T 1031/12**). In **T 588/92** the board pointed out that a different opinion on the specialist knowledge to be applied when interpreting the technical content did not amount to a procedural violation.

In **T 860/93** (OJ 1995, 47) the board found that even though there had been a gross error of judgement on the part of the examining division there was no procedural non-compliance of the kind which was a condition precedent to R. 67 EPC 1973 taking effect.

In **T 863/93** the board held that it was the established jurisprudence of the boards of appeal that in order to fall within R. 67 EPC 1973 a procedural violation as opposed to an error of judgment must have occurred. It concluded that the issue raised by the appellant, i.e. the examining division's misunderstanding of D1, was a matter of judgment which did not justify the reimbursement of the appeal fee.

In **T 970/10** the board held that an incorrect assessment of a document with regard to its date of availability to the public related to a factual error in respect of the substantive requirements under Art. 54(2) EPC, and not to an error in respect of procedural law.

In **T 976/11** the board disagreed that the change of the closest prior art alone could constitute a substantial procedural violation. It held that an examining division had the procedural discretion to revise its objection of inventive step, including the choice of the closest prior art, at any stage of the examination proceedings, including the oral proceedings.

In **T 658/12** the board held that an insufficiently reasoned decision had to be distinguished from a decision that had faulty or unpersuasive reasoning. The board concluded that while the COMVIK-approach may have been incorrectly applied in the case in hand, this was a substantive issue, only involving judgement. Thus, the board found that the decision was reasoned in the sense of R. 111(2) EPC. The board also found that the examining division had not acted unreasonably, as claimed by the appellant (applicant), by not admitting the second auxiliary request. The board held, therefore, that there was no basis for reimbursement of the appeal fee (see also **T 690/06**).

In **T 680/89** the board found that it did not amount to a procedural violation if the examining division wrongly finds that a claim is not sufficiently clear to comply with the requirements of Art. 84 EPC 1973, even where there has been a possible error of judgment and failure to seek clarification from the appellant. It concluded there was no basis for ordering reimbursement of the appeal fee in accordance with R. 67 EPC 1973.

c) Error in the application of the law

In **T 687/05** the board held that the fact that the decision under appeal was based on an incorrect interpretation of Art. 100(c) EPC 1973 did not constitute a "procedural" violation, but was simply an error in the application of the law (see also **J 8/13** and **T 378/14**).

d) Board reaches a different conclusion than the department of first instance

The fact that a board comes to a different conclusion from the department of first instance does not by itself mean that the latter has committed a substantial procedural violation within the meaning of R. 103(1)(a) EPC (R. 67 EPC 1973), which would necessitate reimbursement of the appeal fee (**T 87/88**, OJ 1993, 430; see also **T 538/89**; **T 182/92**; **J 14/12**; **T 203/15**; **T 997/15**).

In **T 182/92** the board stated that the fact that the first instance reached a conclusion regarding the document of priority which could not be confirmed by the board was a matter of interpretation of a document, i.e. a matter of judgement, which could not amount to a procedural violation.

e) Exercising of discretion

In **T 208/00** the board considered that the department of first instance had to be granted a certain degree of latitude in exercising its power of discretion, which, in the case in hand, it had not overstepped in a clearly inappropriate manner. It stated that it was not equitable to reimburse the appeal fee, especially as under the established case law of the boards of appeal (see **T 860/93**) not even "a gross error of judgment" by the department of first instance was regarded as justifying such reimbursement.

In **T 248/00** the board decided that, where a late submission was not admitted, an irregularity had taken place if the department had exercised its discretion incorrectly, that is to say on the basis of irrelevant or arbitrary considerations (see also **T 1651/10**). The board held that, even if the non-admission might ultimately prove to be incorrect, such application of the law did not amount to a substantial procedural violation. The issue was, rather, whether the opposition division's discretion had been incorrectly exercised in not admitting a late-filed request.

In **T 2249/08** the board held that it was apparent that the opposition division had exercised its discretion to disregard "facts and evidence" presented belatedly, i.e. after a final date in preparation for oral proceedings. It stated that such discretionary decisions were not normally subject to review, unless the decision was based on the wrong principles or was otherwise manifestly unreasonable. Thus any finding of a substantial procedural violation through a discretionary decision also presupposed such grave errors, as opposed to mere errors of judgement.

f) Wrong procedure adopted

Normally there is no procedural violation justifying reimbursement of the appeal fee if the wrong procedure is adopted in a situation where the EPC does not lay down clearly what procedure is to be followed and the case law has not yet established any settled practice (**T 234/86**, OJ 1989, 79).

g) Following earlier decisions

In **T 208/88** (OJ 1992, 22) the board held that taking a different line from an isolated appeal decision – as opposed to established board of appeal case law – could not be regarded as a substantial procedural violation.

In **T 494/07** the board held that if two apparently similar case constellations were decided differently, this could at most be regarded as an error of judgment. In the case at issue, the board held that not following an earlier board decision did not constitute a substantial procedural violation.

In **T 875/98** the board noted that the EPC did not contain any rule of procedure which imposed on an opposition division an obligation to abide by a decision in a different case. It held that a single decision did not establish a "case law" which had to be adhered to in

another opposition case, even if the subject-matter of the two respective cases was closely related.

11.6.11 Cases concerning the decision-making process and the decision

a) Issuing of decision

(i) Issuing of decision before expiry of timelimit to comment

In **T 804/94** the board ruled that there had been a substantial procedural violation as the opposition division had issued a decision rejecting the opposition before **expiry of the four-month period** it had set for responding to its communication (see also **T 663/99**; see also chapter III.B.2.6.2).

(ii) Excessive length of proceedings

In **T 900/02** the board found that the extreme length of the delay – three years and seven months – between oral proceedings and the issue of a written decision amounted to a substantial procedural violation.

In **T 358/10** the board found that sending the minutes 19 months after the oral proceedings had taken place and notifying the decision 22 months after its pronouncement at the end of those proceedings were inherently unacceptable procedural violations which, by themselves, sufficed to justify refunding the appeal fee (see also **T 243/87**, **T 563/11**). In **T 2340/13** the length of time between the oral proceedings and issuing of the minutes and written decision of the opposition division was 13 months and 14.5 months respectively. The board noted, with reference to **T 358/10**, that even if this delay by itself were not considered to be a substantial procedural violation, it plausibly contributed to the other procedural violations (see in this chapter V.A.11.6.9).

In **T 823/11** the board considered the duration of the proceedings before the department of first instance of more than twelve years after entry into the European phase as excessive. According to the board, in **T 315/03** even a shorter delay of ten years in a much more complex opposition case had amounted to a substantial procedural violation. The board also referred to the judgment of the ECtHR in Kristiansen and Tyvik AS v. Norway (application No. 25498/08), in which the examination and (administrative) appeal proceedings of a patent application had taken a total of eighteen years. Taking into account the duration of patent protection of twenty years, the ECtHR had found "the length of the administrative proceedings before the patent authorities" to be excessive because it "in effect rendered meaningless any exercise by them [the applicants] of their right of access to a court". See also **T 1243/17**.

In **T 1824/15** the board noted that the reasons for decision **T 823/11** did not explain why the delays in the examination procedure could not be justified by the particular circumstances of the case. Moreover, **T 823/11** did not explain how its reasoning was in line with that of the cited ECtHR decision, in particular why circumstances leading to a finding of a violation under Art. 6(1) ECHR would necessarily lead to a finding of a

substantial procedural violation under R. 103(1)(a) EPC. In the case in hand the examining division had been entitled to raise the new objection so late in the first-instance proceedings. Members of an examining division were free to change their minds at any point in the procedure, including during oral proceedings, as long as the requirements of Art. 113(1) EPC were fulfilled. The board held that the over eleven year delay in raising of the objection based on D3 had led to neither a fundamental deficiency under Art. 11 RPBA 2007 nor a substantial procedural violation. With regard to the time taken by the examining division to issue the written decision and the minutes, the board found that the delay of seven months was not a procedural violation of any sort, let alone a substantial one, and also not a fundamental deficiency under Art. 11 RPBA 2007. The request for reimbursement of the appeal fee was therefore rejected.

In **T 1131/12** the board stated that, although a delay of five years between a last communication and the written decision would be wholly unacceptable, there was no causal link between this excessive delay and the outcome of the examining division's decision. Moreover, the appellant had only filed and substantiated the request for reimbursement shortly before the oral proceedings. For these reasons, the board refused the reimbursement request under Art. 12(1)(a) and (2) RPBA 2007.

In **T 2707/16** the contested refusal decision was taken more than fourteen years after the filing date. The board found that the excessive delays, in particular the lapse of more than seven years before the second substantive communication was sent out, constituted a procedural violation. The board argued that the violation was also substantial because the severe delays had the consequence that the first-instance decision was taken much later than it would have been without the procedural deficiencies. Thus, they had an impact on an essential element of the decision, namely its date ("justice delayed is justice denied"). However, the board was of the opinion that a reimbursement of the appeal fee in the circumstances should be regarded as equitable only where the applicant has made clear by some action that he did not tacitly agree with the stagnation of the proceedings. The board found the appellant failed to provide any such signal for a very long period of time and therefore refused the request for reimbursement.

In **T 2377/17** the board found the delay of 14 years before the examining division issued its first substantive communication to be a substantial procedural violation. The board noted that the appellant had remained inactive for over 12 years before it requested accelerated examination, but the examining division then still did not succeed in issuing a communication within the period of six months to which it had committed; instead, it required close to two more years. After the appellant filed a timely reply, it again took more than 18 months - and a second request for accelerated examination, again leading the examining division to commit itself to a date it ultimately did not keep - before the examining division issued the summons to oral proceedings. Contrasting the applicant's attempts to move the case forward with those of the applicant in **T 2707/16**, in which the same board found the reimbursement of the appeal fee not to be equitable because the applicant there had taken insufficient action to try to move the proceedings forward, and noting the periods of unjustified delay that occurred despite the appellant's attempts to move the case forward, the board considered reimbursement of the appeal fee to be equitable in the case in hand.

In **T 2699/17** the board agreed with the appellant (applicant) that a total processing time of more than 12 years (from filing of the application to the decision to refuse the application) was by far above the average, but found that although undesirably long, the duration of the case did not amount to a substantial procedural violation. Unlike in **T 2707/16**, in which there was a long period of stagnation, in the case in hand the examining division regularly returned to the case and addressed various issues of substance, which the appellant promptly addressed. During prosecution of the case, the decision in **G 1/07** (OJ 2011, 134) was also issued, which was highly pertinent to the application. The board was also unable to see why the appellant waited until the appeal stage to voice its concerns instead of making use of the PACE programme, which gives applicants a convenient tool to speed up the pace at which the proceedings are progressing.

(iii) Lack of competence

A decision taken by a department that is not competent amounts to a substantial procedural violation justifying the reimbursement of the appeal fee (see **T 2411/10** where the Receiving Section, and not the examining division, was competent to decide). A substantial procedural violation is deemed to have occurred if the decision has been taken by a formalities officer who was not competent to decide (**J 10/82**, OJ 1983, 94; **T 114/82**, OJ 1983, 323; **T 790/93**; **T 749/02**).

(iv) Decision not approved by all members

In **T 225/96** the board ruled that to issue the parties with a draft decision not approved by all opposition division members present at the oral proceedings was a substantial procedural violation.

b) Content of decision

(i) Written decision deviates from oral decision

In **T 425/97** the board decided that any substantive deviation of the decision notified in writing from that given orally at the oral proceedings amounted to a procedural violation. **T 1365/09** held that a contradiction between the decision rendered at the oral proceedings and the written decision as sent to the parties contravened R. 111(1) EPC and amounted to a substantial procedural violation.

In **T 1455/14** the board found that there was no basis in the EPC for the opposition division's use of its discretion to correct an obvious error after the proceedings had been closed, for which there was no corresponding request according to R. 139 EPC on the part of the patent proprietor. This resulted in a threefold procedural violation. The written decision was based on a text amended by the opposition division which was (1) not submitted by the patent proprietor, (2) on which the opponent had had no opportunity to comment and (3) which did not correspond to the decision announced at the end of the oral proceedings.

(ii) Decision deviates from previous communication

In **T 2006/08** the board found that although the opposition division had expressed an opinion on the issue of sufficiency of disclosure in favour of the patentee in two communications, this opinion was clearly labelled as being preliminary and non-binding. The board also held that a preliminary, provisional opinion did not prevent a party from making its complete case. It was the responsibility of a party to ensure that the facts and evidence filed were not only unequivocally clear but also as complete as possible. If a party decided to retain or not to file further evidence to support its case, it would run the risk that an adverse decision might be issued based on the available (incomplete) evidence on file. The board rejected the request for reimbursement of the appeal fee.

In **T 980/06**, the contested decision had regarded a claim as patentable, whereas in the sole previous communication the examining division had taken a negative view. In such circumstances, a second communication would have been useful. However, its absence was not a "substantial" procedural violation.

(iii) Failure to deal with objection

In **T 740/94** the board held that the failure of the opposition division to deal with an objection under Art. 100(b) EPC 1973 against an amended claim in its decision to maintain the patent in amended form clearly constituted a substantial procedural violation (see **G 10/91**, OJ 1993, 420, point 19 of the Reasons).

(iv) Third-party observations not mentioned in decision

In **T 283/02** the opposition division had duly forwarded the observations by third parties to the patentee, who had made no comment. The failure of the opposition division to mention these observations in its decision did not constitute a substantial procedural violation, even though a mention would have been desirable.

(v) Board decision containing similar facts not followed

In **T 494/07** the board held that the strict legal obligation to follow the ratio decidendi of a decision of a board (Art. 111(2) EPC 1973) was limited to the same application and the same instance whose decision has been contested in the appeal, but did not extend to other applications (or even to other instances in the same application). This was so even if the subject-matter of the two applications was highly similar (see **J 27/94**, OJ 1995, 831).

(vi) Remarks on substantive matters in decision on admissibility

Remarks on substantive matters in a decision rejecting the opposition as inadmissible have no legal effect. Even if misleading, they do not represent a substantial procedural violation justifying the reimbursement of the appeal fee (**T 925/91**, OJ 1995, 469; see also **T 1051/92**).

(vii) Applying legal provision not yet in force

In **T 991/02** an opposition division decision was set aside for lack of a legal basis. The opposition division's application of a new rule, not yet in force in this case, constituted a substantial procedural violation.

c) Requests

(i) Obligation to reason refusal of request

According to **T 961/00**, it is a party's procedural right to file and maintain such requests as are regarded by the competent organ as unallowable or even inadmissible. If a party does so, then the competent organ has to give a decision on it (see **T 1105/96**, OJ 1998, 249), but cannot simply disregard it and deal with the case as if the request did not exist. This would constitute a substantial procedural violation (see also **T 234/86**, **T 484/88**, **T 155/88**).

In **T 1157/01** the decision under appeal had omitted to give reasons for the refusal of the higher-ranking requests still pending before the examining division; this amounted to a substantial procedural violation (see also **T 488/94**; for opposition procedure see **T 234/86**, OJ 1989, 79).

In **T 1435/13** the board held that because claim 1 of the main request did not fulfil the requirements of the EPC, the main request could not be allowed. This conclusion was unaffected by the fact that independent claim 9 complied with the requirements of the EPC or that it might have been desirable that the decision under appeal included reasoning with respect to all independent claims (and thus also claim 9). As the examining division had decided on all requests before it, the board did not consider that a substantial procedural violation had occurred.

(ii) Auxiliary requests and order of requests

In **J 23/96** the board held that an auxiliary request was filed in case the main request was refused; the auxiliary request then took its place and had to be dealt with in the same decision. The examining division's failure to deal with the auxiliary request for re-establishment in the decision under R. 69(2) EPC 1973 (R. 112(2) EPC) amounted to a substantial procedural violation.

In **T 320/99** (referring to **T 1105/96**) the examining division considered the auxiliary request allowable, but nonetheless issued a decision refusing the main request and thus the application. The correct course of action would have been to issue a communication under R. 51(4) EPC 1973 based on the auxiliary request. The issue of the decision was a substantial procedural violation which justified the reimbursement of the appeal fee.

In **T 883/07** the board held that the examining division's failure to examine the auxiliary requests independently of the main request amounted to a substantial procedural violation within the meaning of R. 67 EPC 1973. Claim requests do not coexist in parallel, but form

a stack which has to be considered – each one independently of all the others – in the sequence indicated by the applicant or patent proprietor (see Guidelines C-VI, 4.1 and E-X, 3 – June 2005 version).

In **T 1758/15** the opposition division had concluded that four attempts to overcome a single issue were enough. The decision to not admit a further request was taken without having identified any signs of procedural abuse and without knowing the content of the further request. The board concluded that the opposition division had not exercised its discretion under R. 116(2) and Art. 114(2) EPC in a reasonable way, which constituted a substantial procedural violation. However, because the appeal was not deemed allowable, the appeal fee was not reimbursed. In any case, during second oral proceedings the appellant withdrew its request for reimbursement.

(iii) Requests not taken into account because of delay within EPO

In **T 231/85** (OJ 1989, 74) the board held that failure to take the applicant's requests into account as a result of a delay within the EPO (in this case six weeks) constituted a substantial procedural violation (see also **T 598/88**). In **T 205/89**, owing to a mistake by a formalities officer, a request for an extension of the time for submitting comments in opposition proceedings never reached the opposition division, which therefore took its decision without considering the argument presented in the subsequently filed submission. The board considered that the failure by the formalities section amounted to a substantial procedural violation on its part and regarded the reimbursement of the appeal fee to thus be equitable.

(iv) Requests not filed by correct party

In **T 1178/04** a procedural violation within the meaning of R. 67 EPC 1973 had occurred, in that the requests relating to the patentability of the claimed invention were made in the oral proceedings before the opposition division by a party to whom the opposition had been purportedly but invalidly transferred. These requests were inadmissible.

d) Amendments

In **T 246/08** the board stated that a refusal to allow amendments made in advance of any amendment being submitted could not be a reasonable exercise of discretion pursuant to R. 137(3) EPC and was ipso facto a substantial procedural violation (see also **T 872/90**).

In **T 121/06** the board held that issuing a communication under R. 51(4) EPC 1973 in which amendments were proposed which the applicant could not reasonably be expected to accept without further discussion constituted a substantial procedural violation.

In **T 901/10** the appellant implied that the way in which the examining division had applied R. 137(3) and (4) EPC amounted to a substantial procedural violation. After the application had entered the European phase, no examination report was issued for six years. Nevertheless, the board held that such delays, undesirable as they may be, do not oblige

the examining division to be more lenient under R. 137 (3) EPC. The appeal fee was not reimbursed.

In **T 1354/13** the board held that an applicant who presents extensively revised claims at a late stage of the proceedings has to be prepared for the possibility that the admissibility of these claims will be considered under Art. 123 and R. 137 EPC. The request for reimbursement of the appeal fee was refused.

e) Signature on decision and minutes

In **T 390/86** the board held that the written reasons for a decision delivered during oral proceedings could only be signed by members of the deciding body who had taken part in the oral proceedings (see also **T 563/11**). In **T 2076/11** the appeal fee was reimbursed as the written decision and the minutes of the oral proceedings were signed by the director of the organisational unit. See also chapter III.B.2.9. "Changes in the composition of the competent department of first instance ".

In **T 211/05**, the board took the view that for a person to take part in a decision when not entitled to do so (here the director signing the decision instead of the second examiner), resulting in failure to comply with the principle that the power to examine a patent application must not only be exercised personally but also be seen – by both the applicant and the public – to be exercised personally, constituted a substantial procedural violation, in particular because it deprived the applicant of his right to be heard by the full examining division (see also **T 1033/16**).

f) Composition of opposition division

(i) Under Article 19(2) EPC

The board of appeal ordered reimbursement of the appeal fee in **T 382/92** because the composition of the opposition division had not complied with the requirements of Art. 19(2) EPC 1973. The Chair and one member of the opposition division had already been members of the examining division which had decided on the application leading to the patent concerned (see also **T 939/91**, **T 960/94**, **T 825/08**, **T 1349/10**, **T 1700/10**, **T 79/12**, **T 1788/14**). See also chapter III.K.1.3.3.

(ii) During opposition proceedings

In **T 2175/16** the person who signed the decision of the opposition division as first examiner had not been the first examiner at the oral proceedings. Thus, a change in the composition of the opposition division had taken place between holding the oral proceedings, at the end of which a decision was given orally, and issuing the written

decision. The board considered the change of composition to be a substantial procedural violation, which justified that the appeal fee be reimbursed (see also chapter III.K.1.3.3.2).

11.6.12 Partiality

In **T 900/02** the board stated that a suspicion of partiality must inevitably arise if a member of an opposition division, or any other first instance body, first solicits and then accepts employment with a firm in which a partner or other employee is conducting a case pending before that member, even if it occurred after oral proceedings had been held. This amounted to a substantial procedural violation.

In **T 585/06** the appellant (opponent) considered that the presence of a former member of the boards of appeal, as a consultant of the patent proprietor, at the oral proceedings before the opposition division had led to partiality of the opposition division. The former member did not address the opposition division, not even under the control of the representative of the respondent. This amounted to an important difference to the facts underlying case **G 2/94**. The authorised representative was absolutely free whether to accept the hints whispered by the former member, who did not make any intervention of his own motion. The appellant's representative accepted at the beginning of the oral proceedings that the former member would sit beside the representative of the respondent and assist him. Even during the oral proceedings no objection was made to his presence. Moreover, no substantiated reasons of partiality of the opposition division were submitted by the appellant. The request for the reimbursement of the appeal fee was refused.

In **T 1647/15** the minutes indicated that the representative of opponent III was interrupted by the Chair during the oral proceedings before the opposition division with: "Shut your mouth" and "Don't talk any more". The board held that the ability of the Chair to hear opponent III with an objective judicial mind could be perceived as having been affected and held that the objection of suspected partiality was justified. The board found it equitable to reimburse the appeal fee paid by each of the opponents I to III.

11.6.13 Suspensive effect of appeal

In **J 5/81** (OJ 1982, 155) it was held that there was a substantial procedural violation where the Receiving Section had ignored the suspensive effect of an appeal in contravention of Art. 106(1) EPC 1973.

11.6.14 Non-compliance with order of the board

In **T 227/95** a decision was taken by a board to remit the case to the department of first instance (opposition division) for further prosecution and not, as assumed by the division, with instructions to maintain the patent. The fact that the opposition division had not carried out the board's order amounted to a substantial procedural violation with regard to Art. 111 EPC 1973. The case was remitted again to the department of first instance, and the appeal fee was reimbursed.

11.6.15 Referral pending before Enlarged Board

Where a decision of the examining division depended entirely on the outcome of proceedings before the Enlarged Board on a legal question or point of law raised under Art. 112 EPC 1973 – and this was known to the examining division – the further examination of the application had to be suspended until the matter had been decided by the Enlarged Board. Failure to do so amounted to a substantial procedural violation under R. 67 EPC 1973 (**T 166/84**, OJ 1984, 489). See also chapter V.B.2.5.3 "Stay of first-instance proceedings following a referral".

11.6.16 Refusal of application on one ground only

In **T 859/97** the board took the view that it was sufficient for the examining division, when deciding to refuse a European patent application under Art. 97(1) EPC 1973, to state one ground only which in their opinion would prejudice the grant of a European patent. In the case in hand, the examining division was unable to grant a patent because it had concluded that the subject-matter of claim 7 was not new. Consequently, it was under no obligation to comment on the patentability of claims 1 to 6. The requirements of R. 67 EPC 1973 were thus not met.

11.6.17 Cases concerning documentation and communications passing between the EPO and the parties

a) Ambiguous communication or wrong form

In **J 3/87** (OJ 1989, 3) it was stated that if an EPO communication was not as clear and unambiguous as it ought to be, and led a reasonable recipient into error, that amounted to a substantial procedural violation, even if the ambiguity of the communication was partly due to an unfortunate provision of the law.

In **J 17/92** the appellants complained that the examining division had used the wrong form for its communication, namely a form threatening that the application would be refused if a response was not filed. The board considered that the failure of the examining division to withdraw the wrong form and the threatened sanction of a possible refusal of the application amounted to a substantial procedural violation.

b) No reply to communication under Article 101 EPC

In **T 362/02** the opposition division had revoked the patent for the sole reason that the appellant had not replied to a communication under Art. 101(2) EPC 1973 inviting him to file observations. The board found that this decision was a substantial procedural violation because the EPC did not provide any sanction for a party's failure to reply to a communication under Art. 101(2) EPC 1973. Further, revocation of a patent for mere failure to reply to a communication was contrary to the clear intention of the law, which required a proprietor to agree to the form in which a patent was granted or amended and to use clear and unambiguous words if he wished to abandon a patent.

c) Wrong type of communication

In **J 10/07** (OJ 2008, 567), the board found that, although the Receiving Section was not to be blamed for issuing a communication under R. 43(2) EPC 1973, as the drawings could not have been in the file on that date, it should not have issued the notification under R. 43(3) EPC 1973 but a communication pursuant to R. 43(1) EPC 1973. This amounted to a substantial procedural violation. If the Receiving Section had followed the legally correct procedure, an appeal would not have been necessary.

d) Period set for opponent to reply to patentee's response

In **T 138/08** the appellant (opponent) complained that two months and 21 days was not sufficient time to reply to the patentee's observations filed in response to the opposition. The board observed that the communication of the observations of the patentee had been made merely for information and the opposition division and had not raised any matter of substance in the communication. For that simple act a period of two months was considered sufficient. Therefore, the reimbursement of the appeal fee under R. 103(1)(a) EPC was not justified.

e) Observations not forwarded to other party

In **T 789/95** the file contained no indication that a copy of the opponent's observations had been forwarded to the patent proprietor. It was therefore to be assumed that the communication of the observations to the patent proprietor had been omitted, in contravention of the Guidelines. In the board's view, this constituted a substantial procedural violation, as it infringed the principle that all parties to proceedings must be accorded the same procedural rights.

f) Appointment of professional representative

In **J 20/96** the EPO had waited one year and three months before requesting the appointment of a professional representative and nearly another year before asking for the appellant's new address. Although conceding that the Receiving Section had been slow to request the appointment of a professional representative, the Legal Board ruled that this was not a substantial procedural violation because such appointments were a matter for the appellant; similarly, it was also up to him or his representative to provide his address.

g) Warning in relation to a grace period

As to the EPO's obligation to issue a warning in relation to the grace period of R. 85a EPC 1973 (this provision was deleted in the EPC 2000), and the question of whether or not this warning constituted a "courtesy service", see **J 17/04** and **J 32/97**.

11.7. Reimbursement must be equitable

11.7.1 Causal link between substantial procedural violation and filing of appeal

In order to render the reimbursement of the appeal fee equitable, as a rule a causal link must exist between the alleged procedural violation and the decision of the department of first instance that necessitated the filing of an appeal (**T 388/09**; see also **J 9/10**, **T 1101/92**, **T 1198/97**, **T 2373/11**). For procedural deficiencies of a general nature (such as excessive length of proceedings) which affect the whole procedure leading to the contested decision, reimbursement can be equitable even in the absence of a causal link (**T 2707/16**). In **T 3071/19** the board held that if as a result of a deficiency the case is remitted to the examining division without any substantial progress having been made on it, reimbursement of the appeal fee may well be equitable even if the deficiency cannot be directly linked to the filing of the appeal.

In **T 677/08** the board held there was no causal link between the procedural violation and the necessity to file an appeal. The application was refused for lack of inventive step, and so the appellant would have had to file the appeal even if the examining division had sufficiently reasoned its refusal of the request for a videoconference.

In **T 2111/13** the board held that, according to established case law, for the reimbursement of the appeal fee to be equitable a causal link between the substantial procedural violation and the filing of the appeal was required. According to an alternative approach, a procedural violation is not to be deemed substantial if the outcome of the proceedings would not have been different had the violation not occurred (see in this chapter V.A.11.6.2). In the case at hand, the board saw no need to choose between these two approaches and rejected the appellant's request for reimbursement.

In the cases that follow the boards held that reimbursement was not equitable because no causal link could be established:

In **T 2106/10** the board reiterated that any reimbursement of the appeal fee had to be equitable and depended on the question of whether the procedural deficiencies were 1) substantial and 2) forced the appellant to file the present appeal. In the case in hand the board did not address the question as to whether a substantial procedural violation had taken place, since the board was of the opinion that the appellant had to file the appeal irrespective of whether or not substantial procedural violations had taken place.

In **T 41/97** a refund was not equitable because the procedural error (refusal of interlocutory revision prior to receipt of the statement of grounds of appeal and before the expiry of the period for filing it) was not the reason the appeal had been filed (see also **T 1891/07**, **T 1994/11**, **T 2227/09**).

In **T 711/11** the appellant alleged that the examining division found a lack of unity without providing adequate reasoning. The board stated that lack of unity was not the sole ground given in the contested decision for refusing the application. The appellant would in any

case have had to file an appeal in view of the ground of lack of inventive step. Therefore, the board considered the reimbursement of the appeal fee not equitable.

In **T 893/90** the contested decision to refuse the application on the grounds of lack of novelty was based primarily on document 1, on which, in contrast to document 2, the appellant had had adequate opportunity to put forward comments. The board stated that the decision under appeal had been fully reasoned, and that the procedural violation as regards the reliance on document 2 was thus not sufficiently closely linked to the need to pay an appeal fee for it to be equitable to reimburse the fee.

In **T 601/92** the opposition division had not commented, either in a communication or in its decision, on auxiliary request (5) submitted by the patent proprietor in good time before the decision was issued. Because auxiliary request (2), which had been submitted in the appeal proceedings and which preceded auxiliary request (5), was allowed, the board did not see any reason, despite the procedural violation, to reimburse the appeal fee, as this would not have been equitable.

In **T 2377/09** the board took the view that reimbursement of the appeal fee solely on the grounds of the established procedural violation would not be in accordance with the equitability requirement of R. 67 EPC 1973 (R. 103 EPC). This was because the rejection decision was based on additional, alternative grounds which had given the appellant no cause to claim a substantial procedural violation and against which it would in any case have had to appeal to get the decision set aside (with reference to **T 893/90**, **T 219/93**, **T 4/98** (OJ 2002, 139) and **T 978/04**).

In **T 840/07** the appellant's request which had succeeded in the appeal was the same as the main request which it had filed before the examining division but had later replaced. The appellant had not pursued that request to the point where it became the subject of a decision. The board concluded that the appellant had had no choice but to appeal if it wanted the result it had eventually obtained before the board. To reimburse the appeal fee would have given the appellant a fee-free appeal which would be inequitable (see also **T 784/11**, referring to **T 4/98**).

In **T 1891/07** the board held that despite the presence of a substantial procedural violation it would not be equitable to reimburse the appeal fee because the violation could not have been causative in filing the appeal since it occurred after the notice of appeal had been filed.

In **T 1990/08** the appellant submitted that the examining division had committed a procedural violation as it had not provided a translation of D1 but had used it to deny inventive step. The board held that even if the inventive step objection including the appraisal of document D1 in the decision were disregarded, the contested decision would still be negative as it had also relied on Art. 84 and 123(2) EPC to refuse the application. Regardless of whether a substantial procedural violation had occurred or not, the appellant would have had to appeal in order to obtain a reversal of the first-instance decision. The alleged procedural violation could not have been the immediate and only cause of the need to appeal and to pay an appeal fee.

In **T 433/08** the board and the parties agreed that a violation of Art. 113(1) EPC had occurred because the opposition division had relied in its decision on a document which had not been referred to in the course of the opposition proceedings. The board held, however, that the opposition division would not have reached a decision more favourable to the opponent if it had not taken into account said document. Thus, the opposition division had not acted to the detriment of the opponent. The board concluded that the rights of the opponent (appellant) were not curtailed to an extent that would make the reimbursement of its appeal fee equitable by reason of a substantial procedural violation.

In **T 1680/11** the board held that an alleged procedural violation with respect to a decision to rectify under Art. 109 EPC could not justify refunding the appeal fee. A decision to grant interlocutory revision could not be the reason for filing the appeal, as it was – by its very definition – taken after the appeal had been filed.

In **T 1414/18** the board found there was a causal link between the substantial procedural violation – the examining division's statement in its communication that "[t]he next procedural step will be summons to oral proceedings during which the application will be refused (Art. 97(2) EPC)" – and the necessity of filing an appeal against the examining division's decision, and found the reimbursement of the appeal fee to be equitable (on its own motion).

11.7.2 Conduct of appellant

The conduct of the appellant may render the reimbursement of the appeal fee not equitable even if a substantial procedural violation occurred (**J 4/09**; see also **T 1500/10**).

a) Reimbursement held not to be equitable

In **J 22/85** (OJ 1987, 455) the board did not consider a reimbursement of the appeal fee to be justified because the appellant had failed to provide the Receiving Section with the evidence subsequently submitted in the appeal proceedings.

In **T 167/96** the impugned decision did not meet the minimum requirements for a reasoned decision. Although there was no doubt that this lack of reasoning amounted to a substantial procedural violation, the board did not consider that a refund of the appeal fee was equitable. The appellant had availed himself of the appeal procedure to file necessary amendments which the opposition division had sought in vain over a period of years to elicit from him (see also **T 908/91**).

In **J 18/96** (OJ 1998, 403) the Receiving Section had failed to observe the provisions concerning examination on filing. Although the appeal was allowed on the ground, inter alia, of a procedural violation, the reimbursement of the appeal fee was not equitable because the appellants themselves had contributed to the failure of the proceedings before the Receiving Section.

In **J 4/09** the board said that, as a rule, an applicant could be regarded as behaving inequitably if it made no use of opportunities to participate in the initial proceedings. In this

case, it had not reacted to the Receiving Section's communication; only in its statement of grounds for appeal had it drawn attention to an obvious inconsistency.

In **T 1216/02** the board held that, albeit for reasons outside the knowledge and control of the examining division, the refusal decision had been based on evidence on which the applicant had not had an opportunity – viewed objectively – to present his comments. This constituted an objective substantial procedural violation under R. 67 EPC 1973. However, the board did not deem reimbursement of the appeal fee equitable, because the appellant should have facilitated further substantive examination in the event of remittal or interlocutory revision by including in his statement of grounds of appeal a substantive response to the examining division's communication, based on the document which, at the time when the appeal was filed, he had known to be correct.

In **T 427/03** the decision (to revoke the patent) under appeal was set aside by reason of a substantial procedural violation – no reference to any article or rule of the EPC as the legal basis for the revocation, no reasoning is provided to justify the revocation. However, the board did not find it equitable to reimburse the appeal fee as the **appellant had contributed to the situation** by filing a new set of claims 16 months after the announcement of the opposition division at the end of the oral proceedings that the patent could be maintained in amended form on the basis of the last set of claims put forward at the end of the oral proceedings instead of providing an adapted description as requested.

In **T 1500/10** the board held that if oral proceedings took place at the instance of the EPO because it considered this to be expedient under Art. 116(1) EPC and the duly summoned party does not attend them without serious reasons, this conduct might have the consequence that it would not be equitable to reimburse the appeal fee.

In **T 674/12** the board held that the appellant, by filing different unclear requests, did not help to expedite the proceedings and contributed to the fact that the decision of the examining division was based on a request which was no longer in the proceedings. The board considered the reimbursement of the appeal fee not to be equitable.

In **T 1750/14**, the appellant's representatives requested a postponement of the final date (under R. 116(1) EPC) repeatedly and separately from their request to postpone the date for oral proceedings. The specific reasons for not allowing any postponement of the final date – regardless of the refusal of the request for postponement of the date for oral proceedings – were not addressed in the decision of the examining division. The board held that the examining division had committed a substantial procedural violation. Nevertheless the board held that the applicant – and in particular its professional representative – must or should have known, in view of the last sentence of R. 116(1) EPC that it is generally not guaranteed that any written submission is automatically admitted into the proceedings before the EPO for the sole reason that it is filed prior to the final date, nor is it entirely unlikely that a submission may be admitted at the department's discretion when filed after that date. The applicant could have followed the invitation from the examining division and attempted to file, for example, amended sets of claims with the aim of overcoming the objections raised in the summons. This, however, was not done by the applicant of its own volition. In the board's view, such procedural behaviour spoke

against regarding the reimbursement of the appeal fee as equitable within the meaning of R. 103(1)(a) EPC. A party cannot gain a procedural advantage from an omission of its own.

b) Reimbursement held to be equitable

In **T 281/03** of 17 May 2006 the board held that reimbursement of the appeal fee was equitable despite the fact that the appellant had continuously delayed his case on inventive step until the last moment. The board noted that delaying detailed substantiation of the ground of inventive step raised in the notice of opposition until the last moment of opposition proceedings should be avoided if possible, since it created an unexpected situation for the other parties and the opposition division. However, the board noted that the case in hand was special, not just in that the inventive step argument was based on the same document as the novelty argument, but that the novelty of the features depended on how D1 was interpreted as a whole. The board held that it was not efficient to expect an opponent to provide a multitude of speculative arguments covering each possibility, nor did it seem sensible to the board to place a formal requirement to provide at least one argument, which may turn out to be completely wrong.

11.8. Reimbursement in full under Rule 103(1)(b) EPC

Under the EPC 1973, when appeal proceedings were terminated by the withdrawal of the appeal, R. 67 EPC 1973 was in general not applicable (see **J 12/86**, OJ 1988, 83; **T 41/82**, OJ 1982, 256; **T 773/91**; **J 30/94**; **T 372/99**; **T 543/99**; **T 1216/04**; **T 552/07**; for exceptions to this rule in case of a violation of the principle of the protection of legitimate expectations see **J 30/94** and **T 308/05**).

Under the EPC 2000, however, the appeal fee is reimbursed if the appeal is withdrawn before the filing of the statement of grounds of appeal and before the period for filing that statement has expired (R. 103(1)(b) EPC). For cases where this provision was first applied, see **T 1495/08**, **T 2052/08**, **T 1822/09**.

For a case in which the patent application was withdrawn after the expiration of the period for filing the statement of grounds and the appeal fee was thus not reimbursed, see **T 683/08**. The board in **T 1613/08** held that R. 103(1)(b) EPC did not confer any discretion on the boards to excuse missing the end of the period even by as short a time as one day.

In **T 193/20** the board held that the withdrawal of the appeal must be expressed by an explicit and absolutely clear statement. The appellant's statement that it had "decided not to file the Grounds of Appeal", even in view of the request for reimbursement of the appeal fee in accordance with R. 103(1)(b) EPC, merely conveyed the appellant's intention not to file the statement of grounds of appeal, it did not imply an unambiguous withdrawal of the appeal. The filing (or non-filing) of the statement of grounds of appeal and the withdrawal of an appeal are separate, distinct procedural steps. See also **T 2704/16**.

11.9. Revised Rule 103 EPC on partial reimbursement of the appeal fee

An amended version of R. 103 EPC entered into force on 1 April 2020. It introduced two new levels of partial reimbursement of the appeal fee: 75%, on which see below in chapter V.A.11.10. on R. 103(2) EPC; and 25%, on which see below in chapter V.A.11.12. on R. 103(4) EPC. These are in addition to reimbursement in full or of half the appeal fee under R. 103(1) EPC (see above in chapter V.A.11.8.) and R. 103(3) EPC (see below in chapter V.A.11.11.) respectively.

11.10. Partial reimbursement (75%) under Rule 103(2) EPC

The appeal fee is reimbursed at 75% under R. 103(2) EPC if, in response to a communication from the board indicating its intention to start substantive examination of the appeal, the appeal is withdrawn within two months of notification of that communication.

In **T 853/16**, the appellant had withdrawn their appeal before any communication from the board indicating its intention to start substantive examination of the appeal. The board held that it followed from the clear wording of R. 103(2) EPC, and a literal interpretation thereof, that there was no refund of 75% of the appeal fee to an appellant where, as in the case in hand, no communication had been issued from the board indicating its intention to start substantive examination of the appeal. The board also explained why **J 9/10** and **J 25/10**, referred to by the appellant, were not applicable in the case in hand, even by analogy. See also **T 43/22** and **T 2447/22**.

11.11. Partial reimbursement (50%)

11.11.1 Partial reimbursement under former Rule 103(2) EPC

Rule 103(2) EPC as amended on 13 December 2013 (CA/D 16/13; OJ 2014, A3) was amended by the decision of the Administrative Council of 12 December 2019 (CA/D 14/19; OJ 2020, A5) as of 1 April 2020. The decisions set out below concern R. 103(2) EPC as in force prior to 1 April 2020. It differs from current R. 103(3) EPC only in that the time limit under R. 103(3)(a) EPC is now "within one month of notification of a communication issued by the Board of Appeal in preparation for [the] oral proceedings" rather than "at least four weeks before [the date of oral proceedings]".

According to R. 103(2) EPC (as prior to 1 April 2020), the appeal fee was reimbursed at 50% if the appeal was withdrawn: after expiry of the period under R. 103(1)(b) EPC; and at least four weeks before the date for oral proceedings (where one had been set) or before expiry of the period set by the board for filing observations in any communication inviting the appellant to file observations. This version of the provision applied to appeals pending on 1 April 2014 and to appeals filed thereafter, until 1 April 2020, from which date the current R. 103 EPC applied to appeals pending at that date and to appeals filed after that date.

In **T 1086/09** the board held that a letter received on 28 March 2014 stating that the appeal should be withdrawn "hereby" would mean that the appeal was withdrawn on 28 March 2014, and thus no longer pending on 1 April 2014. In **T 370/11** the board held that the 50% was to be calculated on the basis of the appeal fee actually paid, and not on the basis of the rate of the appeal fee applicable on the date of withdrawal or reimbursement.

In **T 1402/13** of 31 May 2016, the board stated that under R. 103(1)(b) and (2) EPC (as prior to 1 April 2020) the termination of appeal proceedings caused by a loss of rights due to the non-payment of renewal fees could not be equated to a declaration of withdrawal of the appeal. This result was also supported by the travaux préparatoires (CA/90/13 Rev. 1), which explicitly required the appellant to make a procedural declaration. In order to claim entitlement to reimbursement under R. 103(2) EPC (as prior to 1 April 2020), the appellant was required, at a time when its application was still pending, to make a procedural declaration that left no doubt that withdrawal of the appeal was intended. As this was not the case, the request for reimbursement of the appeal fee was rejected.

In **T 265/14** the appeal had been withdrawn after expiry of the period set by the board in a first communication inviting the party to file observations under R. 100(2) EPC but before expiry of the period set in a second communication. The board held that R. 103(2)(b) EPC (as prior to 1 April 2020) was not to be interpreted as definitively ruling out reimbursement of 50% of the appeal fee where no observations were filed within the period set under R. 100(2) EPC. If a board then set a new period for filing observations, it thereby gave the appellant a fresh opportunity to withdraw the appeal, with the effect of reducing the fee, within that period. So the board concluded that issuing a second invitation under R. 100(2) EPC was to be treated as equivalent to setting a date for oral proceedings after expiry of the period set in the first invitation, which likewise reopened the possibility of the reimbursement of the appeal fee under R. 103(2)(a) EPC (as prior to 1 April 2020). That reimbursement was possible in those circumstances supported the view that R. 103(2) EPC (as prior to 1 April 2020) as a whole was to be interpreted broadly in the light of its object and purpose and that both its scenarios could be treated in the same way. The rationale of **T 265/14** was also followed in **T 110/18** and **T 2044/16**.

In **T 683/14** the examining division committed a substantive and not a procedural error. After the applicant filed an appeal against the decision to refuse the European patent, the examining division rectified their decision to refuse. The request for reimbursement of the appeal fee at 50% under R. 103(2) EPC (as prior to 1 April 2020) was refused on the grounds that by rectifying the decision the examining division had set the decision under appeal aside and had allowed the appeal. The board stated that as such the applicant's request for the withdrawal of its appeal had no object and that in the absence of a pending appeal that might be withdrawn, R. 103(2) EPC (as prior to 1 April 2020) did not apply.

In **T 1548/15** the board ordered that the appeal fee be reimbursed at 50% pursuant to R. 103(2)(a) EPC (as prior to 1 April 2020). The agreement by the appellant (patent proprietor) to terminate the appeal proceedings against the decision of the opposition division to revoke the European patent (in accordance with R. 84(1) EPC), after the patent

had in the meantime lapsed in all designated contracting states, was equivalent to a withdrawal of the appeal.

11.11.2 Partial reimbursement (50%) under Rule 103(3) EPC

The appeal fee is reimbursed at 50% if the appeal is withdrawn after expiry of the period for filing the statement of grounds of appeal, provided withdrawal occurs: (a) if a date for oral proceedings has been set, within one month of notification of a communication issued by the board in preparation for these oral proceedings; (b) if no date for oral proceedings has been set, and the board has issued a communication inviting the appellant to file observations, before expiry of the period set by the board for filing observations; (c) in all other cases, before the decision is issued.

11.12. Partial reimbursement (25%) under Rule 103(4) EPC

Under R. 103(4)(a) EPC, where a date for oral proceedings has been set, 25% of the appeal fee is reimbursed if the appeal is withdrawn later than one month after notification of a communication issued by the board in preparation for these oral proceedings but before the decision is announced at oral proceedings.

Under R. 103(4)(b) EPC, where no date for oral proceedings has been set, and the board has issued a communication inviting the appellant to file observations, 25% of the appeal fee is reimbursed if the appeal is withdrawn after expiry of the period set by the board for filing observations but before the decision is issued.

In **T 1369/18** the patent proprietor had filed an appeal against the interlocutory decision of the opposition division, which had decided that, on the basis of the second auxiliary request, the patent in suit met the requirements of the EPC. After the board issued its preliminary opinion, the patent proprietor withdrew its main request (as filed with the statement of grounds of appeal) for maintenance of the patent as originally granted and requested as a new main request the maintenance of the patent in the amended form as allowed by the opposition division. The board considered that in doing so, the patent proprietor had, in effect, withdrawn its appeal before a decision was issued within the meaning of R. 103(4)(b) EPC.

Under R. 103(4)(c) EPC, 25% of the appeal fee is reimbursed if any request for oral proceedings is withdrawn within one month of notification of the communication issued by the board in preparation for the oral proceedings, and no oral proceedings take place.

In **T 517/17** the appellant's indication that it would not attend the scheduled oral proceedings was taken as an implicit withdrawal of its request for oral proceedings for the purposes of R. 103(4)(c) EPC (see also **T 202/18**, **T 901/18**, **T 666/19**, **T 1554/21**, **T 1563/21** and **T 104/23**; see **T 1888/18** for reimbursement following a request for a decision according to the state of the file). Another interpretation is that R. 103(4)(c) EPC applies only if the party explicitly withdraws its request for oral proceedings (**T 73/17**, **T 191/17**, **T 2698/17** and **T 2356/18**). See also chapter III.C.5.3.1 "Withdrawal only by

virtue of a clearly expressed intention not to proceed with the request" and III.C.5.3.2 "Oral proceedings not held despite the lack of an explicit withdrawal ".

In **T 1282/16**, in response to the communication issued by the board under Art. 15(1) RPBA in preparation for oral proceedings, the appellant had filed a new main request and stated that it was withdrawing its request for oral proceedings if that new main request could in principle be granted. The board considered the main request allowable and so the appellant's condition was met. This meant that the withdrawal of its request for oral proceedings had taken effect on the date of filing the main request, which was within one month of notification of the communication under Art. 15(1) RPBA 2000.

In **T 777/15** the board held that the appellant not having requested oral proceedings could not benefit from another party's withdrawal of the request for oral proceedings. This was so because, for the appellant not having requested oral proceedings, the condition in R. 103(4)(c) EPC that "any request for oral proceedings is withdrawn within one month of notification of the communication issued by the Board of Appeal in preparation for the oral proceedings" was not fulfilled merely because another party had requested oral proceedings and withdrawn their request within the time specified in R. 103(4)(c) EPC (see also **T 795/19**). By contrast, in **T 488/18** the board held that the appellant could obtain reimbursement despite never having requested oral proceedings, based on the respondent's withdrawal of its request for oral proceedings in the time prescribed by R. 103(4)(c) EPC. See also **T 901/18**, **T 598/19**, **T 749/19**, **T 1026/20**.

In **T 1610/15** the board held that the appellant's request for oral proceedings had been withdrawn in time. A respondent's belated withdrawal of its request had no adverse effect in this regard. The wording of R. 103(4)(c) EPC did not require that all requests for oral proceedings filed in a case had to be withdrawn within a month of notification of the communication issued by the board in preparation for those proceedings. For the first condition for partial reimbursement under R. 103(4)(c) EPC to be met, it was instead enough that one request for oral proceedings had been withdrawn in time.

In **T 2249/18** the decision to hold oral proceedings had been made by the board rather than them being requested by the appellant. For the purposes of R. 103(4)(c) EPC, the board likened the situation in the case in hand to that where an appellant makes a request for oral proceedings. This was because conducting oral proceedings had become unnecessary due to an action by the appellant, in that it filed a request overcoming the objections raised by the board. Applying R. 103(4)(c) EPC by analogy, the board decided that 25% of the appeal fee was to be reimbursed.

In **T 1678/17** the request for oral proceedings was not in fact withdrawn within one month of notification of the communication issued by the board of appeal in preparation for the oral proceedings. However, in view of the notice from the EPO dated 1 May 2020 concerning the disruptions due to the COVID-19 outbreak (OJ 2020, A60) and R. 134(2) and (4) EPC, the board held that the conditions for reimbursement of 25% of the appeal fee, stipulated in R. 103(4)(c) EPC, were fulfilled.

In **T 2361/18**, the appellant withdrew its request for oral proceedings after the board had issued the summons to oral proceedings but before notification of a communication issued in preparation for the oral proceedings. The board held that in these circumstances 25% of the appeal fee was to be reimbursed under R. 103(4)(c) EPC. In **T 749/19** the board indicated that it shared the opinion expressed in **T 2361/18** that "within one month" in R. 103(4)(c) EPC, rather than defining a time period starting with the notification of the communication, defines an "end point" for the withdrawal of the request for oral proceedings, if partial reimbursement of the appeal fee is to be obtained.

11.13. Communication in preparation for the oral proceedings

In **T 2044/16** the board found that, even though it had already issued a detailed substantive communication under Art. 15(1) RPBA in preparation for oral proceedings, the wording of R. 103(4)(c) EPC did not preclude it from granting a reimbursement on the basis of an additional communication, issued by it at a later date (here, the board had asked the appellant to inform it whether it intended to attend the oral proceedings), that led to withdrawal of the request for oral proceedings within one month. The board concluded that the deadline under R. 103(4)(c) EPC was triggered anew by each preparatory communication issued. The deliberations in **T 265/14** regarding reimbursement under R. 103(3)(b) EPC also applied to the situation in this case. See also **T 1730/16**.

In **T 110/18** the appellant had withdrawn its request for oral proceedings within one month of notification of the second communication pursuant to Art. 15(1) RPBA, which was exceptionally issued in view of the COVID-19 outbreak. The board followed the rationale of **T 265/14** (of the same board in a different composition) and concluded that the requirements for a 25% reimbursement of the appeal fee according to R. 103(4)(c) EPC had been met.

11.14. Reimbursement of the appeal fee outside of the scope of Rule 103 EPC because of a violation of the principle of the protection of legitimate expectations

In **T 308/05** the board ruled that the appeal fee was to be reimbursed even though the appeal had been withdrawn. Referring to **J 30/94** and **J 38/97** (see below) the board held that the fact that in the case in hand the EPO had been found to have breached the principle of the protection of legitimate expectations, and that the consequence had been the filing of an appeal which was objectively superfluous, made it necessary for reasons of equity to refund the appeal fee paid by the appellant. See also **T 1785/15**.

In **T 613/14** the board stated that in contrast to a request for correction of the minutes or the decision to grant, there was no established case law on the issue of whether or not the rejection of a request for correction of a decision under R. 140 EPC was open to appeal. It found therefore that it was likely, that when filing the appeal, the appellant had relied on the opposition division's statement that the decision was open to appeal. The board considered the opposition division's statement to have created a legitimate expectation that an appeal would be found admissible and examined as to its substance, at least in respect of the request for correction of the decision. However, in its preliminary opinion, the board took the position that the appeal against the opposition division's refusal of the

request to correct its decision was not admissible. The board held that it had thus deprived the appellant of its legitimate expectations. After the board had maintained its preliminary opinion during the oral proceedings, the appellant withdrew its appeal. Under these circumstances, the board considered it justified to order the reimbursement of the appeal fee in accordance with **J 30/94**, **J 38/97**, **T 308/05** and **T 1785/15**.

In **J 30/94** the board held that Art. 109(2) EPC created a legitimate expectation of the parties that an appeal would be remitted to the board of appeal within a reasonable time after the decision of the department of first instance not to allow the appeal. The board held EPO had clearly offended against this legitimate expectation because the appeal was only referred to the Boards of Appeal seven years after its filing. The board found it equitable under these exceptional circumstances to order the reimbursement of the appeal fee even though the appeal had been withdrawn.

In **J 38/97** the appeal was found inadmissible but the appeal fee was nevertheless refunded. The board took the view that the appellant, having requested an appealable decision, could legitimately expect the impugned decision to be issued by the competent department and not by a person lacking legal authority. In accordance with the principle of good faith, it was equitable in these circumstances to order the reimbursement of the appeal fee.

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1. Introduction

The Enlarged Board is responsible for proceedings under Art. 112 EPC (referral of points of law by boards of appeal or the President of the EPO), proceedings under Art. 112a EPC (petitions for review against decisions of the boards of appeal) and proceedings under Art. 23(1), first sentence, EPC (removal from office of a member of the boards of appeal).

The provisions governing the procedure before the Enlarged Board are set out in the EPC, the Implementing Regulations and the RPEBA. The latter are binding upon the Enlarged Board, provided that they do not lead to a situation which would be incompatible with the spirit and purpose of the Convention (Art. 19 RPEBA).

The members of the Enlarged Board are mainly appointed from among the members of the boards of appeal, who continue to exercise their functions in the Legal Board or their respective technical boards ("internal members"). This double function is in itself not a reason for exclusion or objection under Art. 24 EPC (see **R 12/09** of 3 December 2009, **R 19/12** of 25 April 2014 and **R 2/14** of 17 February 2015 for petition for review proceedings). Legally qualified members of national courts or quasi-judicial authorities may also be appointed as members of the Enlarged Board ("external members"), and may continue their judicial activities at national level (Art. 11(5) EPC).

2. Referral under Article 112 EPC

2.1. General

Article 112 EPC defines the conditions in which legal uniformity within the European patent system may be established by means of a referral to the Enlarged Board. It requires the boards (Art. 112(1)(a) EPC) or the President (Art. 112(1)(b) EPC) to deem the referral necessary, either in order to ensure uniform application of the law or if points of law of fundamental importance arise. For a referral by the President, a further admissibility criterion is that two boards of appeal must have given different decisions on the question referred (**G 3/08**, OJ 2011, 10).

This chapter concerns Art. 112 EPC. The Enlarged Board's answers to referred questions of law are covered in the chapters corresponding to these questions.

2.2. Composition

In proceedings under Art. 112 EPC, the Enlarged Board consists of five legally and two technically qualified members; the Chair must be a legally qualified member (Art. 22(2) EPC). If a board of appeal refers a question to the Enlarged Board, at least four members of the Enlarged Board must not have taken part in the proceedings before the referring board (Art. 2(4) RPEBA).

2.3. Referral by a board of appeal

2.3.1 General

Under Art. 112(1)(a) EPC a board of appeal *shall* refer a question to the Enlarged Board if it considers that a decision is required, in order to ensure uniform application of the law or because a "point of law of fundamental importance" arises. With the EPC 2000, the English wording was changed from "important" to "fundamental importance" in order to bring it into line with the French and German versions (see **G 1/12**, OJ 2014, A114).

Only questions on a specific point, not entire cases, may be referred to the Enlarged Board (e.g. **T 184/91** of 25 October 1991, **T 198/12**). The Enlarged Board must examine the admissibility requirements with respect to each referred question individually (**G 1/19,** OJ 2021, A77). In consolidated cases **G 1/22** and **G 2/22** (OJ 2024, A50) the Enlarged Board took the position that since question II should be admitted, question I should also be admitted for the sole reason that the questions were interlinked insofar as an affirmative answer to question I was a precondition for approaching question II.

The Enlarged Board is not a third instance within the EPO, but part of the second instance constituted by the Boards of Appeal (**T 79/89**, OJ 1992, 283). However, the Enlarged Board's answers to the referred points of law are **binding on the referring board** in respect of the appeal in question (Art. 112(3) EPC; see also **J 8/07** of 1 July 2010). In **T 438/22** the appellant submitted that a decision of the Enlarged Board was necessary as the Guidelines would have to take into account a decision by the Enlarged Board. The

board pointed out that the Enlarged Board had no formal powers in this respect. Art. 112(3) EPC made it clear that the formal binding power of the decision of the Enlarged Board was limited to the case before the referring board. The EPC clearly stated that it was within the functions and powers of the President of the EPO to adopt the Guidelines, which the board held had to include the powers to decide how the Guidelines were to be kept up to date with the case law. Such a referral could well be perceived as an attempt to encroach on the President's powers under Art. 10(2)(a) EPC.

Furthermore, according to the board's view in **T 116/18** the referring board is bound by the referring decision's finding when the case comes back from the Enlarged Board. As a consequence of this binding effect, the scope of the proceedings in **T 116/18**, after **G 2/21** (OJ 2023, A85) had been issued, was limited to applying the legal principle, as stated by the Enlarged Board, to the issues left unresolved in the referring decision. See also in this chapter V.B.2.3.3 and chapter V.A.10.2.

The Enlarged Board is not bound by the way the referring board formulated the question, and may reformulate the referred question (see, for example, **G 2/08**, OJ 2010, 456; **G 2/10**, OJ 2012, 376; **G 1/13**, OJ 2015, A42; **G 3/19**, OJ 2020, A119; and **G 1/21**, OJ 2022, A49). However, the specific formulation chosen by a referring board is the starting point to define what a referring board considers a point of law requiring a decision by the Enlarged Board under Art. 112(1)(a) EPC (**G 2/21**). The Enlarged Board may deviate from the wording if this is required to better reflect the true object and focus of the referral. It can also refrain from rephrasing or reordering the referred questions if it does not see a need or justification for it (**G 2/21**). The Enlarged Board does not consider referred questions narrowly, but in a way as to clarify the points of law which lie behind them (**G 3/14**, referring to **G 2/88** and **G 6/88**, OJ 1990, 93 and 114).

The Enlarged Board in petition for review proceedings under Art. 112a EPC is not a "Board of Appeal" within the meaning of Art. 112(1)(a) EPC that could initiate referral proceedings under that provision (**R 7/08**, **R 1/11**, **R 7/12**). The DBA has no power to refer questions to the Enlarged Board either (**D 5/82**, **D 7/82**, **D 9/91**, **D 30/05**).

If a board is not empowered to decide a question, it is not empowered to refer that question to the Enlarged Board (**T 1142/12**).

Questions can be referred by a board either of its own motion or following a request from a party. If a board rejects a party's request for referral, it must give reasons in its final decision (Art. 112(1)(a) EPC). This was considered necessary to provide the parties with a certain guarantee, on the one hand, and to enable a certain degree of standardisation of the jurisprudence on the other (travaux préparatoires, BR/177/72, p. 31). Providing parties with a right of reference was, however, rejected (BR/168/72, p. 51).

If a party to proceedings before the boards of appeal is convinced that certain questions merit the attention of the Enlarged Board, this argument should be made before or during the discussion on this question, but certainly not afterwards (**T 196/22**). The board in **T 196/22** found thus that it was within its discretion to refuse a request by a party for time to formulate questions to the Enlarged Board, the only purpose for which could be to

reopen a debate that had already been closed and upon which the board had relied to reach its conclusions (see also chapter III.C.8.9. "Closing and reopening the debate").

The parties to the appeal proceedings are parties to the proceedings before the Enlarged Board (Art. 112(2) EPC). The Enlarged Board may invite the President of the EPO to comment on questions of general interest; the parties are entitled to submit their observations on the President's comments (Art. 9 RPEBA). Third parties may send written statements (*amicus curiae briefs*) to the Enlarged Board (Art. 10 RPEBA).

2.3.2 Discretion of the board

Several decisions state that referring a question under Art. 112(1)(a) EPC lies within the discretion of the boards (see e.g. **T 1242/04**, OJ 2007, 421; **T 365/05**; **T 1016/10**). In **T 390/90** (OJ 1994, 808) the board stated that the boards have discretionary power to refer any question to the Enlarged Board, either if a request for such reference has been made by a party, or if an important point of law arises and, in both cases, if the board considers that a decision by the Enlarged Board is required to ensure uniform application of the law or to decide upon the point of law that had arisen.

In **G 3/98** (OJ 2001, 62) the Enlarged Board stated that while the view of the referring board is decisive for assessing whether a referral is required, such assessment should be made on objective criteria and should be plausible (see also **G 2/99**, OJ 2001, 83). One of the criteria identified in **T 1242/04** was whether the question can be answered beyond all doubt by the board itself, in which case it does not need to be referred to the Enlarged Board (see also **T 758/20** and in this chapter V.B.2.3.3).

In **T 560/13** the board noted that under Art. 21 RPBA 2007, a referral of questions to the Enlarged Board must be made in cases where the board considers it necessary to deviate from an interpretation of the EPC contained in an earlier opinion or decision of the Enlarged Board. It further noted that according to Art. 20(1) RPBA 2007, if a board wishes to deviate from an earlier decision taken by a board of appeal, a referral is not compulsory (see also **T 314/20**), but the board must give the grounds for deviation unless such grounds are in accordance with an earlier opinion or decision of the Enlarged Board (see also **T 1020/03**, OJ 2007, 204; **T 1676/08**). Moreover, in **G 1/98** the Enlarged Board stated that it was clearly desirable that whenever a board of appeal was aware that its decision involved a different interpretation of the law, on a point of substance and importance, from that applied in a decision of a previous board, that attention be drawn to this fact in its decision in a manner appropriate to the circumstances of the case, and that reasons be given for the different interpretation, so that the President of the EPO can take appropriate action (see also Art. 20(1) RPBA).

In **G 1/14** the Enlarged Board held that while it was primarily up to the board of appeal to explain, in its referral decision, that – and why – it believed it needed an Enlarged Board ruling on the point arising in the case before it, the Enlarged Board must in any event examine whether the referral fulfilled the criteria of Art. 112(1)(a) EPC (including that a "decision is required") and was thus admissible.

2.3.3 Relevance of the referred question for the underlying case

The referred question must not have a merely theoretical significance for the original proceedings which would be the case if the referring board were to reach the same decision regardless of the answer to the referred question (**G 3/98**, OJ 2001, 62; **G 2/99**, OJ 2001, 83; see also **R 13/22**; **T 547/08**; **T 447/22**). It must be relevant for deciding the case in question (**G 2/04**, OJ 2005, 549; consolidated cases **G 1/22 and G 2/22**, OJ 2024, A50; **R 13/22**; **T 2136/16**; **T 758/20**; **T 1738/21**; **T 423/22**; **T 439/22**), or the Enlarged Board must be satisfied that "answers to the questions referred are necessary for each Board of Appeal to be able to dispose of their respective appeals on the correct legal basis" (**G 1/05**, OJ 2008, 271; **G 1/06**, OJ 2008, 307; see also **G 2/06**, OJ 2009, 306). In **T 154/04** (OJ 2008, 46; see also **J 16/90**, OJ 1992, 260; **R 13/22**; **T 1044/07**) the board held that the answer to the referred question must be "essential to reach a decision on the appeal in question".

Citing **G 3/98** the board in **T 116/18** held that if the board were to deny any binding effect of the referring decision and reopen the issues on which the board reached its conclusion in that decision, this would be in logical conflict with the requirements formulated for the admissibility of the referral. According to the board, it could lead to a situation in which the board departs from the assessment made in the referring decision and render the Enlarged Board's answer to the referred question ex post irrelevant, or, conversely, it could require a different referral from that originally made. See also in this chapter V.B.2.3.1.

In **T 520/01** (see also **T 787/06**) the board referred to **G 3/98**, did not maintain the patent on grounds other than those to which the question related, and thus refused the party's referral request. In **T 469/92**, the board granted the appellant's main request, and therefore did not consider its auxiliary referral request.

In **G 1/98** (OJ 2000, 111) one of the questions referred by the board concerned objections of which the appellant had not been made aware before, and the appellant expressed its intention to the Enlarged Board to make the required amendments. As a result, the Enlarged Board doubted the relevance of the referred question and deemed it inappropriate to offer guidance. In **G 7/95** (OJ 1996, 626, see also **G 9/92** of 22 June 1993) the Enlarged Board, having regard to the particular facts of the case before the referring board, deemed it not necessary to answer the referred question either.

In **G 1/09** (OJ 2011, 336) a board referred a question on whether a *rejected* patent application was still pending under R. 25 EPC 1973 (R. 36 EPC; divisional applications) when no appeal had been filed but the time limit for filing an appeal had not yet expired. In his comments under Art. 9 RPEBA, the President of the EPO raised two additional questions, namely whether a *granted* application was still pending in such a situation, and whether the filing of an inadmissible appeal could maintain the pendency of the application beyond the expiry of the time limit for filing an appeal. The first additional question was – although not relevant for the decision in the underlying case – answered by the Enlarged Board in an obiter dictum, whereas the second was considered not to be covered by the referral decision.

In **G 2/03** (OJ 2004, 448) the Enlarged Board stated that not all substantive requirements had been examined by the referring Board and that the referred question could, in the end, turn out to be irrelevant. Taking into account the usual order of examination according to which the referred question (on the allowability of disclaimers) was examined before substantive requirements such as inventive step, the Enlarged Board considered the referral nevertheless admissible. In **G 2/99** (OJ 2001, 83), the Enlarged Board had doubts whether the answer to the referred question would have an impact on the decision in the underlying proceedings, but deemed the referral nevertheless admissible, for reasons of procedural efficiency. In **G 2/07** (OJ 2012, 130) the referrals were considered admissible "irrespective of whether an answer is actually required on all aspects which the referred questions might in theory be seen as embracing".

In **G 1/14** the question referred to the Enlarged Board was whether an appeal is inadmissible or deemed not to have been filed if the notice of appeal is filed and the fee for appeal paid after expiry of the time limit (see chapter V.A.11.3. "Appeal deemed not to have been filed"). Until 1 April 2015 the wording of R. 126(1) EPC was limited to "Notification by post ... by registered letter with advice of delivery" (since amended to: "Notification by postal services ... by registered letter with advice of delivery or equivalent"). In the Enlarged Board's view notification of first-instance decisions by the postal service UPS was not covered by R. 126(1) EPC as formerly in force, so the referring board's finding that the appeal had not been lodged in time was inoperative. As this meant there was no need to refer the question, the Enlarged Board dismissed the referral as inadmissible.

2.3.4 Question of law

Only questions of law, not technical issues (e.g. **T 287/11**: the interpretation of technical features of a specific claim; **T 181/82**: whether the person skilled in the art can understand the technical content of a prior art document; see also **T 1798/08**) may be referred to the Enlarged Board. Similarly, in **T 118/89** the board stressed that only questions of law, not questions of fact may be referred (see also **T 364/20**).

2.3.5 Pending proceedings

A board may only refer a point of law to the Enlarged Board "during proceedings on a case" (Art. 112(1)(a) EPC). If the underlying appeal is withdrawn (see **G 3/06**, OJ 2007, 312; **T 1040/04**), or the underlying application deemed to be withdrawn (**G 2/14**, OJ 2015, A13), the proceedings before the Enlarged Board are terminated.

The referral to the Enlarged Board must precede the decision of the board of appeal (**T 2271/08**). After a board has issued a decision in respect of certain issues, it has no power to refer a question to the Enlarged Board in connection with the issues already decided, even though other issues are still pending in proceedings on the same case (**T 79/89**, OJ 1992, 283).

For a referral to be admissible, the appeal has to be admissible (see **T 1954/14**). This principle does, however, not apply if the referral itself concerns the admissibility of the

appeal. Without this exception, the boards would be denied the opportunity to refer questions on important points of law concerning the admissibility of an appeal. This would contradict Art. 112(1)(a) EPC where no restrictions of that kind appear (**G 1/12**, OJ 2014, A114; see also **G 2/90**, OJ 1992, 10; **G 8/92**, not published in the OJ; **G 3/99**, OJ 2002, 347 and **G 2/04**, OJ 2005, 549).

2.3.6 Ensuring uniform application of the law

In order to be admissible, the referred question must either concern a non-uniform application of the law by the boards or, alternatively, a point of law of fundamental importance (see in this chapter V.B.2.3.7). According to Art. 112 EPC, this requirement concerns not only referrals by a board but also referrals by the President, which, however, must in any case concern "different decisions" of the boards (see in this chapter V.B.2.4.3).

In **T 154/04** (OJ 2008, 46) the board found that deviating from an opinion given in another decision of a board of appeal or a deviation from national jurisprudence are not per se valid reasons for referral under Art. 112(1)(a) EPC (see also **T 314/20**). According to the board, the legal system of the EPC allows for the evolution of the case law, which is not case law in the Anglo-Saxon meaning of the term. In **T 15/01** (OJ 2006, 153) the board did not consider a referral to the Enlarged Board necessary, because only one previous decision of the boards deviated from its own conclusion as to the exhaustion of priority rights. In **T 248/88** the board also held that a single and isolated non-uniform decision did not qualify under Art. 112(1)(a) EPC. According to the board in **T 314/20** a referral would only be appropriate if two or more conflicting lines of interpretation existed, which would lead, in the case in hand, to diverging outcomes.

In **T 438/22** the board admitted that the wording of Art. 112(1)(a) EPC may appear to suggest that the removal of a discrepancy between the Guidelines and the case law could also be understood as "ensuring uniform application of the law" and as such be a good reason for an admissible referral. However, the board held that a referral whose sole purpose was to correct the Guidelines and which was not necessary either for ensuring a uniform case law within the boards or for the board's decision was inadmissible. See also in this chapter V.B.2.3.1.

In **T 712/10** the board stated that the Enlarged Board does not have the power to ensure uniform application of the law between the boards of appeal and national courts. However, a lack of uniformity between the law as applied by the boards of appeal and national courts could, in theory, bring to the fore a point of law of fundamental importance.

With regard to **T 712/10** the board in **T 447/22** remarked that, although a lack of uniformity between the law as applied by the boards of appeal and national courts could, in theory, bring to the fore a point of law of fundamental importance, the purpose of referring a question to the Enlarged Board could not be to ensure uniform application of the law between national courts.

In **T 2477/12** the board held that the application of the same legal principles and criteria may lead to different results in different cases. This is a consequence of the specific facts

of each individual case and not, however, an indication of a contradictory interpretation or an inconsistent application of the law. See also **T 314/20** and **T 364/20**.

In **G 1/12** (OJ 2014, A114), the Enlarged Board considered the requirement of non-uniform application of the law to be fulfilled because some decisions allowed deficiencies in the appellant's name to be remedied under R. 101(2) EPC, whereas in other decisions on analogous situations the boards applied R. 139 EPC. A minority of the members of the Enlarged Board were of the opinion that this merely demonstrated that, as long as the removal of the deficiency did not lead to a change of the appellant's true identity, both procedures were available according to consistent case law.

In **G 2/21** (OJ 2023, A85) the Enlarged Board accepted the referring board's perception of divergencies in the case law, if only for the use of different conceptual and terminological approaches underlying the referred questions. According to the Enlarged Board, confronted with these approaches, the referring board considered itself unable to arrive at a clear conclusion for the case at hand.

In consolidated cases **G 1/22** and **G 2/22** the Enlarged Board considered the condition that an answer to referred question I was required to ensure uniform application of the law met. The Enlarged Board reasoned that the EPO's jurisdiction concerning the entitlement to the priority right had been questioned by boards of appeal in several cases and was arising in various other cases before different boards.

2.3.7 Point of law of fundamental importance

The requirement that the referred question must either concern a lack of uniform application of the law by the boards or a point of law of fundamental importance concerns both referrals by a board and referrals by the President (see in this chapter V.B.2.4.1).

G 1/12 (OJ 2014, A114) concerned the correction of errors regarding the identity of the appellant and, in this context, the admissibility of an appeal. The Enlarged Board held that the referred question related to a "point of law of fundamental importance" because it was relevant to a large number of similar cases (see also **G 2/21**, OJ 2023, A85, **T 271/85**, OJ 1988, 341, **T 1242/04**, OJ 2007, 421 and **T 1676/08**: "a substantial number of similar cases") and was therefore of great interest not only to the parties to the specific appeal proceedings in question (see also **T 590/18** of 4 July 2018). Settling this point of law was important not only to the users of the European patent system but also to the boards of appeal and the department of first instance in examination and opposition proceedings. A minority of the members of the Enlarged Board disagreed and considered the referral inadmissible. According to the minority, the majority's view implied that "importance" within the meaning of Art. 112 EPC was nothing more than mere relevance. The number of cases affected, however, was neither a suitable nor an appropriate criterion for establishing the admissibility of a referral. In **G 1/13** (OJ 2015, A42) and **G 2/21** (OJ 2023, A85), the Enlarged Board confirmed the view of the majority in **G 1/12**.

In **G 1/19** the Enlarged Board held that the requirement of fundamental importance was fulfilled despite the small number of board decisions in the field of the application in suit. It

added that in an unknown number of cases, the issues at play in the underlying appeal had been avoided through claim drafting techniques; the referred questions could also be pertinent for these cases.

In consolidated cases **G 1/22** and **G 2/22** the Enlarged Board found that while question II referred to a specific situation, the answer would not necessarily be limited to the viability of the "PCT joint applicants approach" and may cover other situations where the applicant's entitlement to the priority right was challenged. It added that even if the answer covered only the situation described in question II, the question was considered to touch a point of law of fundamental importance in the terms of Art. 112(1) EPC.

Referring to **G 1/84**, **G 3/93**, **G 2/04** and **G 3/04**, the board in **T 1286/23** found that party status, whether before the first-instance divisions or in appeal proceedings, was normally a fundamental question of law.

In **G 4/19** the Enlarged Board noted that a point of law could be of fundamental importance even where there was no divergence in the case law (see also **T 1286/23**).

In **T 26/88** (OJ 1991, 30) the board held that a question was not sufficiently important when the legal framework upon which the question was based (here: R. 58(5) EPC 1973) had changed in the interim and the question was therefore unlikely to arise again very often (see also **T 1286/23**). Similarly, in **T 2459/12**, the board stated that a question regarding a point of law the answer to which would affect only a relatively small number of applicants for a limited period of time, after which it would become obsolete (here: due to an amendment to R. 164 EPC), was not a question relating to a point of law of fundamental importance.

In **T 364/20** the board noted that the question concerning university theses to be made available to the public in view of legal provisions or university regulations in Finland was highly specific so that no point of law of fundamental importance arose. Similarly in **T 423/22** the board considered the circumstances of the witness hearing defined in the question to be very specific (hearing by videoconference, witness is an employee of the opponent and located at the opponent's office during the hearing) and hence not applicable to the majority of witness hearings during first-instance proceedings. According to the board the question was not of fundamental importance.

The lack of case law on a particular issue is in itself not a sufficient reason to refer a question to the Enlarged Board (**T 998/99**).

In **J 5/81** (OJ 1982, 155) the appellant requested the referral of a question which the Legal Board considered an important point of law. The Legal Board refused the appellant's request regardless, as the question could be answered by reference to the EPC without doubt (see also, for example, **J 14/91**, OJ 1993, 479; **T 1196/08**; **T 1676/08**; **T 2477/12**). In **T 39/05**, the board already denied the existence of an important point of law if a question could be answered by reference to the EPC without doubt.

In **J 10/15** the Legal Board was of the opinion that the legal situation in the case in hand was clearly to be derived from the EPC and the PCT, so that there was no question of law of fundamental importance which could justify a referral to the Enlarged Board.

2.4. Referral by the President of the EPO

2.4.1 General

Under Art. 112(1)(b) EPC, in order to ensure uniform application of the law (see in this chapter V.B.2.3.6) or if a point of law of fundamental importance (see in this chapter V.B.2.3.7) arises, the President of the EPO may refer a point of law to the Enlarged Board "where two boards of appeal haven given different decisions on that question".

2.4.2 Discretion of the President

Under Art. 112(1)(b) EPC, the President of the EPO *may* refer a point of law and is entitled to make full use of the discretion granted by Art. 112(1)(b) EPC. The President's appreciation of the need for a referral may change even after a relatively short time, for example because the President's assessment of the case law of the boards of appeal has changed, or a change in the presidency has taken place (**G 3/08**, OJ 2011, 10).

2.4.3 Differing decisions

In **G 3/08** (OJ 2011, 10) the Enlarged Board found that the terms "different/abweichende/divergentes" decisions in Art. 112(1)(b) EPC had to be interpreted in the light of the provision's object and purpose according to Art. 31 of the Vienna Convention. The purpose of the presidential referral right under Art. 112(1)(b) EPC is to establish uniformity of law within the European patent system. Having regard to this purpose, the notion "different decisions" has to be understood restrictively in the sense of "conflicting decisions". Legal development is an additional factor which must be carefully considered. Development of the law is an essential aspect of its application and inherent in all judicial activity. Consequently, legal development as such cannot on its own form the basis for a referral, because case law does not always develop in linear fashion, and earlier approaches may be abandoned or modified. See also **G 3/19**.

Legal rulings are characterised not by their verdicts, but by their grounds. The Enlarged Board may thus take obiter dicta into account in examining whether two decisions satisfy the requirements of Art. 112(1)(b) EPC (see also **G 3/93**, OJ 1995, 18).

In **G 4/98** (OJ 2001, 131) the Enlarged Board held that a discrepancy between office practice of the EPO and the case law of the boards of appeal was not in itself sufficient to justify a referral by the President, if the practice of the EPO was not warranted by the case law.

In **G 3/95** (OJ 1996, 169) the Enlarged Board considered the President's referral inadmissible due to the absence of different, i.e. conflicting decisions. In **G 3/08** (concerning Art. 52(2) EPC, computer programs), the Enlarged Board said that **T 424/03**

indeed deviated from **T 1173/97**, but that this was a legitimate development of the case law and that there was no divergence which would make the referral admissible.

In **T 646/13** the board, with reference to **G 3/08**, rejected the request for a referral to the Enlarged Board, finding that alleged contradictions between decisions **T 464/05** and **T 1811/13** did not exist. Rather, in the board's view, these decisions illustrated a development of the case law on a particular question.

2.4.4 Two boards of appeal

Different decisions by a single technical board in differing compositions may be the basis of an admissible referral by the President (**G 3/08**, OJ 2011, 10). In **G 1/04** (OJ 2006, 334), the Enlarged Board found the President's referral, based on two different decisions of the same technical board of appeal, admissible and stressed that the decisions were rendered by the board in completely different compositions and that other technical boards had adopted the findings of one of the conflicting decisions.

In **G 4/98** (OJ 2001, 131) the Enlarged Board stated that if the President's power of referral were to be defined by a restrictive reading of "two Boards of Appeal", no referrals would be possible with respect to the Legal Board. This would unduly restrict the effect of Art. 112 EPC, since conflicting decisions could also occur within that board. See also **G 3/19**.

2.5. Procedural issues

2.5.1 Question already decided by the Enlarged Board

Should a board consider it necessary to deviate from an earlier opinion or decision of the Enlarged Board, the question must be referred to the Enlarged Board (Art. 21 RPBA).

In **T 297/88** the board examined under which circumstances it was possible to re-refer a question which had already been decided by the Enlarged Board. It took the view that a board may only refer the same point of law another time to the Enlarged Board if the Enlarged Board's arguments were so weak that doubts as to the correctness of the decision were unavoidable. This was also the case where the arguments were based on a false premise so that there were doubts about the conclusion drawn. Finally, a decision of the Enlarged Board could also be questioned where the premise was correct, the arguments were conclusive and the conclusion therefore also correct, but where legal or technical developments occurring in the interim made it desirable in the public interest to have the question reviewed again by the Enlarged Board.

In **T 82/93** (OJ 1996, 274; see also **T 80/05**, **T 1213/05**) the board rejected the requested referral because the question had already been decided by the Enlarged Board. In **T 423/22** the board pointed out that it did not consider a decision of the Enlarged Board to be required since it did not intend to deviate from an earlier decision of the Enlarged Board.

In **T 1063/18** the board decided that R. 28(2) EPC was in conflict with Art. 53(b) EPC as interpreted by the Enlarged Board in **G 2/12** and **G 2/13** and saw no reason to deviate from the Enlarged Board's interpretation of Art. 53(b) EPC. Furthermore, the board stated that no point of law arises in relation to the course of action in case of a conflict between a rule of the Implementing Regulations and an article of the EPC because this situation is governed by Art. 164(2) EPC. For these reasons the board decided a referral under Art. 112(1)(a) EPC was not justified.

In **G 9/93** (OJ 1994, 891), the Enlarged Board confirmed the referring board's view that the concept of opposition proceedings set out in **G 1/84** differed fundamentally from that in **G 9/91** and **G 10/91**, which it endorsed.

2.5.2 Question already pending before the Enlarged Board

In **T 208/88** of 20 July 1988 the board referred a question already pending once again to the Enlarged Board, because new aspects had emerged which it deemed useful for the Enlarged Board's decision. The same questions, supplemented by an additional question, were also referred again in **J 15/90** of 4 September 1992 (see also **T 83/05** of 8 July 2013), because the Legal Board wished to give the Enlarged Board the opportunity to consider another type of case. In **T 803/93** (OJ 1996, 204) the board complemented the questions already pending and said that important questions of law should, if possible, be considered in the context of proceedings involving parties having opposing interests in relation to these questions. In **T 184/91** of 25 October 1991 the President of the EPO had referred questions to the Enlarged Board. The board referred the already pending questions again, stating that nothing prevented a board from reiterating questions that are pending, in order that the parties to an appeal may enjoy being parties to the proceedings before the Enlarged Board. In **T 1553/13** of 20 February 2014 and **T 2017/12** of 24 February 2014 two different technical boards referred an almost identical question to the Enlarged Board.

2.5.3 Stay of first-instance proceedings following a referral

In **T 166/84** (OJ 1984, 489) the board stated that, in its opinion, where a decision of the examining division depended entirely on the outcome of proceedings before the Enlarged Board on a legal question raised under Art. 112 EPC 1973 – and this was known to the examining division – the further examination of the application must be suspended until the matter was decided by the Enlarged Board. Failure to do so would amount to a substantial procedural violation under R. 67 EPC 1973 (R. 103(1)(a) EPC).

When **G 3/14** (concerning clarity objections in opposition proceedings) was pending before the Enlarged Board, the President of the EPO decided that all proceedings before the opposition divisions where the decision depended entirely on the outcome of the Enlarged Board's decision were to be stayed ex officio, thereby superseding the then general practice under the Guidelines to stay proceedings only upon request of a party (notice from the EPO dated 7 August 2014 concerning the staying of proceedings due to referral **G 3/14**, OJ 2014, A87, see also notice from the EPO dated 2 October 2015 concerning the staying of proceedings due to referral **G 1/15**).

According to the Guidelines (E-VII, 3 – April 2025 version), where the outcome of examination or opposition proceedings depends entirely on the answer to questions referred to the Enlarged Board, the proceedings *may* be stayed by the examining or opposition division on its own initiative or on request of a party. Under a previous version of the Guidelines (E-VI, 3 – September 2013 version), the proceedings were to be stayed "only upon request of at least one of the parties" (see also notice from the EPO dated 1 September 2006 concerning staying of proceedings, OJ 2006, 538).

2.5.4 Stay of appeal proceedings following a referral

It follows from Art. 112(3) EPC that the proceedings before the referring board are stayed until the Enlarged Board gives its decision. Proceedings before other boards of appeal may also be stayed.

In **T 426/00** of 27 June 2003, the board had to answer questions that were identical to the questions raised in a referral pending before the Enlarged Board (concerning Art. 123(2) EPC, disclaimers). The board raised the purpose of ensuring a uniform application of the law under Art. 112 EPC and the need to comply with the spirit of Art. 16 RPBA 1980 (Art. 21 RPBA; see in this chapter V.B.2.3.6). In order not to anticipate the Enlarged Board's evaluation of the questions before it, the board suspended the appeal proceedings.

In **T 1875/07**, the board acknowledged the patentability of the invention under Art. 52(2) EPC but did not consider the claimed subject-matter to be inventive. A referral on Art. 52(2) EPC was pending before the Enlarged Board. According to the board, the legal basis on which an application is refused determines only the reasons for the decision, but not the decision itself. Since the decision in the appeal proceedings did not depend entirely on the outcome of the referral, the board refused the request to suspend the appeal proceedings (see also **T 787/06**, **T 1044/07** and **T 1961/09**).

3. Petition for review under Article 112a EPC

3.1. General

Article 112a EPC was introduced with the EPC 2000, following a suggestion of the Enlarged Board (**G 1/97**; OJ 2000, 322). Its purpose is not to make the Enlarged Board a third instance (**R 5/16**: second judicial instance) but to provide for a limited judicial review of decisions of the boards of appeal. The grounds on which a petition for review can be based have been exhaustively defined by the legislator. These are, firstly, fundamental procedural defects which occurred in appeal proceedings and, secondly, the existence of a criminal act which may have had an impact on a decision (Art. 112a(2) EPC).

Art. 112a EPC expands on the right to a fair trial guaranteed by Art. 6 ECHR (**R 9/14**). The examples in Art. 112a(2)(a) to (c) EPC and particularly the wording of Art. 112a(2)(d) EPC make it clear that only fundamental (but not minor) procedural defects can be the basis for a petition for review (explanatory remarks in OJ SE 4/2007, 126; see also **R 8/14**). Review proceedings are confined to procedural defects so fundamental as to be intolerable for the

legal system and overriding the principle that proceedings which have led to a final decision should not be re-opened in the interest of legal certainty (**R 16/12**, **R 8/16**). Art. 112a EPC provides an "exceptional means of redress" (**R 1/08**, **R 18/11**, **R 2/12** of 17 October 2012, **R 3/14**, **R 5/14**; see also **R 9/14**), an "extraordinary legal remedy" (travaux préparatoires, MR/21/00; see also **R 1/08**, **R 20/10**, **R 1/11**, **R 3/11**), the provisions of which have to be applied strictly (**R 1/08**, **R 23/10**). A petition for review has no suspensive effect (Art. 112a(3) EPC).

From 13 December 2007 (the entry into force of Art. 112a EPC) to 31 December 2024, 197 decisions of the Enlarged Board on petitions for review (petitions withdrawn or deemed not to have been filed and interlocutory decisions excluded) have been published on the internet. In ten cases (**R 7/09**, **R 3/10**, **R 15/11**, **R 21/11**, **R 16/13**, **R 2/14** of 22 April 2016, **R 3/15**, **R 4/17**, **R 5/19** and **R 3/22**) the decision under review was set aside and the appeal proceedings re-opened; the remaining petitions were rejected.

3.2. Transitional provisions

The decision of the Administrative Council of 28 June 2001 on the transitional provisions under Art. 7 of the Act revising the EPC of 29 November 2000 provides that "Article 112a EPC shall apply to decisions of the Boards of Appeal taken as from the date of its entry into force" (see **R 2/08**). Referring to **G 12/91** (OJ 1994, 285), the Enlarged Board in **R 5/08** interpreted "taken" to be the date a decision given orally is pronounced, not the date of notification. A petition based on a decision dated prior to, yet not notified to the parties until after entry into force of the EPC 2000, is therefore inadmissible.

3.3. Article 112a EPC – Continuity of the petitioner's legitimate interest

In **R 12/20** the Enlarged Board noted that the petitioner's ongoing legitimate interest had to continue to exist and the admissibility requirements had to continue to be met throughout the entire review proceedings, and that the EPO had to consider these criteria of its own motion. During the review proceedings in hand, the opposition proceedings had been continued. The opposition of the petitioner (opponent) had been rejected and the opposed patent maintained as granted without the petitioner filing as much as a precautionary appeal against that decision. The Enlarged Board concluded that the petitioner could no longer argue that they still had a legitimate interest and that the admissibility requirements for the originally filed petition for review were therefore no longer met. The petition for review was therefore rejected as clearly inadmissible.

3.4. Article 112a(1) EPC – party adversely affected by the board's decision entitled to file a petition for review

Under Art. 112a(1) EPC, any party **adversely affected by the decision** of a board may file a petition for review.

3.4.1 Article 112a(1) EPC – Party adversely affected

In the case underlying **R 1/11**, the patent had been transferred and the transferee had filed an appeal against the decision of the opposition division to revoke the patent. The transfer of the patent had, however, not been registered in line with R. 22 EPC before the expiry of the period for filing the notice of appeal. Therefore, the decision under review had rejected the transferee's appeal as inadmissible. The transferor's appeal, filed after the expiry of the period for filing a notice of appeal, had also been considered inadmissible. Both the transferee and the transferor filed a petition for review. The Enlarged Board held that the requirement of Art. 112a(1) EPC that the petitioner be adversely affected for a petition to be admissible was fulfilled with respect to the transferee, irrespectively of its party status before the board of appeal, since the adverse effect resulted from the refusal to acknowledge that it had the status of appellant (his petition was, however, considered clearly unallowable in the end). The transferor's petition, on the other hand, was considered clearly inadmissible because, not being the current proprietor, the transferor was not adversely affected by the impugned decision.

In **R 13/22** the Enlarged Board emphasised that Art. 112a(1) and 107 EPC both refer to the adverse effect being from a/the decision, **not the reasoning** set out in the decision. Furthermore, the Enlarged Board saw no reason to give "adversely affected" in Art. 112a(1) EPC a different meaning from that given to it in Art. 107 EPC. The case law on "adversely affected" under Art. 107 EPC was thus of relevance to the interpretation of this term in Art. 112a(1) EPC. The Enlarged Board referred among others to **T 193/07** in which the board considered that a party was only adversely affected if the Order of the appealed decision did not comply with its request. The Enlarged Board also recalled further case law of the boards, according to which, in cases where the Order of the decision of the opposition division was the revocation of the patent, an opponent who had requested revocation of the patent in its entirety was not "adversely affected by" said decision within the meaning of Art. 107 EPC, irrespective of the reasons given in the decision.

3.4.2 Article 112a(1) EPC – Whether there has been a decision

In **R 4/18** the Enlarged Board held that **minutes** were **not considered to be a decision** (see also **R 1/22**). It did not see how the use of the word "conclusion" instead of "preliminary view" in the context of the minutes of an oral proceeding could transform those minutes into a decision, noting that the appeal proceedings had been terminated by the appellant's (petitioner in the case in hand) withdrawal of the appeal in the proceedings under review. The Enlarged Board noted that it was the common practice of the boards to express views or conclusions on the substantive issues before them during the course of the oral proceedings. A decision on the case is then made at the end of the oral proceedings. See also chapter V.A.2.2. "Appealable decisions".

In **R 3/22**, the Enlarged Board considered a **communication of the Registrar** a decision for the purposes of Art. 112a(1) EPC. The Enlarged Board interpreted the Registrar's communication as a decision in which the board had implicitly decided on the appeal, while not deciding on the request for correction. The Enlarged Board noted that a ruling of this kind would not normally be considered a decision within the meaning of the EPC.

Notwithstanding, in order to avoid gaps in legal protection, an exception had to apply in the situation where a board of appeal expressly indicated that it considered the appeal proceedings to be closed and refused to deal with the case further. See also **R 3/22** in this chapter V.B.4.4.3. On this point, see also chapter III.K.3.1. "When is there a decision within the meaning of Rule 111 EPC?".

In **R 5/23** the Enlarged Board concluded that the review procedure under Art. 112a EPC did not, in any event, in accordance with the applicable provisions, concern decisions that did not put an end to proceedings before a board of appeal in respect of the party concerned. This conclusion was not inconsistent with the case law, which allowed petitions for review of decisions which, though not formally taken, put an end to appeal proceedings (see **R 3/22**). Accordingly, in the case in hand, the petition for review of the replacement board's decision to refuse a request to reject all its members on the ground of suspected partiality was rejected as clearly inadmissible.

3.4.3 Article 112a(1) EPC – Whether a decision has been taken by a board

In **R 21/22** the Enlarged Board stressed that "the decision" referred to in Art. 112a(1) EPC was a decision of a board. The decision to appoint a member of the board as rapporteur and the decision not to hold oral proceedings on this issue, which had been taken in the current case, had been decisions of the Chair. Thus, these decisions could not be subject to a petition for review.

3.5. Scope of review by the Enlarged Board

3.5.1 Article 112a(2) EPC – grounds for a petition for review

A petition for review may only be filed on the grounds listed in Art. 112a(2) EPC. Those defined in Art. 112a(2)(a) to (c) EPC concern a breach of Art. 24 EPC governing exclusion of and objection to members of a board of appeal; the participation of persons not appointed as a member of the boards of appeal; and the fundamental violation of Art. 113 EPC. In addition, Art. 112a(2)(d) EPC opens up the possibility of using the Implementing Regulations to define further fundamental procedural defects on which a petition for review might be based (explanatory remarks in OJ SE 4/2007, 126). Under R. 104 EPC, such a defect may arise from either a failure to arrange for the holding of oral proceedings requested by a party (R. 104(a) EPC), or a failure to decide on a request relevant for the board's decision (R. 104(b) EPC). Finally, a petition for review may also be filed on the ground that a criminal act may have had an impact on the decision (Art. 112a(2)(e) EPC).

3.5.2 Grounds listed exhaustively

The grounds for a petition for review have been exhaustively defined by the legislator, namely in Art. 112a(2) EPC in conjunction with R. 104 EPC (**R 1/08**; see also **R 10/09**, **R 14/09**, **R 16/09**, **R 17/09**, **R 18/09**, **R 20/09**, **R 20/10**, **R 6/11**, **R 13/11**, **R 19/11**, **R 20/11**, **R 2/12** of 17 October 2012, **R 18/12**, **R 4/13**, **R 5/13**, **R 5/14**, **R 7/14**, **R 9/14**, **R 6/15**,

R 3/16, **R 14/22**, **R 20/22**). What is not defined by the Implementing Regulations does not qualify as a procedural defect under Art. 112a(2)(d) EPC (**R 16/09**, **R 10/20**, **R 12/22**).

The erroneous application of a procedural rule, which does not in itself belong to the grounds for review enumerated in the EPC, can only be considered if it results in one of the procedural defects listed in Art. 112a(2) EPC in conjunction with R. 104 EPC (**R 2/08**, **R 20/10**, **R 18/12**). In **R 8/16** the Enlarged Board noted that Art. 125 EPC expressly states that it is only applicable in the absence of procedural provisions in the EPC and held that for this reason it could not be the basis for extending the scope of Art. 112a EPC.

In particular, the following issues cannot be considered in review proceedings:

– requests concerning the interpretation of the RPBA (**R 2/23**)

– allegedly insufficient reasoning (**R 6/11**; see also **R 1/08**, **R 19/11**, **R 5/13**, **R 1/15**, **R 8/15**, **R 7/16**, **R 4/20**, **R 10/20**, **R 8/23**), unless this involves a fundamental violation of Art. 113 EPC

– illogical and contradictory reasoning (**R 10/20**)

– an alleged failure to attach to the decision information on the available means of redress (**R 3/21**)

– the alleged violation of Art. 114 EPC in conjunction with R. 116(1) and (2) EPC or, respectively, R. 101 and 99(2) EPC (**R 14/09**)

– the refusal to allow the recording of oral proceedings, the use of a different (but equivalent) terminology than the one used in the EPC during the oral proceedings or the non-validation of the minutes at the end of the oral proceedings (**R 17/09**)

– the alleged inadequate keeping of minutes, the alleged incompetence to decide on the exclusion from file inspection or the alleged misunderstanding of a party submission (**R 20/09**, **R 7/17**)

– the alleged violation of Art. 6 ECHR (**R 18/09**, **R 1/16**), unless this involves a fundamental violation of Art. 113 EPC (see **G 3/08**, OJ 2011, 10, as to the general applicability of fundamental procedural rights in EPO proceedings)

– the alleged violation of the principle of legitimate expectations (**R 13/11**, **R 1/16**)

– the allegedly incorrect reversal of the burden of proof (**R 21/10**, **R 1/20**)

– alleged irrationality or "Wednesbury unreasonableness" (**R 19/11**)

– allegedly insufficient time allowed for the oral proceedings (**R 2/12**)

– the alleged violation of the right to be heard in respect of another party (**R 5/14**)

– the alleged lack of technical understanding of a board member, so that the board did not consist of two "technically qualified members" as required by Art. 21(4)(a) EPC (**R 3/12**)

– the alleged violation of Art. 4(3) EPC, or of Art. 11, 15(4) and 20 RPBA 2007 (**R 9/14**)

– the alleged violation of Art. 15(5) and 15(6) RPBA 2007, unless this involves a fundamental violation of Art. 113 EPC or a fundamental procedural defect under Art. 112a(2)(d) EPC in combination with R. 104(b) EPC (**R 7/14**; see also **R 10/08**)

– the alleged violation of Art. 20(1) RPBA 2007 (**R 7/13**)

– the alleged violation of Art. 114 EPC, of Art. 13 RPBA 2007, or the alleged lack of impartiality (**R 10/14**)

– the alleged violation of the principle of procedural economy (**R 1/16**).

– an alleged misapplication of a provision of the RPBA 2007, unless it can be shown that it resulted in a fundamental procedural violation within the meaning of Art. 112a(2) EPC (**R 3/17**).

As R. 106 EPC implies, only procedural defects actually attributable to a board of appeal can be reviewed under Art. 112a EPC. Procedural defects that occurred in first-instance proceedings may not be the subject of a petition for review (**R 20/10**, **R 8/11**; see also **R 19/12** of 12 April 2016, **R 3/16**).

3.5.3 No suspensory effect – review of substantive law excluded

Article 112a(3) EPC makes it clear that the petition for review is an extraordinary legal remedy the filing of which does not affect the force of res judicata of the decision under attack. Implicitly it follows that a successful petition for review results in a decision of the Enlarged Board which sets aside the decision of the board of appeal, i.e. overturns its res judicata effect, and re-opens appeal proceedings (explanatory remarks in OJ SE 4/2007, 128). Decisions of the boards of appeal must remain final decisions (see also **R 1/08**).

Under no circumstances may the petition for review be a means to review the application of substantive law. This restriction is justified because the function of the petition for review is to remedy intolerable deficiencies occurring in individual appeal proceedings, not to further the development of EPO procedural practice or to ensure the uniform application of the law (explanatory remarks in OJ SE 4/2007, 126; **R 13/10**: established case law since **R 1/08**). The Enlarged Board has no competence under Art. 112a EPC to examine the merits of the decision and to go into the substance of a case (**R 4/09**, **R 13/10**, **R 5/15**, **R 7/17**, **R 3/21**, **R 11/21**, **R 15/21**, **R 12/20**), not even indirectly (**R 19/11**, **R 6/13**, **R 3/18**, **R 24/22**). A review of the correct application of substantive law would amount to the Enlarged Board being a third instance which has been explicitly excluded (**R 3/09**; see also **R 13/09**, **R 3/18**). It is not the purpose of petition for review proceedings to evaluate

whether or not the reasons selected by the board are appropriate (**R 13/14**, **R 2/18**, **R 12/22**); the Enlarged Board cannot replace a board's substantive assessment with its own (**R 9/14**). The Enlarged Board cannot act as a third instance or second-tier appellate tribunal in petition proceedings (**R 9/10**, **R 11/11**, **R 5/13**; see also **R 1/08**, **R 3/09**, **R 13/09**, **R 3/18**).

Not being competent to decide on the merits of a case necessarily implies that the Enlarged Board has no power to control the normal exercise a board makes of its discretion (**R 10/09**, see also **R 6/17** and **R 4/22**). The exercise of discretion is only subject to review if arbitrary or manifestly illegal (**R 10/11**, **R 13/21**, **R 12/22**, **R 24/22**), thereby involving a fundamental violation of the right to be heard (**R 9/11**; see also **R 17/11**, **R 6/20**, **R 7/21**, **R 4/22**, **R 24/22**). In **R 13/21** the Enlarged Board clarified that in proceedings under Art. 112a EPC, it was at most necessary and permissible to examine (i) whether the party had been heard on the question of the admission of new submissions or new requests and/or (ii) whether there had been an error of discretion (see also **R 4/22**). The latter examination should focus on two aspects at most, namely whether there had in fact been discretionary power available to the board, and whether the board had recognised that fact (abuse of or failure to exercise discretionary power) and whether the discretionary power had been exercised in an arbitrary or manifestly unlawful manner (abuse or misuse of discretion).

In **R 13/12** the Enlarged Board stated that it had to remain vigilant and thwart any attempt to blur the frontier between what might clearly be a matter for a violation of the right to be heard under Art. 113 and 112a(2)(c) EPC, and anything else presented as a violation of the right to be heard but which actually pertained to the substantive merits of the decision under review.

In **R 25/22** the Enlarged Board held that not being competent to judge the correctness of a decision, however, did not mean that the Enlarged Board was in principle prevented from analysing and understanding the board's reasoning. In order to determine whether an ignored argument by a party or a surprising new argument by a board had indeed been causal for a board's decision, the Enlarged Board would inevitably have to go into the substance of the case and at least understand the parties' arguments and the board's reasoning (see also in this chapter V.B.4.3.2).

In **R 3/18** the Enlarged Board noted that the question at issue, i.e. the "estoppel situation" as characterised by the petitioner, might, in principle be eligible for a referral to the Enlarged Board under Art. 112 EPC. However, the Enlarged Board held that an absence of such a referral under Art. 112 EPC did not entitle the Enlarged Board in proceedings under Art. 112a EPC to deal with the petitioner's request to correct this estoppel situation and to set aside the decision under review.

The following issues cannot be considered in review proceedings:

– the assessment of inventive step (**R 1/08**, **R 12/09** of 15 January 2010, **R 6/11**, **R 14/13**, **R 6/15**), including the determination of the closest prior art (**R 5/13**)

– the interpretation of a prior art document (**R 9/08**, **R 8/09**, **R 4/11**)

– the assessment of clarity (**R 15/10**)

– the assessment of public prior use (**R 19/10**)

– the assessment of evidence (**R 21/09**)

– the conclusions in relation to arguments, facts and evidence, including the question of which party to the appeal proceedings bore the burden of presenting arguments, facts and evidence, or to what extent any counter-evidence was required (**R 11/21**)

– whether to remit a case to the department of first instance (**R 10/09**, **R 12/09**, **R 9/10**, **R 7/13**, **R 24/22**)

– whether to admit a new request (**R 10/11**, **R 11/11**, **R 13/11**, **R 4/13**) or a new document (**R 10/09**, **R 17/11**) under Art. 12 RPBA 2007 or under Art. 13(1) RPBA 2007 (**R 1/13**, **R 4/14**, **R 6/17**)

– whether an appeal is admissible (**R 10/09**, **R 10/14**)

– whether or not the exception to reformatio in peius mentioned in **G 1/99** (OJ 2001, 381) applies to a particular case (**R 4/09**; see also **R 10/14**)

– whether to refer a question to the Enlarged Board under Art. 112 EPC (**R 7/13**, **R 17/14**)

– whether the boards are empowered to decide on a request to hold oral proceedings before the examining division in Munich instead of in The Hague (**R 13/14**)

– sufficiency of disclosure (**R 2/14** of 22 April 2016).

3.6. Petitions for review of an interlocutory decision

In **R 2/15** of 21 November 2016 the Enlarged Board held that petitions for review of interlocutory decisions were not generally inadmissible (see also **R 5/08**, **R 5/15**). The Enlarged Board saw no reason to assume that Art. 106(2) EPC, which stipulates that a decision which does not terminate proceedings as regards one of the parties can, as a rule, only be appealed together with the final decision, was to be applied to the petition for review procedure. Neither Art. 112a EPC nor R. 104 to 110 EPC contained a provision corresponding to Art. 106(2) EPC.

In **R 5/15** the Enlarged Board acknowledged that interlocutory decisions dealing with objections of suspected partiality unquestionably had consequences of utmost importance for the proceedings as a whole. The petitioner had argued that it was likely that the Enlarged Board would set aside the decision of the board in its alternate and that the board had violated its right to be heard by failing to consider its request for postponement. The

Enlarged Board held it was not appropriate to base a decision on speculation. The interlocutory decision of the Board in its alternate composition was binding and had the force of res judicata.

3.7. Obligation to raise objections

Under R. 106 EPC, a petition under Art. 112a(2)(a) to (d) EPC is only admissible where an objection in respect of the procedural defect was raised during appeal proceedings and dismissed by the board, except where such objection could not be raised.

3.7.1 Purpose of Rule 106 EPC

The purpose of R. 106 EPC is to give the board a chance to react immediately and appropriately by either removing the cause of the objection or by dismissing it (see e.g. **R 5/08**, **R 3/20**, **R 11/21**, **T 1544/08**, **T 144/09**, **T 1977/13**, **T 1203/19**), thereby ensuring legal certainty for the parties and the public as to whether the ensuing substantive decision of the board is open to review under Art. 112a EPC (**R 4/08**, **R 1/10**, **R 14/11**, **R 16/12**, **R 9/22**, **R 2/23**, **T 1690/22**). By ensuring that errors can be corrected by a board before a final decision is taken, R. 106 EPC also ensures that unnecessary petitions for review are avoided (**R 14/11**, **R 18/12**).

3.7.2 Requirements of a valid objection

a) Recognisable immediately as an objection, defect clear and unambiguous

Raising an objection under R. 106 EPC is a procedural act and a precondition for access to the extraordinary legal remedy under Art. 112a EPC (**R 4/08**, **R 7/08**, **R 3/11**, **R 7/11**, **R 16/12**). The objection must be expressed by the party in such a form that the board is able to recognise immediately and without doubt that an objection under R. 106 EPC is intended (**R 6/22**, **R 9/22**, **R 2/23**). It also must be specific, indicating clearly and unambiguously on which procedural defect the petitioner intends to rely (see **R 4/08**, **R 7/08**, **R 8/08**, **R 1/10**, **R 17/10**, **R 7/11**, **R 5/12**, **R 6/12**, **R 16/12**: established jurisprudence, **R 3/14**, **R 8/16**, **R 9/22**, **R 2/23**).

An objection under R. 106 EPC is additional to and distinct from other statements, such as arguing or even protesting against the conduct of the proceedings or against an individual procedural finding (**R 2/08**, **R 7/08**, **R 9/09**, **R 1/10**, **R 14/11**, **R 21/11**, **R 16/12**, **R 6/22**, **R 9/22**). An objection under R. 106 EPC must be something other than an alleged reference being made to a potential violation of Art. 113 EPC (**R 2/23**). An objection must be expressly described as such (**R 8/08**, **R 21/11**, **R 7/18**). However, even if an objection does not contain an explicit reference to R. 106 EPC, it can qualify as an objection under R. 106 EPC (**R 21/09**; see also **R 12/14**, **R 17/14**).

In **R 18/12**, the Enlarged Board stated that only an objection which, in substance, raised a procedural defect which could be the subject of a petition for review under Art. 112a(2)(a) to (d) EPC could be regarded as an objection within the meaning of R. 106 EPC. In the case in hand, the Enlarged Board held that objecting, in substance, to the board's

conclusion on clarity did not qualify as such an objection, even if the petitioner explicitly referred to Art. 113 EPC. Referring to **R 18/12** the Enlarged Board recalled in **R 6/22** that in determining whether the petitioner has complied with R. 106 EPC, what matters is not the formal wording of the objection but its substance as it could be objectively understood by the board. In the case in hand, during the discussion before the board on the admittance of the auxiliary request, the proprietor (petitioner) had made a statement that failure to admit the request would be a violation of its right to be heard. The Enlarged Board found that, even if the board might have subjectively perceived that the proprietor's argument was intended as an objection under R. 106 EPC, the board apparently had not considered the objection to have been effectively raised.

In **R 8/18** the Enlarged Board noted that neither the petition, nor the request for correction of the minutes, nor the declarations of the representatives, stated anywhere that Art. 113 EPC or a violation of the right to be heard was mentioned by the petitioner in connection with the refused interruption, in which case the Enlarged Board might have recognised the objection as a reference to Art. 112a(2)(c) EPC. The Enlarged Board therefore concluded that the petitioner's own initial submissions did not suggest, let alone prove that a recognisable objection within the meaning of R. 106 EPC had been made.

b) Objection raised in good time by persons capable of validly doing so

In **R 1/14** the Enlarged Board held that it was an indispensable prerequisite for the admissibility of a petition that an objection be raised "in good time", i.e. at a time when the board can still rectify the alleged violation. An objection to a refusal to postpone the date of oral proceedings must therefore be made before or, at the latest, at the beginning of these oral proceedings.

In **R 21/09** the Enlarged Board held that if an objection is made during oral proceedings, the fact that it is only raised after further requests have been discussed has no bearing on the admissibility of the petition.

In **R 14/11** the Enlarged Board held that an objection cannot be formulated prematurely, i.e. before a procedural defect has come into existence (see also **R 8/08**, **R 17/10**, **R 21/11**, **R 11/21**, **R 6/22**, **T 1203/19**). In **R 11/21** the board added that making a request conditional might prevent it from being considered as submitted too late, but did not remedy a premature submission, at least in the context of R. 106 EPC.

In **R 9/09** the board held that an accompanying person cannot validly make procedural declarations, such as an objection under R. 106 EPC (see also **R 3/08**).

c) Different defects must be objected to and considered separately

Different alleged procedural defects must be objected to separately under R. 106 EPC (**R 5/13**; see also **R 10/14**), and also have to be considered separately by the Enlarged Board (**R 3/08**, **R 17/11**).

d) Board's explicit reaction to an alleged objection

In **R 6/22** the Enlarged Board pointed out that there was no trace of any explicit dismissal of an alleged objection on file. In the Enlarged Board's view it seemed likely that the board had not taken note of the intended objection. In this way, the absence of any discernible reaction from the board was a further indication that the board could not perceive the right to be heard argument as a recognisable objection within the meaning of R. 106 EPC. The Enlarged Board held that in a situation where the board does not react in a recognisable and explicit manner to an intended objection a diligent party should normally insist on a discernible response from the board. Failure to do so may leave the party with an indication that weighs against its case.

3.7.3 Written form to avoid uncertainties

In the light of the purpose of the obligation to raise objections, the board in **T 1690/22** considered that raising an objection in writing was a practice making it possible to clearly determine its scope. Although it made no difference to the objection's substance whether it was raised in writing or merely verbally, doing so in writing made it possible to record verifiably what the board had had to decide on and avoid uncertainties in any review proceedings about how the party raising the objection had intended to formulate it. See also in this chapter V.B.3.7.5.

3.7.4 Examples of invalid objections

The following are examples of acts that the respective boards have found did not qualify as an objection under R. 106 EPC:

– contesting insufficiency of disclosure or offering new documents (**R 7/08**)

– requesting that a late-filed document not be admitted into the proceedings (**R 9/09**, **R 17/10**)

– protesting against the hearing of an expert (**R 2/11**)

– an objection against the board raising a new line of argument or a request for remittal or postponement (**R 14/11**)

– requesting that a board make a statement on the scope of a claim, the request being repeatedly refused (**R 3/14**)

– a statement (a remark) that failure to admit an auxiliary request would be a violation of the party's right to be heard (**R 6/22**)

3.7.5 Minutes as evidence that the objection was raised

The test whether an objection was validly raised during oral proceedings is normally the minutes, which, as prescribed by R. 124(1) EPC, must contain the relevant statements of

the parties (**R 4/08**, **R 17/10**, **R 8/16**). In **T 1690/22** the board explained that the essentials of the oral proceedings to be recorded in the minutes of the proceedings under R. 124(1) EPC included the fact as such that an objection had been raised, but not the supporting grounds and arguments put forward by the party concerned and required to make the objection admissible. Instead, it was the parties' responsibility to submit explanations and reasons for their requests in writing. See also in this chapter V.B.3.7.3.

The absence in the minutes of an objection under R. 106 EPC and of any request for correction of the minutes is a strong indication that such an objection, if any, was at least not duly qualified (**R 3/11**; see also **R 6/13**, **R 3/14**, **R 5/14**, **R 1/22**).

In **R 7/11** the Enlarged Board noted that unless duly corrected, the minutes of the oral proceedings authenticate the facts they relate to, and in **R 2/12** of 17 October 2012 the Enlarged Board stated that If a party is really convinced that a violation of its right to be heard has occurred during the oral proceedings the subsequent objection must be clearly raised as such, so that it will oblige the board of appeal to react, and require this to be recorded in the minutes in accordance with R. 124 EPC.

In **R 8/17** the board stated that the petitioner's own submissions did not allow the conclusion that it had raised an objection in the oral proceedings which could qualify as an objection under R. 106 EPC and if the petitioner had considered the minutes to be incomplete in this regard, one would have expected it to submit a corresponding request for correction (see **R 17/10**). However, in **R 3/08** the Enlarged Board also took private minutes taken by an employee of the petitioner into account.

In **R 8/16** the Enlarged Board noted that while there was no strict formal obligation on parties to request a correction to the minutes, not doing so will leave them with the burden of proof against the minutes in case of dispute.

3.7.6 Requirements of a valid dismissal of an objection

In **R 6/22** the petitioner considered its "unequivocal statement" that failure to admit the auxiliary request would be a violation of its right to be heard an objection within the meaning of R. 106 EPC. The Enlarged Board pointed out that there was no trace of any explicit dismissal of the alleged objection on file and it was not convinced about the petitioner's explanation, according to which the non-admittance of the auxiliary request had to be regarded as the implicit dismissal of its intended objection.

3.7.7 Objection could not have been raised

Under R. 106 EPC an objection is not a requirement for the petition to be admissible where such objection could not be raised during the appeal proceedings. Therefore, if the alleged procedural defect becomes apparent to the parties only through the written reasons for the decision (in **R 3/10**: through the announcement of the decision), the admissibility of the petition is not conditional upon a corresponding objection having been raised during the oral proceedings (**R 4/08**; see, by way of example, also **R 1/08**, **R 2/08** (written procedure), **R 9/08**, **R 3/09**, **R 4/09**, **R 7/09**, **R 11/09**, **R 19/10**, **R 8/11**, **R 21/11**, **R 14/13**, **R 6/20**,

R 11/21, **R 14/22**). If a petition addresses mostly the reasoning of a decision, the benefit of the doubt is given to the petitioner as to its possibility to raise an objection before the end of appeal proceedings (**R 1/11**, see also **R 18/14**).

In **R 16/09** the petitioner requested the correction of the minutes of oral proceedings in order to establish what, in its view, had been the order of the procedural steps followed by the board, to prove that it could not raise any objection in respect of the procedural defect during oral proceedings. The Enlarged Board held that the lack of possibility for the petitioner to raise an objection could not be excluded, even if the request to correct the minutes was rejected.

In the proceedings underlying **R 10/08**, the petitioner wanted to submit a new auxiliary request, allegedly during the announcement of the decision at the oral proceedings, but the board had declared itself formally bound by the decision as announced. The petitioner could thus no longer raise an objection "during the appeal proceedings". However, in **R 12/14** the Enlarged Board held that, if the pronouncing of the decision immediately follows the closing of the debate, requiring the appellant to interrupt the Chair would overstretch the obligations arising from R. 106 EPC.

In **R 5/17** the petitioner (opponent) had misinterpreted the acts and words of the board in the decision under review and without further questioning based its strategy on this interpretation. The Enlarged Board did not accept the argument of the petitioner that, although objectively an objection could have been raised, it could nevertheless not have been raised because the petitioner subjectively had no reason to raise an objection. Only the petitioner was responsible for this misunderstanding, and thus had to bear the consequences thereof.

3.7.8 Compliance with Rule 106 EPC left open

If a request is unallowable, it can be left open whether the petitioner complied with R. 106 EPC (**R 15/09**, **R 18/09**, **R 20/09**, **R 16/11**, **R 2/12** of 17 October 2012, **R 16/12**, **R 1/13**, **R 15/13**, **R 7/14**, **R 17/14**, **R 2/16**).

3.8. Contents of the petition for review

3.8.1 Petition must be adequately substantiated

In **R 5/08** the Enlarged Board stated it was clear that apart from any reasons accepted by the Enlarged Board as special enough to justify the submission of additional facts, arguments or evidence, the petition itself must be adequately substantiated. R. 107(2) EPC requires a petition to indicate the reasons for setting aside the decision of a board of appeal and the facts and evidence on which it is based. This corresponds to the similar provisions requiring substantiation of an opposition or an appeal (R. 76(2)(c) and R. 99(2) EPC). The contents of a petition must be sufficient for the petitioner's case to be properly understood on an objective basis and must enable the Enlarged Board (and any other parties) to understand immediately why the decision in question suffers from a fundamental procedural defect. The petition must thus set out the reasons why it requests

that the impugned decision be set aside, specify the facts, arguments and evidence relied on and must do so within the time limit for filing the petition, namely two months after notification (see Art. 112a(4) EPC; see also **R 4/13**, **R 17/13**, **R 3/18**).

In **R 9/10** the Enlarged Board held that an implicit request to set aside the decision was sufficient. In **R 20/10** the Enlarged Board stated that the obligation to file a reasoned statement could not be construed so narrowly as to mean that any kind of reasoning was sufficient to fulfil this requirement, as long as it was extensive enough. In **R 2/08** the Enlarged Board held that for the petition to be admissible, it was however sufficient if only one ground was sufficiently reasoned in the request, just as it is for an appeal or opposition (see also **G 9/91**, OJ 1993, 408).

3.8.2 Non-compliance with Rule 107 EPC and failure to remedy a deficiency

In **R 6/10** the board held that if a petition did not comply with R. 107(2) EPC, it must be rejected as inadmissible.

Under R. 108(2) EPC, if the Enlarged Board notes that the petition does not comply with R. 107(1)(a) EPC, it shall invite the petitioner to remedy the deficiencies noted within a period to be specified. If the deficiencies are not remedied in due time, the Enlarged Board shall reject the petition as inadmissible. In **R 6/09** the Enlarged Board noted that such rejection was subject to the petitioner's request for re-establishment of rights.

3.9. Time limit for filing a petition for review

In accordance with Art. 112a(4) EPC, a petition for review shall be filed within two months of notification of the decision of the board of appeal (or within two months of the date on which the criminal act has been established where applicable).

In **R 3/21** the Enlarged Board stressed that it could only examine the merits of grounds for review under Art. 112a(2)(a) to (d) EPC which had been substantiated within the two-month time limit under Art. 112a(4), first sentence, EPC. Both the request and the statement of reasons required under R. 107(2) EPC therefore had to be filed within two months of notification of the contested decision.

In **R 3/14** the Enlarged Board held that it was essential to observe the two-month time limit expressly prescribed in Art. 112a(4), second sentence, EPC for filing the reasons for the petition and the supporting submissions; no exceptions could be made.

In **R 5/14** the Enlarged Board stated that filing a petition and paying the fee before the orally announced decision has been notified to the petitioner in writing did not make it inadmissible under Art. 112a(4) EPC (see also **R 20/10**).

In **R 2/10** the Enlarged Board held that the established jurisprudence of the boards of appeal that mere payment of the appeal fee was not an act which sufficed for the admissible filing of an appeal applied *mutatis mutandis* to petition for review proceedings.

In **R 1/18** the Enlarged Board saw no reason not to apply the findings reached in Opinion **G 1/18** (OJ 2020, A26) to the provisions governing the legal effects of late payment of the fee for petition for review and so concluded that the petition for review had to be deemed not filed and that the associated fee had to be reimbursed. The Enlarged Board further concluded that the proper legal effect of late payment of the fee for requesting **re-establishment of rights** was a finding that the request was deemed not to have been filed and that the fee was to be reimbursed (see also **T 46/07** in chapter III.E.9. "Reimbursement of the fee for re-establishment").

3.10. Article 12(1) RPEBA – late-filed submissions in the review procedure

Pursuant to Art. 12(1) RPEBA the Enlarged Board may consider new submissions made by the petitioner after expiry of the time limit for filing the petition for review, if this is justified for special reasons. In **R 12/10**, **R 4/13** and **R 8/16** no such reasons were advanced by the petitioner, and the Enlarged Board rejected the late-filed submissions (see also **R 6/22**). In **R 15/13** the Enlarged Board stated that "special reasons" could not extend to the late introduction of grounds not relied on unless or until the grounds in the petition proved insufficient. In **R 4/12** and in **R 16/12** the Enlarged Board said that an entirely new complaint submitted for the first time during the oral proceedings before the Enlarged Board had no bearing whatsoever on the findings as to the petition's admissibility and merits reached on the basis of the grounds, facts, arguments and evidence set out in the petition.

In **R 2/08** the Enlarged Board accepted the petitioner's additional explanations in response to its communication, and in **R 18/09** a late-filed external legal opinion on the admissibility of the petition.

3.11. Rule 109 EPC – composition of the Enlarged Board and review procedure

Unless otherwise provided, the provisions relating to proceedings before the boards of appeal apply (R. 109(1) EPC). The RPEBA also apply in proceedings under Art. 112a EPC (Art. 1 RPEBA).

3.11.1 Composition of the Enlarged Board

Petition for review proceedings consist of two stages. In the first stage, a panel of the Enlarged Board composed of three members (two legally qualified, one technically qualified) examines all petitions for review and rejects those which are clearly inadmissible or clearly unallowable (unanimity is required; R. 109(2)(a) EPC). Those not rejected are considered by a panel composed of five members (four legally qualified, one technically qualified; R. 109(2)(b) EPC). In these cases, the three-member panel under R. 109(2)(a) EPC is supplemented by two further legally qualified members (Art. 2(3) RPEBA). The Chair of the board against whose decision the petition was filed may not take part in the proceedings (Art. 2(6) RPEBA).

In **R 25/22** the Enlarged Board held that the correct criterion for determining whether the petition was "clearly" unallowable within the meaning of R. 109(2)(a) EPC was not just the

depth of the analysis required to understand the case from a legal or technical point of view. What also mattered was the degree of conviction of the individual members of the Enlarged Board as to whether the alleged procedural defect was indeed a fundamental one within the meaning of Art. 112a(2)(a) to (d) EPC, once the relevant facts of the case had been identified, possibly only after an exhaustive and detailed examination of all the legally and technically relevant facts.

3.11.2 Involvement of parties other than the petitioner in petition for review proceedings

Parties other than the petitioner are not to be involved in the first stage of petition for review proceedings (R. 109(3) EPC; **R 7/14**). In **R 5/08** the Enlarged Board held that non-petitioner parties, as long as they are not involved, have no right to be heard that could be violated. Although not summoned to oral proceedings in the first stage, non-petitioner parties may, however, attend such proceedings which are public.

3.11.3 Group parties

In **R 18/09** the Enlarged Board held that the principles set out in **G 3/99** (OJ 2002, 347), also applied to petition for review proceedings, namely that a plurality of persons acting in common must be treated as a single party (a "group party") and that such a group party must act through a common representative.

3.11.4 Procedural efficiency

Petition for review proceedings should by their nature be dealt with as speedily as possible, acceleration requests are therefore unnecessary (**R 18/09**, **R 15/13**). In **R 11/12** the board also stated that petitions for review should, in the interest of legal certainty, be dealt with expeditiously, and did not consider a planned birthday party a reason justifying the fixing of a new date for oral proceedings before the Enlarged Board.

In **R 5/08** the Enlarged Board noted that R. 109(1) EPC provides that certain specific procedural time limits do not apply to petition for review proceedings and stated that this allowed the Enlarged Board to shorten these time periods in the interest of procedural efficiency. However, it clearly provides no justification for parties to disregard time limits set by the Enlarged Board itself.

3.12. Factual bases for the review – minutes and grounds for the decision

The factual bases for a review procedure under Art. 112a EPC are the minutes of the oral proceedings and the grounds for the decision under review (**R 15/09**, **R 6/14**). However, in **R 3/10** the Enlarged Board also took signed declarations of persons who had attended the oral proceedings into account.

According to the Enlarged Board in **R 6/14** the parties can be expected to review the contents of minutes soon after receiving them and to report any errors they find. The Enlarged Board clarified in **R 18/22** that it understood this to require a party to submit a request for correction of the minutes in the shortest time possible after their receipt. This

would ensure that the relevant facts and submissions were still fresh in the minds of the members of the deciding body and, if applicable, the other party or parties.

In **R 4/16** the Enlarged Board stated that, according to its settled case law on petitions for review, the boards were not obliged to explicitly state the reasons underlying a decision until they issued the final decision in writing (see **R 8/13** of 15 September 2015). R. 124(1) EPC required only that the minutes of oral proceedings contain the essentials, so they did not have to record every single point addressed at those proceedings. It therefore could not be inferred from a point's omission from the minutes that it had not been considered.

3.13. Burden of proof

The petitioner bears the burden of proving its allegations (**R 4/09**). However, in **R 15/11** the petition was allowed and the Enlarged Board stated that it is not for the party which alleges a breach of its right under Art. 113(1) EPC to prove that it has not been heard (negativa non sunt probanda). It would rather be the task of the boards to draft their own texts in a way that enables the reader, taking into account all documents on file, to conclude that the right to be heard was respected with regard to the grounds on which the decision is based.

In **R 4/17** the Enlarged Board considered, in respect of the implausibility of the non-arrival of letters put forward by the other party, that it could not be expected that the petitioner should prove a negative, that is the non-receipt of a letter, or provide a plausible explanation for non-receipt (negativa non sunt probanda).

In **R 8/18** the petitioner pointed to decision **R 15/11** and the principle of "negativa non sunt probanda", arguing that it was not for the party to prove that it had not been heard. The Enlarged Board distinguished the case in hand from **R 15/11**. The petitioner in **R 15/11** could point to the absence of facts which led to a legal conclusion, namely, the finding that the party had not been heard. In the case in hand the petitioner based its claims on positive facts, namely, the events that were stated to have occurred. Under these circumstances, the Enlarged Board found that the petitioner clearly carried the burden of proof that these events indeed occurred as stated.

3.14. Effects of a successful petition for review

3.14.1 Decision of board of appeal set aside

If the petition is allowable, the Enlarged Board sets aside the decision of the board of appeal and orders the re-opening of the proceedings before the board (R. 108(3) EPC). The limitation of the petition for review to a particular part of the decision (e.g. the non-reimbursement of the appeal fee) is admissible.

In **R 19/12** of 12 April 2016, the Enlarged Board held that although Art. 112a(5) EPC and R. 108(3) EPC did not explicitly provide for setting a decision aside only partially, this possibility followed from general procedural principles (see also **R 16/14**).

In **T 379/10** of 21 September 2015 the board cited **R 21/11**, in which it was held that the re-opening of appeal proceedings did not mean that the parties had to be given another opportunity to comment on all the matters in dispute. Rather, proceedings re-opened after a successful petition for review had to be restricted to rectifying the defect found in the review decision.

The board in **T 695/18** interpreted Art. 112a(5) and R. 108(3) EPC and held that there was nothing textual in the EPC to suggest that the proceedings re-opened in the present case by the Enlarged Board's decision **R 3/22** were the appeal proceedings. The board saw the Enlarged Board's Order in **R 3/22** as one that opened "ancillary proceedings" for establishing whether the request for correction of the withdrawal of the appeal was allowable: if the request were found allowable, the appeal proceedings would continue; if not, the appeal proceedings would be regarded as terminated as of the date when the withdrawal of the appeal took effect.

3.14.2 Replacement of board members

The replacement of board members under R. 108(3) EPC after a petition for review has been held allowable lies in the discretion of the Enlarged Board, to be exercised fairly and proportionately in the light of the facts (**R 21/11**).

In **R 15/11** the Enlarged Board held that unless there was a compelling reason for proceeding otherwise, the BDS must be adhered to and applied to a case re-opened before the board.

In **R 16/13**, the Enlarged Board rejected the request that members be replaced because it was not substantiated. In **R 21/11**, the Enlarged Board also rejected the petitioner's request that members be replaced, stating inter alia that such a replacement would necessitate the repetition of the whole appeal proceedings, which would be disproportionate. However, after the decision in **R 21/11** had been taken, the Chair of the technical board concerned retired, and the appeal proceedings had, in any event, to be repeated. As a consequence, both the technically and the legally qualified member recused themselves under Art. 24(2) EPC (**T 584/09** of 1 March 2013).

3.14.3 Reimbursement of the fee for petitions for review

In **R 21/11** the Enlarged Board stated that the only condition for the fee for a petition for review to be reimbursed under R. 110 EPC is that the proceedings before the board of appeal are re-opened (a reimbursement request is not required).

4. Grounds for petition for review

4.1. Article 112a(2)(a) EPC – alleged breach of Article 24 EPC

For general information on Art. 24 EPC, see chapter III.J. "Suspected partiality". The present chapter deals with decisions of the Enlarged Board under Art. 112a(2)(a) EPC.

In **R 16/10** the Enlarged Board rejected the petitioner's argument that Art. 24(1) EPC, concerning the exclusion of members from a board, included not only the specific situation where one of the members had represented a party in the case in question but also the general situation where a member had previously acted as representative of that party in any matter. In **R 20/09** the Enlarged Board confirmed that, in cases of suspected partiality of a board member, Art. 112a(2)(a) EPC requires that a decision has been taken on the suspected impartiality (Art. 24(4) EPC).

In **R 3/16** the Enlarged Board confirmed that Art. 112a(2)(a) EPC foresees the situation where a member of the board has taken part in the decision despite being excluded pursuant to a decision under Art. 24(4) EPC or in breach of Art. 24(1) EPC. The petitioner had further contended that it was an established principle that a party had no obligation to appear before an unlawful court; that, on the contrary, it could be prejudicial to do so since the right to be heard could not be properly guaranteed before such a court, thus leading to the question as to whether appeal proceedings held by a board unlawfully composed may amount per se to a breach of the right to be heard. This question, however, remained open because the Enlarged Board did not come to the conclusion that the board had actually ignored the procedure of Art. 24(4) EPC.

In **R 17/09** the Enlarged Board found that in English the term "man in the street" had no pejorative associations, but was commonly used to describe an average citizen.

In **R 12/22** the Enlarged Board held that a right to always be able to obtain advance information on a board member from publicly accessible sources could not be accepted. Whether the Art. 24 EPC requirements were met could still be checked by asking the board member concerned questions about this at oral proceedings.

4.2. Article 112a(2)(b) EPC – person not appointed as a board member

The Enlarged Board has not yet found allowable or admissible any petition for review alleging that a board of appeal included a person not appointed as a board member.

In **R 21/22** the Enlarged Board considered that Art. 11(3) and 112a(2)(b) EPC both referred to the same appointment, that is to the Boards of Appeal as a whole, and not the attachment of a member to a particular board or boards. It took the view that for the ground of petition under Art. 112a(2)(b) EPC to be applicable, a member of a particular board must be someone who has not been appointed to the Boards of Appeal under Art. 11(3) EPC. Thus, the petitioner's arguments relying on the use of the singular "board of appeal" in the German language version of Art. 112a(2)(b) EPC ("nicht zum Beschwerdekammermitglied ernannt") failed to persuade the Enlarged Board.

According to Art. 19(1), second sentence, RPBA, only members of the board shall participate in the deliberations; the Chair may, however, authorise other officers to attend. In **T 857/06** the board held that, under this provision (then Art. 19(1) RPBA 2003), a board's assistant may attend and take part in the deliberations.

4.3. Article 112a(2)(c) EPC – alleged fundamental violation of Article 113 EPC

4.3.1 General

The decisions of a board of appeal may only be based on grounds or evidence on which the parties have had an opportunity to present their comments (Art. 113(1) EPC), and a patent application or a patent may only be examined in the text submitted or agreed by the applicant or proprietor of the patent (Art. 113(2) EPC). For general information on the right to be heard under Art. 113 EPC, see chapter III.B. "Right to be heard".

In most petitions for review, the alleged fundamental violation of Art. 113(1) EPC is among the grounds on which the petition is based. The majority of petitions for review that have been successful so far concern a fundamental violation of Art. 113 EPC (see in this chapter V.B.4.3.21 and in this chapter V.B.4.4.3).

4.3.2 "Fundamental" violation of Article 113 EPC – causal link and adverse effect

A violation of Art. 113 EPC can only be considered fundamental within the meaning of Art. 112a(2)(c) EPC if there is a causal link between the alleged violation and the final decision (**R 1/08**, **R 11/08**, **R 11/09**, **R 13/09**, **R 6/13**, **R 2/14** of 22 April 2016, **R 17/14**, **R 6/16**, **R 25/22**). The Enlarged Board specified in **R 25/22** that, in order to establish whether the disputed finding by the board was decisive for its final decision, their decision as a whole had to be examined in the light of the totality of the facts as derivable from the file, in particular the facts and arguments submitted by the parties, as well as the board's preliminary observations on the argued issues.

In **R 22/10** the Enlarged Board held, referring to the jurisprudence of the boards of appeal, that such a necessary causal link does not exist when, even if a procedural violation can be demonstrated, the same decision would have been taken for other reasons (see also **R 19/09** and **R 5/22**).

In **R 8/16** the Enlarged Board held that an alleged violation could not be fundamental, in the sense of intolerable, if it did not cause an adverse effect (see also **R 25/22**). In the case in hand the Enlarged Board stated that the omission of the reasons for the admission of the main request may not be a practice which it expressly endorsed but given that the petitioner did not explain and the Enlarged Board itself could not see what adverse effect might have been caused by not hearing the petitioner on this issue, and given that the admission of the petitioner's main request was clearly a positive result for the petitioner, it was not seen as a fundamental violation of Art. 113(1) EPC.

4.3.3 No prior assessment of the merits of a submission

The right to be heard is a fundamental right of the parties which has to be safeguarded irrespective of the merits of a submission. The necessity to respect it is absolute and cannot be made dependent on a prior assessment of the likelihood that the petitioner's arguments would have convinced the board (**R 3/10**, **R 5/13**). In the context of review proceedings the Enlarged Board is not entitled to go into the merits of a party's case. It is

not entitled to assess whether or not and to what degree, if any, a party's standpoint which it alleges it would have taken had it been given the opportunity to present it, would have been well-founded (**R 3/10**).

In **R 21/11** the Enlarged Board stated that it could not be ruled out that a different decision would have been reached if the party had been heard on the point on which it alleged its right to be heard had been infringed.

4.3.4 Objective approach – board's intention irrelevant

In **R 3/10** the Enlarged Board held that when determining whether a fundamental violation of the petitioner's right to be heard had occurred, an objective approach must be applied. It is therefore not relevant that it was not the deciding board's intention in any way to deprive the petitioner of its right to be heard orally on the issue of inventive step.

4.3.5 No obligation to provide detailed reasons for a decision in advance

It is settled case law that a board of appeal is not required to provide the parties in advance with all foreseeable arguments in favour of or against a request (**R 1/08** with reference to **G 6/95**, OJ 1996, 649; see also **R 13/09**, **R 18/09**, **R 4/13**, **R 5/15**, **R 6/16**, **R 9/18**, **R 25/22**). In other words, parties are not entitled to advance indications of all reasons for a decision in detail (see e.g. **R 12/09** of 15 January 2010, **R 15/09**, **R 4/11**, **R 18/12**, **R 2/13**, **R 9/14**, **R 7/15**, **R 8/17**, **R 14/21**, **R 20/22**, **R 4/23**). Thus, the right to be heard does not go so far as to impose an obligation on a board to disclose in advance to the parties how and why, on the basis of the decisive issues under discussion, or at least those foreseeable as the core of the discussion, it will come to its conclusion. This is part of the reasoning given in the written decision (see e.g. **R 8/17**, **R 4/23**).This principle also applies to the application of the problem-solution approach and even identification of an objective problem (**R 8/19**), an interpretation of a passage in the state of the art forming only part of such reasons (**R 19/11**, **R 15/12**, **R 16/13**, **R 15/21**), and to reasons of any level of generality (**R 10/17**).

In **R 8/19** the Enlarged Board held that the right to be heard in the context of the problem-solution approach meant that there should normally have been a discussion on the relevant prior art, the differences between the prior art and the claimed invention, and the technical relevance of these differences. Within the framework of what had been addressed in the course of these discussions, the deciding organ should be free to apply the problem-solution approach as it sees fit, and even identify an objective technical problem that had not been explicitly spelled out as such during the proceedings.

4.3.6 Boards' obligation to remain neutral

According to settled case law, a board must remain neutral in *inter partes* proceedings, both in its communications to the parties and in oral proceedings (**R 15/09**; see also **R 11/08**), especially when the opposing party is not present (**R 9/14**). By giving a party possible reasons to decide against its requests (**R 18/09**, **R 15/10**), by prompting a party to make further submissions (**R 9/11**, **R 3/13**, **R 17/13**), by informing a party of a possible

different interpretation of a passage in a prior art document (**R 19/11**; see also **R 18/09**), or by suggesting a possible wording of a claim (**R 4/09**, **R 22/10**; see also **R 7/14**) a board would assist a party and compromise its neutrality (see also **R 1/19**).

4.3.7 Independence of the board members

In **R 12/22** the Enlarged Board found that the right to be heard did not give a party any right to proof that a board member was sufficiently prepared – be it in the case of a substitution at short notice or in general – as exercising such a right would violate the independence of the board member concerned.

4.3.8 Parties' obligation to participate actively in the appeal proceedings

Corresponding to a board's obligation to remain neutral (see in this chapter V.B.4.3.6), parties are obliged to participate actively in the appeal proceedings (**R 2/08**, **R 6/12**, **R 12/12**), in particular in *inter partes* proceedings (**R 12/09** of 15 January 2010, **R 15/09**). Parties and their representatives are responsible for the conduct of their case and it is for them to submit the necessary arguments to support their case on their own initiative and at the appropriate time (**R 17/12**; see, by way of example, also **R 18/09**, **R 13/11**, **R 17/12**, **R 1/13**, **R 15/13**, **R 1/17**, **R 24/22**). It is for the parties to address any point they consider relevant and fear may be overlooked and to insist, if necessary by way of a formal request, that it be discussed in the oral proceedings. If then a board does not give a party the opportunity to bring forward its arguments, this may give rise to the complaint that the right to be heard under Art. 113(1) EPC has been infringed (**R 17/11**, see also **R 6/16**, **R 5/17**, **R 6/17**).

4.3.9 Reasons for a decision allegedly surprising

a) No opportunity to comment, surprising reasons

"Grounds or evidence" under Art. 113(1) EPC is understood as the essential legal and factual reasoning on which a decision is based (see chapter III.B.2.4.2 "The meaning of 'grounds or evidence'" and e.g. **R 16/13** and **R 5/22**).

While the boards are not obliged to provide the parties in advance with all reasons for a decision in detail (see in this chapter V.B.4.3.5), Art. 113(1) EPC requires that decisions may only be based on grounds or evidence on which the parties concerned have had an opportunity to present their comments. In **R 3/13** the Enlarged Board held that this implied that a party may not be taken by surprise by the reasons of a decision referring to unknown grounds or evidence (see also **R 15/09**, **R 21/10**). However, the application of principles established under the EPC should not come as a surprise (see **R 9/14**, **R 1/20**).

In **R 3/10**, **R 15/11** and **R 16/13** the petition was allowed because of surprising reasons on which the parties had not been given an opportunity to comment (see in this chapter V.B.4.3.21). On the other hand, in **R 19/11** the Enlarged Board held that there can be no denial of the right to be heard if a board of appeal, after hearing all parties in inter partes proceedings, subsequently reaches its own conclusion which is then recorded in its written

decision (see also **R 15/12**, **R 16/13**, **R 10/17**, **R 7/18**, **R 8/19**). Similarly in **R 8/19** the Enlarged Board held that the question of whether the board's reliance on an objective technical problem that had never been mentioned to the petitioner amounted to a fundamental violation of the right to be heard could not generally be answered in the affirmative. According to the Enlarged Board, in any case the objective technical problem, which had not been explicitly spelled out as such during the proceedings and which had been eventually used in the reasoning, had to be based on technical effects (or the lack of any) and the features of the invention causally linked to such effects, upon which the parties had an opportunity to comment.

In **R 6/18** the Enlarged Board found that it could not come as a surprise that the board, when deciding whether there was an unambiguous disclosure of the claimed invention, did not only consider the passage sensu stricto referred to by the petitioner but also the sentences which directly followed that passage. Parties had to be aware that in general the question of added matter could not be decided by simply relying on isolated passages of the description but required a comprehensive analysis of the application documents.

In **R 10/20**, the Enlarged Board found that – even though the board had not faulted it for not carrying out its own tests – the petitioner had had an opportunity to comment on the comparative tests in the patent by submitting the results of such tests of its own. The board had regarded the comparison made in the patent to be plausible, and so considered that sufficient evidence had been provided. That had made it incumbent on the petitioner to rebut this evidence by means of comparative tests. The Enlarged Board therefore rejected the assertion that the right to be heard had been infringed.

Referring to **R 8/13** of 15 September 2015, the Enlarged Board stated in **R 5/19** that submissions parties made (only) in writing also had to be taken into account and that appeal proceedings were conducted mainly in writing. Parties were not required to reiterate those written submissions at the oral proceedings to ensure they were taken into account in the decision.

b) Grounds not emanating from the board

Grounds or evidence within the meaning of Art. 113(1) EPC need not emanate from the board, it is sufficient if another party raises the objection (**R 2/08**; see also **R 1/08**, **R 1/13**, **R 6/16**, **R 1/20**). If the reason given in a decision corresponds to an argument put forward by the other party, the petitioner was aware of it and thus not taken by surprise (**R 4/08**, **R 12/09** of 15 January 2010; see also **R 8/14**, **R 8/19**, **R 1/20**), unless the board clearly indicated that it regarded those arguments as not convincing (**R 11/12**, see also **R 6/16**). According to the Enlarged Board in **R 1/20**, that had to apply all the more to the arguments put forward by the EPO. In its decision, the opposition division had explicitly placed the burden of proof on the petitioner. The decision under review had simply confirmed the opposition division's allocation of the burden of proof. The petitioner could have raised all issues relating to the burden of proof at the outset of the appeal proceedings.

c) Subjective surprise

A subjective surprise has no bearing on whether a party knew the issues which might be raised and had an adequate opportunity to comment thereon (**R 13/11**, **R 17/12**; see, by way of example, also **R 12/09** of 15 January 2010, **R 22/10**, **R 1/13**, **R 3/13**, **R 4/14**, **R 5/16**, **R 8/19**, **R 1/20**). What is relevant is whether a reasoning is surprising when seen objectively in light of the circumstances of the specific case (see e.g. **R 4/23**).

In **R 8/13** of 15 September 2015 the Enlarged Board held that in order to determine which subject-matter (grounds, facts and evidence) could have been expected to be discussed, and whether new facts and grounds were introduced ex officio by a board of appeal in its decision, the Enlarged Board has to check the file history (see also **R 1/15**).

In **R 8/14** the Enlarged Board held that establishing the closest prior art is part of the process of arriving at a decision and takes place only after all arguments have been heard, in the final deliberations of the board. If the closest prior art is redefined because of an amendment to a claim, the board is not obliged to address this at oral proceedings. In **R 2/16** the Enlarged Board found that there had been no need for the board hearing the case at issue to give advance notice of the objective technical problem defined in accordance with the problem-solution approach, nor to comment on whether the invention was obvious, in order to comply with the appellant's right to be heard. In its communication, the board had set out in great detail what prior art it was taking as the starting point and how it considered it to differ from the claimed invention. It had expressly stated that the issue of the problem solved would be settled at the oral proceedings and clearly specified which documents it provisionally considered relevant for assessing obviousness.

The petitioner in **R 4/16** asserted that there had been at least some confusion on its part as to the scope of the discussion. The Enlarged Board held that whether or not a petitioner might have been confused was a highly subjective matter and was not enough by itself to establish that there had been a fundamental violation of its right to be heard. The most important thing was to examine the objective evidence of how the oral proceedings had unfolded, taking into account their place within the overall context of the appeal proceedings as a whole.

d) Reasoning formed part of the proceedings

In **R 4/11** the Enlarged Board held that in order for the decision to comply with Art. 113 EPC it was sufficient that the party concerned had an adequate opportunity to present its point of view to the board before a decision was taken, that the board considered the arguments presented by the party and that the decision was based on a line of reasoning that could be said to have been in the proceedings (see also **R 11/12**, **R 18/12**). Several further cases in which the petitioner claimed that the decision under review took it by surprise have been rejected by the Enlarged Board:

In **R 7/12** the Enlarged Board found that the argument in question was "part of the appeal proceedings". See also **R 8/09** in which the Enlarged Board found that the document in question "formed part of the debate".

In **R 9/14** the Enlarged Board stated that it was sufficient that the "relevance [of a factor] became clear during the proceedings".

According to the Enlarged Board in **R 7/21** the technical board appeared to have based its decision on a line of reasoning that had been in the proceedings and thus complied with the requirements of **R 4/11**.

In **R 22/10** the Enlarged Board found that the decision did "not contain any reasons which could not be objectively foreseen".

In **R 8/13** of 15 September 2015 the Enlarged Board held that "a representative with normal experience and training could foresee what the crucial issues were for the board".

4.3.10 Timing of a decision allegedly surprising

It is not sufficient to claim that the duration of the oral proceedings resulted in a violation of the right to be heard. The petitioner must rather establish that, for reasons of lack of time, it was deprived of the possibility to defend its case properly, resulting in a decision based on grounds that it did not have an opportunity to comment upon (**R 2/12** of 17 October 2012).

In **R 14/10** the petitioner argued that it was surprised that the requests as read out would be interpreted as its final requests. The Enlarged Board held that the Chair had also read out the opponent's request "that the decision under appeal be set aside and that the European patent […] be revoked" indicated beyond any reasonable doubt that, after the closure of the debate, the board had intended to deliberate on the patentability of independent claims and that, depending on the outcome of said deliberation, it could pronounce the revocation of the patent as a whole (see also **R 7/14**).

In **R 4/12** the Enlarged Board stated that when a board, after discussing novelty, interrupts oral proceedings for deliberation, a party should be aware that the board could take a negative decision on novelty. In **R 3/10** the Enlarged Board held, however, that be surprising for a party if only novelty was discussed and a request is then rejected due to lack of inventive step (see in this chapter V.B.4.3.21).

4.3.11 Consideration of the parties' arguments in the written decision

a) Requirement to have comments considered

The right to be heard under Art. 113(1) EPC requires that those involved be given an opportunity not only to present comments (on the facts and considerations pertinent to the decision) but also to have those comments considered, that is reviewed, with respect to their relevance for the decision in the matter (**R 23/10**; see also **R 13/12**, **R 12/14**). Decisions of boards of appeal are open only to review but not to appeal, and thus not covered by R. 111(2) EPC which requires that decisions which are open to appeal be reasoned (**R 6/11**; see, however, also **R 12/10**; see also in this chapter V.B.3.4.2).

In **R 8/11** the Enlarged Board held that Art. 113(1) EPC obliged the decision-making body to allow the parties to present the necessary arguments on all essential aspects of the case, to take note of these arguments and to acknowledge them in its decision (see also **R 19/12** of 12 April 2016). In **R 8/15** the Enlarged Board stated that a party must be able to examine whether the board has afforded it the right to be heard in order to decide whether or not to file a petition for review.

In **R 4/12** the Enlarged Board held that oral remarks made by a Chair directly before a decision is pronounced do not form part of the reasons that must reflect, within certain limits, a party's arguments.

In **R 8/15** the Enlarged Board held that Art. 113(1) EPC must be interpreted more narrowly than R. 102(g) EPC. The latter requires a board to give reasons for its decision, but infringement thereof is not as such a ground for review. Reasons may be incomplete, but as long as they permit the conclusion that the board, in the course of the appeal proceedings, substantively assessed a certain point that it found it to be relevant, there is no violation of Art. 113(1) EPC (see also **R 2/18**, **R 11/21**, **R 8/23**). Confirming the approach taken in **R 8/15**, the Enlarged Board held in **R 10/18** that a board is presumed to have taken into account a party's submissions that it did not address in the reasons for its decision, meaning that, in a first step, it had taken note of them and, in a second step, considered them, i.e. assessed whether they were relevant and, if so, whether they were correct. An exception may apply if there are indications to the contrary, e.g. if a board does not address in the reasons for its decision submissions by a party that, on an objective basis, are decisive for the outcome of the case, or dismisses such submissions without first assessing them as to their correctness.

In **R 6/20** the Enlarged Board affirmed its previous decisions **R 8/15** and **R 10/18** and referred to point 1, second paragraph, of the latter's Catchword stating that Art. 113(1) EPC would be infringed if the board did not address submissions that, in its view, were relevant for the decision in a manner adequate to show that the parties were heard on them, i.e. that the board substantively considered those submissions. The Enlarged Board clarified in this regard that the requirement that "the Board substantively considered those submissions" should be given the meaning that "the Board considered the contents of those submissions", with this consideration comprising matters pertaining to admittance of facts, evidence and requests, and/or relating to substantive law, i.e. the merits of a case. Applying this approach to the case at issue, the Enlarged Board held that in view of non-admittance to the appeal proceedings of certain submissions, there had been no point in discussing their merits. See also chapters III.B.2.5. "Consideration of the parties' arguments, requests, evidence and other submissions" and III.K.3.4.2 "Right to be heard – right to have submissions taken into consideration".

In **R 10/20** the Enlarged Board endorsed the approach taken in **R 10/18** in terms of presuming that a board has taken a party's submissions into account and of how that presumption can be rebutted. It also clarified that it had to be glaringly obvious that a submission had been "objectively decisive for the outcome of the case". This followed from the fact that the review procedure under Art. 112a EPC was not as a rule aimed at

reviewing matters of substantive law, and that exceptions to this principle could only be permitted under strict conditions.

Referring to the principles set out in **R 10/18** and **R 10/20** on the extent to which the duty to give reasons could be reviewed under Art. 112a EPC, the Enlarged Board confirmed in **R 12/22** that deficiencies in the reasons were only relevant in review proceedings under the conditions of Art. 112a(2)(c) in conjunction with Art. 113(1) EPC. It was only under those conditions that the duty to state the reasons for a decision was the "correlate" of the right to comment under Art. 113(1) EPC. More generally, its "correlate" could be considered to be the right to have the comments taken into account. Contradictory reasoning could only be objected to if the contradictions were tantamount to the board not having dealt with the submissions in the grounds for its decision and this having been objectively decisive for the outcome of the case. It had to be glaringly obvious that contradictory reasoning amounted to non-reasoning, for example in that it made no sense at all.

In **R 20/22** the petitioner pointed out that the decision under review did not use the term "continuously", which term was used in the petitioner's argument, and that the absence of this term proved that the argument had not been taken into account. According to the Enlarged Board, however, it was derivable from the decision under review that the argument had been considered. Furthermore, the mere fact that the minutes of the oral proceedings before the board did not mention the petitioner's argument did not mean that the board had not duly considered the argument when taking the decision at the oral proceedings (see also **R 12/20**). Similarly in **R 8/23** the Enlarged Board noted that a board must have a considerable degree of freedom in the language it uses to refer to and summarise the documents before it. The Enlarged Board found that the omission of the word "waiver" in the board's final reference to a document that had been before it did not support a finding that the petitioner's right to be heard had been violated (see also **R 7/23**).

b) No obligation to consider each and every argument

It is not necessary to consider each and every argument of the parties in detail in a decision (**R 19/10**, **R 17/11**, **R 6/12**, **R 15/12**, **R 19/12** of 12 April 2016, **R 2/13**, **R 5/15**).

In **R 13/12** the Enlarged Board stated that while the boards have an obligation to discuss in their decisions issues and arguments to the extent that they are relevant for the decision, they may disregard irrelevant arguments (see also **R 21/10**). In **R 16/14** the Enlarged Board stated that not explicitly addressing specific points which, in the deciding organ's view, did not have to be addressed in order to arrive at an understandable decision did not mean that such points are ignored. In **R 8/16** the Enlarged Board stated that not addressing specific arguments in the decision was not necessarily a fundamental violation of the petitioner's right to be heard.

In **R 11/21** the board had not considered some arguments of the petitioner to be relevant. The Enlarged Board stated that while it might have been desirable for the considerations regarding the lack of relevance of these aspects to have been explicitly set out in the decision under review, not doing so did not amount to a deficiency in the board's

reasoning. Therefore, the Enlarged Board could not establish that the board's reasoning constituted a violation of Art. 113(1) EPC, let alone a fundamental one.

In **R 19/12** of 12 April 2016 the Enlarged Board stated that the allegedly insufficient consideration, by a board, of arguments concerning a procedural defect before the department of first instance could only constitute a fundamental violation of the right to be heard when the alleged procedural defect impacted on the decision at first instance.

In **R 8/17** the Enlarged Board held that it would have been highly questionable and contradictory for the board to have dealt in substance with an argument of a party in the written reasons after it had not allowed a discussion on it in the oral proceedings.

In **R 14/22** the petitioner was of the view that its submissions made with regard to inventive step should have been considered by the board also in any further context in which these submissions became relevant for the board's decisions. The Enlarged Board held that it was not the board's task to make the argument for the petitioner by taking the petitioner's submission out of the relevant context in which it had been presented and by elaborating on the submissions on the basis of what would be obvious and beneficial for the petitioner to argue.

4.3.12 Parties' obligation to know the case law, references to decisions

Even under the assumption that the information given by a technical board of appeal on a decision of the Enlarged Board was unclear, parties are deemed to know the case law, at least when represented by an authorised representative. Thus, a party cannot plead lack of such knowledge as an excuse (**R 4/09**).

In **R 17/09** the Enlarged Board held that reference to decisions in a decision, even decisions not cited to the party earlier in writing or at the oral proceedings, could not constitute a fundamental violation of the right to be heard.

In **R 9/14** the Enlarged Board held that a qualified professional representative can be assumed to be familiar with the analytical sequence of the problem-solution approach. Special guidance from the board is not necessary. Likewise in **R 5/16** the Enlarged Board found that a party to appeal proceedings and its professional representative should be aware of the methodology established in the case law of the boards of appeal for examining inventive step and should be prepared to submit its relevant arguments in this respect.

In **R 4/16** the Enlarged Board held that the boards might sometimes be obliged to back up a reference they made to established case law, but the onus could not be on them always to seek out specific decisions that a party had not cited in support of a position it was arguing. Were a board to do so in opposition proceedings, that would amount to its making the case for one of the parties itself, to the detriment of the other party and contrary to its duty of impartiality.

4.3.13 Normally no violation of the right to be heard where oral proceedings held by videoconference

In **R 12/22** the Enlarged Board recalled that, as held in **G 1/21**, conducting oral proceedings as a videoconference does not, in principle, constitute a violation of the right to be heard. A merely theoretical possibility of impaired communication and discussions in oral proceedings held by videoconference before a board of appeal did not amount to a violation of Art. 113(1) EPC. See also chapters III.C.8.3. "Format of oral proceedings" and III.B.2.7. "The right to be heard in oral proceedings".

4.3.14 No right to be heard separately on all requests

A party has no absolute right to be heard separately on each and every one of its auxiliary requests. The right to be heard is satisfied if a party had the opportunity to comment on the grounds for a decision on the main request, and the remaining requests are not allowed on the same grounds (**R 6/11**; see also **R 11/08**, **R 14/10**, **R 3/12**, **R 2/14** of 22 April 2016, point 11 of the Reasons).

4.3.15 No right to a further hearing at first instance

In **R 9/10** the Enlarged Board held that there is no right to a remittal, only a discretion which may or may not be exercised in a party's favour under Art. 111(1) EPC and which is the subject of considerable case-law. If there is no right to a remittal, there is no right to a further hearing before the first instance. See also **R 12/09** of 15 January 2010, **R 2/16**, **R 7/16**.

In **R 7/16** the board of appeal found that the decision of the opposition division presented a fundamental deficiency, but decided not to remit the case to the opposition division, exercising its discretion under Art. 11 RPBA 2007. The petition was based upon an alleged insufficiency of reasoning in the written decision. The Enlarged Board commented that a detailed discussion of the substantive issues before a decision on the remittal would have rendered any remittal pointless since the first instance would have been bound by the considerations of the board of appeal or could have expected that its decision would be reversed if it was not in line with the considerations of the board of appeal. The refusal of a remittal cannot per se be a ground for allowing a petition.

4.3.16 No right to a referral under Article 112 EPC

The right to be heard is not infringed if a board decides, after having heard the parties, not to refer a particular question to the Enlarged Board (**R 8/11**; see also **R 17/14**).

4.3.17 No right to a communication; communication allegedly misleading

The communication of a board, if any, is a means at the board's disposal to streamline the appeal proceedings and above all the oral proceedings. Not issuing a communication does not constitute a violation of the right to be heard (**R 16/09**). In **R 14/12** the Enlarged Board

stated that if a board decided not to issue a communication, it could be assumed that it regarded the whole file as relevant for discussion at the oral proceedings.

In **R 3/09** the Enlarged Board noted that discrepancies between a board's provisional opinion as expressed in a communication preparing oral proceedings and its analysis in its final decision was in itself not a fundamental procedural defect.

In **R 3/16** the Enlarged Board held that a petitioner is itself responsible for not having attended the oral proceedings where the alleged ambiguity of a communication could have been dispelled. A petitioner is free not to attend the oral proceedings but this choice is at its own risk since a board is never obliged to postpone oral proceedings only because a party does not appear, provided that it bases its decision on the facts and arguments on file (R. 115 EPC and Art. 15(3) RPBA). See also chapter III.B.2.8.3 "Non-attendance at oral proceedings before the boards – Article 15(3) RPBA".

4.3.18 Late-filed submissions – boards' discretion under Article 13 RPBA 2007

In **R 16/09** the Enlarged Board saw no legal basis for an obligation to hear a party on substantive issues before deciding on the admissibility of a proposed auxiliary request. In the proceedings under review the petitioner had expressed its intention to present an auxiliary request in the closing stages of the oral proceedings without having prepared a set of amended claims. The Enlarged Board stated that requiring a board to always invite a party to supply a text of amended claims before a decision on the admissibility of a proposed auxiliary request is taken, would deprive it of the discretion explicitly provided by Art. 13 RPBA 2007.

In **R 5/11** the Enlarged Board held that the mere fact that a board takes into account the lateness of an auxiliary request when exercising its discretion under Art. 13 RPBA 2007 – although it did not explicitly raise this issue in the oral proceedings – does not infringe the right to be heard.

4.3.19 Alleged violation of Article 113(2) EPC

Art. 113(2) EPC does not give any right to an applicant in the sense that the EPO is in any way bound to consider a request for amendment put forward by the applicant. The effect of this provision is merely to forbid the EPO from considering and deciding upon any text of an application other than that "submitted to it, or agreed, by the applicant or proprietor" (**G 7/93**, OJ 1994, 775). See also **R 10/08**, **R 11/11**).

In **R 10/08** the Enlarged Board stated, citing **G 12/91** (OJ 1994, 285), that the moment a decision is pronounced is not the last moment at which parties may still make submissions: "This must be done at an earlier point in the proceedings to allow the decision-making department time to deliberate and then to issue its decision based on the parties submissions". Even if the debate could be re-opened in exceptional cases, the parties have to expect that, as long as it is not re-opened, a decision can be given after deliberation.

In **R 8/16** the petitioner alleged a fundamental breach of its right to be heard partially on the basis that the decision of the board did not explain what had happened to requests withdrawn and replaced by the petitioner before the final decision of the board. The Enlarged Board held that giving reasons on withdrawn requests might well have given rise to an objection under Art. 113(2) EPC.

4.3.20 Further examples of unsuccessful petitions

In **R 17/13** the Enlarged Board stated that if a party informed the board that it would not be attending the oral proceedings and the case was then **decided in the party's absence**, the party's right to be heard was not infringed.

In **R 16/12** the Enlarged Board found that the **principle of efficiency** required a board of appeal to focus on what is relevant for the decision. If a case can be decided on the basis of sufficiency of disclosure, discussing any other ground such as inventive step would concern an obiter dictum.

In **R 4/12** the Enlarged Board stated that the assertion that the petitioner learned during the break in the oral proceedings, from a **third party** who had presented himself as the examiner who had taken the decision, that its appeal was going to be dismissed, had no bearing on an alleged infringement of the right to be heard.

In **R 21/09** the Enlarged Board found that **national judgments and documents submitted in national proceedings** may be introduced into appeal proceedings. Accepting such documents as evidence – to be freely assessed by the board – does not, as such, violate the right to be heard.

In **R 10/08** the Enlarged Board stated that if the **Chair deviated from the procedure provided for in Art. 15(5) RPBA 2007** by not stating the requests before closing the debate, this omission had not affected the petitioner's right to be heard under Art. 113(1) EPC in the case in hand, in that it had had sufficient opportunity to present its comments on the grounds and evidence on which the decision of the board of appeal was based.

In **R 3/08** (referring to **G 4/95**, OJ 1996, 412) the Enlarged Board stated that oral **submissions made by an accompanying person** were under the discretionary control of the EPO. The Enlarged Board found that the denial of a request – made shortly before the oral proceedings – for an accompanying person to present oral submissions (requiring interpretation) was not a fundamental violation of Art. 113(1) EPC.

In **R 12/22** the Enlarged Board held that a merely abstract breach of the conditions laid down in **G 4/95** for the admission of submissions by an accompanying person could not be decisive when examining whether the right to be heard had been violated. That right related to having an opportunity to respond appropriately to the content of specific statements, not to the right to have this content presented by an accompanying person entitled to make detailed submissions under the supervision of a professional representative.

4.3.21 Successful petitions under Article 112a(2)(c) EPC

In **R 7/09** the petition was allowed, as the EPO was not able to establish delivery of the opponent's statement of grounds of appeal to the patentee and subsequent petitioner. The petitioner had therefore been **unaware of the grounds** on which the decision of the board of appeal revoking its patent was based. The fact that the statement of grounds became available to the public and, thus, also to the petitioner by way of electronic file inspection had no bearing on the right of parties to be individually and specifically informed by the EPO.

Similarly, in **R 4/17** the petitioner argued that it had no record of ever having received the notice of appeal or statement of grounds for appeal and that it had **no knowledge of the existence of the appeal** until it received the decision in the appeal case. The EPO was not able to establish that the critical communications had reached their destination, as required under R. 126(2) EPC. The Enlarged Board held that parties must be able to rely on the EPO complying with the relevant provisions of the EPC and, at least for the purposes of Art. 113(1) EPC, they and their representatives have no duty to monitor the proceedings themselves by regularly inspecting the electronic file. It cannot be expected that the respondent should prove a negative, i.e. the non-receipt of a letter, or provide a plausible explanation for non-receipt (see also in this chapter V.B.3.13. "Burden of proof").

In the inter partes proceedings under review in **R 3/10** the Chair had stated after the parties' submissions on novelty "that the Board will decide on patentability". The board then closed the debate and held that the main request was novel but lacked an inventive step. According to the Enlarged Board, the term "patentability" covered a variety of potential objections and the Chair could not have meant to address all of them. Thus, the **petitioner had no reason to assume that the board's decision would address more than what had been previously discussed**, i.e. novelty. As the petitioner had not been given the opportunity to comment on inventive step, the Enlarged Board allowed the petition (see also chapter III.B.2.6.1 "Decision could not be expected").

In the ex parte proceedings under review in **R 15/11** the board had held that the request did not comply with the requirements of Art. 84 EPC. According to the Enlarged Board, there was **no explicit or implicit indication in the file** of the appeal procedure from which it could be derived **that a possible lack of clarity was at any time discussed** with the petitioner or that at least an objection was raised in this respect. The Enlarged Board allowed the petition and held that a minimum prerequisite for an opportunity to comment on a specific ground (here: Art. 84 EPC) was that the petitioner was aware or could have been aware that compliance with that ground was at issue. A statement in the communication concerning a potential discussion of, inter alia, Art. 84 EPC did not amount to a specific objection regarding the request at issue.

In the inter partes proceedings under review in **R 16/13** the petitioner had filed a document with comparative test results. In its written decision, **the board of appeal raised an issue that had not been raised in the proceedings** and it had not been possible for the petitioner to infer the board's reasoning, on the basis of its own expertise, from the way the proceedings developed. The Enlarged Board allowed the petition, stating that the right

to be heard is violated when a board gives, ex officio, reasons in its decision without having given the party adversely affected an opportunity to comment on these reasons or to submit new requests. In **T 1378/11** the board stated that **R 16/13** could not be understood to give the parties the right to find out from the deciding body how it assesses the facts and arguments on which its decision is likely to be based.

In the inter partes proceedings under review in **R 2/14** of 22 April 2016, the Enlarged Board noted that the board's decisive line of argument had concerned the aspect of modifying the inactive SEQ ID NO: 4 by means of recloning the desaturase, starting from E. gracilis. The reasons given by the board were limited in so far as, after establishing the need for recloning, it had immediately stated its conclusion that, although the skilled person could in fact perform each of the necessary steps, combining those steps created an undue burden for them. The other two **alternative approaches relied upon by the petitioner had not been discussed at all by the board**; they had merely been referred to as suffering from the same negative conclusion. The board had mentioned neither facts nor a sequence of arguments that had led it to this conclusion. Therefore, it could not be understood and reproduced by the affected party. The Enlarged Board allowed the petition.

In **R 3/15** the Enlarged Board set aside the inter partes decision under review on account of a breach of the right to be heard. The **board had reformulated the problem** based on a **new interpretation** of claim 1, **presented for the first time** in the written reasons for its decision, that none of the parties had previously made a case for, either in the opposition or the appeal proceedings. It was apparent from the parties' submissions that not only the appellant but also the respondents had assumed a different interpretation of claim 1 in the discussion on feature (ii). Thus the appellant had been surprised by the board's new line of argument on inventive step in its written decision, on which it had not had an opportunity to comment. That was a breach of the right to be heard (Art. 113 EPC).

In **R 5/19** the Enlarged Board decided that the opponent's petition for review based on a violation of the right to be heard (reason for the decision surprising) under Art. 113(1) EPC was well-founded. The opponent had based the request for review, inter alia, on a fundamental violation of the right to be heard, which had resulted from the fact that the board of appeal had, without prior notice, surprisingly disregarded all the inventive-step attacks raised in writing in the statement of grounds of appeal. According to the decision under review, the written arguments had not been taken into account because the problem-solution approach had not been used. Thus, the decision had been based on a ground on which the opponent had not been able to comment before taking note of it.

4.4. Article 112a(2)(d) EPC – any other fundamental procedural defect

Under R. 104 EPC, a fundamental procedural defect may have occurred where the board of appeal, contrary to Art. 116 EPC, failed to arrange for the holding of oral proceedings requested by the petitioner, or decided on the appeal without deciding on a request relevant to that decision. What is not defined by the Implementing Regulations does not qualify as a procedural defect within the meaning of Art. 112a(2)(d) EPC (**R 16/09**, **R 10/20**, **R 12/22**; see in this chapter V.B.3.5.2).

4.4.1 Rule 104(a) EPC – failure to arrange requested oral proceedings

The right to oral proceedings under Art. 116(1) EPC forms a substantial part of the right to be heard under Art. 113(1) EPC. Non-compliance with a request for oral proceedings deprives the party of an important opportunity for presenting its case (**T 1050/09**) and may constitute a fundamental procedural defect which merits the same treatment as the cases covered by Art. 112a(2)(a) to (c) EPC (CA/PL 5/02 Rev. 1 Add. 1, p. 26).

In **R 2/12** of 17 October 2012 the petitioner argued that R. 104(a) EPC should be understood not only as an obligation to arrange oral proceedings but also to give the parties enough time to exercise their right to be heard. The board held that the duration of oral proceedings is, as such, not listed among the procedural defects that might justify filing a petition for review (see also **R 21/10**).

4.4.2 Rule 104(b) EPC – failure to decide on a party's request

According to R. 104(b) EPC, a fundamental procedural defect under Art. 112a(2)(d) EPC may have occurred where the board decided on the appeal without deciding on a request relevant to that decision. Like R. 104(a) EPC (see in this chapter V.B.4.4.1), R. 104(b) EPC also reflects an aspect of the right to be heard (**R 21/11**).

In **R 19/10** it was acknowledged by the Enlarged Board that the EPC does not contain an explicit definition of the term "request". However, according to the common practice in the proceedings before the EPO, requests are in general directed to executable legal consequences sought by the parties. The arguments provided by the parties in support of these legal consequences do not normally belong to the legally binding requests (see also **R 17/11**, **R 6/22**). In **R 6/22** the Enlarged Board explained that the fact that an argument is decisive for the particular case did not make it a "relevant request" under R. 104(b) EPC. According to the Enlarged Board, the relevant procedural request in the case in hand, which had been directed to the admittance of the auxiliary request, had been duly decided on by the board.

In **R 3/14** the Enlarged Board explained that only requests submitted in writing or requests which the party had been recorded in the minutes of the oral proceedings fell under R. 104(b) EPC (see also travaux préparatoires, CA/PL 5/02 Rev. 1 Add. 1, p. 27). In **R 19/10** the Enlarged Board further held that it was not a procedural duty of the boards of appeal under R. 104(b) EPC to analyse the submissions of the parties in order to identify potential requests which were not explicitly made (see also **R 17/11**). In **R 14/10** the Enlarged Board confirmed that, if a party's request is unclear, it is the duty of the deciding body to ask for clarification before deliberation (see also **R 7/14**). However, if the requests as read out by the Chair in conformity with Art. 15(5) RPBA 2007 do not correspond to a party's intention, it is that party's duty to intervene at that point. In **R 12/14** the Enlarged Board stated that if a party submits written requests which the board is entitled to regard as the party's final requests under Art. 15(5) RPBA 2007, the board can also safely assume that these requests are complete.

In **R 18/22** the petitioner based its petition inter alia on R. 104(b) EPC, claiming that the board had decided on the appeal without deciding on requests relevant to that decision. The petitioner did not identify which of its requests had not been decided upon. Since the Enlarged Board itself was unable to identify any such requests, it concluded that the petition for review was clearly unallowable in this regard. See also **R 2/23**.

A request "relevant to that decision" within the meaning of R. 104(b) EPC is a request that could possibly have led to a different decision (**R 21/11**). See also **R 3/22** in chapter V.B.4.4.3.

In the proceedings under review in **R 17/13** the petitioner requested remittal of the case coupled with reimbursement of the appeal fee on the grounds of a substantial procedural violation, alternatively that the patent be maintained as granted, and finally oral proceedings. The board held oral proceedings and refused the request for maintenance of the patent and for reimbursement of the appeal fee. The Enlarged Board held that the petitioner's request for remittal was only relevant in the event of there having been a substantial procedural violation, which was held not to be the case.

In **R 15/09** the Enlarged Board held that a decision to revoke a patent necessarily includes the rejection of all auxiliary requests.

In the appeal proceedings under review in **R 13/14** the appellant had requested that the examining division's refusal of its request to hold oral proceedings in Munich instead of in The Hague be set aside. The board had stated, in the reasons for the decision, that it was not empowered to decide on this request. The Enlarged Board held that this statement, even if not expressed in the usual and formal terminology, had to be considered as a decision on the appellant's request.

In **R 10/08** (see also **R 6/14**), the Enlarged Board referred to **G 12/91** (OJ 1994, 285) and stated that the last point in time to intervene is not the moment a decision is announced but the moment at which the Chair declares the debate closed for deliberation. The petitioner should then have requested that the debate be re-opened if it intended to file a further request. Whether the petitioner intervened during or after the announcement of the decision is not relevant.

In **R 11/08** the Enlarged Board dismissed the petitioner's allegation that the board had not ruled on a request which it had considered too general.

In **R 16/14** the Enlarged Board held that since the condition underlying conditional request (iii) in the proceedings under review (namely, that the board of appeal took the position that an examining division had the option to ignore arguments advanced by an applicant) was not met, the petitioner's allegation that conditional request (iii) had become relevant again for the written reasons of the decision under review and should have been decided upon did not hold. As a consequence, the Enlarged Board held that the claim of infringement of R. 104(b) EPC must be dismissed.

4.4.3 Successful petition under Rule 104(b) EPC

In **R 21/11**, the petitioner (patentee) claimed that the board had decided on the appeal without deciding on a request for admission of a second expert testimony filed by fax. The Enlarged Board found that R. 104(b) EPC was a specific manifestation of the right to be heard which applied regardless of whether the party's submission might have persuaded the board. The argument that the undecided request was irrelevant because its admission would not have made a difference could only be accepted if it could be shown that all aspects "lost" as a result of its non-admission had been taken into account in the decision under review. According to the Enlarged Board, the procedural defect asserted by the petitioner constituted an infringement of its right to be heard, both under Art. 112a(2)(d) EPC in conjunction with R. 104 EPC and under Art. 112a(2)(c) EPC in conjunction with Art. 113(1) EPC. While the petitioner had argued that this infringement consisted in the board's failure to take account of the second testimony in its decision, the Enlarged Board saw the infringement in the board's failure to consider the request for its admission. Had that request been granted, it could have influenced the outcome. There was therefore a causal link between the denied opportunity to comment and the board's decision (see in this chapter V.B.4.3.2). The contested decision was set aside.

In **R 3/22**, the applicant had requested correction of a withdrawal of the appeal under R. 139 EPC. The Registrar informed the appellant in a communication that, following the appellant's withdrawal of the appeal, the appeal proceedings before the board had been terminated and the board was no longer competent to deal with the case. The Enlarged Board interpreted the Registrar's communication as a decision in which the board implicitly decided on the appeal, while not deciding on the request for correction (see in this chapter V.B.3.4.2 and chapter III.K.3.1.). The request for correction, i.e. the retraction of the withdrawal of the appeal filed after its withdrawal, was a relevant request within the meaning of R. 104(b) EPC for the purposes of Art. 112a(2)(d) EPC. According to the case law of the boards of appeal on R. 139 EPC (see chapter V.A.7.3.7), the success of such a request cannot be ruled out a priori, and if the request is successful, a decision on the merits of the appeal would be possible. For this reason, the Enlarged Board held that the board's refusal to decide on the request for correction under R. 139 EPC in the case at issue was a fundamental procedural defect within the meaning of Art. 112a(2)(d) EPC, and that the petition was allowable.

4.5. Article 112a(2)(e) EPC – criminal act having an impact on a decision

Under Art. 112a(2)(e) EPC, a petition for review may be based on the ground that a criminal act may have had an impact on a decision. A competent court or authority must have finally established that the criminal act occurred; a conviction is not necessary (R. 105 EPC). Deviating from the general rule, the time limit for filing the petition is two months after the criminal act has been established, and in any event not later than five years after notification of the decision (Art. 112a(4) EPC).

In **R 2/10** the petitioner referred to alleged criminal acts which had, however, not been established by a criminal court or authority. The Enlarged Board rejected the petition as clearly inadmissible, due to failure to observe the time limit for filing the petition.

In **R 3/21** the Enlarged Board stated that it was not empowered to act in the capacity of a criminal court or other prosecuting authority and establish criminal acts within the meaning of Art. 112a(2)(e) EPC, be it in relation to members of an examining division or board, the President of the Boards of Appeal or any other person. It also pointed out that, in its composition under R. 109(2)(a) EPC as an independent judicial body for patent grant proceedings, it had no formal supervisory duty to investigate alleged criminal offences or to transmit any criminal complaints to criminal authorities, whether on request or of its own motion.

5. Removal from office of a board member

5.1. General

According to Art. 23(1) EPC, first sentence, members of the Enlarged Board and the boards of appeal may not be removed from office during their term of appointment, except if there are serious grounds for such removal and if the Administrative Council, on a proposal from the Enlarged Board, takes a decision to this effect. According to Art. 12a RPEBA, the Administrative Council or the Vice-President of the EPO in charge of the Boards of Appeal (since the structural reform in 2016, the Boards of Appeal are now organised as a separate unit directed by the President of the Boards of Appeal) may make a request to the Enlarged Board to make a proposal, to the Administrative Council, for the removal from office of a board member.

5.2. Composition

According to Art. 2(5) RPEBA (see also Art. 10 BDS/EBA), the Enlarged Board in proceedings under Art. 23(1) EPC consists of five legally and two technically qualified members. The Chair of the Enlarged Board who is, under current practice, also President of the Boards of Appeal, must be replaced by their alternate, and two of the legally qualified members must be external members of the Enlarged Board (see Art. 11(5) EPC).

In **G 2301/15** the Enlarged Board held that the arrangements laid down in Art. 2(5) RPEBA and Art. 10 BDS/EBA for the composition of the Enlarged Board in proceedings under Art. 23(1) EPC were compatible with the EPC and general principles of law. It could not be inferred from Art. 23(1) EPC that a proposal to remove a member from office must be decided by the full Enlarged Board (consisting of all internal and external members under Art. 1 BDS/EBA).

5.3. Removal and judicial independence

In **G 2301/15** the Enlarged Board stated that removing an irksome judge from office could be used to indirectly influence decisions. It was crucial to judicial independence that judges could not be removed without special institutional safeguards. The requirement that a board member may only exceptionally be removed from office on a proposal from the Enlarged Board intended to make sure that unsubstantiated or groundless allegations could not be used as pretext for getting rid of an irksome judge.

In **G 2301/16** the Enlarged Board concluded that the EPO President's procedurally irregular intervention in the form of a position statement was incompatible with the Enlarged Board's judicial independence.

5.4. Independence from disciplinary proceedings

According to Art. 12a(8) RPEBA, proceedings under Art. 23(1) EPC are to be conducted independently of any disciplinary or national proceedings. In **G 2301/15**, the Enlarged Board stated that Art. 23(1) EPC requires that the Administrative Council may apply to a board member the most severe disciplinary sanction available (dismissal) only if it has first received a proposal for their removal from office from the Enlarged Board. The administrative disciplinary proceedings before the appointing authority are separate from the judicial proceedings before the Enlarged Board, which must satisfy itself that the allegations are true, and so serious as to require the removal from office.

5.5. Adversarial judicial proceedings

In **G 2301/15** the Enlarged Board held that proceedings under Art. 23(1) EPC were to be conducted in proper judicial form. A request by the Administrative Council initiated adversarial proceedings to which the board member concerned is a party as respondent (Art. 12a(4) RPEBA). The Administrative Council's request must set out all the facts, arguments and evidence relied on; all documents referred to must be attached (Art. 12a(5) RPEBA). According to the Enlarged Board, this provision requires that the Administrative Council's request specify individual incidents and the evidence for them, and give reasons why they constitute a serious ground within the meaning of Art. 23(1) EPC. It was not be up to the Enlarged Board to define of its own motion which facts may be derived from documents and exhibits. Simply referring to facts and evidence and leaving the Enlarged Board to reconstruct the events for itself neither satisfied the requirements of Art. 12a(5) RPEBA nor the respondent's right to know the charges against him. In the case in hand, as the Administrative Council's request was not substantiated as prescribed by Art. 12a(5) RPEBA, the Enlarged Board rejected the request as inadmissible.

5.6. Publication of the decision

According to Art. 18(3) RPEBA, the final decision of the Enlarged Board in proceedings under Art. 23(1), first sentence, EPC, may be published, due regard being taken of the confidentiality of the proceedings. Case **G 2302/15** was terminated following the Administrative Council's withdrawal of its request that the Enlarged Board make a proposal for the removal from office of a board member. The Enlarged Board's decision was final in that it terminated the proceedings, albeit for non-substantive reasons. The Enlarged Board decided that the decision be published.

5.7. Reimbursement of costs

According to Art. 12a(10) RPEBA the Enlarged Board may on request propose the reimbursement of some or all costs incurred in the proceedings by the respondent if the request to make a proposal for their removal from office has been rejected (see

G 2301/15). In **G 2302/15** the proceedings were terminated following the Administrative Council's withdrawal of its request during oral proceedings. The Enlarged Board proposed the reimbursement of all costs incurred by the respondent, as the costs for preparing his defence had turned out to be unnecessary as a result of the withdrawal.

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1. Introduction

Representation of natural or legal persons in proceedings established by the EPC may only be undertaken by professional representatives whose names appear on a list maintained for this purpose by the EPO (Art. 134(1) EPC). Any natural person who is a national of a contracting state, has their place of business or employment in a contracting state and has passed the EQE may be entered on the list (Art. 134(2) EPC; see also Art. 134(3) EPC). Legal practitioners from the contracting states are also entitled to act as representatives, subject to certain conditions (Art. 134(8) EPC), and persons resident or having their principal place of business in a contracting state may authorise an employee to represent them (Art. 133(3) EPC).

Article 134a EPC, introduced under the EPC 2000, incorporates the substance of Art. 134(8) EPC 1973 and anchors in the EPC the existence of the epi, which was set up under the Regulation on the Establishment of an Institute of Professional Representatives before the EPO (OJ 1978, 85; as amended: OJ 1997, 130 and 350, OJ 2002, 429, OJ 2004, 361 and OJ 2007, 12).

All persons on the list of professional representatives must be members of the epi (Art. 134a(2) EPC; Art. 5(1) of the aforementioned Regulation). They are subject to the RDR (Supplementary publication 1, OJ 2024, 145, consolidated version of the text as published in OJ 1978, 91; as amended: OJ 2008, 14; OJ 2018, A57; see also Art. 134a(1)(c) EPC) and to the epi Code of Conduct (OJ 2022, A61).

The first-instance bodies which rule on infringements of the rules of professional conduct are the epi Disciplinary Committee and the EPO Disciplinary Board (Art. 5 RDR; see also Additional Rules of Procedure of the Disciplinary Committee and those of the Disciplinary Board, Supplementary publication 1, OJ 2024, 156 and 166, consolidated version of the texts published in OJ 1980, 177 and 183 respectively, with amendments published in OJ 2007, 552). The DBA hears appeals against decisions of both these bodies (Art. 5, 8 RDR; see also RPDBA, Supplementary publication 1, OJ 2024, 70 (consolidated version of the text published in OJ 1980, 188 with amendments published in OJ 2007, 548). DBA decisions on disciplinary matters are reported in this chapter V.C.3. to V.C.5.

For further information on representation before the EPO, see chapter III.V.

The EQE, referred to in Art. 134(2)(c) EPC, is governed in particular by the REE (version in force from 1 January 2025, OJ 2024, A4) and the IPREE (OJ 2024, A25), subject to Art. 27(2) REE and R. 29(2) IPREE (see in this chapter V.C.2.). The DBA hears appeals against decisions of the EQE Examination Board and the Secretariat (Art. 24 REE). DBA decisions in EQE cases are reported in this chapter V.C.2. Appeals decided under earlier provisions of the REE and IPREE are referred to if considered still relevant.

2. European qualifying examination

The EQE is designed to establish whether a candidate is qualified to practise as a professional representative before the EPO (Art. 1(1) REE). In principle, only persons who

have passed the EQE may be entered on the list of professional representatives (Art. 134(2)(c) EPC; see also Art. 134(3) EPC). The EQE is held online, with the same papers being made available to candidates simultaneously (Art. 20 REE).

On 14 December 2023 the Administrative Council of the EPO unanimously approved amendments to the REE then in force for the purposes of launching a new EQE in 2025 (OJ 2024, A4). Unless otherwise provided in Art. 27(2) REE (see below), the 2025 version replaced the REE in force from 1 January 2009, OJ 2009, 9 ("REE 2009"). The IPREE (OJ 2024, A25) entered into force on 1 January 2025 and, unless otherwise provided in R 29(2) IPREE, replaced the IPREE as adopted on 13 December 2018 ("IPREE 2018", Supplementary publication 2, OJ 2019, 18).

Changes included the gradual introduction of five new modules (F, M1, M2, M3 and M4) between 2025 and 2027 (Art. 1(5) and 27(2) REE), changes to the conditions for registration and enrolment, in particular to the periods of professional activity required before taking the examination (Art. 11 REE) and removal of the compensable fail. The REE includes transitional provisions (Art. 25 REE). Unless otherwise stated, references to the REE and IPREE in this chapter are to the 2025 version.

This chapter V.C.2. includes summaries of or references to decisions which were issued in writing in the period up to the end of 2024. It follows that versions of the REE and IPREE earlier than 1 January 2025 apply to these decisions. Moreover, Art. 27(2) REE provides that the REE 2009 and IPREE 2018 will continue to govern specific EQE papers until the end of 2026. From 2027, all EQE papers will be sat in accordance with the REE and IPREE.

2.1. Formalities and conditions for registration and enrolment

The Examination Secretariat decides on the registration and enrolment of candidates in accordance with the REE and the IPREE (Art. 9(2)(c) REE).

In **D 4/08** the board confirmed the Examination Secretariat's strict application of the published closing date for enrolment for the EQE (Art. 20 REE 1994; see Art. 18 REE), stressing its importance for the timely and orderly preparation of the examination. According to **D 7/08**, it followed from the applicable provisions that it was the candidate's responsibility to file the complete application, including the enrolment form and all necessary supporting evidence, by the closing date (see also **D 12/08**, **D 15/09**, **D 3/18**, **D 4/18**, and R. 1(2) IPREE).

2.1.1 Required qualification or equivalent knowledge

To qualify for registration and enrolment, candidates must normally possess a university-level scientific or technical qualification, i.e. a bachelor's degree or equivalent academic degree awarded at the end of a full-time course of a minimum of three years, with at least 80% of the course hours taken to obtain this degree having been devoted to scientific and/or technical subjects (Art. 11(1)(a) REE, R. 11 IPREE, also R. 12 IPREE). The qualifying subjects include biology, biochemistry, chemistry, construction technology,

electricity, electronics, information technology, mathematics, mechanics, medicine, pharmacology and physics (R. 13 IPREE). The EQE provisions do not distinguish between applied and pure mathematics; nor does it matter if the subject is taught as part of a specialised or an interdisciplinary course (**D 5/18**).

There is no legal requirement as to the minimum number of course hours required; to establish if a candidate's degree qualifies, the legislator chose the number of years "a "minimum" benchmark easier to establish than the number of hours) and the percentage of courses devoted to technical and/or scientific subjects (**D 13/14**). The board in **D 9/14** emphasised that the 80% is always to be calculated from the required course hours for the particular degree under scrutiny (which in the case in hand required four years of study). Furthermore, as many educational establishments issue certificates indicating the awarded credits, but not necessarily the course hours, it considered that a calculation based on credits may be suitable for the purposes of R. 11(2) IPREE 2010 but that, in the case of any discrepancy between the calculations based on course hours and those based on credits, the former is authoritative. In **D 3/18**, **D 5/18** and **D 3/20** the calculation was based on course credits awarded under the European Credit Transfer and Accumulation System ("ECTS"). See also **D 4/18** and **D 2/19** (both non-ECTS cases).

Otherwise, under Art. 11(1)(a) REE and R. 14 IPREE, equivalent knowledge may be demonstrated on the basis of at least ten years' experience in the activities defined in Art. 11(2)(b)(i) or (ii) REE (as to which see the next section). The board applied R. 14 IPREE 2010 in **D 9/13** and **D 9/14**, concluding in each case that neither alternative of Art. 11(1)(a) REE was fulfilled. In cases **D 7/14** and **D 8/14**, however, the appellants had started their practical training before the REE 2009 entered into force. The DBA held that, on the basis of good faith and equal treatment, the REE 1994 with its IPREE and relevant Instructions should be applied in accordance with the Examination Secretariat's practice before 1 January 2009 (see e.g. **D 1/12**). Taking into account in particular **D 5/08** regarding the 1994 Instructions, the board was satisfied in both cases that the appellant was suitably qualified under the 1994 provisions. Other decisions on the qualifications required under the REE 1994 are **D 15/04**, **D 17/04**, **D 18/04**, **D 8/04** and **D 10/08**.

See also **D 3/20**, according to which the Secretariat was correct in admitting the appellant to the EQE only under Art. 11(2)(a) REE 2009 and R. 11(3),14 IPREE 2018, and in finding that the requirements of Art. 11(1)(a) REE 2009 and R. 11(1), (2) IPREE 2018 were not fulfilled.

2.1.2 Professional experience

A further requirement for enrolment is that at the date of the examination a candidate must have completed a period of professional activity as set out in Art. 11(2) to (5) REE and R. 15 IPREE. The period may be reduced by six months for candidates who have successfully completed specialised studies of at least one academic year in the field of industrial property (R. 16(1) IPREE).

One way of acquiring this work experience is to complete a training period under the supervision of and as an assistant to one or more professional representatives before the

EPO, in accordance with Art. 11(2)(b)(i) REE. According to **D 4/86** (OJ 1988, 26), to comply with the equivalent provision (Art. 7(1)(b)(i) REE 1977, as amended), the trainee had to have completed their training period under conditions likely to ensure that they had actually assisted a professional representative by constantly taking part in activities pertaining to patent application procedures of which the representative was in fact in charge. **D 14/93** (OJ 1997, 561) ruled that the training period could not be served with a legal practitioner whose name did not appear on the list of professional representatives, even if the said practitioner was a patent attorney under national law (see Art. 134(7) EPC 1973; cf. Art. 134(8) EPC). The activities referred to in Art. 7(1)(b) REE 1991 presupposed the scientific or technical knowledge required for activities pertaining to European patent applications and patents; persons training EQE candidates needed to possess such knowledge, and legal practitioners did not normally do so. **D 25/96** (OJ 1998, 45) ruled that the period of professional activity required for the EQE enrolment could not be served with a self-employed German patent agent who was not on the list of professional representatives.

A candidate may alternatively complete the prescribed period of professional activity as an employee, in accordance with Art. 11(2)(b)(ii) REE (also in the 2009 version). The relevant conditions are not met where the candidate's employer is not represented before the EPO by the candidate in accordance with Art. 133(3) EPC but by external patent attorneys, or where the candidate's main activity has been in the field of national or international applications and patents (**D 6/10**, with reference to **D 12/06** and **D 13/06**; see also **D 11/11**, with reference to **D 32/07**; furthermore **D 1/12** to **D 4/12**). Given the tenor of Art. 11(2)(b)(ii) REE, (mere) professional activity and activities pertaining to patent law cannot be treated as two distinct requirements. Professional activity can be recognised only if and for such time as candidates were able to represent their employer before the EPO and in fact did so. They must have been authorised to act as representative by their employer, but formal authorisation is not enough by itself, as it does not show whether, as required, they have actually worked in that capacity (**D 1/13**).

In **D 16/04** the board confirmed that the Examination Secretariat's practice of allowing only periods of professional activity completed after the required degree was obtained was not in conflict with Art. 10 REE 1994. Article 10(1) REE 1994 mentioned the requirement of possessing a university-level scientific or technical or equivalent qualification first, followed by a reference to the conditions set out in paragraph 2, i.e. the three-year full-time training period to be completed by the date of the examination. The required length of the training period was a consequence of the candidate's technical or scientific degree acquired before starting the training period rather than vice versa. See also **D 6/08**. This is now a requirement under Art. 11(3) REE, which, in conjunction with R. 15(2) IPREE, also specifies how periods of professional activity may be aggregated to make up a full-time training period.

The period under Art. 11(2)(a) REE may be reduced by up to one year if a candidate has been a patent examiner at the EPO or the national patent office of a contracting state (R. 16(2) IPREE).

The required professional experience can also be acquired by performing full-time work as an examiner at the EPO (Art. 11(2)(b)(iii) REE). In **D 19/04** the board pointed out that corresponding provision Art. 10(2)(b) REE 1994 related to EPO examiners, who in view of their professional experience could be assumed to have a comprehensive knowledge of the European patent grant procedure. The professional experience of long-serving examiners in national offices could not be equated with that of EPO examiners.

2.2. Examination conditions – principle of equal treatment

It is established case law of the DBA that equal treatment of candidates is an issue which may be the subject of appeals under Art. 24(1) REE (see e.g. **D 8/21,** reported in this chapter V.C.2.2.3). The principle of equal treatment requires that candidates take part in the examination under equal conditions. Consequently, unequal conditions which may cause unjustified disadvantages for candidates should be compensated for, to the extent feasible (see e.g. **D 29/21**, also reported in this chapter V.C.2.2.3). However, only candidates who have in fact been treated unequally to their disadvantage in comparison to other candidates can invoke unequal treatment (**D 37/22**).

2.2.1 Application of the European qualifying examination language rules

The EQE papers are drawn up in the three official languages of the EPO and all candidates receive them in all three languages (Art. 12(1) REE). Candidates may, if they so request when enrolling for the examination, submit their answers in an official language of a contracting state which is not an official language of the EPO (R. 5(1) IPREE).

In **D 1/94** (OJ 1996, 468) the board ruled that a translation error could constitute a violation of Art. 11(3) REE 1991 (see Art. 12(3) REE, R. 5 IPREE), since this provision assumed a totally correct translation into an EPO language from the official language of a contracting state selected by the candidate for his answers. In its decision, the Examination Board therefore had to give reasons why the translation errors had not been found to be serious.

In **D 2/95** an argument that candidates whose mother tongue was not an EPO official language were at a disadvantage and should therefore be given more time did not convince the DBA that this amounted to an infringement of the relevant provisions. Similarly, in **D 9/96** the appellant submitted that the linguistic regime of the REE contravened the principle of equal treatment of candidates. The board recalled that decisions of the Examination Board may in principle only be reviewed for the purpose of establishing that they do not infringe the REE, the provisions relating to its application or higher-ranking law (Art. 27(1) REE 1994; **D 1/92**, OJ 1993, 357; **D 6/92**, OJ 1993, 361; see also Art. 24(1) REE). It conceded that not all candidates were treated equally since not all received examination papers in their mother tongue. However, this differentiation was a direct consequence of the linguistic regime of the EPC 1973. The official languages of the EPO were English, French and German (Art. 14(1) EPC 1973). Each professional representative was inevitably confronted with documents and notifications in one of those languages and thus had to be expected, in the public interest and the interest of their clients, to understand at least one of them and be able to work on documents and notifications drafted in it. See also **D 11/00**. In **D 30/05** the board further drew attention to

the option for candidates to submit their answers in an official language of a contracting state which is not an EPO official language (Art. 15(3) REE 1994; see. Art. 12(3) REE, R. 5(1) IPREE).

2.2.2 Online examination

In **D 37/21**, the appellant alleged that the Examination Board had failed to take into account systematic failures of the Wiseflow software used in the examination and the resulting time loss that candidates encountered. The DBA found it plausible that the time loss caused by the closing of the lockdown browser window was not insignificant and, even if not excessively long, would have caused additional stress preventing the appellant from concentrating on the paper. The DBA provided examples of how the loss of time could be compensated, following a conservative and a more generous approach, and remitted the case to the Examination Board for re-marking (see also **D 39/22** in this chapter V.C.2.3).

2.2.3 Mark-up error and missing question

Several appeals (e.g. **D 8/21**, **D 18/21**, **D 28/21**, **D 37/21**, **D 42/21** and **D 54/21**) concerned a mark-up error in the English and German version of Paper B of the 2021 EQE. One of the features was erroneously not in bold to reflect a change made by the client. This error did not appear in the French version. According to the DBA, candidates writing the French and English or German version had to write Paper B under different conditions. These different conditions amounted to unequal treatment deserving compensation.

The background to several appeals (**D 10/97**, **D 15/97**, **D 17/97** and **D 5/97**) was that some (but not all) copies of Paper D did not contain Question 11 and that the Examination Board automatically gave all candidates full marks for that question. The DBA reaffirmed **D 14/95**, which had stated that equal treatment did not have to be absolute, provided that the nature and extent of any unequal treatment was justifiable in the circumstances. It would be wrong in law, however, if the examination conditions put certain candidates at a disadvantage for no good reason. The Examination Board had compensated the affected candidates in a way which appeared entirely appropriate. This necessarily involved a certain unequal treatment, which however was limited in its extent and acceptable in this special situation. In particular, it ensured that no candidate was worse off than if their answer had been marked objectively. The way in which the Examination Board had corrected the error did not constitute unlawfully unequal treatment.

2.2.4 Other circumstances

In **D 2/95** (see above), the fact that certain candidates had been allowed to use normal as opposed to copy paper for the examination was held not to be in breach of the provisions governing its conduct. Some candidates might find copy paper more awkward, but others might well prefer it. In fact, only two candidates had been allowed to use normal paper, for medical reasons.

In **D 14/95** the appellant was a specialist in biochemistry, whereas Paper C was taken from mechanical engineering. The board found against any breach of the principle of equal

treatment; the appellant's position was no different from that of any other candidate whose specialist field did not happen to be used in the paper as set. True, the examination procedure did in effect involve a certain "inequality". The Examination Board set a limited number of papers, and therefore had to make a choice amongst the different technical fields. So there would always be candidates who happened to be more specialised than others in the particular field selected. This however was inherent in any general examination, and thus did not constitute arbitrary unequal treatment. Furthermore, Paper C was less concerned with testing specialist technical knowledge than the ability to draft a notice of opposition to a European patent.

The appeal in **D 11/19** concerned the pilot project during the 2019 EQE session, in which 15 candidates selected at random were additionally permitted to use a laptop with a text editor during the examination. The appellant, who sat the examination under the regular conditions, submitted in his appeal that those candidates were given an unfair advantage. The board referred to the DBA's settled practice of reviewing whether the principle of equal treatment of EQE candidates has been adhered to as higher-ranking law (see **D 2/95**; **D 14/95**; **D 10/97**; **D 5/99**; **D 19/04**). It concluded that the arrangement of the pilot project was in breach of this principle because it meant that the respective groups of candidates were treated unequally without any objectively justifiable reason (see also in this chapter V.C.2.3). See also **D 15/19**.

2.3. Complaints about the conduct of the examination – duties of the Examination Board

Complaints concerning the conduct of the examination need to be submitted by the candidates at the latest on the day after the examination paper in question (R. 19(3) IPREE; under R 19(3) IPREE 2018 they had to be submitted 30 minutes after the closing signal on the final day of the examination).

In **D 17/96**, **D 2/97**, **D 2/99** and **D 3/99**, the DBA pointed out that, under the then applicable Instructions to candidates (OJ 1995, 145) and Instructions to invigilators (OJ 1995, 153; see now R. 19(3) IPREE), a timely and formally correct complaint about the conduct of the examination was to be submitted to the Examination Board, which was then to issue a provisional opinion, together with an invitation to comment. Failure to do so put it in breach of generally recognised principles of procedural law (Art. 125 EPC), notably the right to be heard (Art. 113(1) EPC).

According to **D 3/04**, the appealed decision did not show that the appellant's complaint about unsuitable conditions during the examination had been taken into consideration by the Examination Board. In the view of the DBA, where the Examination Board found the circumstances referred to in a complaint not to justify the allocation of additional marks, brief reasons should be given explaining why this was so. See now R. 19(4) IPREE and e.g. **D 12/21** and **D 26/21**. According to the board in **D 39/22**, the failure of the Examination Board to specify the exact loss of time recognised in its compensation calculation constituted a breach of the requirement to state reasons under R. 19(4) IPREE (see also in this chapter V.C.2.2.2). The DBA reached a similar conclusion in **D 26/22** and noted that

the Examination Board also failed to explain why it used the first calculation method proposed in **D 37/21** (see in this chapter V.C.2.2.2).

In **D 3/10** the appellant had raised a complaint about disturbances during the examination only with the appeal. The DBA held that it would be inadmissible to examine the alleged disturbances in the context of an appeal without any prior decision of the Examination Board in this regard. By not submitting a complaint in accordance with R. 19(3) IPREE 2009, the appellant had deprived the Examination Board of the opportunity to determine the exact circumstances involved and to react accordingly, if necessary with a decision pursuant to R. 19(4) IPREE, or to deal with the allegations in its decision on the result of the examination under Art. 6(5) REE (see **D 3/04** above).

The view taken in **D 3/10** was endorsed in **D 11/19**. However, the board went on to examine the relevance of R. 19(3) IPREE 2018 to the case in hand. This concerned the special conditions of a pilot project in which 15 EQE candidates who had been selected at random (and did not include the appellant) were additionally permitted to use a laptop with a text editor during the examination. The board found that, as the pilot was conducted in a separate location, it had no adverse effect on the conduct of the examination according to the regular procedure, and the remaining candidates could not observe that it was taking place. Therefore, R. 19(3) IPREE 2018 did not apply in the appellant's case. Moreover, since the appellant only became aware of the pilot at a later point, he could not have submitted, or reasonably have been expected to submit, an objection until filing the appeal. Indeed, in the context of the rectification procedure (Art. 24(3) REE), the Examination Board could and should have reconsidered its decision on the examination result in the light of the appellant's submissions. See also in this chapter V.C.2.2.4.

The board in **D 45/21** held that the appellant bore the burden of proof that a filing complying with the time limit in R. 19(3) IPREE was received by the EPO (see **T 1200/01**, **T 2454/11** and **T 1587/17** in chapter III.G.4.3.7 and **D 17/19**).

2.4. Setting, marking and grading

The examination committees prepare the examination papers and marking sheets (Art. 8(1)(a), (b) REE). Each answer paper or part of an answer paper is marked by the relevant examination committee and/or by autoscoring on a scale determined by the Examination Board (R. 6(1) IPREE). To pass the examination, a candidate must have passed each paper or have obtained the minimum grades as specified in the IPREE (Art. 14(1) REE, R. 6(5) IPREE). There is no "compensable fail" grade under the REE (see R. 6(3) IPREE, cf. R. 6(3)(c) IPREE 2018). A candidate who fails the examination may resit the paper or papers not passed (Art. 16(1) REE).

On the Examination Board's implied obligation with regard to preparing the examination papers and corresponding marking scheme correctly, see **D 6/13**, summarised in this chapter V.C.2.6.3. The examination committees are also expected to base their evaluations on a legally correct premise. They must apply both the Guidelines and the basic case law when assessing whether alternative solutions not covered by the examiner's report are equally suitable to render a claim novel and inventive (**D 14/23**).

One of the changes included in the REE was the gradual introduction of five new modules (F, M1, M2, M3 and M4) starting in 2025 with the introduction of paper F. From 2027, all examination papers will be sat in accordance with the new REE (Art. 27 REE).

2.4.1 Setting and marking the pre-examination

From the entry into force of the REE on 1 January 2025, the pre-examination according to the REE 2009 and the IPREE 2018 is no longer held (Art. 25(6) REE).

The pre-examination was a single paper (R. 10(2) IPREE 2018), set in multiple-choice form. In several decisions, the DBA held statement 5.4 in the German version of the 2016 pre-examination paper to have been unclear and confusing. In some cases (e.g. **D 1/16**, **D 4/16** and **D 15/16**), the additional points awarded resulted in the candidate achieving the "PASS" grade. Challenges to other statements in the same paper were, however, rejected (e.g. **D 5/16**, **D 6/16**, **D 10/16**). In **D 5/16** the board concluded with some general remarks, as follows. It was essential to ensure that the questions to be answered and any statements to be evaluated in a multiple-choice examination such as the EQE pre-examination were formulated clearly and unambiguously. It was crucial to formulate statements in such a way that clearly only one "True" or "False" answer was possible and "correct" in the circumstances (see also **D 6/16**, later decision **D 3/19**, citing **D 13/02** and **D 2/24**). However, concerning the ambiguity of words and the relevance of the factual context of questions, if a question was logical and made sense, so that, using common sense, it was clear what answer was expected, candidates could not rely on exceptions to the rule or explore alternative interpretations with a view to showing that a different answer might also be conceivable in specific instances. See also **D 3/14** and e.g. **D 2/21**, reported in this chapter V.C.2.6.4 "Review of the marking of the pre-examination".

2.4.2 Case law on pre-examination questions and marking not applicable to the European qualifying examination

The DBA has made it clear that the case law on the questions and marking of the pre-examination is not applicable to the EQE because the former leaves no room for discretionary marking. Thus, according to **D 20/16**, the decisive difference between the pre-examination (R. 10 IPREE 2010) and the EQE, in particular Paper A (R. 23 IPREE 2010), is as follows. In the former, candidates are expected to respond to clearly defined questions or statements in a multiple-choice mode, to which they can only answer "true" or "false" by ticking a box; they have no possibility to add any reasons or explanatory notes. In the latter, candidates can offer solutions which they find meet the requirements of R. 23 IPREE 2010, and even, if need be, give reasons for their proposals in supplementary notes (R. 23(6) IPREE 2010). For Paper A, the members of the Examination Board have a broad discretion when awarding marks. See also e.g. **D 16/17**.

2.4.3 Marking the European qualifying examination answer papers consistently

On the principle of consistency of marking (Art. 6(2)(c) REE; cf. Art. 16 REE 1994, English version, "uniformity of marking"), the board in **D 4/99** stated that the appellant's starting point, namely that in case of non-identical marks by the two examiners only one value

could be the correct one, was irreconcilable with the fact that marking was an individual assessment of the candidate's work. Rather, more or less strict standards were possible and different aspects might be considered essential or less important even within the general instructions for marking contained in the IPREE 1994. Examiners must have some latitude of evaluation when awarding marks and individual examiners might arrive at different marks, both results being justifiable. Therefore, differences in marking did not violate the REE 1994 and its IPREE (**D 5/94**, **D 6/98**). In order to safeguard the principle of equal treatment, harmonisation of marking was provided for in the marking sheets. If the marking was different, the two examiners might revise their marks on the basis of a discussion between them. The examination committee recommended the grade, and the Examination Board adopted it or otherwise, in full knowledge of the different marks awarded by the two examiners. This system ensured uniformity of marking (Art. 16 REE 1994; **D 12/82**, OJ 1983, 233).

The following decisions confirmed this approach. According to **D 6/99**, small differences in marking were an unavoidable consequence of Art. 8(b) REE 1994. The board was not aware of any provision supporting the submission that in such cases only the better mark awarded in each category of the paper should be counted. In **D 12/00** the board rejected the appellant's claim that any discrepancy between the markings of each examiner showed gross disregard for the principle of uniformity within the meaning of Art. 16 REE 1994. Confirming the principles of its established case law (see **D 1/92**, OJ 1993, 357, reported in this chapter V.C.2.6.3; see also **D 4/99** above), the board held that differences of opinion over the number of marks to be awarded for a given answer were a reflection of value judgments which were not, in principle, subject to judicial review. And in **D 3/00** (OJ 2003, 365), which concerned Paper D, the board held that a candidate was not per se entitled to claim the highest mark awarded by one of the examiners for each answer to a sub-question or sub-element.

In **D 10/02** (OJ 2003, 275) the DBA noted that neither the REE 1994 nor its IPREE regulated the procedure to follow in the exceptional cases where a committee was unable to agree on the marking; nor did they provide for calling in an additional examiner. Hence the appointment of a third examiner without any basis in the REE 1994 or its IPREE had to be deemed a substantial procedural violation.

2.4.4 Marking the European qualifying examination answer papers fairly

The DBA has repeatedly invoked the principle of fair marking. In **D 7/05** (OJ 2007, 378) it stated that details of the marking of Paper D were deemed to include sufficient sub-division of the maximum achievable mark and the candidate's overall mark into sub-marks, and an indication of the substantive and legal issues for which those sub-marks were awarded. In producing schedules of marks there had to be a trade-off between their purpose of ensuring uniform marking (Art. 16 REE 1994) and the need also to allow for fair marking of answers which deviated from the scheme but were at least reasonable and competently substantiated. The schedules therefore had to leave some room for manoeuvre and – merely – be sufficiently detailed to constitute details of the marking within the meaning of R. 6(1) IPREE 1994 (cf. R. 4(1) IPREE) allowing candidates to verify, on the basis of the documents published or made accessible, whether the marking of their answers infringed

marking principles the respect of which was subject to review by the DBA. See also in this chapter V.C.2.5. and e.g. **D 11/07**, **D 23/08**, **D 8/12** and **D 13/17**.

D 6/07 and **D 7/07** were among a number of appeal decisions concerning Paper C. A large number of candidates had taken as the starting point for their attack on the claims a document which the examination committee did not consider to represent the closest prior art and had been awarded no points in this regard. The Examination Board took the view that, in keeping with long-standing practice, in this situation some credit should be given for properly drafted problem-solution approaches. Given the lateness of the proceedings and the impossibility of re-marking all the papers, it decided, as an exceptional measure, that the fairest option would be to award ten additional points (being the maximum number possible) to all candidates having sat the paper. The DBA held first that the awarding of no points by the examination committee infringed the requirements of R. 4(2) and (3) IPREE 1994: the "fit to practise" criterion required the examiners in marking the individual parts of a candidate's answers not to disregard their merit in the context of the whole answer paper (**D 3/00**, OJ 2003, 365) and the need to allow for the fair marking of answers which, although deviating from the marking scheme, were nonetheless reasonable and competently substantiated (**D 7/05**, OJ 2007, 378, see also **D 3/23** and **D 14/23**). The board further ruled that, under Art. 7(3) REE 1994, it fell to the Examination Board to award the grades "pass", "fail", or "compensable fail" and formally to decide whether the whole examination had been passed or not. Its powers did not extend to the preceding marking of candidates' individual papers on a scale of zero to 100, and therefore the alteration of the marks awarded by the examination committee (in accordance with Art. 8(b) REE 1994 and R. 4(1) IPREE 1994) by the blanket addition of ten marks per paper had been ultra vires. The abstract awarding of marks without regard to the "fit to practise" criterion of R. 4 IPREE 1994 in the individual candidates' examination papers infringed the principle of objectivity as well as Art. 8(b) REE 1994 and R. 4 IPREE 1994. In conclusion, the DBA ordered a new marking of Paper C of each appellant in accordance with R. 4 IPREE 1994, with the ten additional points already awarded to be retained by the appellant.

The candidate's different choice of the closest prior art from that of the examination committee was also in issue in e.g. **D 14/17**, **D 20/17**, **D 25/17** and **D 3/23**. Referring to **D 7/05** (OJ 2007, 378) and **D 12/82** (OJ 1983, 233), the DBA again highlighted the examiners' obligation to allow for fair marking, which had its basis in the "fit to practise" criterion of Art. 1(1) REE.

In **D 13/17** the DBA stressed that Paper A had a particular structure in that it was based on a single set of facts which meant that a wrong answer to one part was very likely to result in the other parts being wrongly answered too. That had to be taken into account when devising a marking scheme, as did the applicable regulatory requirements. In particular, R. 6(1) IPREE 2010 provided that each answer paper was to be marked on a scale from 0 to 100; it said nothing about deducting marks. There was much to suggest that the marking had to start from zero, with marks then being awarded for each correct answer or partial answer and added up. Especially given Paper A's structure, a marking scheme that allowed more marks to be deducted overall than were achievable in total was essentially untenable if the requirement for fair marking established in the case law was to be met. A different conclusion could, if at all, be reached only if the possible deductions

were not cumulative and instead applied to separate and mutually exclusive wrong or incomplete answers. With regard to the possibility that marks might be lost twice for a single mistake because, owing to Paper A's structure, a wrong answer to one part could have implications for the answer to another part, the board held that such a "double penalty" was not in keeping with the standards for fair marking set in the case law. Citing **D 9/11**, the DBA in **D 22/21** emphasised that separate deductions for claims and corresponding arguments was not necessarily a double penalty and as such not necessarily unfair. The marking was only unfair to the extent that equal errors were penalised unequally, or repeated errors were penalised repeatedly. See also **D 11/21, D 19/21**, **D 27/21**, **D 39/21**, **D 48/21** and **D 54/21**.

2.5. Substantiation of European qualifying examination decisions

At issue in **D 12/97** (OJ 1999, 566) was whether Examination Board decisions informing candidates that they have failed the examination have to be reasoned. The DBA pointed out that this was not required by the REE 1994. It also held the appellant's constitutional arguments - that substantiation of such decisions was a generally recognised principle of procedural law within the meaning of Art. 125 EPC 1973 - to be unfounded. For this to be so, it had to be shown that substantiation of such decisions was required in the EPC contracting states.

In **D 3/03** the DBA confirmed **D 12/97** (OJ 1999, 566). The REE 1994 neither required EQE decisions to be reasoned nor made reference to R. 68(2) EPC 1973 (see R. 111(2) EPC), which therefore did not apply. The Guidelines were not applicable for the same reasons. The REE and its IPREE were lex specialis for the EPC; unless they expressly referred to the EPC, then only they and not the EPC applied. Their subsidiary nature was justified in that they governed a particular matter unrelated to the EPC stricto sensu, since their purpose was to establish whether a candidate was considered fit to practise as a professional representative before the EPO. With regard to the review by the courts of decisions concerning the EQE, the German Federal Constitutional Court had also held that the obligation to give reasons for examination decisions cannot be regarded as an expression of the structural elements of any protection of basic rights intended by the Basic Law (see decision 2 BvR 2368/99 of 4 April 2001).

This case law was again confirmed in **D 7/05** (OJ 2007, 378). In its extensive reasoning the board also held that, apart from the fact that the marking sheets under R. 6(1) IPREE 1994 already had a decision substantiation function, the extent to which the principles of rule-of-law process also demanded individual substantiation of examination decisions could not be assessed without consideration of the extent of the board's powers of review under Art. 27(1) REE 1994. The absence of an obligation to provide individual substantiation was to be seen in connection with the fact that Examination Board decisions in EQE proceedings were subject to only limited judicial review (as to this see also in this chapter V.C.2.6.1 and V.C.2.6.3 below).

2.6. Appeals against decisions of the Examination Board and the Examination Secretariat

2.6.1 Competence of the Disciplinary Board of Appeal

Under Art. 24(1) REE (see Art. 27(1) REE 1994), an appeal lies from decisions of the Examination Board and the Secretariat only on grounds of infringement of the REE or of any provision relating to its application. On the extent of the DBA's competence to review decisions of the Examination Board see **D 1/92** (OJ 1993, 357), **D 6/92** (OJ 1993, 361) and the further decisions in this chapter V.C.2.6.3 (for the EQE) and V.C.2.6.4 (for the pre-examination); concerning decisions of the Secretariat, see e.g. **D 1/13** and **D 5/18**. The DBA has only very limited scope for reviewing the legal validity of implementing provisions drawn up by the Administrative Council or, in the case of delegation, by the relevant subsidiary body. In **D 3/89** (OJ 1991, 257) the board stated in justification of its limited powers of scrutiny that the relevant bodies had discretionary powers in drawing up such provisions. As long as the legislative organ and subsidiary bodies had not misused their discretionary powers, the DBA could apply the provisions concerning examinations only to the case in point (see also **D 1/81**, OJ 1982, 258, **D 5/89**, OJ 1991, 210, **D 14/96**, **D 11/99**, **D 7/05**, OJ 2007, 378 and **D 11/19**).

2.6.2 Procedural aspects

a) Requirements for appeal – paper form, statement of relief sought and payment of the appeal fee

The notice of appeal, to be filed in writing within one month from notification of the contested decision, must already include the statement setting out the grounds; the appeal fee is to be paid within the same period (Art. 24(2) REE).

The board in **D 36/21** explained that to correctly interpret the term "filed in writing" under Art. 24(2), first sentence, REE this provision had to be read in conjunction with Art. 6(1), second sentence, and Art. 6(2) RPDBA. These provisions made it clear that a fax alone did not suffice as a means of communication for filing an appeal. The standard means of communication for filing an appeal, constituting the rule, was an appeal document in paper form signed by the appellant. This document could be sent by postal services or delivered by hand to the Secretariat. The sole exception to this rule was the option to file the appeal by fax in due time provided that the original was subsequently filed within two weeks (Art. 6(2) RPDBA). Since the appellant had filed an appeal solely by email within the time limit, the appeal was rejected as inadmissible.

Citing **D 2/20** (see in this chapter V.C.3.1), the DBA in **D 40/21** held that a request for re-evaluation of the appellant's paper without requesting a better grade was inadmissible because such request was not aimed at eliminating a substantive adverse effect to the appellant. It was not sufficient to request that the decision be set aside without requesting (and reasoning why) a different (or further) legal effect should result from the appeal proceedings instead of the appealed legal effect.

In **D 9/17** the DBA confirmed that the RFees applied, at least mutatis mutandis, to the payment of the fee for an appeal lodged under Art. 24(2) REE. This fee was to be paid by payment or transfer to a bank account held by the Office (Art. 5(1) RFees); in particular, payment of the fees according to Art. 17 REE by debit order was not provided for in the ADA (see chapter III.U.2.2.1).

b) Rectification of decisions

Under Art. 24(3) REE, if the Examination Board or the Secretariat considers the appeal to be admissible and well-founded it must rectify its decision and order reimbursement of the appeal fee. If the appeal is not allowed within two months of notification of the decision, it is remitted to the DBA.

In **D 5/19** and **D 8/19** the board pointed out that the Examination Board's powers of rectification under Art. 24(3) REE form an exception to the devolutive effect of an appeal. The term "well-founded" (German "begründet", French "fondé") refers to a situation in which the Examination Board considers that the reasons which it gave for a decision which is then appealed no longer hold in light of the appeal submissions, i.e. if the appeal removes the reasons underlying the contested decision, for example, if parts of the appellant's answers to a paper have been overlooked and not marked. In this context, "rectify" (German "abhelfen", French "faire droit") is to be understood as "correct" or "amend".

However, the brevity of the period under Art. 24(3) REE does not always allow the Examination Board to review the matter in full before it expires. To impose such a constraint can hardly have been the legislator's intention, and so it is reasonable to infer that, within the period for rectification, the Examination Board may also opt to set aside the contested decision (simple annulment) and resume the proceedings before it. If, on the other hand, the Examination Board considers the appeal to be either inadmissible or unfounded, it must refer the case to the DBA, as a rule without giving reasons, since such reasons would amount to a decision on the merits of the appeal. In summary, the Examination Board normally has the following options under Art. 24(3) REE: it can either annul the contested decision and replace or not replace it by a rectified decision, or refer the case to the DBA without giving reasons.

According to the board, this interpretation of Art. 24(3) REE was in line with the main purpose of interlocutory revision to shorten the appeal proceedings in the interests of procedural expediency and economy, which is to the benefit of both the appellant and the EPO. Moreover, if rectification is granted, unnecessary work is avoided for the DBA. Even though it entails resuming the administrative proceedings, the Examination Board can normally be expected to resolve the contentious issues more expediently by this means than on remittal after a full consideration of the appeal by the DBA. Given the limited powers of review accorded to the DBA under Art. 24(1) REE, a resumption of the proceedings before the Examination Board can even be to an appellant's advantage in the sense that - in contrast to the appeal procedure before the DBA - it allows a review of the entire examination procedure, including the re-marking of an appellant's answer to an examination question.

See also earlier cases **D 38/05** of 17 January 2007 and **D 4/06** on decisions of the Examination Board, **D 3/18** and **D 4/18** on decisions of the Secretariat, as well as **D 3/14** in this chapter V.C.2.6.4 concerning the pre-examination.

c) Oral proceedings

Oral proceedings take place either at the instance of the disciplinary body if it considers this to be expedient or at the request of the party (Art. 13 RDR). In **D 9/17**, though the appellant had requested oral proceedings in relation to her main request, no such request had been filed with respect to the question raised in the board's communication on whether an appeal was deemed to have been filed (which turned on the question of valid payment of the appeal fee – see under a) above). Considering that the question whether an admissible appeal existed was to be examined by the appeal board ex officio, and the appellant had not availed herself of the opportunity which she had been given to comment on the reasons for the decision, the DBA did not consider oral proceedings to be expedient.

In **D 11/19** the DBA refused the appellant's request that a German patent attorney be allowed to accompany him at the oral proceedings. The board observed that proceedings before the DBA were not public (Art. 24(4) REE in conjunction with Art. 20 RDR) and the right to attend oral proceedings was limited (Art. 24(4) REE combined with Art. 14 RDR): only other professional representatives or legal practitioners qualified to act as such in a contracting state were permitted to provide assistance (Art. 17 RDR). Professional representatives are familiar with the EQE and what it tests. They are also subject to a supranational set of rules based on Art. 134a EPC, which, in addition to professional rights and obligations, includes disciplinary supervision. Their legal status is similar to that of legal practitioners qualified in a contracting state. This ensures not only the confidentiality of the proceedings but also an orderly process.

d) Remittal and special reasons

If the DBA considers an appeal to be admissible and well-founded, it is in principle, in accordance with Art. 24(4), second sentence, REE, only authorised to set aside the contested decision and remit the matter to the Examination Board for a new decision. Only in very exceptional cases, where there are compelling reasons for non-remittal, is non-remittal justifiable (Art. 12 RPDBA). This is conceivable, for example, where the Examination Board lacks the discretion to award a grade (see e.g. **D 3/14**) or where the Examination Board's discretion to reassess a paper in the event of remittal is so marginal that the binding effect of a DBA decision would be ignored if the Examination Board were not to change the grade (see e.g. **D 14/17**). The appellant must provide full details of any such exceptional reasons (**D 3/23** with reference to **D 1/86**). See also **D 5/86**; **D 11/91**, OJ 1995, 721; **D 8/08** and **D 9/08**.

2.6.3 Objective review of the marks awarded in the examination

In accordance with the DBA's consistent case law (see in particular **D 1/92**, OJ 1993, 357 and **D 6/92**, OJ 1993, 361), decisions of the Examination Board may in principle only be reviewed for the purposes of establishing that they do not infringe the REE, the provisions

relating to its application or higher-ranking law. In **D 1/92** and **D 6/92**, the DBA therefore concluded that its functions did not include reconsidering the examination procedure **on** its merits. Accordingly, the Examination Board's value judgment concerning the number of marks that an examination paper deserved was not subject to review by the board. Only if the appellant could show that the contested decision was based on serious and obvious mistakes could the board take this into account. The alleged mistake must be so obvious that it could be established without re-opening the entire marking procedure, for instance if an examiner was alleged to have based their evaluation on a technically or legally incorrect premise on which the contested decision rested. Any further claims regarding alleged defects in the assessment of candidates' work fell outside the DBA's jurisdiction, since **value judgments** were **not subject to judicial review**. These findings were confirmed in **D 7/05** (OJ 2007, 378). See also, for example, **D 9/00**, **D 7/01**, **D 11/01**, **D 11/07**, **D 14/08**, **D 23/08**, **D 5/13**, **D 11/18** and **D 11/19**.

In **D 6/98**, the DBA added that these conditions were in line with those for correcting errors under R. 89 EPC 1973 (see now R. 140 EPC), particularly in the case of errors of transcription or calculation in the marking. Under Art. 27(1) REE 1994 (see Art. 24(1) REE), the DBA was not empowered to reopen the assessment procedure (**D 15/97**). The DBA was not intended to be a department of second instance empowered to examine whether the marks awarded for a candidate's examination were justified on their merits or correct, and thus to superimpose its own value judgment on that of the Examination Board (**D 20/96** and **D 6/02**).

D 12/00 concerned a complaint about differences between the individual marks awarded by the two examiners. Relying on the principle of uniformity of marking (Art. 16 REE 1994; Art. 6(2)(c) REE, English text, now provides for consistency of marking), the appellant claimed that the higher number of marks should count. The board confirmed its established case law (see **D 1/92**, OJ 1993, 357, above): differences of opinion over the number of marks to be awarded for a given answer were a reflection of value judgments which were not, in principle, subject to judicial review. The fact that two independent examiners had arrived at different marks was not per se a violation of the applicable provisions. See also case summaries in this chapter V.C.2.4.3.

In **D 13/02** the board stated that obvious mistakes as referred to above were those which could be identified without a re-evaluation of the examination paper. That would be the case, for instance, if one and the same paper had been marked **very** differently by the two examiners, since the marking discrepancy alone would indicate an infringement of the principle of uniform marking, irrespective of the level of the marks awarded. Another example of an obvious mistake would be a question whose wording was ambiguous or incomprehensible. That would be clear straight away, without any reference to marks awarded, from the meaning that common sense would ascribe to the wording of the question concerned.

In **D 6/24** the board held that the marking of the appellant's Paper B had infringed R. 6(1) IPREE 2018, which provided that each answer paper is to be marked on a scale from 0 to 100 by the relevant examination committee. Although the examiner's report indicated 30 points for establishing inventive step, the points to be awarded for each step amounted

in total to 27 and not 30 points. The proper distribution of the 3 additional points could have resulted in a "compensable fail" as requested by the appellant. The board remitted the case to the Examination Board for the proper allocation of the 3 additional points.

D 17/05 cited **D 13/02** to point out that the existence of a mistake within the meaning of **D 1/92** could not be deduced from a comparison of the candidate's answer with another answer. The board also cited the statement that the disclosure of marking instructions which may have been used by the examiner was not required for a decision on an appeal and that under the established case law no other entitlement existed to any such disclosure.

D 6/13 concerned an alleged infringement by the Examination Board of R. 23(3) IPREE 2010 (regarding the content of Paper A). The Board agreed that the Examination Board has an implied obligation to prepare the examination papers and corresponding marking scheme correctly, in that the marking scheme should award the appropriate marks for correct solutions and this "correct" marking scheme should also be "correctly" applied in every case. However, the DBA may not be competent to determine whether the marking scheme or individual marking is correct from every possible aspect which may have adversely affected the marking of a candidate, given that Art. 24(1) REE excludes certain appeal grounds. Therefore, if the Examination Board did not "perfectly" fulfil this implied obligation, in that arguably correct solutions were not awarded any or enough marks, this could not qualify immediately as an infringement of R. 23(3) IPREE 2010 in the sense of Art. 24(1) REE, but was a question be decided on a case-by-case basis. If the DBA were to extend the examination of appeals to an in-depth technical examination, this would in effect reduce to zero the scope of the restriction on the possible appeal grounds stipulated in Art. 24(1) REE, and require value judgments to be made. See also e.g. **D 10/19**.

D 14/17 and **D 20/17** concerned the candidates' inventive step attack in Paper C starting from Annex 6 as the closest prior art, for which they had received 0 out of 20 marks. Based on a summary examination and (at least) a figure filed by the appellant, it was evident for the board that, contrary to what was asserted in the examiners' report, no technical obstacle existed with regard to Annex 6, which was reasonably to be regarded as an alternative starting point (see also e.g. parallel case **D 25/17**). Furthermore, having concluded that there were special reasons not to remit the case to the Examination Board (see Art. 12 RPDBA; here: prima facie competent and logical answer, small number of marks involved, very short time between oral proceedings and next EQE session), the board in **D 14/17** allowed the appellant's requests to be awarded a "compensable fail" for Paper C and, based on that, to be declared to have passed the EQE (Art. 14(1) REE). See also **D 3/23** and, concerning the EQE pre-examination, **D 3/14**, summarised in the next section, and **D 5/14**.

The burden of establishing serious and obvious mistakes necessarily lies with the appellant who alleges it (**D 46/07**). In **D 24/17** the DBA found that on most issues the appellant did not substantiate in detail in what respect the solution of the examiners' report was incorrect, but left it to the board to establish of its own motion to what extent the official solution and the marking of her papers was or could have been wrong. This would go beyond the scope of the board's review. Only on the clarity-related issues in Paper B were

the appellant's submissions (partly) well-founded. It was evident that she had addressed at least some of them in her answers, and it was therefore incomprehensible that no point at all was awarded. This amounted to a serious and obvious mistake which affected the marking. The board remitted the case for Paper B to be re-marked with respect to the aspect of clarity and ordered reimbursement of the appeal fee at 25%.

2.6.4 Review of the marking of the pre-examination

From the entry into force of the REE on 1 January 2025, the pre-examination according to the REE 2009 and the IPREE 2018 is no longer held (Art. 25(6) REE).

In **D 3/14** the appellant had obtained the grade "fail" (with 68 marks) in the EQE pre-examination. She argued that the answer to statement 10.4 in the question paper should have been "false", rather than "true", as given in the examiners' report, and requested that the decision of the Examination Board be set aside and that she be awarded a "pass".

Applying the principles established in the case law on the EQE itself (e.g. **D 1/92**, see chapter V.C.2.6.3 above), the board examined whether the alleged mistake was so obvious that it could be established without reopening the entire marking procedure. It found that statement 10.4 should have been formulated differently in order to express the aim intended. Candidates could not be expected to make an assumption in this respect (R. 22(3) IPREE 2018, see R. 21(3) IPREE), providing that candidates must limit themselves to the facts given). The appellant's understanding of statement 10.4 was justified from an objective point of view. The answer to it was "false" and not "true" as indicated in the examiners' report. The examiners had based their evaluation on an incorrect premise and therefore the contested decision was based on serious and obvious mistakes which could be established without reopening the entire marking procedure. The decision had to be set aside and the appeal fee reimbursed (Art. 24(4) REE).

Concerning the requested award of a "pass", the board held that the DBA was not empowered by Art. 24(4), second sentence, REE to correct the decision, i.e. to review the marks and grade of an examination paper, and therefore considered whether special reasons provided a legal basis for not remitting the case to the Examination Board (see Art. 12 RPDBA). Only in a few exceptional cases had the DBA found such special reasons (e.g. **D 5/86**; **D 11/91**, OJ 1995, 721; **D 8/08** and **D 9/08**: see also in this chapter V.C.2.6.2(d)), but in appeals against decisions of the Examination Board it had not made use of this power to review the contested decision on its merits. However, in the pre-examination, a multiple choice paper, the marks were awarded according to a strict scheme not involving any discretion and the award of a "pass" or "fail" was merely the arithmetical outcome of the marks achieved. From a limited review, the board was able to establish the correct marks on the basis of the appellant's answer paper without interfering with any value judgment of the examination committee or Examination Board. Also taken into account were the matter's urgency, since a "pass" in the pre-examination was a precondition for the main examination, and the fact that the Examination Board, by not rectifying its decision, even though the discrepancy had been comprehensively substantiated, had burdened the appellant with appeal proceedings. With the correction, the total marks rose from 68 to 70 and a "pass" was therefore awarded. See **D 3/19** and

the following decisions concerning statement 12.4 of the EQE pre-examination 2021: **D 2/21**, **D 3/21**, **D 4/21**, **D 5/21**, **D 6/21** and **D 7/21**. See also **D 2/24**.

In **D 1/15** too, the DBA considered that the settled jurisprudence (e.g. **D 1/92**; **D 6/92**; **D 7/05**, OJ 2007, 378) also applied to appeals on the pre-examination, even if the marking was hardly ever in dispute, given the simple marking scheme of a multiple-choice test. However, the review requested in this case was directed at the content of the examination as presented to the candidates. To decide on the issues, the board would have had to review at least a substantial part of the paper and perform a detailed, partly technical analysis of the facts presented. This exercise appeared to be well beyond the powers of the board. See also e.g. **D 6/16**.

See also the decisions in this chapter V.C.2.4.1, "Setting and marking the pre-examination".

2.6.5 Legitimate interest

According to the established case law, a candidate who appealed against failing the EQE but resat and passed it before the appeal had been decided still retained a legitimate interest in pursuing the appeal. This was confirmed in **D 3/98**. Any other view would amount to denying him recourse to the law; legitimate interest would then depend on how long proceedings took. However, appellants could exert little influence over that, and should therefore not have to suffer the consequences. Whether there was a legitimate interest was to be determined with reference to the date the proceedings were initiated (in this case, on the day the appeal was filed).

3. Disciplinary matters

The RDR (Supplementary publication 1, OJ 2024, 145, consolidated version of the text published in OJ 1978, 91, with amendments published in OJ 2008, 14 and OJ 2018, A57) contains not only provisions on general professional obligations, professional secrecy and conduct towards clients but also provisions relating to the disciplinary bodies responsible for imposing disciplinary measures (see Art. 5 RDR; also Additional Rules of Procedure of the Disciplinary Committee and those of the Disciplinary Board, Supplementary publication 1, OJ EPO 2024, 156 and 166, consolidated version of the texts published in OJ 1980, 177 and 183 respectively, with amendments published in OJ 2007, 552; see also RPDBA, Supplementary publication 1, OJ 2024, 70, consolidated version of the text published in OJ 1980, 188 with amendments published in OJ 2007, 548). While the RDR lays down the general requirements for the epi members, the associated epi Code of Conduct (OJ 2022, A61) lays down the general principles of professional conduct (see points 1(a) and (b) of the Code).

3.1. Admissibility of the appeal - statement of the relief sought

Appellants in appeal proceedings before the DBA must seek a specific relief (Art. 6(1), first sentence, RPDBA, see also e.g. **D 1/20**). According to **D 1/20**, the requirement to seek a specific relief is satisfied if the imposition of a disciplinary measure is requested but the

nature of the measure is left to the discretion of the DBA. It is not satisfied, however, if the appellant makes a request tantamount to a request for a declaratory finding (in the case in hand, a request that it be clarified whether use of the title "European patent Litigator" constituted a misleading statement under Art. 1(1) RDR). See also in this chapter V.C.3.4.

In **D 2/20** (appeal by the epi President) the DBA found the appeal inadmissible on the first ground of appeal (cost reimbursement decision) for lack of statement of the relief sought by the appellant, contrary to Art. 6(1) RPDBA. According to the DBA, "relief" in Art. 6(1) RPDBA had to be interpreted in view of the overall purpose of the appeal proceedings, which was to establish if the legal effects of the impugned decision were correct or not. It was not sufficient to request, as the appellant had done, that a decision be set aside without requesting (and reasoning why) a different (or further) legal effect should result from the appeal proceedings (see also **D 40/21** in the context of appeals under Art 24 REE). In the specific circumstances of **D 55/21**, however, the DBA was of the view that the epi President could not have been expected to request a specific and different substantive outcome. The epi President had explicitly stated why the decision was wrong and that it had to be set aside, and the appeal was found admissible.

The appeal was also found to be admissible in **D 1/22** (appeal by the epi President), which concerned a decision of the epi Disciplinary Committee dismissing the complaint. The DBA noted that according to **D 55/21**, for an appeal of the epi President to be admissible, it was sufficient to indicate why the decision under appeal was wrong in substance. Depending on the circumstances, it may not be necessary to specifically request what the expected substantive outcome should be; a request for remittal on the merits may suffice (see also **D 2/20**). In the case in hand, the DBA regarded a request for remittal as sufficient with respect to the breach of Art. 6(3) and 20 RDR invoked by the appellant, allegedly amounting to substantial procedural violations (see in this chapter V.C.3.3.1 and V.C.3.3.2). On the substantive issue (applicability of the RDR, see in this chapter V.C.3.2), the appellant considered that the epi Disciplinary Committee should not have dismissed the matter. Since the issue was about jurisdiction and the defendant was not called upon to present a defence, the request for remittal on the merits was also found to be sufficient.

3.2. Applicability of the Regulation on Discipline for Professional Representatives

In **D 16/95** the board ruled that, although drafting and filing translations and paying fees in the national phase in a contracting state were not directly related to grant, opposition or appeal proceedings, such activities were still covered by Art. 1 RDR. They were, after all, **activities in connection with a European patent** (see Art. 65 EPC and 141 EPC 1973) and as such part of a professional representative's job. Regarding them as covered by Art. 1 RDR was also justified by the fact that it was difficult for outsiders (e.g. persons commissioned to translate patent specifications) to distinguish between those of a representative's activities which were directly related to grant, opposition or appeal proceedings and those which were not. See also **D 25/05**.

According to the board in **D 19/99**, it followed from Art. 134(1) and (4) EPC that professional representatives are, in principle, the only ones entitled to act in all proceedings instituted by the EPC. Therefore, the disciplinary power delegated by the

contracting states in Art. 134(8) EPC 1973 (Art. 134a(1) EPC) must necessarily be understood as relating to their activity as such. Moreover, it was a settled principle of law in the jurisdiction of the contracting states that **provisions enacting disciplinary sanctions** that restrict the free exercise of a profession were, like those of criminal law**, to be interpreted narrowly**. This narrow interpretation was also necessary to avoid conflicts of jurisdiction between the EPO and national disciplinary bodies. Thus, the **disciplinary powers** of the bodies set up under Art. 134(8) EPC 1973 (now Art. 134(a)(1) EPC) **clearly applied only to the activities of professional representatives relating to the grant of a European patent**. Furthermore, the wording in Art. 1(1) RDR required such interpretation. Under this narrow interpretation it would not be possible for the texts imposing disciplinary sanctions to govern, by analogy, other ancillary activities that a professional representative might also engage in. In the case at issue, it was clear from the file that all the unpaid invoices (which were the subject of the complaint) related only to British patents without any connection with any European patent. It followed that the applicant was acting in a capacity other than that of a European patent attorney.

The appellant in **D 1/22** argued that the RDR applied, although the complaint concerned a dispute relating to a national patent (failure to transfer the patent as instructed by the complainants). The board disagreed, noting that the jurisdiction of the disciplinary bodies of the epi and the EPO as established by the RDR did not cover all conduct or activities of a professional representative (see **D 19/99**). The board pointed out that, while **D 25/05** stressed that the power of the disciplinary bodies of the epi and the EPO was not solely restricted to activities as a professional representative in proceedings before the EPO, it confirmed that this power did not encompass conduct or activities which were **not related to a European patent**. Both **D 25/05** and **D 16/95** concerned the filing of a translation and/or the payment of fees under the EPC for the national parts of a granted European patent as required by the EPC (see in this chapter V.C.4.1). While in **D 1/22** the national patent served as a priority application for a European patent, the complaint was only about the omission of a transfer of that national patent under the applicable national law. The national parts of the European patent, which claimed priority of the national application, were not at issue. The complaint was not related to any provision of the EPC either. The defendant's activities on which the complaint was based thus had no connection with a European patent and provisions of the EPC applicable to the national parts of any such patent (e.g. Art. 65 and 141 EPC). The fact that the defendant was a professional representative did not as such establish the link between the facts of the complaint and the EPC.

3.3. Procedural aspects

3.3.1 Observation of the time limit under Article 6(3) RDR

In **D 1/22** the appellant argued that a final decision taken by the epi Disciplinary Committee after expiry of the time limit under Art. 6(3) RDR should be considered a substantial procedural deficiency because the epi Disciplinary Committee no longer had the competence to rule after that time. The DBA disagreed, noting that there was no devolutive effect upon expiry of the time limit pursuant to Art. 6(3) RDR; the epi Disciplinary Committee remained competent to deal with the case. The Disciplinary Board can,

however, assume responsibility for the case by a decision of its chair transferring the case to the Disciplinary Board, in which case the Disciplinary Committee would no longer be able to rule on the case. The possibility of the Disciplinary Committee taking a decision more than nine months after being notified of an alleged breach of the rules of professional conduct is therefore only ruled out if the matter is transferred to the Disciplinary Board under Art. 6(4)(b) RDR. In any event, the DBA found that in the case in hand the Disciplinary Committee did not exceed the nine-month time limit under Art. 6(3) RDR.

3.3.2 Breach of the confidentiality of deliberations under Article 20 RDR

Article 20, second sentence, RDR provides that the deliberations of the disciplinary bodies "shall be confidential". In **D 1/22**, the DBA disagreed with the appellant's contention that the Disciplinary Committee had violated the confidentiality of deliberations by indicating in the contested decision that the decision had been taken by unanimity, and that this constituted a substantial procedural violation. According to the DBA, the indication merely ruled out any disagreement among the members and did not convey any further information on the actual deliberations. In any case, there was no causal link between the announcement and the decision itself. Therefore, even if there was a procedural violation, it was not a substantial procedural violation that would justify remitting the case for further prosecution.

3.4. Disciplinary measures

According to **D 5/86** (OJ 1989, 210), an infringement of the rules of professional conduct must be established to the satisfaction of the disciplinary body before it can impose a disciplinary measure. Absolute certainty is not required, but a degree of probability which in human experience verges on certainty. A disciplinary measure cannot be imposed if there is reasonable doubt as to whether the infringement has occurred.

In **D 11/91** (OJ 1995, 721) the EPO Disciplinary Board had ordered the deletion of the appellant from the list of professional representatives for an indefinite period. In his appeal, the appellant argued that the procedure before the DBA did not comply with the provisions of the ECHR, in particular because the DBA had been established not by national law but by the Administrative Council, the disciplinary bodies did not constitute an independent court, the DBA was not a national authority, and its decisions could not be referred to a higher court of appeal.

The DBA decided that the ECHR contained provisions which expressed general principles of law common to the member states of the European Patent Organisation. As such these provisions should be considered part of the legal system of this Organisation and should be observed by all its departments. This therefore applied to Art. 13 ECHR, which guaranteed the protection by the judiciary of the rights of the individual. The "national authority" mentioned in this article was clearly meant to be understood as a competent authority in accordance with the law of the state concerned. However, in ratifying the Munich Convention, the contracting states accepted a transfer of prerogatives whereby professional representatives before the EPO became subject to the same set of professional regulations, controlled by a central body whose decisions were open to

effective remedy before a body of second instance whose independence was guaranteed by the rules governing its composition. The drafting of these regulations and the establishment of these bodies was thus consistent with general principles of law, in particular those enshrined in the ECHR.

The board took the view that, in order to ensure that the penalty was proportionate to the seriousness of the charges and that the maxim whereby penalties should not be arbitrary but fixed or predetermined was respected, Art. 4(1)(e) RDR should be understood as meaning "for a period not defined by the text", that is for a discretionary period to be decided by the competent disciplinary body. In its decision, the latter should fix the said period and give reasons for its choice. See also **D 1/21** below.

In **D 20/99** (OJ 2002, 19), appellant X filed an appeal against the EPO Disciplinary Board's decision to issue him with a reprimand. The DBA, reviewing the penalty imposed in respect of the first charge only, held that X's actions, for which he had been prosecuted in France, were in breach of Art. 1(1) and(2) RDR. It was clear that D had been involved in drawing up European patent applications in consultancy L, owned by X, while being paid by company P. However, it was evident from the file that this contractual arrangement had never been the subject of invoicing. That gave an advantage to consultancy L by cutting the cost of drawing up patent applications. As it inevitably entailed unfair distortion of competition in relation to other European patent attorneys, this was an undue advantage. The misuse of corporate assets was tantamount to unfair competition and thus represented a breach of the rules of professional conduct.

According to **D 1/18**, the requirement for a Disciplinary Committee decision to state which rule of professional conduct was violated and which recommendation, if any, was not observed (Art. 17 Additional Rules of Procedure of the epi Disciplinary Committee; see also Art. 15 Additional Rules of Procedure of the EPO Disciplinary Board and Art. 17 RPDBA) is not merely a formality. To the extent that disciplinary proceedings have similarities with criminal proceedings (see also **D 19/99**), this is an expression of the principle "nullum crimen sine lege". There is no room for issuing a penalty under Art. 4(1) RDR for generally violating the spirit, aim and purpose of the RDR or the epi Code of Conduct.

In **D 1/21**, the DBA concluded that the EPO Disciplinary Board had failed to provide any reason why the period of 9 months indicated in the decision under appeal was regarded as a necessary and appropriate as well as a sufficient penalty for the established failure to comply with the rules of professional conduct. The EPO Disciplinary Board had committed a fundamental procedural violation by ordering a penalty which had no legal basis in the pertinent provision of Art. 4 RDR. The board stated that Art. 4 RDR was the only basis for disciplinary measures for a professional representative who fails to comply with the rules of professional conduct.

In **D 1/20** (appeal by the epi President) a professional representative had used on their company's website the title "IP attorney" for not yet qualified employees (i.e. team members who had not yet passed the EQE or obtained any other professional qualification, and were therefore not entitled to represent clients independently). According

to the DBA, this constituted a statement which was "misleading to the public" within the meaning of Art. 1(1), second sentence, RDR and paragraph 3(b) of the epi Code of Conduct. For the infringement of these provisions and taking into account mitigating circumstances, the professional representative concerned was given a warning under Art. 4(a) RDR.

3.5. Appealability of decisions of the epi Disciplinary Committee

In **D 15/95** (OJ 1998, 297) the DBA ruled that a Disciplinary Committee decision dismissing a complaint was a decision in the legal sense only as regards the persons referred to in Art. 8(2) RDR, and only they could appeal against it. Thus the person who made the complaint had no right of appeal. Review on appeal was limited to safeguarding the rights of the "accused", i.e. the "professional representative concerned" within the meaning of the RDR (see also **D 1/98**). In **D 28/97** and **D 24/99** the DBA added that the purpose of disciplinary proceedings was not for individuals to pursue their interests vis-à-vis others (although these might be affected in individual cases) but rather to serve the public interest in orderly and proper exercise of professional representation before the EPO. Any claims by individuals arising from a representative's infringement of the rules of professional conduct were exclusively a matter for the competent (civil) courts (see also **D 25/05** and **D 3/13**).

In cases **D 1/18** and **D 2/18** the question arose whether a decision by the epi Disciplinary Committee to refer a matter to the EPO Disciplinary Board under Art. 6(2)(c) RDR is a final decision within the meaning of Art. 8(1) RDR and hence appealable to the DBA. In its two decisions **D 2/18** of 5 April 2019 (appeal by the epi President) and **D 2/18** of 8 April 2019 (appeal by the professional representative), the board answered this question in the affirmative based on the wording "final decision" in Art. 6(3) RDR. However, in **D 1/18**, a subsequent decision, the interpretation given in decisions **D 2/18** was not followed and the board held that only a decision which effectively terminates the disciplinary proceedings by a substantive decision vis-a-vis the professional representative is meant to be a "final decision" under Art. 8(1) RDR. The Disciplinary Committee's decision under Art. 6(2)(c) RDR to refer the complaint before it to the Disciplinary Board does not terminate first-instance proceedings, as it does not result in a dismissal of the complaint or a penalty under Art. 4(1) RDR. Rather, the proceedings continue before the other first-instance disciplinary body. The referral has only a procedural effect. It is thus not a final decision within the meaning of Art. 8(1) RDR and is not appealable. Subsequent decisions have endorsed the reasoning in **D 1/18** (see e.g. **D 1/19** of 13 December 2022, **D 18/19** of 22 November 2021 and **D 19/19** of 12 November 2021).

4. Code of Professional Conduct

The epi Code of Conduct (OJ 2022, A61) lays down the general principles of professional conduct. Paragraph 1(a) of the Code refers in turn, as regards the general requirements for epi members, to the RDR. According to **D 1/18**, the Code serves the interpretation of the rather generally formulated rules of professional conduct in the RDR (see Art. 1 to 3 RDR); in a decision of a disciplinary body established under Art. 5 RDR, the Code's provisions can only be invoked with a specific provision of the Regulation.

4.1. General professional obligations

Since national-phase-related activities were covered by Art. 1 RDR (see **D 16/95** in this chapter V.C.3.2), reprehensible conduct in connection with them constituted a breach of a representative's general professional obligations under that provision (see also **D 25/05**).

See also **D 1/20** reported in this chapter V.C.3.4 concerning a breach of paragraph 3(b) of the epi Code of Conduct (statement "misleading to the public").

4.2. Professional secrecy

In **D 11/91** (OJ 1994, 401), the appellant had requested the removal of various documents placed on file by the complainant. The appellant argued that his request was justified because, inter alia, their inclusion contravened the rule of confidentiality to which professional representatives were subject. The documents were items of correspondence between the complainant and the disciplinary bodies and correspondence pertaining to an opposition case.

The board decided that the professional secrecy referred to in Art. 2 RDR set limits on the disciplinary bodies' powers of investigation and on the obligation under Art. 18 RDR for a professional representative before the EPO to supply all relevant information. However, the mere obligation of confidentiality deriving from the principle enshrined in Part I RDR could not be invoked to resist a request under Art. 18 RDR.

5. Non-appealability of decisions of the Disciplinary Board of Appeal

In **D 5/82** (OJ 1983, 175) the DBA already noted that it has no power to refer questions to the Enlarged Board. See also e.g. **D 6/82** (OJ 1983, 337), **D 19/19** and **D 3/20**.

In **D 7/05** of 2 January 2007 and **D 2/06** of 31 August 2006 the DBA had to consider requests seeking a review of its final decisions. The board stated that decisions of the boards of appeal and the DBA became final when issued, and were no longer subject to appeal, nor could they be set aside by the board itself. It refused the requests as inadmissible, with reference to the principles set out by the Enlarged Board in **G 1/97** (OJ 2000, 322), according to which the decision on inadmissibility is to be issued by the board of appeal which took the decision forming the subject of the request for revision. The decision on the request could be issued immediately and without further procedural formalities.

VI. THE EPO ACTING AS A PCT AUTHORITY – EURO-PCT APPLICATIONS

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1. Introduction

The EPC provisions governing "international applications filed under the Patent Cooperation Treaty – Euro-PCT applications" are contained in Part X of the Convention (Art. 150 EPC to Art. 153 EPC) and Part IX of the Implementing Regulations (R. 157 EPC to R. 165 EPC). Pursuant to Art. 150(2) EPC, international applications filed under the PCT may be the subject of proceedings before the EPO. In such proceedings, the provisions of the PCT and its Regulations apply, supplemented by the provisions of the EPC. In case of conflict, the provisions of the PCT or its Regulations prevail. An international application for which the EPO is a designated Office (or, optionally, an elected Office), and which has been accorded an international filing date, is equivalent to a regular European application ("Euro-PCT application", Art. 153(2) EPC).

The Guidelines for Search and Examination at the EPO as PCT Authority (April 2025 version) set out the practice and procedures to be followed for international applications before the EPO in the course of the international phase, while Chapter E-IX of the Guidelines for Examination in the EPO (April 2025 version) focuses on aspects particular to the handling of Euro-PCT applications in the European phase.

2. Jurisdiction of the Boards of Appeal

The PCT does not expressly provide for appeal or petition during the international phase (see WIPO PCT Applicant's Guide – International Phase, para. 6.054). The sole exception under the EPC 1973 was the boards' competence to decide on protests against additional search or examination fees charged by the EPO acting as ISA (Art. 17(3)(a) PCT and

Art. 154(3) EPC 1973) or IPEA (Art. 34(3)(a) PCT and Art. 155(3) EPC 1973) after a finding of lack of unity of invention.

Thus, in **J 24/99** the Legal Board confirmed that, apart from protest cases for which the boards' responsibility explicitly derived from Art. 154(3) and 155(3) EPC 1973, the jurisdiction of the boards was limited by the EPC, in particular Art. 21 and 106 EPC, which do not confer any jurisdiction on them to review actions taken by the EPO as IPEA (see also **J 20/89**, OJ 1991, 375; **J 15/91**, OJ 1994, 296; **J 14/98**; **J 10/15**, **T 2948/18**). Decisions of the boards of appeal on protests under the former procedure are to be found in chapter II.B. "Unity of invention". The current protest procedure under R. 158(3) EPC and the preceding interim procedure are dealt with in chapter II.B.1.

A case in the same vein was **T 506/08**, in which the EPO, acting as ISA, had issued a declaration of non-establishment of the ISR under Art. 17(2)(a) PCT. The examining division did not carry out a further search on the amended application, which it subsequently refused for lack of inventive step. At the appeal stage the applicant filed a request for a (partial) refund of the international search fee. However, the board declined jurisdiction to deal with the request. The guarantee of due process of law (see **G 3/08**, OJ 2011, 10), as invoked by the appellant, did not mean that each and every claim against the EPO was a matter for the boards (e.g. **J 14/87**, OJ 1988, 295; with reference to Art. 9 EPC 1973).

Once a Euro-PCT application enters the regional phase before the EPO, the appeal procedures provided for under the EPC supplement the provisions of the PCT (**J 20/89**, OJ 1991, 375). See also in this chapter VI.3.

3. The EPO acting as designated or elected Office

Article 23(1) PCT provides that no designated Office is to process or examine the international application prior to the expiration of the time limit under Art. 22 PCT (**G 1/09**).

The EPO only becomes competent as European patent granting authority when the requirements for the entry into the European phase according to Art. 22(1) PCT are fulfilled or an express request for entry into the European phase pursuant to Art. 22(2) PCT has terminated the international phase of an international application. The time limit of 30 months according to Art. 22(1) PCT is extended to 31 months by virtue of R. 159(1) EPC (**J 18/09**).

3.1. Competence of the EPO as designated or elected Office

The EPO can be either a "designated Office" or an "elected Office" for an international application filed under the PCT that designates "EP" (Euro-PCT application). If an applicant enters the European phase without having requested international preliminary examination under PCT Chapter II, the EPO will act as a "designated Office". If, before entering the European phase, the application was processed under PCT Chapter II, the EPO will act in the European phase as an "elected Office". Pursuant to Art. 153(2) EPC,

an international application for which the EPO is a designated or elected Office is deemed to be a European patent application.

In **J 26/87** (OJ 1989, 329) the Legal Board held that if, on the proper interpretation of the request for grant of an international application, an applicant designated an EPC contracting state for which the PCT was in force on the filing date of the international application, the EPO was bound by the provisions of Art. 153 EPC 1973 to act as the designated Office for that contracting state, even if the international application had been published by the International Bureau without mentioning that contracting state as a designated state.

J 19/93 also concerned the designation of EPC contracting states in an international application for the purpose of obtaining a European patent. The Legal Board pointed out that the EPO as elected or designated Office was fully competent to interpret applications appointing it to act in these capacities. It was not bound by the interpretation of the receiving Office or of the International Bureau (see also **J 26/87**, **J 17/99**).

In **J 3/94** the Legal Board could not agree with the applicant's contention that the election of two EPC contracting states made the EPO an elected Office by operation of law. In the PCT request, the applicant had designated a European patent under "Regional Patent" and five PCT contracting states, including Germany and the United Kingdom, under "National Patent". However, in the demand for international preliminary examination, filed with the EPO as IPEA, only the five PCT contracting states were elected; under "Regional Patent" there was no cross indicating the European patent. The Legal Board held that the EPO did not become an elected Office in this case. One of the principles implemented by Art. 31(4)(a) PCT was that applicants could choose the office for which they intended to use the results of the international preliminary examination. Furthermore, it was not only a matter for the EPC to decide whether an election made for the national route was also valid for the EPO. The validity of an election had to be decided during the international phase in order to give effect to the election and, in particular, to the IPEA's duty of confidentiality (Art. 38 PCT).

As to whether the EPO had competence to interpret a declaration in the demand differently from the IPEA, the Legal Board in **J 4/94** observed that the interpretation of the demand was at the outset the task of the IPEA. However, this did not necessarily exclude an office alleged to be an elected Office from interpreting the demand as well. In the case in hand, there had been a formal deficiency in the demand (two EPC contracting states had been indicated as elected Offices in handwriting, next to the "EP" box). Instead of inviting the applicant to correct the deficiency, the IPEA had deleted the handwritten indication. A clear deviation by the IPEA from the intention expressed in the demand was not binding on the EPO. It was therefore possible for the EPO to regard itself as a validly elected Office.

3.2. Remedies under the PCT applied by the EPO as designated Office

3.2.1 Review (Article 25 PCT, Article 24(2) PCT)

Under Art. 25 PCT, the EPO may decide to allow an international application deemed to be withdrawn, or not accorded a filing date, to proceed as a European application. It must first decide whether the refusal, declaration or finding within the meaning of Art. 25(1) PCT was justified under the provisions of the PCT and its Regulations (Art. 25(2) PCT). If it finds that the refusal or declaration was the result of an error or omission on the part of the receiving Office or that the finding was the result of an error or omission on the part of the International Bureau, it must, as far as effects before the EPO as designated Office are concerned, treat the international application as if this error or omission had not occurred. To obtain such a review by the EPO as designated Office, applicants must observe the two-month time limit under R. 51.1 PCT.

Pursuant to Art. 24(2) PCT, the EPO as designated or elected Office may maintain the application as a European application even if this is not required by virtue of Art. 25(2) PCT (OJ 1984, 565). The filing of a request under Art. 24(2) PCT is governed by the same requirements as a request for review under Art. 25(2) PCT, with the exception that the two-month time limit under R. 51 PCT does not apply (**J 19/16**).

In exercising its discretion under Art. 24(2) PCT, a designated Office is not bound by the views or actions of any of the authorities involved in the patent application's international phase. On the contrary, when acting as designated Office, the EPO has to exercise that discretion in accordance with the same rules and principles it applies in identical or comparable situations concerning direct European applications. This non-discriminatory approach is not only a fundamental principle of the PCT itself (see, for example, Art. 26 and 48(2)(a) PCT) but also a direct consequence of Art. 150(3) EPC 1973 (**J 17/99**). See also **J 16/03**.

3.2.2 Opportunity to correct before designated Offices (Article 26 PCT)

In accordance with Art. 26 PCT, the EPO as designated Office must not reject an international application on the grounds of non-compliance with the requirements of the PCT and its Regulations without first giving the applicant the opportunity to correct that application to the extent and according to the procedure provided under the EPC for the same or comparable situations in respect of European patent applications.

In **J 8/01** the Legal Board held that the competence of the receiving Office under R. 91.1(e)(i) PCT did not exclude the application of Art. 26 PCT to allow for correction under regional law in proceedings before the EPO after entry of the application into the regional phase. See also **J 2/92**.

3.2.3 Excusing of delays in meeting time limits (Article 48 PCT, R. 82*bis* PCT)

Article 48(2)(a) PCT requires a contracting state to excuse, for reasons admitted under its national law, any delay in meeting any time limit. R. 82*bis*.2 PCT specifies that the

provisions of the national law referred to in Art. 48(2) PCT are those provisions which provide for reinstatement of rights, restoration, restitutio in integrum or further processing in spite of non-compliance with a time limit, and any other provision providing for the extension of time limits or for excusing delays in meeting time limits.

It thus follows from Art. 48(2)(a) PCT and R. 82*bis*.2 PCT that a Euro-PCT applicant who has not performed a certain procedural act within the time limit prescribed in the PCT can take advantage of the relevant provisions of the EPC on re-establishment of rights in all cases where "direct" European applicants may invoke them if they fail to observe the applicable time limit. For this reason, the provisions of Art. 122 EPC, which relate to the possibility of re-establishment of rights where a time limit has not been respected, should apply to Euro-PCT applicants to the same extent as they apply to direct European applicants (see decisions **G 3/91**, OJ 1993, 8, point 1.4 of the Reasons, and **G 5/93**, OJ 1994, 447, point 1.1.3 of the Reasons).

As illustrated in **J 13/16**, re-establishment of rights under Art. 122 EPC is ruled out in proceedings before the EPO in respect of the period under R. 49*ter*.2(b)(i) PCT for filing a request for restoration of a right of priority. The period for filing a request under Art. 122 EPC and R. 136 EPC for re-establishment of rights in respect of the priority period under Art. 87(1) EPC is directly comparable to the period for filing a request for restoration of the right of priority under R. 49*ter*.2 PCT, even if they differ in terms of duration. This means that, because re-establishment of rights is excluded under Art. 122(4) and R. 136(3) EPC for direct European applicants in the event of failure to observe the period for filing a request for re-establishment in respect of the priority period under R. 136(1), second sentence, EPC, Art. 48(2)(a) PCT does not oblige the EPO to give Euro-PCT applicants the possibility of re-establishing rights in respect of the period for filing a request for restoration of the right of priority under R. 49*ter*.2 PCT. See also **J 1/08**, **J 8/18** and **J 1/19**.

3.2.4 Rectification of errors made by the receiving Office or the International Bureau (Rule 82*ter* PCT)

The appeal in **J 3/00** concerned the question whether the Receiving Section should have rectified, under R. 82*ter* PCT, a purported error of the EPO acting as receiving Office (RO/EPO) for the purposes of the regional phase before the EPO. Specifically, the Legal Board examined whether the filing date of the international application was incorrect due to an error made by the RO/EPO which was such that, had it been made by the EPO (as designated Office) itself, it would have to be rectified under the EPC (R. 82*ter* PCT). The international application had been filed two days before expiry of the priority period with the description and claims in Swedish by mistake. The RO/EPO accorded as the international filing date the day of receipt of the corrected, i.e. English-language, documents (Art. 11(2)(b) PCT) and furthermore cancelled the priority claim. The applicant argued that the RO/EPO should have warned it of the deficiency. The Legal Board found that the protection of legitimate expectations required the EPO to warn the applicant of any loss of rights if such a warning could be expected in all good faith (**G 2/97**, OJ 1999, 123). As the two relevant conditions were met, i.e. the deficiency was immediately identifiable on the face of the application in the course of the Art. 11(1) PCT check and the applicant was in a position to correct it at very short notice, the Legal Board

decided that, as far as designations for the purpose of obtaining a European patent were concerned, the international filing date accorded by the RO/EPO had to be rectified under R. 82*ter* PCT.

For other cases relating to R. 82*ter* PCT, see **J 6/00** (against a decision of the examining division refusing a request that the withdrawal of the priority claims made in the international application be treated as having no effect for the EPO) and **J 10/04** (against a decision of the Receiving Section concerning the refusal of a request to correct the filing date and to recognise a US priority claim).

3.2.5 Restoration of the right of priority (Rule 49*ter* PCT)

In order to reflect the provisions of Art. 13(2) of the Patent Law Treaty (PLT) 2000 and of R. 14(4) and (5) of the Regulations of the PLT 2000, the possibility of requesting restoration of the priority right was introduced into the PCT (R. 49*ter*.2 PCT) and the possibility of requesting re-establishment of the priority right was introduced into the EPC (Art. 122 EPC and R. 136 EPC) for applicants who failed to comply with the priority period.

The Legal Board held in **J 13/16** that the remedy in R. 49*ter*.2 PCT was directly applicable to Euro-PCT applications in proceedings before the EPO acting as designated Office. If, in the international phase, a receiving Office had restored a right of priority under the "unintentional" criterion of R. 26*bis*.3(a)(ii) PCT, the restoration was not effective in proceedings before the EPO acting as designated Office, since the EPO applied only the "due care" criterion (R. 49*ter*.1(b) PCT). In such cases, within the period specified in R. 49*ter*.2(b)(i) PCT, the applicant had to file a (new) request for restoration of a right of priority under R. 49*ter*.2 PCT with the EPO acting as designated Office. For the purposes of R. 49*ter*.2 PCT, the request filed with the receiving Office under R. 26*bis*.3(b) PCT could not be taken into account in the proceedings before the EPO acting as designated Office. See also **J 17/16**, **J 10/17**, **J 8/18**, **J 1/19**, **J 8/21**, **J 14/21**.

A request for restoration of the right of priority as specified in R. 49*ter*.2 PCT is deemed not to have been filed if the applicable fee has not been paid within the relevant time limit (**J 8/18**, **J 1/19**).

In **J 14/21** the Legal Board referred to the Understanding adopted by the Assembly of the PCT Union (see PCT/A/34/6, Annex IV, point 8) which stated that "where ... the designated Office reinstates the rights of the applicant … in accordance with R. 49.6 or 76.5(ii) … such reinstatement will extend to ... the time limit under R. 49*ter*.2(b)(i)" and held that this PCT Understanding had to be taken into account when interpreting R. 49*ter*.2(b)(i) PCT, as it expressed the intention of the PCT legislator as an act of authentic interpretation (Art. 31 Vienna Convention). In the case in hand, the Legal Board found that the request for restoration of the right of priority by the designated Office, which had been filed on the same day as the timely request for further processing in respect of the 31-month period under R. 159(1) EPC, had been made in time. Furthermore, further processing and re-establishment of rights were excluded in respect of the time limit for requesting restoration of the right of priority before the designated Office, because a request for restoration of

rights as specified in R. 49*ter*.2 PCT was equivalent to, and identical in legal nature, to a request for re-establishment of rights under the EPC (**J 13/16**, **J 8/18**).

In accordance with its practice under Art. 122 EPC, the EPO applies the "due care" criterion for the purposes of R. 49*ter*.2(a) PCT (for recent decisions, see **J 8/21**, **J 14/21**). According to established case law, due care is considered to have been taken if non-compliance with the time limit results either from exceptional circumstances or from an isolated mistake within a normally satisfactory monitoring system. The party requesting re-establishment of rights bears the burden of proving that these requirements are met (see chapter III.E.5.2.).

4. Language of the proceedings

According to the Enlarged Board in **G 4/08** (OJ 2010, 572), if an international application has been filed and published under the PCT in one official language of the EPO, it is not possible, on entry into the European phase, to file a translation of the application into one of the other two EPO official languages, which would then become the language of the proceedings. Neither the EPC 1973 nor the EPC 2000 can be interpreted as allowing that. Nor is there any conflict between EPC and PCT provisions. EPO departments cannot use, in written proceedings on a European patent application or an international application in the regional phase, an EPO official language other than the language of proceedings used for the application under Art. 14(3) EPC.

5. Priority

The EPO is competent to assess whether a party is entitled to claim priority under Art. 87(1) EPC. There is a rebuttable presumption under the autonomous law of the EPC that the applicant claiming priority in accordance with Art. 88(1) EPC and the corresponding Implementing Regulations is entitled to claim priority. The rebuttable presumption also applies in situations where the European patent application derives from a PCT application and/or where the priority applicant(s) are not identical with the subsequent applicant(s). In a situation where a PCT application is jointly filed by parties A and B, (i) designating party A for one or more designated States and party B for one or more other designated States, and (ii) claiming priority from an earlier patent application designating party A as the applicant, the joint filing implies an agreement between parties A and B allowing party B to rely on the priority, unless there are substantial factual indications to the contrary (**G 1/22** and **G 2/22**).

VII. INSTITUTIONAL MATTERS

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1. Legal status of the EPO Boards of Appeal

1.1. The institutional structure of the European Patent Organisation

In **G 3/08** (OJ 2011, 10) the Enlarged Board held that the European Patent Organisation is an international, intergovernmental organisation, based on the separation of powers principle, which the sovereign contracting states have entrusted with the exercise of some of their national powers in the field of patents. The EPC assigns executive power to the Office to grant patents and to its President to manage the Office in organisational respects (Art. 4(3) and 10 EPC, see also **G 5/88** (OJ 1991, 137), while to the Administrative Council it assigns limited legislative powers restricted to lower-ranking rules (Art. 33 EPC), along with financial and supervisory powers. The boards of appeal, which in their decisions are bound only by the EPC (Art. 23(3) EPC), are assigned the role of an independent judiciary in this patent system (Art. 21 to 23 EPC; see also **G 6/95**, OJ 1996, 649, points 2 et seq. of the Reasons), even if they are not an independent organ of the European Patent Organisation (Art. 4(2) EPC) but departments of the Office (Art. 15 EPC; see also **R 19/12** of 25 April 2014 and **R 2/14** of 17 February 2015). The Enlarged Board further stated that the boards of appeal of the EPO, like the judiciary of any democratic entity based on the

separation of powers principle, guarantee the due process of law within the European Patent Organisation. They are also assigned interpretative supremacy with regard to the EPC in terms of its scope of application (see Art. 23(3) EPC). Under Art. 21(1) EPC they are responsible for reviewing decisions taken by the Office in grant and opposition proceedings. Their interpretation of the EPC is the basis for the practice established by the Office for the examination of patent applications and oppositions to granted patents.

At the 148th meeting of the Administrative Council of the European Patent Organisation (Munich, 29 and 30 June 2016), the Council approved the reform of the Boards of Appeal, see CA/43/16 rev. 1 of 30 June 2016 (Reform of the Boards of Appeal); CA/D 6/16 of 30 June 2016, OJ 2016, A100 (Decision of the Administrative Council of 30 June 2016 amending the Implementing Regulations to the European Patent Convention); CA/D 7/16 of 30 June 2016, OJ 2016, A101 (Decision of the Administrative Council setting up a Boards of Appeal Committee and adopting its Regulations). The aims of the reform were to strengthen the Boards of Appeal's organisational and managerial autonomy, and to increase their perceived independence and efficiency. There was no need to revise the EPC. Since entry into force of the reform, the Boards of Appeal and the Enlarged Board, including their registries and support services, have been organised as a separate unit and directed by the President of the Boards of Appeal.

The delegation of functions and powers from the President of the Office to the President of the Boards of Appeal is published in the Official Journal (OJ 2018, A63).

1.2. Authority to amend the RPBA

The RPBA and RPEBA are adopted in accordance with the Implementing Regulations (Art. 23(4) EPC). Since entry into force of the reform of the Boards of Appeal (see above), the Boards of Appeal Committee has been responsible under R. 12c EPC for issuing the RPBA and the RPEBA. Under R. 12b(3)(c) EPC, the Presidium of the Boards of Appeal advises the President of the Boards of Appeal on proposals for amending the RPBA and the RPEBA. The RPBA and RPEBA require the approval of the Administrative Council under Art. 23(4), second sentence, EPC (see the latest decision of the Administrative Council of 13 December 2023 approving amendments to the RPBA, OJ 2023, A103).

In **T 1400/11** the board pointed out that, to guarantee their judicial function, proceedings before the Boards of Appeal are governed by the RPBA.

In case **T 1914/12**, the board underlined that the RPBA can help in clarifying and interpreting the EPC but they cannot confer on the boards any powers that the EPC does not give them.

See also chapter V.A.1.2. "Rules of Procedure of the Boards of Appeal (RPBA)".

1.3. Boards of Appeal as judicial authorities

1.3.1 Courts of law under the EPC

In **G 1/86** (OJ 1987, 447) the Enlarged Board held that "those EPC provisions governing the independence of members of the Boards of Appeal (Art. 23 EPC), their competence and method of work and the nature of the decisions they take, indicate that the Boards act as courts with the task of ensuring that the law is respected when the EPC is applied. (...) Moreover, there is no appeal against decisions of the Boards of Appeal. In the Member States of the European Patent Organisation decisions by departments of last instance, i.e. those terminating proceedings concerned with checking the legality of administrative actions and the protection of the rights of the individual, can only be taken by courts of law."

Article 112a EPC, which has now been introduced at the suggestion of the Enlarged Board (**G 1/97**; OJ 2000, 322), is intended to provide limited judicial review of decisions of the boards of appeal and not to introduce a second judicial instance (**R 5/16**, point 7 of the Reasons) (see chapter V.B.3. "Petition for review under Article 112a EPC").

In **T 1400/11** the board stated that according to the Enlarged Board decisions in **G 7/91** and **G 8/91** (OJ 1993, 356 and 346, point 7 of the Reasons, and correction to **G 8/91**, OJ 1993, 478), **G 9/91** and **G 10/91** (OJ 1993, 408, 420, point 18 of the Reasons) and **G 1/99** (OJ 2001, 381, point 6.6 of the Reasons), the appeal procedure is to be considered as a judicial procedure proper to an administrative court. See also chapter V.A.1. "Legal character of appeal procedure".

In **G 2301/15** the Enlarged Board stated that the board members' function as judges was generally recognised. In decision **G 2301/16**, concerning the same case, the Enlarged Board saw the Office President's letter of 10 June 2016 as indirectly exerted pressure that undermined the principle of judicial independence enshrined in Art. 23(3) EPC. The Enlarged Board's judicial independence in deciding on this case had been fundamentally denied.

1.3.2 Boards of Appeal as judicial or quasi-judicial authorities according to national case law

In **J 3/95** (OJ 1997, 493) the Legal Board stated that the status of the Boards of Appeal had been addressed by the High Court of Justice in the United Kingdom (Patents Court) in R. v The Comptroller of Patents, Designs and Trade Marks ex parte Lenzing AG. The High Court held that "the final arbiter of revocation under the new legal system [of the EPC] is to be the Board of Appeal of the EPO". It further stated that "the UK and the other Member States have agreed at an international level via the EPC that the BoA is the final arbiter of oppositions. It is the agreed EPO equivalent of the House of Lords (now, the UK Supreme Court), Cour de Cassation or Bundesgerichtshof... Those who apply for patents in the EPO must accept the results of its findings and its methods of procedure". **J 3/95** also acknowledged that the Boards of Appeal constitute a specialised court exercising

judicial authority within the meaning of Art. 32 TRIPS (see OJ 1997, 493, point 6.3 of the Reasons; see also this chapter VII.1.3.4.).

In **R 1/10** the Enlarged Board affirmed that the Boards of Appeal were set up as required by the rule of law, and in particular affirmed their judicial independence. It pointed out that several high-ranking national courts of EPC contracting states (in particular, the UK's Patents Court and Germany's Federal Court of Justice (Bundesgerichtshof) and Federal Constitutional Court (Bundesverfassungsgericht)) had declared the Boards of Appeal to be independent courts based on the rule of law (see also **R 19/12** of 25 April 2014) and recognised their decisions as those of such a court which they took into consideration when developing their case law.

In ex parte case **T 1473/13**, the appellant justified its request in support of a stay of proceedings on the basis of a number of constitutional complaints pending before the German Federal Constitutional Court (FCC) (see 2 BvR 2480/10, 2 BvR 421/13, 2 BvR 756/16, 2 BvR 786/15) that were based on an accusation of insufficient judicial relief ("wegen unzureichenden Rechtsschutzes") at the EPO against a decision of the Boards of Appeal. As the board did not see itself in a position to find that the complaints were clearly inadmissible or devoid of any merit, it assessed whether there would be any adverse consequences of refusing a stay of the proceedings.

It initially found that decisions by the Boards of Appeal were, in principle, subject to review by the FCC but that so far there had been no FCC case law according to which an EPO decision had infringed the German Basic Law ("deutsches Grundgesetz").

The board considered that the appellant did not show that non-stay would cause a legal disadvantage for it in case of success of the constitutional complaints. It also noted that, if other boards adopted the same approach, the administration of justice by the boards might become severely hampered. Consequently, the request for a stay was refused. With regard to the functioning of the boards, the board also made reference to examples showing that board of appeal decisions were or are qualified as administrative rulings in jurisdictions other than that of the European Patent Organisation.

In its decision of 8 November 2022, the FCC rejected constitutional complaints 2 BvR 2480/10, 2 BvR 421/13, 2 BvR 756/16, 2 BvR 786/15 and 2 BvR 561/18. The appellants had not sufficiently substantiated that the organisation of the EPO's judicial system failed to provide the required minimum level of effective legal protection. Insofar as they criticised the institutional position of the Technical Boards of Appeal and the Enlarged Board within the European Patent Organisation's system of legal protection and the associated shortcomings with regard to the material and personal independence of their members, it does not appear to be ruled out that these were not guaranteed until the structural reform of 2016. However, these shortcomings had largely been remedied by the structural reform of 2016, which had unbundled the administrative and judicial functions and made the judicial function of the Boards of Appeal largely institutionally independent.

1.3.3 "Self-binding" of the Boards of Appeal as tribunals under Article 6 of the ECHR

According to the first sentence of Art. 6(1) of the ECHR, "[i]n the determination of his civil rights and obligations ... everyone is entitled to a fair and public hearing within a reasonable time by an independent and impartial tribunal established by law."

In **R 8/13** of 20 March 2015 the Enlarged Board stated that it was established case law of the Enlarged Board (**R 2/14** of 17 February 2015: and of the Boards of Appeal) that the EPC, which had been signed by contracting parties to the ECHR, must be applied in a way which supports the fundamental principles of Art. 6(1) ECHR (**G 1/05**, OJ 2007, 362, point 22 of the Reasons; **G 2/08**, OJ 2010, 456, point 3.3 of the Reasons). It further stated that the Enlarged Board fell within the definition laid down by the ECtHR in Campbell and Fell v. the United Kingdom (28 June 1984, No 7819/77, paragraph 76): "the word 'Tribunal' in Article 6 paragraph 1 is not necessarily to be understood as signifying a court of law of the classic kind, integrated within the standard judicial machinery of the country". A tribunal may, according to the ECtHR, also be set up to deal with specific subject-matter which can be appropriately administered outside the ordinary court system. What is important, to ensure compliance with Art. 6(1) ECHR, are the guarantees, both substantive and procedural, which are in place (ECtHR, Rolf Gustafson v. Sweden, 1 July 1997, No. 23196/94, paragraph 45).

In **R 1/16**, the Enlarged Board ruled that a complaint based on a breach of the right to a fair trial under Art. 6(1) ECHR, of the protection of legitimate expectations and of the judicial duty to direct the parties was inadmissible **as such** because those were not grounds included in the exhaustive list under Art. 112a(2) EPC in conjunction with R. 104 EPC.

As to the interpretation of the EPC in the light of the ECHR, see also chapter III.H.7.

1.3.4 Judicial or quasi-judicial authorities under the TRIPS Agreement

As to the significance of the TRIPS Agreement in proceedings before the EPO, see chapter III.H.6.

Article 62(5) TRIPS provides that final administrative decisions in procedures concerning the acquisition or maintenance of intellectual property rights and, where a member's law provides for such procedures, administrative revocation and inter partes procedures such as opposition, revocation and cancellation, must be subject to review by a **judicial or quasi-judicial** authority. Art. 32 TRIPS requires member countries to provide an opportunity for **judicial** review of any decision to revoke or forfeit a patent.

In **G 1/97** (OJ 2000, 322) the Enlarged Board noted that boards of appeal may be seen as having the status of judicial authorities, since they embody all the features of such an authority: in their decisions, the members of the boards are not bound by any instructions and are obliged to comply only with the provisions of the EPC (Art. 23(3) EPC 1973; see also **R 19/12** of 25 April 2014, where the Enlarged Board stressed that the Service Regulations for EPO employees provide in Art. 1(4) that they only apply to board members

in so far as they are not prejudicial to their independence); they are appointed for a fixed term, during which they may not be removed from office except if there are serious grounds for so doing (Art. 23(1) EPC 1973); the EPC contains provisions for safeguarding the impartiality of board members (Art. 24 EPC 1973); the boards always include at least one legally qualified member (Art. 21 EPC 1973); they have their own rules of procedure; and finally, they issue written decisions containing a statement of reasons (R. 66(2) EPC 1973 – R. 102 EPC). Regarding the judicial nature of the boards of appeal, reference was also made to the House of Lords' decision of 26 October 1995 in Merrel Dow v. Norton, [1996] R.P.C. 76, and to the decision of the United Kingdom High Court of Justice dated 20 December 1996, in the case of Lenzing AG's European Patent (UK), [1997] R.P.C., 245). The Enlarged Board added that, even if the status of a judicial authority were to be contested, it would be clear that, in the light of the foregoing, the boards of appeal constitute at least a quasi-judicial authority as referred to in Art. 62(5) TRIPS.

The Enlarged Board also examined the relationship between Art. 62(5) TRIPS and Art. 32 TRIPS and found in application of the principle of lex specialis derogat legi generali that Art. 62(5) TRIPS takes precedence over Art. 32 TRIPS in matters relating to the grant of European patents (see also **J 3/98**).

In **T 557/94** the appellant (patentee) referred to Art. 32 TRIPS, which guarantees an opportunity for judicial review of any decision to revoke a patent, and requested that the case be remitted to the department of first instance if the patent were revoked on the basis of a prior art document introduced during appeal proceedings. The board found that, under Art. 111(1), second sentence, EPC 1973, the board of appeal was empowered either to decide on the merits of the case **or** to remit the case; it was not restricted to the latter alternative if the opposition division maintained the patent and the board was considering revoking the patent for the first time (see chapter V.A.9. "Remittal to the department of first instance"). Reading Art. 32 TRIPS in the context of the usual structure of judicial review in the EPC contracting states and the EPC 1973 itself, this provision guaranteed an instance for judicial review in revocation proceedings, but did not oblige the reviewing instance to remit the case to the department of first instance for continuation of proceedings when revocation was being considered by the reviewing instance for the first time.

1.3.5 Not a court or tribunal of an EU Member State

In case **T 276/99**, the board noted that **referrals** to the Court of Justice of the European Communities (CJEC; Court of Justice of the European Union – CJEU since 1 December 2009) were governed by the requirements of Art. 234 of the EC Treaty (Art. 267 of the Treaty on the Functioning of the EU (TFEU) since 1 December 2009. The board pointed out that, prima facie, as the EPO Boards of Appeal were not a court or tribunal of an EU Member State, they did not have the status to refer a question to the CJEC.

In **G 2/06** (OJ 2009, 306) the appellant had requested a referral of questions to the CJEC on the argument that, since R. 28(c) EPC repeats the wording of Art. 6(2)(c) of Directive 98/44/EC (Biotech Directive), the Enlarged Board in interpreting R. 28(c) EPC was interpreting EU law and, as a court of a contracting state, was obliged to make a referral to the CJEC. The request was rejected as inadmissible. The Enlarged Board made

it clear that neither the EPC nor the Implementing Regulations thereto contain any provision for a referral by any instance of the EPO of questions of law to the CJEC. The Boards of Appeal are a creation of the EPC, and their powers are limited to those given in the EPC. Art. 234 of the EC Treaty (Art. 267 TFEU since 1 December 2009)gives the CJEC jurisdiction to give preliminary rulings concerning the interpretation of acts of the institutions of the European Community, such as the Directive, but in the view of the Enlarged Board does not appear to provide any basis for a board of appeal of the EPO to request the CJEC to give a ruling on any questions before a board of appeal. Art. 234 EC Treaty (Art. 267 TFEU since 1 December 2009) requires the question to be raised in a case pending before a court or tribunal of an EU member state. The Enlarged Board pointed out that, although the EPO's Boards of Appeal have been recognised as courts or tribunals, they are not courts or tribunals of an EU member state, but of an international organisation whose contracting states do not all belong to the EU. The seat of the EPO Boards of Appeal in an EU member state, Germany, does nothing to alter their status as part of an international organisation with jurisdiction conferred under the EPC. The Boards of Appeal are not and have never been treated as courts or tribunals of their host country.

In **R 1/10**, the Enlarged Board stated that a CJEU finding that the Boards of Appeal lacked the independence required of a judicial body adhering to the rule of law would not be binding on the boards. This is because the EPC is not part of EU legislation but, together with the European Patent Organisation, is a subject of international law which is autonomous and inherently independent of the EU and whose members do indeed include all EU Member States but also non-EU states.

1.4. Relationship with the law of the European Union and with CJEU case law

In **G 3/19** (OJ 2020, A119), the board concluded that the legally effective and binding interpretation of Union law, whether provisions of primary law, e.g. the treaties, or of secondary law, e.g. regulations and directives, lay within the exclusive competence of the CJEU. Irrespective of this, as an independent international organisation with its own autonomous legal order, the European Patent Organisation was not directly bound by Union law. It was therefore all the more true that a legally non-binding notice on the interpretation of the Biotech Directive issued by the EU Commission in reaction to decisions of the Enlarged Board on the interpretation of a provision of the EPC, i.e. Art. 53(b) EPC, did not form part of EPC law.

See also chapter III.H. "Interpretation of the EPC".

1.5. Nature of the case law of the Boards of Appeal – no binding precedents

With regard to its decisions in petitions for review cases, the Enlarged Board stated in **R 14/11** that, like boards of appeal decisions, these review decisions do not have the legal nature of creating a precedent in the sense that it would have to show in which respect a later decision differs from an earlier one in order for that later decision to be legally justified. Referring to **R 11/08** the Enlarged Board explained that such differences are normal and that the usefulness of case law is not confined to similar or identical facts but lies in the

principles or guidance (such as interpretation of legislative provisions) which, whether the facts are similar or not, can be extracted from earlier cases.

In **G 3/19** (OJ 2020, A119) the Enlarged Board stated that a particular interpretation which has been given to a legal provision can never be taken as carved in stone, because the meaning of the provision may change or evolve over time. This aspect is intrinsic to the ongoing development of the law by way of judicial decision-making, and, in the context of the jurisprudence of the boards of appeal, is reflected in Art. 21 RPBA, which requires a board of appeal to make a referral to the Enlarged Board if it intends to deviate from an earlier decision or opinion of the Enlarged Board. Such a new referral would be pointless if there was no possibility, not even a theoretical one, that the Enlarged Board would revise its previous ruling on the point of law in question.

In **T 844/18** the board observed regarding the interpretation of "any person" (Paris Convention) that there was no case law, either of the EPO or of national tribunals, that clearly and unambiguously adopted the interpretation proposed by the appellants. In general, the bar for **overturning long-established case law and practice** should be a high one because of the disruptive effects a change may have. The board noted that the appellants were faced with over one hundred years of consistent case law and practice adopting the "all applicants" approach that they needed to show as incorrect. This was a considerable burden (point 53 of the Reasons). The continuation of such long-standing and rationally based practices could be considered **an aspect of legal certainty** (point 86 of the Reasons).

1.6. Significance of national law and national case law for the Boards of Appeal

1.6.1 In principle no binding effect – strive for harmonisation

Proceedings before the boards are independent and decisions of national courts are not binding in law. This does not, however, preclude a degree of interaction between national judicial systems and the European system, particularly with a view to developing harmonious European case law (see **R 21/09**, point 2.4 of the Reasons, which is very detailed in this respect, and, as examples of decisions dealing with the relationship between national case law and board decisions, **T 1904/12**, **T 885/02**, **T 202/13**, **T 231/13**, **T 488/16**, **T 926/20**).

Case **T 2220/14** recalled the relationship between national decisions and procedures before the boards of appeal. In the latter questions of patentability are to be decided solely in accordance with the EPC. As regards decisions made on patentability in contracting states to the EPC, these are not to be cited as if they were binding upon the boards of appeal, and claims should not be refused because their patentability cannot be upheld under the jurisdiction of one member state (**T 452/91**). Such considerations also apply to decisions of courts of non-member states such as the USA (point 16 of the Reasons).

In **G 5/83** (OJ 1985, 64) the Enlarged Board pointed out that in the interpretation of international treaties, which provide the legal basis for the rights and duties of individuals and corporate bodies, it is necessary to pay attention to questions of harmonisation of

national and international rules of law. This aspect of interpretation is particularly important where, as is the case with European patent law, provisions of an international treaty have been taken over into national legislation. The establishment of harmonised patent legislation in the contracting states must necessarily be accompanied by harmonised interpretation. For this reason, it is incumbent upon the EPO, and particularly its Boards of Appeal, to take into consideration the decisions and expressions of opinion of courts and industrial property offices in the contracting states (point 6 of the Reasons).

For certain (mostly procedural) sub-issues, however, national law is to be consulted.

In **G 1/13** (OJ 2015, A42), for instance, the Enlarged Board stated that legal entities such as companies exist only by virtue of the national legal system which governs their incorporation, subsequent existence and cessation. When determining whether a legal entity exists or has ceased to exist, and has capacity to act, the starting point should be the clearly established principle under the EPC that national law should be referred to (points 5.1 and 6 of the Reasons). The Enlarged Board qualified this by stating that there are limits on the extent to which the EPO should follow national law. For example, a provision of national law which conferred on a company procedural rights which were contrary to the EPC could not be acknowledged by the EPO.

According to **J 14/19**, the question of when proceedings became pending was to be assessed, in relation to R. 14 EPC, under the (national) procedural law of the state in question. Where the EPO was called on to apply foreign law (here: German law), it had, according to the Legal Board, to do so within the overall context of the foreign legal system, wherever possible. As an international organisation independent of state authorities and courts, the EPO was not bound by the case law of national courts when interpreting the foreign law to be applied but, if aware of such case law, in particular of the highest national courts, it should nevertheless consider and evaluate it in coming to its decision. Since legal commentaries were not official publications and did not form part either of the law created by legislation or of the case law, they were not in themselves to be taken into account when applying foreign law.

As to the binding effect of national decisions, see also chapter III.H.8.2. "National decisions: no binding effect on the boards of appeal".

1.6.2 Binding nature of national decisions in relation to procedures under Article 61(1) EPC

In **J 14/19** the Legal Board noted that, in accordance with Art. 9(2) of the Protocol on Recognition, the jurisdiction of the (national) court whose decision on the right to the grant of a European patent was to be recognised, and the validity of such decision, could not be reviewed. Although primarily addressing the contracting states of the EPC, the Protocol on Recognition was an integral part of the EPC according to Art. 164(1) EPC and thus also binding on the EPO (see **J 36/97** and, for the duty to recognise, R. 16(2) EPC). The Legal Board also made reference to **G 3/92**, in which the Enlarged Board stated that substantive examination of a claim was the preserve of the national court under the Protocol on Recognition and the EPO had no authority in this regard.

In **G 1/22** (OJ 2024, A50) the Enlarged Board confirmed that the EPO has no power to decide a dispute as to whether a particular applicant is legally entitled to apply for and be granted a European patent in respect of the subject-matter of a particular application. The determination of questions of entitlement to the right to the grant of a European patent prior to grant is governed by the "Protocol of Recognition".

1.7. Competency of the EPO to assess priority entitlement

In **G 1/22** (OJ 2024, A50) the Enlarged Board noted that a strict distinction should be made between the title to the subsequent application and the right to claim the priority date for that application. It held that Art. 60(3) EPC does not apply to the right of priority referred to in Art. 87(1) EPC, neither directly nor by analogy. The Enlarged Board concluded that the EPO is competent to assess priority entitlement and that this assessment should be made under the autonomous law of the EPC. Acknowledging the EPO's competence to assess priority entitlement also respected the argument that the EPO, in view of Art. 87(1) EPC, has to assess all aspects of the right of priority. If all four requirements underlying Art. 87(1) EPC are assessed by the EPO, the EPO is competent for all aspects that may be relevant to determine the prior art, enabling it to assess all aspects of patentability. According to the Enlarged Board, there is a rebuttable presumption under the autonomous law of the EPC that the applicant claiming priority in accordance with Art. 88(1) EPC is entitled. As to the competency of the EPO to assess priority entitlement, see also chapter II.D.2.2.

2. Extension agreements and ordinances

2.1. Legal nature

An extension agreement is an international treaty between the European Patent Organisation and an extension state which the President of the EPO is authorised by the Administrative Council to conclude with the Council's approval (Art. 33(4) EPC). Such an agreement serves the interests not only of applicants, by providing a simple route to patent protection in the extension states, but also those of the extension state, by enabling it to offer patent protection for its territory by extending the effects of European and Euro-PCT applications and patents (**J 9/04**; see also **J 2/05**, **J 14/00**, OJ 2002, 432).

In **T 7/07** the board stated that according to the "Basic principles" set out in OJ 1994, 75, the extension system provided European patent applicants with a simple and cost-effective way of obtaining protection in the extension state. It largely corresponds to the EPC system operating in the EPC contracting states, except that it is not based on direct application of the EPC but on national law modelled on the EPC. The national law of the extension state governs the proceedings and the legal effects of the extension.

In **J 9/04** the Legal Board noted that, as bilateral ordinances, the Extension Ordinances essentially deal – exhaustively and strictly separately from the Convention – with matters pertaining to the integration of extended European applications and protective rights into the respective national law and their relationship to national applications and rights. This includes, in particular, the conferral of the same effects on extended applications and

patents as on national ones, the obligation to provide the national patent offices with a translation of the claims into the respective language, the national authentic text of extended applications and patents, their prior-art effect with respect to national applications and patents, and, finally, simultaneous protection. According to the board, none of these provisions give rise to any obligations on the part of the EPO. The EPO merely undertakes vis-à-vis the national patent authorities to assist with the administrative tasks associated with the extension of European patents.

2.2. No jurisdiction of the Boards of Appeal

In **J 22/10** the Legal Board stated that decisions taken by the EPO when carrying out its obligations under the co-operation agreements with certain states extending the protection conferred by European patents (extension agreements) were based not on the EPC itself but solely on the co-operation agreements between the European Patent Organisation and the extension states; it therefore rejected the respective appeals as inadmissible (see **J 14/00**, OJ 2002, 432; **J 19/00**; **J 9/04** of 1 March 2005; **J 2/05**; **J 4/05**). Any decisions based on such international treaties did not fall within the scope of the EPC and, as a result of this, were not subject to the jurisdiction of the boards of appeal. The extension agreements made it absolutely clear that references to provisions of the EPC were exhaustive and, thus, that there could be no corresponding application of other provisions, including those of Art. 106 EPC concerning the appeals procedure. In other words, the Legal Board was not competent to decide a case that was governed solely by a "foreign" legal system.

In **J 14/00** (OJ 2002, 432) the Legal Board decided on the admissibility of an appeal directed against a letter issued by an EPO formalities officer in application of the EPC 1973 in relation to the Extension Ordinance (OJ 1994, 75) associated with the Extension Agreement with the Republic of Slovenia. It held that, according to the exhaustive provision in Art. 106(1) EPC 1973, only those decisions of the EPO could be contested which were taken, within the framework of their duties under the EPC 1973, by the departments listed therein. This was not the case for decisions taken by the EPO when carrying out its obligations under the Extension Agreement. The Legal Board found that there was no basis in the structure or legal nature of the Extension Ordinance for the appealability of a letter issued by an EPO formalities officer. The board held that the extension procedure generated legal effects exclusively on the basis of Slovenian national law. The Extension Ordinance thus made it absolutely clear that its references to provisions of the EPC 1973 were exhaustive and that there was no question of any corresponding application of other provisions, including those of Art. 106 EPC 1973 on the appeals procedure.

As to the role of the national jurisdictions, see also **J 9/04** in this chapter, VII.2.1. (previous section).

2.3. Non-applicability of Article 105(1)(a) EPC

In **T 1196/08** an assumed infringer intervened under Art. 105(1)(a) EPC and claimed that the Romanian patent resulting from the extension of a European patent had to be seen as a European patent granted under the EPC. The board did not agree. The term "the same

patent" in Art. 105(1)(a) EPC meant a European patent within the meaning of Art. 2(1) EPC 1973. While there were certain parallels between the extension system and the European patent system, fundamental differences still existed. The extension system, including all the conditions and legal effects of extension, was based exclusively on the application of national law unless express reference was made to the EPC. By contrast, the European patent system and the effects of a European patent in the contracting states relied solely on the direct application of the EPC, even if certain provisions of the EPC referred to national law. The board concluded that a patent extended to the territory of an extension state was not a European patent within the meaning of Art. 2(1) EPC 1973. Furthermore, the Romanian extension ordinance did not refer to Art. 105 EPC. The references in the Romanian extension ordinance to the provisions of the EPC being exhaustive, there could be no question of applying Art. 105 EPC by analogy.

3. Legal status of the President of the EPO

According to Art. 10(1) EPC the EPO is managed by the President, who is responsible for its activities to the Administrative Council. To this end, Art. 10(2)(a) EPC empowers and requires the President to "take all necessary steps to ensure the functioning of the European Patent Office". According to Art. 5(3) EPC, the President shall represent the European Patent Organisation. In **G 8/88** (relating to an Administrative Agreement between the Presidents of the German Patent Office (as it was at the time, now German Patent and Trade Mark Office) and the EPO); OJ 1991, 137) the Enlarged Board found that the capacity to represent the European Patent Organisation by virtue of Art. 5(3) EPC 1973 is one of the President's defining functions but does not give him or her any power extending beyond representation of the Organisation. The President may only represent the Organisation by performing a legal act, such as the signing of an agreement, provided he or she has the power to perform that act. The extent of the President's power to act in directing the EPO is derived from and governed by Art. 10 EPC 1973. "Art. 10(2) EPC 1973 contains a list of the President's particular functions and powers, which (…) are essentially concerned with internal matters of the EPO. The extent to which, under Art. 10 EPC 1973, the President can lawfully "direct the EPO" concerning any external activity without the supervision of the Administrative Council in accordance with Art. 4(3) EPC 1973, insofar as such external activity is not directly related to the President's particular functions and powers listed in Art. 10(2) EPC 1973, is not specifically defined by the EPC, and is therefore a matter of interpretation". See also **G 5/88**, **G 7/88**.